

# The new UPC system is approaching 100 cases, what is the situation? Some remarks

*Trend, statistics and general overview after  
the first five months of operation*

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### 1. Introduction

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In the dynamic world of European patent law, the Unified Patent Court (UPC) has emerged as a transformative force, with the potential to reshape how patent enforcement and litigation occur across EU Member States. This document encapsulates the latest news and updates on the UPC since the commencement of the new UP/UPC system on June 1, 2023.

### 2. Background on the UPC

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The UPC represents a milestone in harmonizing patent law within the European Union. Born from the Agreement on a Unified Patent Court (UPCA), it signifies a convergence of efforts to streamline patent enforcement and dispute resolution across participating EU Member States. Seventeen states, including Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Portugal, Slovenia e Sweden, have ratified the UPCA, forging a path toward unified patent litigation. The UPC consists of a Court of First Instance, a Court of Appeal, and a Registry. The Court of First Instance has a central division (headquartered in Paris with a branch in Munich and an already established future branch in Milan) and several local (including a local division in Milan) and regional divisions. The Court of Appeal is located in Luxembourg.

### 3. Entry into Force of the New UP/UPC System

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On June 1, 2023, the European patent landscape ushered in a new era as the new UP/UPC system materialized, aiming at a simpler approach to patent enforcement across participating Member States. The

system's hallmark is a unified court decision capable of spanning numerous countries, providing a streamlined alternative to the intricate pre-existing national procedures. This means that patent owners no longer need to litigate in multiple national courts to enforce or defend their patents in Europe. The UPC system also allows patent owners to opt out their EPs from the exclusive jurisdiction of the UPC for the entire life of the patent. However, once an EP is opted out, it can be opted back in (only once) provided there is no pending litigation before a national court.

#### **4. Types of Actions Available Under the UPC System**

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The UPC system ushers in an array of actions accessible to entities navigating the new system. These actions encompass not only infringement actions and revocation actions but also provisional measures, injunctions, damages, declarations of non-infringement, and compensation for licenses. This comprehensive spectrum empowers users of the new system to address various facets of patent protection and enforcement seamlessly.

#### **5. Statistics and trends**

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We now come to the analysis of the data available online at the end of October noting that the number of 100 cases filed before the UPC will be reached very soon, also considering the delay of some days with which the database available online are updated with the newly filed cases.

Here the subdivisions of the pending case:

- 46 counterfeiting proceedings,
- 23 revocation actions,
- 12 preliminary measures, including some requests for preservations of evidence and inspection.

The preliminary measures, the preservation of evidence and the order for inspection are urgent proceedings aimed at collecting evidence or proof of the alleged counterfeiting that must be followed by a subsequent counterfeiting proceeding in the merit.

Some preservations of evidence have been effectively used to take evidence of counterfeiting during a temporary exhibition. In these cases, the UPC court revealed to be very efficient and time-responsive so that the measures were executed before the conclusion of the respective exhibitions.

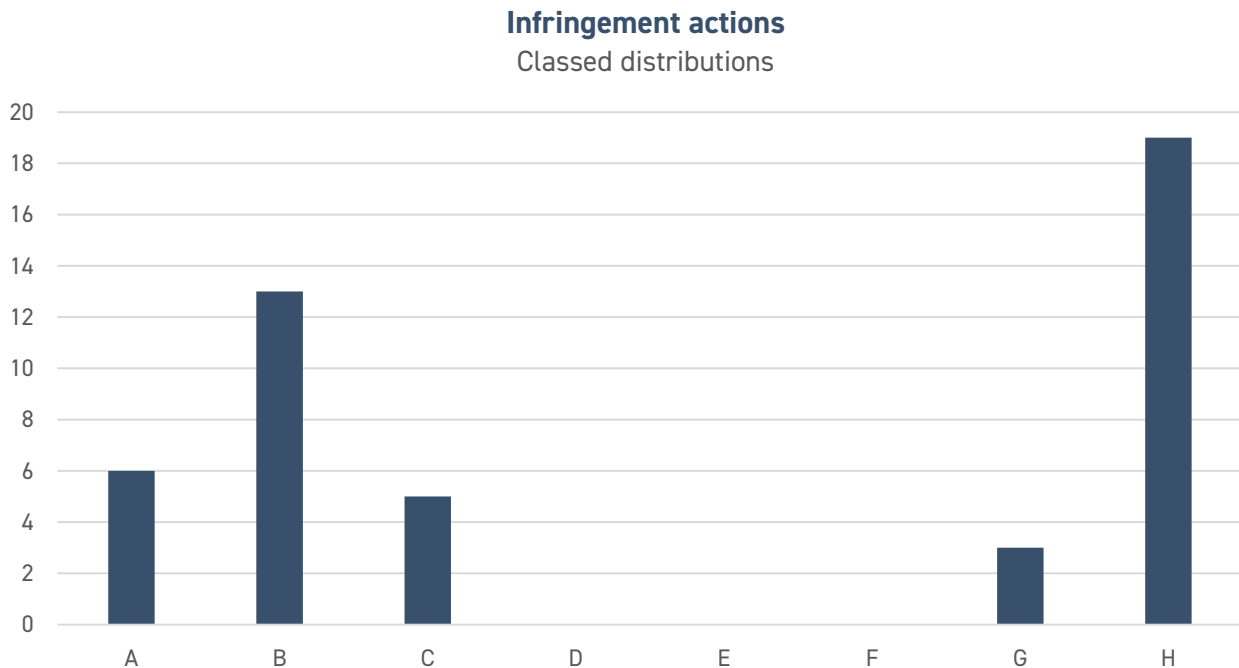
##### **5.1 The technological sector of reference**

