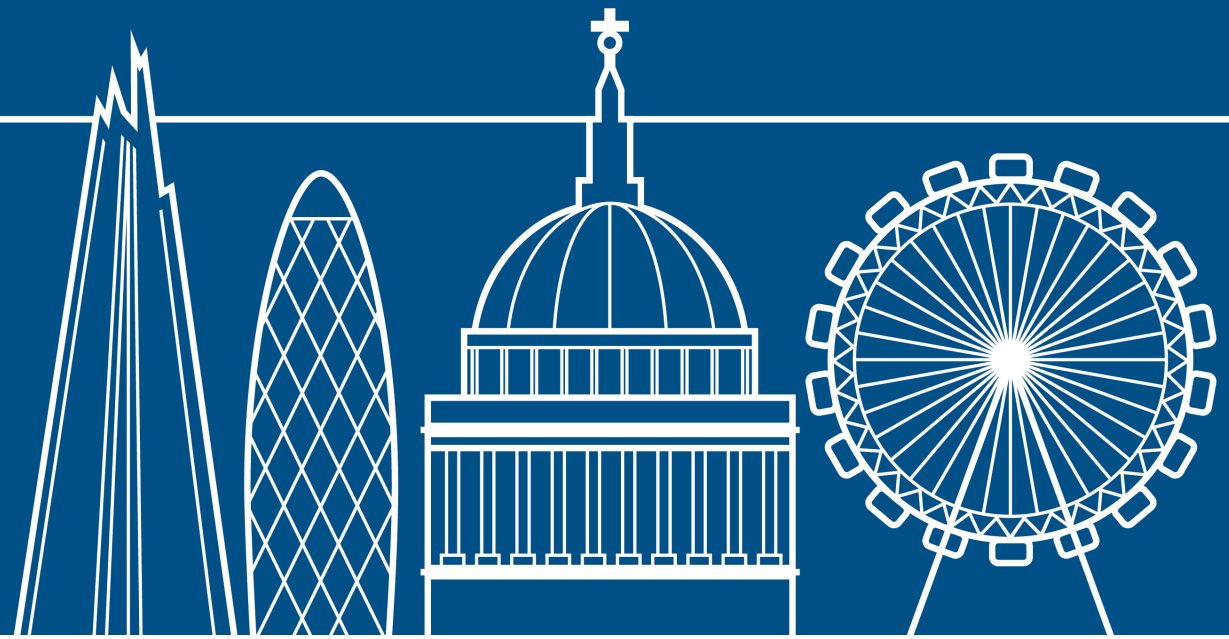




# FICPI ExCo & 21st Open Forum

London, 1-7 October 2023



## The Unified Patent Court (UPC) – What has been the experience 100 days in?

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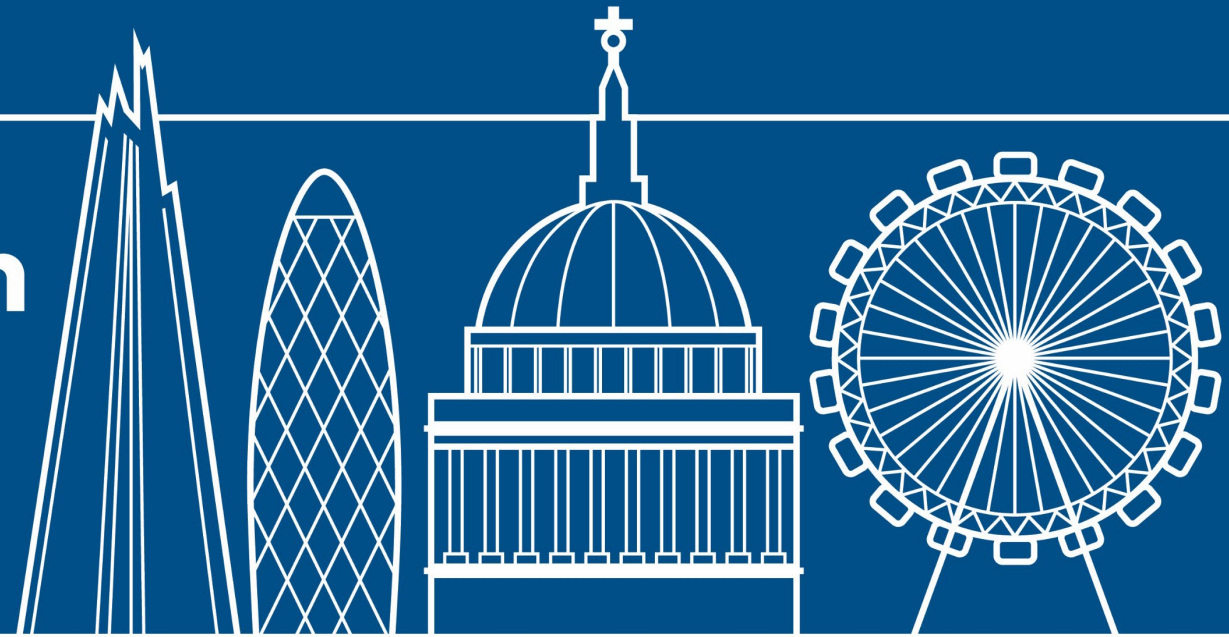
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# 21st Open Forum

London

4-7 October 2023



## Introduction

Dr. Daniel Alge  
Sonn & Partner  
Austria



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Dr. Daniel Alge



Dr. Klaus Grabinski



Dr. Silvia Dondi



Dr. Stefan Luginbühl



# The Unitary Patent (UP) and the Unified Patent Court (UPC) – The first 100 days

Just for those who still do not believe it really happened...



# The Unitary Patent (UP) and the Unified Patent Court (UPC) – The first 100 days

21st Open Forum  
London, England  
4-7 October 2023



Just for those who still do not believe it really happened:

- |                         |  |
|-------------------------|--|
| 15 December 1975:       | Signature of the Community Patent Convention (CPC) |
| 7 March 2003:           | EU Common Political Approach                       |
| 19 February 2013:       | Signature of the UPC-Agreement                     |
| 1 March to 31 May 2023: | The sun rises (“Sunrise Period”)                   |
| 1 June 2023:            | UPC opened up its doors                            |
| 1 June 2023:            | first UPs possible                                 |



