



Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

The Unified Patent Court (UPC) – A patent court for Europe

Dr Klaus Grabinski, President of the UPC Court of Appeal

Stanford University, 7 December 2023

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

I. State of Play until 31 May 2023



Prosecution of a European Patent -

One stop shop

- European patents (EPs) are granted **by the European Patent Office (EPO)** under the European Patent Convention (EPC) of 5 October 1973
 - 38 Contracting States, including all 27 EU Member States and 11 other non-EU Member States

“Bundle patent”

- The European patent (EP) has in each EPC Contracting State for which it has been granted **the effect of a national patent** granted in that State, Art. 2(2), 64(1) EPC
- Provided it has been validated and maintained in the respective EPC Contracting State.
 - Translation
 - Fees



Enforcement of an EP state by state

- As the EP has the effect of a national patent in each EPC Contracting State,
 - **generally only the national courts of the State where the infringement occurred have jurisdiction on an infringement action and**
 - **only the national courts of the State where the EP has the effect of a national patent have exclusive jurisdiction on actions for revocation of that part of the EP.**

II. State of Play as of 1 June 2023 (Entering into force of the UPC Agreement)

1 June 2023

- **Agreement on a Unified Patent Court of 19 February 2013** entered into force.
 - **Establishment of the Unified Patent Court (UPC).**
- **Regulations (EU) No 1257/2012 and No 1260/2012 of 17 December 2012** became applicable.
 - **Creation of unitary patent protection (European patent with unitary effect = Unitary patent)**

- **The Unified Patent Court (UPC) is a “court common to several (currently 17) EU Member States”**, Art. 71a Brussels Ia Reg
- As such **the UPC has exclusive jurisdiction**
 - **where the courts of the CMS would have jurisdiction in EP matters**
 - **if the UPCA had not transferred that competence to the UPC**, Art. 71a Brussels Ia Reg.

Jurisdiction of the UPC – infringement actions

The UPC has jurisdiction on an EP infringement action when

- **the place of the infringement or**
- **the seat of the defendant or**
- **the seat of one of a number of defendants** (provided the claims are closely connected)

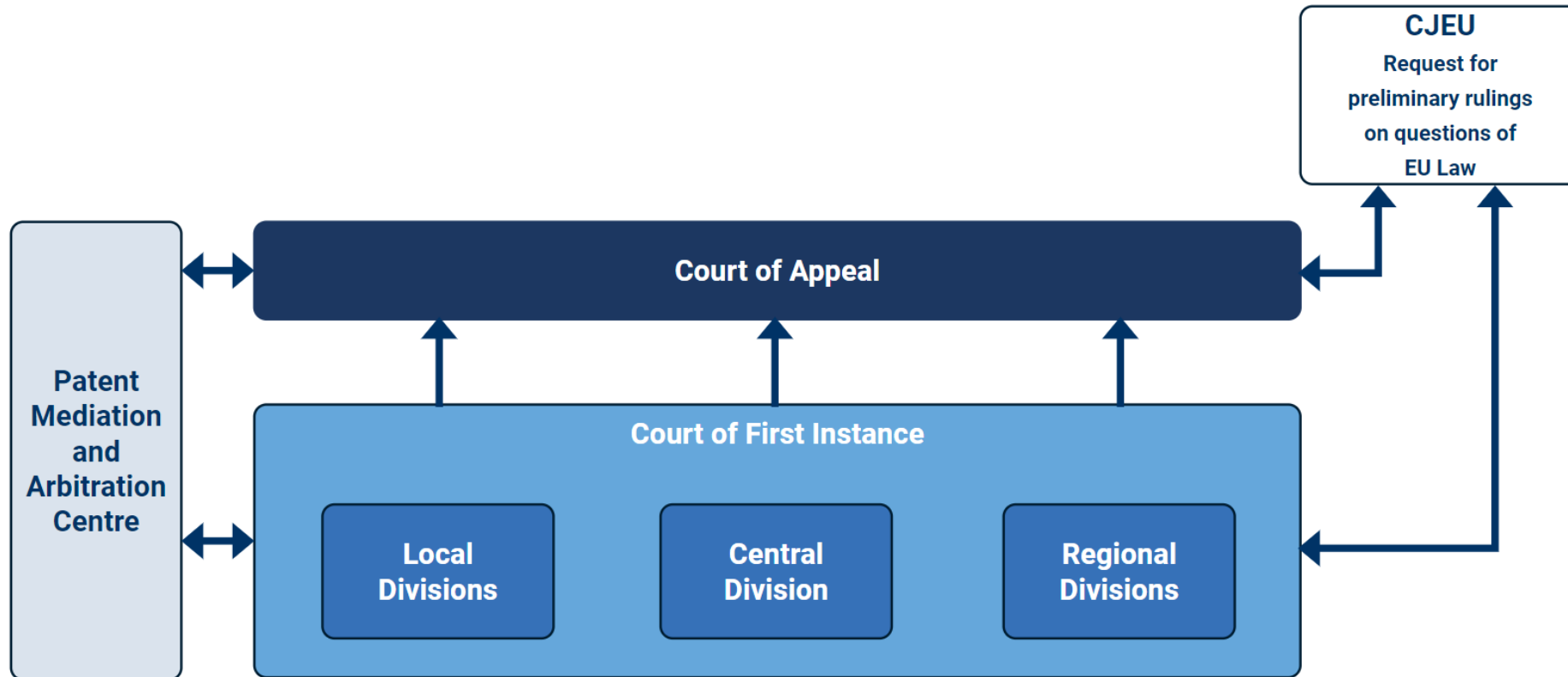
is in a Contracting Member State (CMS).

