

# *Collegio Italiano dei Consulenti in Proprietà Industriale*

---

## **One Year of UPC**

---

Gualtiero Dragotti

June 2024



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION  
VON PATENTANWÄLTEN

# PRELIMINARY REMARKS



## One-year old baby

- It walks! \_\_\_\_\_
- Still confused \_\_\_\_\_
- Smiles \_\_\_\_\_
- How clever! \_\_\_\_\_
- Be careful! \_\_\_\_\_
- *It works*
- *CMS – Room for improvement*
- *Cooperation and support by the court*
- *Quality of decisions*
- *Fast, not the fastest*
- Balance of work
  - Enter Milan
  - Enter time
- Language



# COMPETENCE OF THE UPC



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE  
INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS  
INTERNATIONALE FEDERATION  
VON PATENTANWÄLTEN

## Multiple defendants

**CD Paris - ORD\_18817/2024, 11 April 2024**

***ICPillar v. ARM***

- In the case of multiple defendants, if one of the defendants has its residence within the territory of the Local Division seized, Article 33(1)(b) UPCA must be applied, regardless of whether the other defendants are based inside or outside the Contracting Member States or inside or outside the EU.
- Hence the only requirements to be met are: 1) the multiple defendants have a commercial relationship, 2) the action relates to the same alleged infringement.
- The requirement of a “commercial relationship” implies a “certain quality and intensity”. However, to avoid multiple actions and the risk of irreconcilable decisions from separate proceedings, and to comply with the main principle of efficiency within the UPC, the interpretation of the link between the defendants should not be too narrow.
- The fact of belonging to the same group (legal entities) and having related commercial activities aimed at the same purpose (such as R&D, manufacturing, sale and distribution of the same products) is sufficient to be considered as “a commercial relationship”.

# CLAIM CONSTRUCTION



## **LD Dusseldorf, ORD\_592936/2023**

***Ortovox Sportartikel GmbH v Mammut Sports Group AG et al.***

Claim construction I - December 11, 2023

File history: Art. 24 (1)(c) UPCA, Art. 69 EPC

### **Art. 24(1)(c) UPCA**

When hearing a case brought before it under this agreement, the court shall base its decisions on the European Patent Convention (EPC)

### **Art. 69 EPC**

The extent of protection conferred by a European patent or a European patent application shall be determined by the claims. Art. 69 EPC is conclusive with respect to the material that can be used for claim construction

## **German approach**

“ [...] The grant file must in principle not be taken into account for the interpretation of the patent. [...] Simple statements made during the granting procedure initially have no significance in terms of limiting the scope of protection. At most, they may have an indicative meaning as to how the person skilled in the art may understand the feature in question. ”



## LD Munich, ORD\_596193/2023

### SES-imagotag SA v Hanshow Technology Co. Ltd et al.

Claim construction II - December 20, 2023

Claim construction is the process by which a court determines the scope and meaning of a patent's claims

The Munich Local Division concluded that *"the original version of the claim of a European patent may be used as an aid for claim construction in connection with changes made to the version of the claim during the grant procedure"*

It further clarified that the defendants' costs for depositing protective letters at the UPC must be reimbursed as part of the costs in the proceedings for preliminary measures when the later filed application was unsuccessful.

The decision has been appealed by the patent holder. The appeal has been rejected (Case: UPC\_CoA\_1/2024 Order/decision: ORD\_17447/2024 of 13 May 2024)





# **Court of Appeal, ORD\_6653/2024**

## ***Nanostring v. 10x Genomics***

Claim construction III - 26 February 2024

Art. 69 EPC + Protocol

### The role of description and drawings

1. Explanatory aids for the interpretation on of the patent claim and not only to resolve ambiguities.
2. Adequate protection for the patent proprietor with sufficient legal certainty for third parties.

### Infringement and Validity

1. Same principles
2. Problem-solution approach as a possible option

### Sufficient degree of certainty (R. 211.2 RoP)

1. Balance of probabilities
2. More likely than not

### The distribution of burden of proof



# PARALLEL ACTIONS



## CD Paris, ORD\_578356/2023

### *Edwards Lifesciences Corporation v Meril Italy*

“Same parties” (Art. 33 (4) UPCA)

#### **Art. 46, 47 UPCA**

*„legal person entitled to initiate proceedings in accordance with national law“*

Narrow interpretation of Art. 33 (4) UPCA „same parties“

*„identical and indissociable“* interests doesn't matter

#### **„Strawman“**

Fully-owned company is not a strawman of parent unless legal activity produces effect in favor of parent

UPCA allows for parallel invalidity attacks Local division has the possibility (or needs to (?)) to stay the case pursuant to R 295 (m) RoP

# ORDER TO PRESERVE EVIDENCE (SAISIE)



## The Milan Local Division experience

ORD\_576298/2023 and ORD\_500982/2023

- The Saisie tradition: Article 60 UPCA (Rule 192-199 RoP) and the corresponding Italian (and French) provisions
- **Urgency and extreme urgency: click carefully**
  - a. Standing judge (Paris) -> Presiding judge (Milan) -> Single judge (Milan)
  - b. One-day travel
  - c. The language issue