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Going into the merits of the pending cases, it is interesting to see the patent technology sector on which the proceedings before the UPC courts are based.

About the infringement proceedings, the histogram below shows the distribution of cases through the classes of the international patent classification.

Where many classes are associated to the same patent, only the first has been considered for displaying the chart below.



**Legend**

A: human needs; B: execution of operations, transport; C: chemistry, metallurgy; D: textiles, paper; E: fixed constructions; F: mechanical engineering, lighting, heating; G: physics and H: electricity.

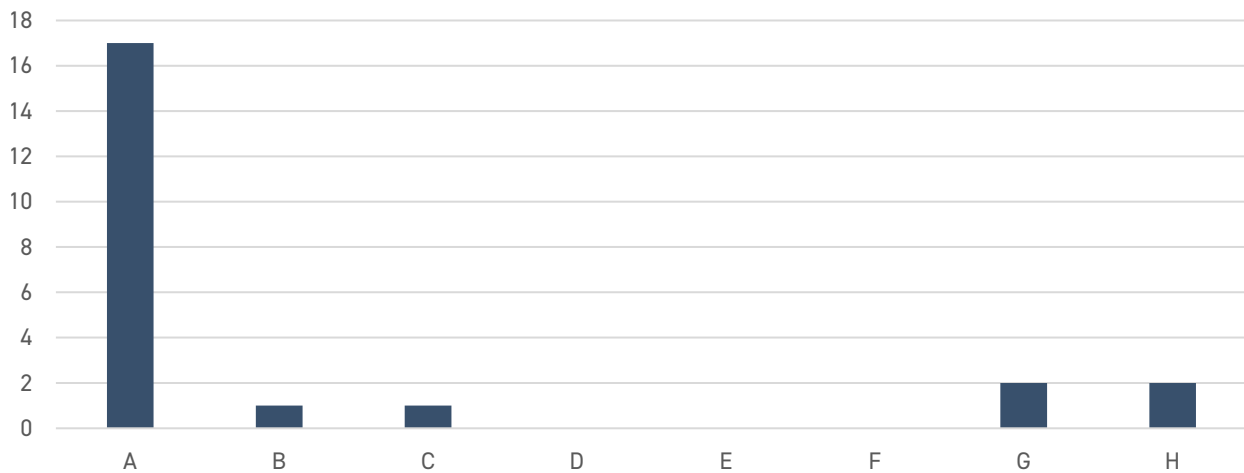
Most of the proceedings pertain to the electrical/electronic/IT or telecommunications sector (classes G and H). The remaining cases are based on mechanical patents (class B) or chemical-pharmaceutical (classes A or C).

About the revocation actions, it should be noted that several proceedings relate to the same patent which has been enforced by the patentees in a parallel infringement action. Only a few cases have been filed as counterclaims, whilst some others have been filed as separated independent revocation proceedings.

About the technological field, most of revocation actions (17 out of 23) relate to patents classified in class “A”, whilst very few cases concern patent in classes B, C, G and H.