Jurisdiction of the UPC – revocation actions

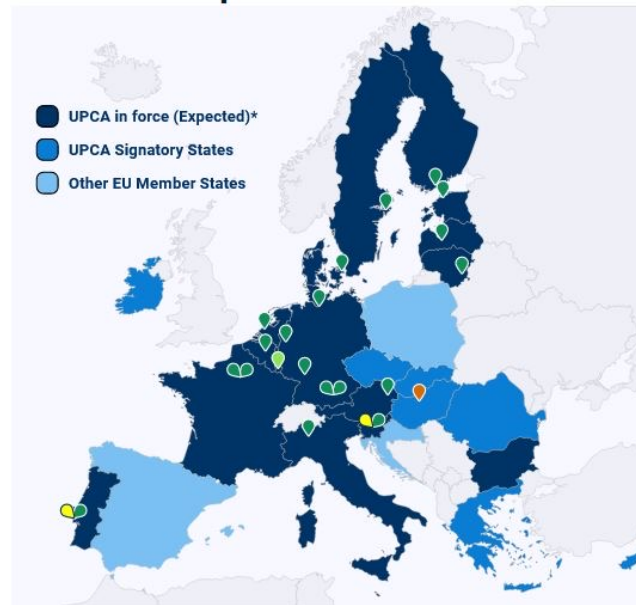
- **The UPC has jurisdiction on a revocation action or counterclaim for revocation concerning the national parts of an EP (bundle patent) that have been granted for the CMS**
 - provided the EP has not been opted-out.

Jurisdiction of the UPC – Unitary patents

- **The UPC also has exclusive jurisdiction on EPs with unitary effect (Unitary patents).**
 - **Since the UPCA entered into force, the applicant of an EP may, after grant of the EP, request to obtain an EP with unitary effect (Unitary patent) within one month.**
 - **A Unitary patent**
 - **confers on its proprietor protection throughout the territory of the CMS and**
 - **reduces complexity and lowers costs.**



Locations Map



* UPCA stands for "Agreement on a Unified Patent Court"

Show location types

- Court of Appeal
- Court of First Instance
- Training Centre
- Patent Mediation and Arbitration Centre

Select a Member State below to learn more

- | | | |
|--|---|--|
| ● Austria | ● Latvia | ● Czech Republic |
| ● Belgium | ● Lithuania | ● Greece |
| ● Bulgaria | ● Luxembourg | ● Hungary |
| ● Denmark | ● Malta | ● Ireland |
| ● Estonia | ● Netherlands | ● Romania |
| ● Finland | ● Portugal | ● Slovakia |
| ● France | ● Slovenia | ● Croatia |
| ● Germany | ● Sweden | ● Poland |
| ● Italy | ● Cyprus | ● Spain |