# The Unitary Patent (UP) and the Unified Patent Court (UPC) – The first 100 days

21st Open Forum  
London, England  
4-7 October 2023

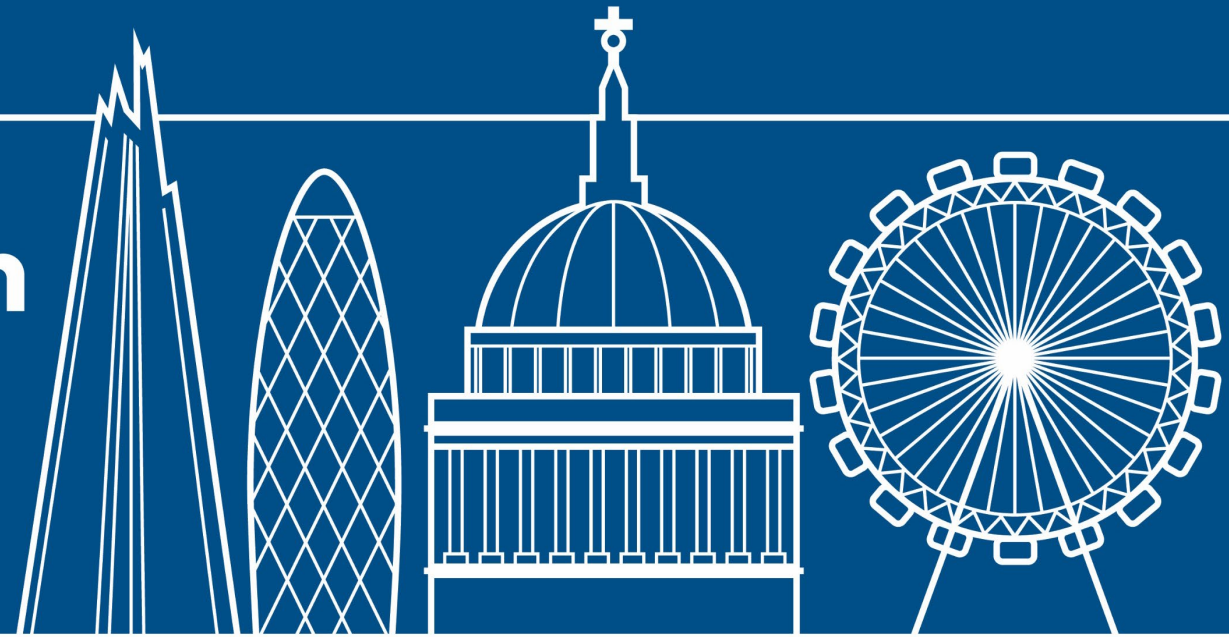




# 21st Open Forum

London

4-7 October 2023



## [The EPO grants (generates) the UP]

Dr. Stefan Luginbühl

Head of Department – Patent Law Policy and Harmonisation, European  
Patent Office

Germany



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# 21st Open Forum

London

4-7 October 2023



## [The UPC makes the judgements over UPs and EPs]

Dr. Klaus Grabinski