It is interesting noting that there are no cases registered up to date relating to patents belonging to classes D, E and F, either in infringement or revocation proceedings.

**Revocation actions**  
Classes distributions



**5.2 Pending proceedings**

It is noted that the parties involved are above all medium and large companies. This confirms the expectations according to which the system is complex and expensive to deal with for a micro or small company, which lacks the structure and resources that would allow it to face the expenses of such a procedure. In the electrical/electronic/IT or telecommunications sector, Panasonic has proved to be very active, launching 12 counterfeiting proceedings, enforcing 6 different European patents. Even the counterparties in the aforementioned proceedings are giants of the caliber of Xiaomi and Oppo. Large multinationals active in the most diverse sectors are also parties to the other pending proceedings; among the best known it is worth mentioning Huawei, Netgear, Philips, Belkin, Tesla, Gucci, Fujifilm, Kodak. Even in the proceedings based on patents belonging to the chemical/pharmaceutical sector, large companies are involved, perhaps less known to the general public, and in some cases even prestigious universities or research centers, such as those of Harvard and Osaka.

In the Table 1 below there are listed the names of the plaintiffs and the defendants involved in the pending cases. When the same parties are involved in more than one proceeding, for example because different proceedings are pending related each to a respective different patent, they are listed only once in the table. In parenthesis there are indicated the reference numbers of the European Patent that the claimants enforced.

For most of these proceedings, which should last approximately ten-thirteen months from their filing, there aren't information available about their prosecution. Only in some cases some interlocutory decisions/orders have been issued relating above all formal preliminary objections.

It should be noted that for the most recent proceedings, as those filed in the last 2-3 months, the

Defendants may still file a revocation action, or this action can have already been filed very recently but this information is not yet available in the online database, due to the delay of some days/weeks necessary for their updating.

Table 1 – Infringement actions		
Claimant/Patent Owner	Defendant	Notes
Ocado Innovation Limited (EP3653540, EP4101791, EP3795501)	Autostore	W
Amgen Inc. (EP3666797)	Sanofi-Aventis et al	X
10x Genomics Inc. (EP4108782)	Vizgen Inc.	
10x Genomics Inc., Harvard univ (EP2794928, EP4108782)	Nanostring Technologies	X, PI
Philips (EP2867997, EP2372863, EP2628233)	Belkin et al	
Avago technologies (EP1838002, EP1612910)	Tesla Germany et al	X
Edwards Lifescience corp. (EP3646825, EP2628464)	Meril	X
Franz Kaldewei (EP3375337)	Bette GmbH	X
KraussMaffei Extrusion GmbH (EP3221117)	Troester GmbH	
N.V. Nutricia (EP2359858)	Nestlé Health Science	X
Huawei (EP3611989)	Netgear	
Aim sport Vision (EP3295663)	Supponor	PI
Dexcom Inc. (EP3797685, EP3435866, EP3831282)	Abbott et al	
Oerlikon Textile GmbH (EP2145848)	Himson Engineering	PI
Oerlikon Textile GmbH (EP2145848)	Bhagat Group	PI
myStromer (EP2546134)	Revolt Zycling	PI
Plant-e BV (EP2137782)	Arkyne Technologies	
Panasonic holding corp. (EP2584854, EP3024163, EP2197132, EP2207270, EP3096315, EP2568724)	Guangdong Oppo mobile et. Al.	sep
Panasonic holding corp. (EP3024163, EP2584854, EP2197132, EP2207270, EP2568724, EP3096315)	Xiaomi et. Al	sep
Agfa nv (EP3388490)	Gucci Spa	
MSG Maschinenbau (EP3225320)	EJP Maschinen GmbH	
SodaStream Industries (EP1793917)	Aarke	
Fujifilm corporation (EP3511174, EP3476616, EP3594009)	Kodak GmbH	
Seoul Viosys Co., Ltd. (EP3223320, EP3926698)	expert e-Commerce GmbH	
Hewlett-Packard (EP2089230, EP1737669)	Lama France	

Legend for the notes to Table 1 above

w = action withdrawn. It seems that the parties have reached an agreement settling all the pending proceedings, even those pending before other foreign national jurisdictions.

X = defendant has filed a revocation action for challenging the enforced patent, regardless the revocation action has been filed as a counterclaim in the same proceeding or as a separate action.