# Saisie order: First analysis

## Jurisdiction

- Article 33.1(a) UPCA
- Exhibition amounts to threatened infringement

## Validity and infringement

- No opposition
- No protective letter
- Technical opinion (the traditional Italian approach)
- Balancing positions – the order to preserve evidence as low-impact measure

## Execution

- The national way – bailiff and technical expert (Rule 196.5 RoP – Impartiality)
- Confidentiality measures (Attendance of the parties and Rule 196.2 RoP)
- No security

## Service of the order

- Service by alternative method
- Rule 276 RoP – national way

## Side issues

- Technical expert registration with the CMS
- Filing documents and fees request
- Expedite decision (1-2 days)

## **LD Paris, ORD\_587064/2023**

### ***C-Kore Systems Limited v Novawell***

#### **Requirements R. 194.2 RoP**

1. Urgency: Competitive market (only a few players), product was exhibited at a trade fair, less than three months to file the application is a reasonable delay for the standard procedure (instead of the urgent procedure)
2. Without hearing defendants: Various projects outside the jurisdiction of the UPC, product easily transportable, digital data can be hidden or erased. This indicates high risk of destruction of evidence

Balance of interests: Applicant is a small enterprise and patent its most successful product, defendant intends to expand worldwide. Leads to threat of definitive destruction of evidence prevails

Request granted and executed in accordance with national (French) law

Security deposit of EUR20,000

Essentially in line with decisions of LD Milan

Appointment of an expert alongside the bailiff in charge of drafting the report of the saisie to the court + confidentiality authorized persons to protect evidence collected from business secret leaks

Appointment of one plaintiff representative to be present during the saisie (contrary to French practice)



# ACCESS TO COURT FILE AND DOCUMENTS



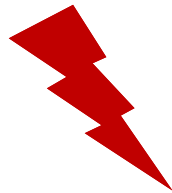


## File inspection requests - R. 262.1 (b) RoP

CD Munich: Concrete and verifiable, legitimate reason required - difference to R. 262.1 (a) RoP

### CD Munich, ORD\_552745/2023:

- To be informed of the proceedings for the purposes of education and training is not a legitimate reason
- It is also not sufficiently concrete and verifiable to be used as a measure to weigh against the interest in denying access



Nordic Baltic RD: Application with a credible justification for access shall be approved - weighing with interest in confidentiality

### RD Nordic Baltic, ORD\_543819/2023:

- Written procedure of the Court shall, in principle, be open to the public unless the Court decides to make it confidential
- Interest in how the claim was filed in a new court system is a credible explanation, as no request for confidentiality was made

**Decision of the Luxembourg Court of Appeal pending**

LD Milan: Application must be submitted by a third party

### LD Milan, ORD\_569313/2023:

- A lawyer who is authorized to access files, but not to represent or defend, is not a third party
- Assertion of a precise, concrete, and current reason for access to the file other than the interest of the parties
- It is not sufficient to apply only to have a longer defense preparation time

# The Court of appeal position

## Court of Appeal - ORD\_19369/2024, 10 April 2024

### *Ocado v. Autostore*

- When a request to make written pleadings and evidence available to a member of the public is made pursuant to R.262.1(b) RoP, the interests of a member of the public of getting access to the written pleadings and evidence must be weighed against the interests mentioned in Art. 45 UPCA.
- These interests include the protection of confidential information and personal data ('the interest of one of the parties or other affected persons') but are not limited thereto. The general interest of justice and public order also have to be taken into account. The general interest of justice includes the protection of the integrity of proceedings.
- Art. 9(1) UPCA must be interpreted such that if the subject matter of the appeal proceedings is of a non-technical nature only, and there are no technical issues at stake, the Court of Appeal may decide the matter without the need to assign two technically qualified judges to its panel of three legally qualified judges.

# PRELIMINARY INJUNCTIONS



## **“Sufficient degree of certainty”(R 211 No. 2 RoP)**

Predominant likelihood that  
patent is infringed and valid  
(i.e. 50+x %)  
Preliminarily confirmed by  
Court of Appeal

Doubts in some aspects can be  
compensated by high  
assurance in other aspects

The more likely the patent has  
been infringed and is valid the  
more a PI is justified

# LANGUAGE



## Language of the proceedings

**Court of Appeal, ORD\_18194/2024, 17 April 2024**  
***Curio Bioscience Inc. v. 10x Genomics, Inc.***

When deciding on a request to change the language of proceedings into the language of the patent on grounds of fairness, all relevant circumstances shall be taken into account. Relevant circumstances should primarily be related to the specific case and the position of the parties, in particular the position of the defendant. If the outcome of balancing of interests is equal, the position of the defendant is the decisive factor

# PENALTY AND ENFORCEMENT



## Penalty payments

LD Munich, ORD\_ 577241/2023, 2 December 2023, LD Dusseldorf, ORD\_557761/2023

### Factors

- Importance of injunction
- Interest in enforcement
- Type, scope and duration of infringement
- Degree of fault/negligence
- Advantage from infringing act
- Risk of future infringements