President – The Unified Patent Court

Germany



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Unified Patent Court  
Einheitliches Patentgericht  
Juridiction unifiée du brevet

# 100 days up and running - Proceedings before the Unified Patent Court (UPC)

*Dr. Klaus Grabinski, President of the UPC Court of Appeal*

FICPI Open Forum, London, 5 October 2023

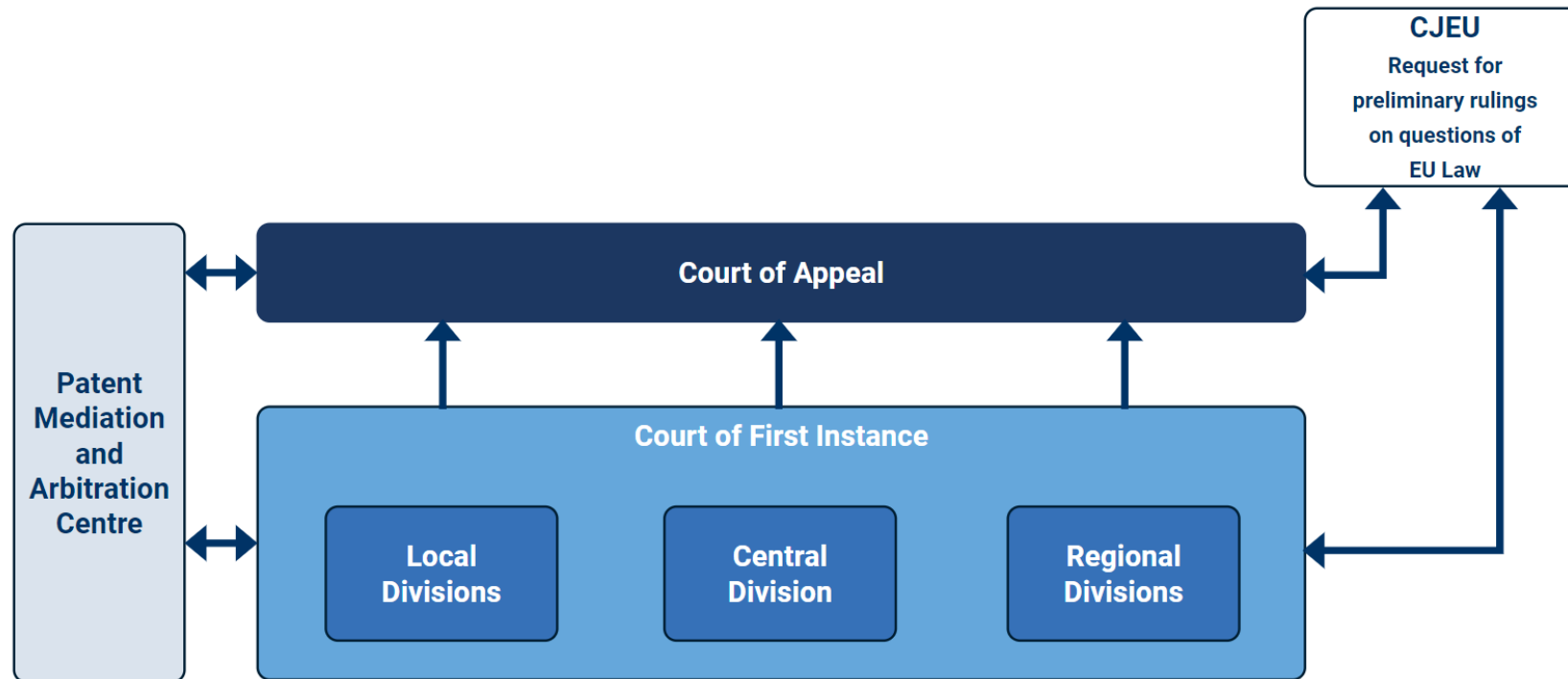
All written and said is my personal view and not a communication of the UPC Court of Appeal.