Sep = it seems that some of these patents relate to Standard Essential Patents that are already object of a wider worldwide litigation between the same parties.

PI = before or during the main proceeding a request for a preliminary injunction was filed, see the Table 3 below and the related comments for the details.

In the following Table 2, revocation actions are listed which have been initiated without any previous infringement action in relation to the same patent was filed. In parenthesis the number of the European patent subject of the action has been indicated.

Table 2 - Revocation actions	
Claimant	Defendant/Patent Owner
<b>Astellas Institute for Regenerative Medicine</b>	Healios KK, Osaka University (EP3056563, EP3056564)
<b>Bitzer Electronics</b>	Carrier Corporation (EP3414708)
<b>Njoy Netherlands</b>	VMR Products (EP2875740, EP3456214, EP3613453, EP3626092)
<b>Njoy Netherlands</b>	Juul Labs (EP3498115, EP3504989, EP3504990, EP3504991, EP3430921)
<b>Hanshow Germany</b>	SES-imagotag (EP3883277)
<b>Advanced Bionics</b>	MED-EL Elektromedizinische Gerate (EP4074373)
<b>Walter</b>	Iscar (EP3195963)

The following Table 3 contains the list of the requests for provisional measures that were filed and that are available on the online databases.

Table 3 - Request for Provisional measures			
Claimant/Patent Owner	Defendant	RoP	Division
<b>myStromer (EP2546134)</b>	Revolt Cycling	206	Düsseldorf
<b>Aim sport Vision (EP3295663)</b>	Supponor	206	Helsinki
<b>Edwards Lifescience corp. (EP3763331)</b>	Meril	206	Munich
<b>Progress Maschinen &amp; Automation AG (EP2726230, EP4108782)</b>	Schnell SpA, Awm srl	192, 199	Milan
<b>SES-imagotag (EP3883277)</b>	Hanshow Germany	206	Munich
<b>Josef Nelissen (EP2331036)</b>	OrthoApnea SL	192	Brussels

<b>Steindl Krantechnik Gesellschaft (EP3287315)</b>	Beha Bau- und Forstgreiftechnik et al	206	Munich
<b>10x Genomics Inc., Harvard univ (EP2794928, EP4108782)</b>	Nanostring Technologies	206	Munich
<b>Oerlikon Textile Gmbh (EP2145848)</b>	Himson Engineering	192	Milan
<b>Oerlikon Textile Gmbh (EP2145848)</b>	Bhagat Group	192	Milan

Due to the temporary nature of the provisional measures, these applications were then followed by a respective main proceeding. For this reason, most of the cases of Table 3 are listed also in Table 1 since the Claimant after filing these requests filed also a main infringement action. For the most recently-filed requests for provisional measures it is possible that the main proceeding has not been filed yet, or alternatively the cases can already have been filed but the online databases are not yet updated.

Rule 192 of the Rules of Procedure regulates the Application of preserving evidence.

In the two cases filed by Oerlikon Textile Gmbh as a claimant, the requests were granted in a very few days, just in time to execute the preservation of evidence before the end of the exhibition where the two defendants showed the alleged infringing machines.

Rule 199 of the Rules of Procedure regulates the order for inspection.

The action filed by Progress Maschinen & Automation AG request both the preservation of evidence and an order for inspection. The requests were granted *ex-parte* in a few weeks by the Division, ordering to execute the decision during a contemporary access to the premises of the two joined defendants. In the decision two court experts were nominated to collect the evidences and carry out the inspection. Some limitations to the people that were allowed to assist during the operation in the name of the claimant were provided to safeguard the know-how of the defendants. The Claimant had to pay a security for having executed the decision.

Rule 206 of the Rules of Procedure regulates the provisional measures, together with Art. 60 of the UPC Agreement, that can be request to the UPC on an urgent basis to cease the infringement and avoid harmful or irreparable damages due to the infringement.

Generally speaking, where the preliminary injunctions were granted, the competent Divisions were convinced that the validity of the Patent was proven to a sufficient degree of certainty, for example based on the outcome of other national proceedings. For these reasons a preliminary injunction was granted *inter partes* in relation to the patent EP 4108782 and a preliminary injunction was granted *ex parte* in relation to the patent EP2546134.

Generally speaking, it is noted that before granting a preliminary injunction requested invoking Rule 206, every Division usually orders to hear the defendants, regardless of the fact that a protective letter was on filed or not.