Select a Location below to learn more

- | | | |
|---|--|---|
| ● Luxembourg (LU) | ● Copenhagen (DK)/L | ● Milan (IT)/L |
| ● Paris (FR)/C | ● Düsseldorf (DE)/L | ● Munich (DE)/L |
| ● Munich (DE)/C | ● Hamburg (DE)/L | ● Paris (FR)/L |
| ● Riga (LV)/R | ● Helsinki (FI)/L | ● The Hague (NL)/L |
| ● Stockholm (SE)/R | ● Lisbon (PT)/L | ● Vienna (AT)/L |
| ● Tallinn (EE)/R | ● Ljubljana (SI)/L | ● Lisbon (PT) |
| ● Vilnius (LT)/R | ● Mannheim (DE)/L | ● Ljubljana (SI) |
| ● Brussels (BE)/L | | ● Budapest (HU) |

C: Central division L: Local division R: Regional Division

Central Division

- **Panel of 3 judges**
 - **2 legally qualified judges** from different CMS
 - **1 technically qualified judge**

Local/Regional Division

- **Panel of 3 or 4 judges**
 - **3 legally qualified judges** partly from and partly not from the CMS hosting the Local Division or from the CMS that share a Regional Division**and**, most of the time,
 - **1 technically qualified judge**
(to be allocated when a counterclaim for revocation has been filed which has not been referred to the central division for decision [bifurcation] or upon request of a party or on initiative of the panel).

Court of Appeal

- **Panel of 5 judges**
 - **3 legally qualified judges**
 - **2 technically qualified judges**

Central Division

- Language in which the patent concerned was granted.

Local/Regional Division

- Official language(s) of the CMS hosting a LD or sharing a RD.
- CMS may designate one or more of the official EPO languages. (In practice all CMS designated English.)
- With the agreement of the parties and consent of the panel: the language in which the patent was granted (English, French or German)
- At the request of one party and after having heard the other parties, the CFI President may decide on the language in which the patent was granted.

Court of Appeal

- Language of proceedings before the CFI.
- Parties may agree on the language in which the patent was granted.
- Exceptionally the CA may decide on another official language of a CMS.

- **135 cases filed with the Court of First Instance** (as of 17 November 2023)
 - **57 actions for infringement**
 - Local/Regional Divisions
 - **39 counterclaims for revocation**
 - Local/Regional Divisions
 - **23 actions for revocation**
 - Central Division (Paris seat or Munich section)
 - **9 requests for preliminary measures**
 - Local/Regional Divisions
 - **5 requests for preserving evidence**
 - Local/Regional Divisions
 - **1 requests for inspection**
 - Local/Regional Division

- **Stages of proceedings of an EP infringement action**
 - **Written procedure**
 - Front loaded (all relevant facts and evidence relied on have to be submitted).
 - Deadlines for written submissions
 - **Interim procedure**
 - Preparation of oral hearing
 - Exploration of possibilities to settle the case
 - **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.

- **Further procedural aspects:**
 - **Videoconference**
 - Parties and representatives may be allowed to attend the oral hearing by video conference
 - Parties, witnesses or experts may be heard by video conference
 - Hearings may be held by video conference under exceptional circumstances.
 - **Public access to the electronic register**
 - decisions and orders are published
 - written pleadings and evidence are available upon reasoned request by decision of the judge-rapporteur after consulting the parties
 - A party may request that certain information be kept confidential .

- **Further procedural aspects:**
 - **Protection of confidential information**
 - Confidentiality club available
 - Representatives and at least one natural person from each party
 - **Pretrial procedures**
 - No pretrial discovery US style available
 - Order to preserve evidence (e.g. by detailed description or seizure of the allegedly infringing product) or to inspect premises
 - Provisional and protective measures (preliminary injunctions, etc.)
 - **Experts**
 - Party experts or court appointed experts
 - Examination in oral hearing by the judges and the party representatives

- **Further procedural aspects:**
 - **Permanent injunction**
 - When infringement has been found and upon request of the claimant permanent injunction will be granted
 - No Ebay test US style but injunctions have to be **proportionate**, Art. 3(2) ED.
 - **Award of damages**
 - 3 ways of calculation (lost profits, return of infringer's profits, royalties)
 - No punitive damages

– **Uniform format of orders and decisions**

- Orders and decisions have very different formats in the UPC Contracting Member States.
- However, orders and decisions of the UPC must have a **uniform format**.
- **Guidances with regard to the drafting of orders and decisions** and, in particular, **the operating part**, have been published.
- These guidances will assist
 - panels in drafting orders and decisions and
 - party representatives in drafting requests in their written pleadings.

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Thank you for your attention