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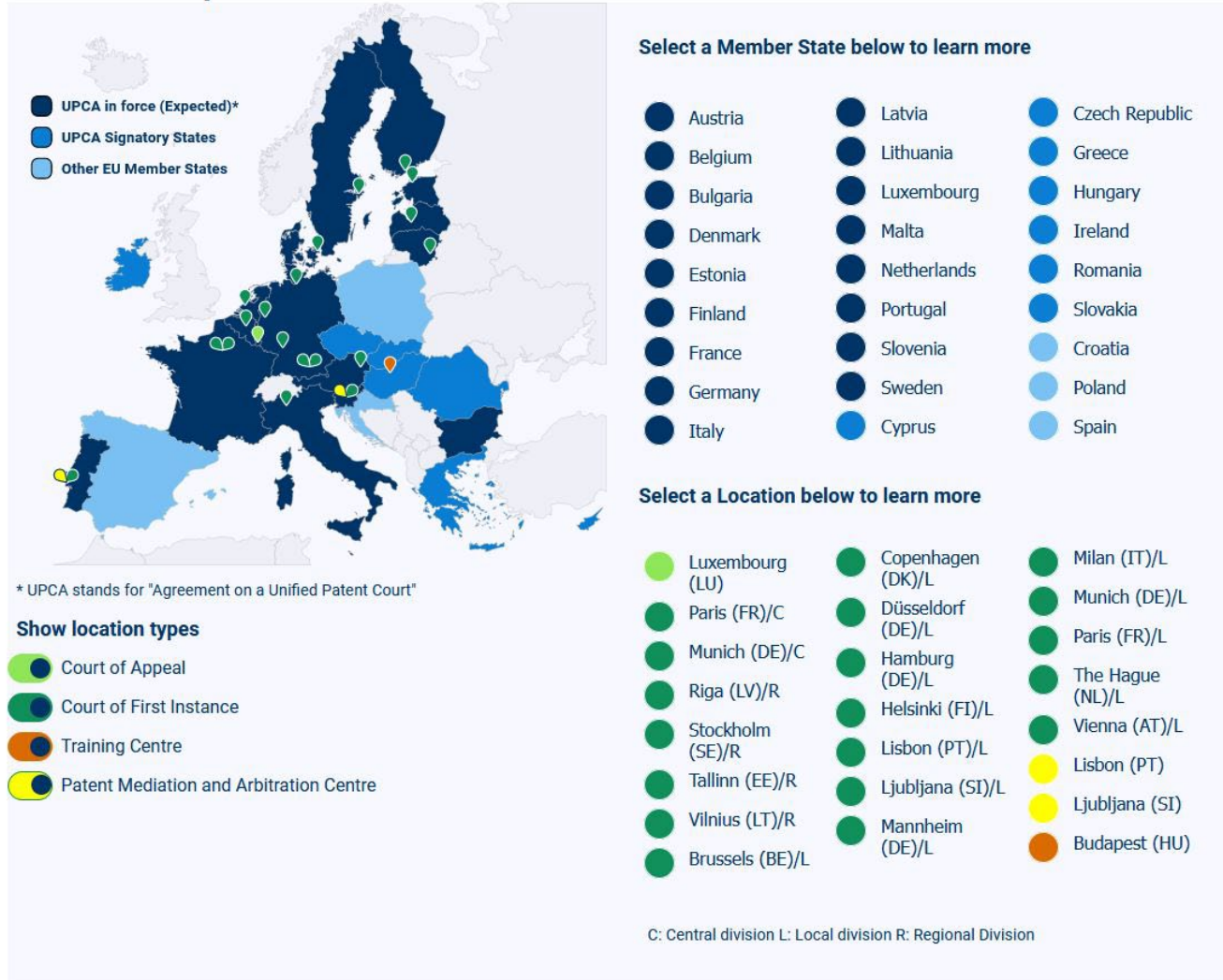
# **I. Court Structure and distribution of cases**