In the case based on EP3295663 the preliminary injunction was denied for formal reason, because the patent was opted out at the time of filing the action and therefore the Division decided it was not competent to hear the case.

The remaining cases are still pending and no decision/order are available up to now.

It is interesting noting that the revocation action filed by Hanshow Germany followed as a reaction the request for provisional measures previously filed by SES-imagotag.

### 5.3 Locations of ongoing proceedings

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As far as revocation proceedings are concerned, most have been attributed to the Paris seat, and only four cases to the Munich office. The Milan branch of the central division does not yet manage any cases since it will only become operational from June 2024. In the cases where revocation actions have been filed as a counterclaim in the context of a previous infringement action, it seems that the same local division decided to remain competent also to hear the revocation case. Therefore, the trend of the first cases seem not to bifurcate the two proceedings in different courts, but keeping both of them before the same division.

As far as counterfeiting proceedings are concerned, it is possible to group the various divisions in the following four different groups according to the number of cases managed.

- Group 1: German local divisions (Munich, Mannheim, Dusseldorf and Hamburg), Milan and Paris local division, which are the most preferred by the claimants. Each of these divisions manages several proceedings, generally more than five. Munich local division is the division handling the highest number of proceedings.
- Group 2: Nordic-baltic regional division and Helsinki local division, which manage each some cases, typically from 2 to 5 proceedings based in each of them.
- Group 3: Brussels, The Hague and Vienna local divisions seems to manage one or two cases per each.
- Group 4: There are no proceedings started in Copenhagen, Ljubljana and Lisbon local divisions up to now.

### 6. Conclusions

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From the analysis of the data, we can draw the following considerations.



- By virtue of the high costs and complexity of these proceedings, the cautious approach of micro and small enterprises is confirmed, which at the moment do not seem to be involved either as plaintiffs or as defendants in pending cases. On the contrary, the pending proceedings mostly involve large multinational groups or medium-sized enterprise.
- According to many observers the number of pending proceedings before UPC is higher than the expected one; the effectiveness and the competence of the courts seem to be appreciated by many users.
- It is noted that in many cases several defendants are involved in the same proceeding. This can be advantageous because it avoids the plaintiff having to initiate numerous parallel national cases and, in this case, also the high costs of the proceedings before the UPC could be comparable to the sum of the costs of the different national proceedings, with the advantage that – in the case to which the counterfeiting is recognized – the plaintiff could be awarded considerable damages, given that they can cover a broader geographical territory and a very vast market.
- The reduced number of revocation procedures could be, at least in part, the consequence of the number of European patents for which the opt-out request has been filed, which according to several observers was much higher than initial expectations.
- The counterfeiting proceedings are concentrated only in a few local divisions, in particular the German ones (especially in Munich and Düsseldorf), that of Milan, Paris and that of Helsinki, as well as in the Baltic regional division; venues which could be chosen by the applicants as they are considered the most effective and those with the most experienced judges.
- The patents subject to litigation are mainly grouped in international classes A (especially for the revocation cases), B and H (especially for the infringement cases), with a few residual cases in classes C and G. Apparently, up to now no proceedings have been filed relating to patents belonging to classes D, E and F.
- Almost the totality of the litigated patents is part of a wider litigation strategy: many of them have been object of opposition proceedings before the EPO, whilst for several cases the claimant and the defendant are already involved in numerous court proceedings in different national jurisdictions that were started before the upcoming of the UPC.
- Many requests for provisional injunctions were filed due to the promptness with which the involved Division treats the requests. In some cases, these requests were granted in a very short time (even within one-two days), in time to be able to be executed before the end of the exhibition. It should be remembered, however, that these requests have provisional effect and therefore must be followed by the filing within a few weeks of respective proceedings on the merits, during which the possible counterfeiting of the enforced patents will be discussed.

- Agreeing what has been raised by several observers, the issue of transparency and timeliness arises in updating the official database ([unified-patent-court.org/en/registry/cases](https://unified-patent-court.org/en/registry/cases)) that collect data on pending proceedings, which do not include timely all the actions that would have actually been filed with the UPC. Moreover, many field must be selected or filled in, which result in a not user-friendly database, where the information are very fragmented. Besides this official database, some third-party databases are also available or under development that have interfaces that are more user-friendly and might be useful to retrieve information easily and quickly.