### Penalties granted (examples)

- LD Dusseldorf
  - a. EUR 1000 (continued stand operation)
  - b. EUR 500 (delayed deletion of Instagram account)
  - c. EUR 25.000 (presentation of E-bike)
- LD Munich
  - EUR 100.000 (continued infringement in several instances)



# General enforcement principles

Art. 82 UPCA, R 354 RoP

1

Orders directly enforceable in participating Member States

2

Claimant needs to notify UPC which part of the order should be enforced

3

Certified translation of order and notification in office language of Contracting Member State

4

Service of order, notification and - where applicable - of certified translations by Registry

# DIRECT EXPERIENCES



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE  
INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS  
INTERNATIONALE FEDERATION  
VON PATENTANWÄLTEN

## **Paris Central Division, Order no. 597664/2023; Neo v. Toyota**

---

- Opt-out application filed by only one proprietor
- Art. 83(3) UPCA - *Unless an action has already been brought before the Court, a proprietor of or an applicant for a European patent granted or applied for prior to the end of the transitional period (...), shall have the possibility to opt out from the exclusive competence of the Court. To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period. The opt-out shall take effect upon its entry into the register*
- R.5.1(a) RoP first sentence - *Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out.*
- UPCA prevails on RoP
- Opt out is an option vis-à-vis the default position provided by the UPCA

*“To conclude, in view of its meaning and purpose, Art. 83(3) UPCA must be interpreted such that a valid opt out application requires that it is lodged by or on behalf of all proprietors of all national parts of a European patent. Rule 5.1(a) RoP is in conformity therewith.”*

**Decision confirmed by Court of Appeal, ORD\_30505/2024, 4 June 2024**

## **Munich LD, ORD\_598328/2023, 21 May 2024, Dyson v. SharkNinja**

### **Urgency (R 209.2(b) RoP) and unreasonable delay (R 211.4 RoP)**

In the case of a suspected infringement in two or more countries, in view of the necessary prior examination of whether the defendants' embodiments actually make use of the teaching of the patent in suit and whether legal action will also be possible with any prospect of success, as well as in view of the corresponding serious preparation of the proceedings, it cannot normally be concluded that an unreasonably long wait was made if the application for interim measures was filed within two months.

### **Interpretation of claims**

The principles established by the Court of Appeal in UPC\_CoA\_335/2023 must be applied when interpreting the patent or certain features in the patent claim. This applies equally to the assessment of infringement and the legal validity of a European patent.

### **Invalidity**

Due to the summary nature of the examination of legal validity in proceedings for the adoption of interim measures, it is not possible to consider a full examination of all legal validity defences as in nullity proceedings. Rather, the number of arguments raised against the legal validity must generally be reduced to the best three from the defendant's point of view.



## Resources

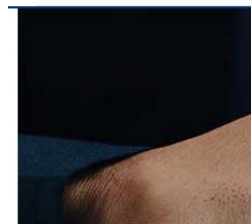
<https://www.unified-patent-court.org/en/decisions-and-orders>

<https://patentblog.kluweriplaw.com/category/upc/>

<https://www.dlapiper.com/it-it/insights/publications/upc-le-novita-della-settimana>



Home Court ▼ Register Kluwer Patent Blog



[Home](#)

### UPC

The Unified Patent Court (UPC) is a planned future court common to EU Member States which pa Unitary Patent system, and it will be part of their judicial system. After a transitional period of 7 most, it will have exclusive competence in respect of traditional European patents and European effect (Unitary Patents). The UPC is based on the Unified Patent Court Agreement. The Unitary Pa are planned to start functioning once certain ratification conditions have been fulfilled.

#### UPC: Another preliminary injunction for 10x Genomics

Jonathan Santman (Brinkhof) / June 7, 2024 / Leave a comment

On 30 April 2024, the UPC's Local Division Düsseldorf handed down a new chapter in the 10x Genomics saga. This time the case is not against NanoString (see this post on the lost appeal) but against the US-based

#### UPC denies preliminary against UEFA for use of technology ahead of EL

Sophie Britton (Bristows) / June 6,

On 3 June 2024, the UPC's Hamburg rejected a PI application against UI Associations Européennes de Foot GmbH (a technology partner) in rei

Wolters Kluwer



### Latest issues



UPC: resi noti i nomi dei giudici della Divisione centrale di Milano



Nominati i tre nuovi giudici UPC in Germania: la parola ai colleghi tedeschi

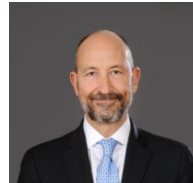


UPC: la divisione locale di Parigi si pronuncia sulle competenze in caso di più convenuti



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE  
INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS  
INTERNATIONALE FEDERATION  
VON PATENTANWÄLTEN

# THANK YOU



Gualtiero Dragotti  
Partner | Global Co-Chair Patent Group  
Intellectual Property & Technology  
T: +39 0280618514  
[gualtiero.dragotti@dlapiper.com](mailto:gualtiero.dragotti@dlapiper.com)