## 1 June 2023

- UPC Agreement and Statute entered into force.
  - Rules of Procedure
- Regulations (EU) No 1257/2012 and 1260/2012 on unitary patent protection became applicable.



## Locations Map



## 56 Cases filed (as of 11 September 2023)

- 7 revocation actions
  - \* 4 Munich
  - \* 4 Paris
- 37 infringement actions
  - \* 16 Munich Local
  - \* 6 Mannheim
  - \* 4 Dusseldorf
  - \* 3 Milan
  - \* 3 Hamburg
  - \* 2 Nordic-Baltic
  - \* 1 Helsinki
  - \* 1 Paris Local
  - \* 1 The Hague
- 12 Preliminary Measures / Preserving Evidence / Order for Inspection.  
Milan, Munich Local, Düsseldorf, Vienna and Helsinki

## **4 hearings in cases on provisional measures before the Local Divisions in Munich and Vienna**

- 5 September 2023 LD Munich
- 13 September 2023 LD Vienna
- 19 September 2023 LD Munich
- 10 October 2023 LD Vienna

## **II. Composition of panels**



## 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**

- **Art. 17(4) UPC Agreement and Art. 4(3) UPC Code of conduct**

The exercise of the office of a technically qualified judge who is a part-time judge of the Court shall not exclude the exercise of other functions provided there is no conflict of interest.

In order to maintain confidence in the independence and impartiality of the court, to allow judges to work together in a spirit of mutual trust and to avoid potential conflicts of interest, the judge may not act as a representative before the Court, as provided for in Article 48 UPCA, in any matter, and may not give legal or technical advice in any capacity on a case pending before the Court or after being instructed to prepare therefore.

- The mere registration as representative in order to make use of the grandfather clause in due time (see Rule 12 EPLC Rules) is not considered to be an infringement of Rule 4.3 UPC CoC.

### **III. Language of Proceeding**

## Central Division

- **Language in which the patent concerned was granted**, Art. 49 (6) UPC

## Local/Regional Division

- **Official language(s) of the CMS hosting the LD or the official language(s) designated by CMS sharing a RD**, Art. 49 (1) UPCA
- **CMS may designate one or more of the official EPO languages**, Art. 49 (2) UPCA
- **Parties may agree on the language in which the patent was granted subject to approval by the panel**, Art. 49 (3) UPCA
- **With the agreement of the parties the panel may decide on the language in which the patent was granted**, Art. 49 (4) UPCA
- **At the request of one party and after having heard the other parties, the Co<sup>1st</sup> I President may decide on the language in which the patent was granted**, Art. 49(5) UPCA

## Court of Appeal

- **Language of proceedings before the Co<sup>1st</sup>I**, Art. 50 (1) UPC
- **Parties may agree on the language in which the patent was granted**, Art. 50 (2) UPCA
- **Exceptionally the CoA may decide on another official language of a CMS**, Art. 50 (3) UPCA.

- By 31 May 2023 all Contracting Member States (MS) that host a or several Local Division have designated in a communication to the Court **English** as (alternative) language of proceedings of their Local Division(s), Art. 49(2) UPCA.
- At the same time many of the Contracting MS made use of Rule 14.2(c) UPC RoP giving the judge rapporteur the power to order that
  - the judges in the oral proceedings use the official language of Contracting MS hosting the Local Division and
  - the court makes any order and delivers any decision in that official language.

## **IV. Court Proceedings**

- **Infringement action - Stages of proceedings**
  - **Written procedure**
    - **Exchange of written pleadings**
      - claim
      - preliminary objection
      - defence      counterclaim for revocation  
(against patent proprietor)
      - Reply      defence      amendment(s) of  
patent
      - Rejoinder      reply      defence
      - -      rejoinder      reply
      - -      -      rejoinder
    - **Front loading** (all relevant facts and evidence relied on have to be submitted. No skeleton arguments only.)
    - **Deadlines** for written pleadings



- **Stages of proceedings**
  - **Written procedure**
    - Decision on bifurcation by Local or Regional Division
      - proceed with action for infringement and counterclaim for revocation or
      - refer the counterclaim for revocation to the Central Division or
      - refer the case for decision to the CD with agreement of the parties
    - Allocation of technically qualified judge
      - mandatory, if LD or RD decides to proceed with counterclaim for revocation

- **Stages of proceedings**
  - **Interim procedure**
    - Before the judge-rapporteur
    - Interim conference may be held by telephone, video or in person.
    - Preparation of oral hearing
      - In particular: orders regarding production of further pleadings, experts (party of court appointed), experiments, inspections, witnesses, etc.
    - Exploration of possibilities to settle the case

- **Stages of proceedings**
  - **Oral procedure**
    - Oral hearing in person before the full panel
    - 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.

- **Videoconference available, Rule 112 RoP**
  - Parties, representatives or accompanying persons may be allowed to attend the oral hearing by video conference
  - Parties, witnesses or experts may be heard through electronic means, such as video conference,
  - Hearings may be held by video conference if all parties agree or the court considers it appropriate to do so due to exceptional circumstances

- **Public access to the register, R. 262 RoP**
  - Decisions and orders are published.
  - Written pleadings and evidence are available to the public upon reasoned request to the Registrar by decision of the judge-rapporteur after consulting the parties.
  - A party may request that certain information be kept confidential.
- **Protection of confidential information, R. 262A RoP**
  - A party may request that access to certain information contained in its pleadings be restricted to certain persons (**confidentiality club**).
  - The court decides after having heard the other parties.
  - The number of persons having access shall include at least one natural person from each party and respective lawyers or other representatives.

Unified Patent Court  
Einheitliches Patentgericht  
Juridiction unifiée du brevet





Thank you for your attention.

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# 21st Open Forum

London

4-7 October 2023



## [How do the users use the UP and the UPC?]

Dr. Silvia Dondi  
Partner, Bugnion S.p.A.  
Italy





# How do the users use the UP and the UPC?

Silvia Dondi

Partner, Bugnion S.p.A., Italy



## WHERE WERE WE ...



- as usual in IP, there is no «one-size-fits all» strategy
- the system is new for everyone, so no safe recipes are known
- conservative approach with some attempts to become familiar with UPC
- stay update on case law
- be ready to adjust the strategy



***It was just the beginning***

## OUR JOURNEY FROM THEN ON

supporting companies  
in taking decisions on  
the existing EP  
portfolios

developing strategies  
for new EP filings

## CHALLENGES AND OBSTACLES

- explaining the link UP/UPC
- explaining the consequence of «doing nothing»
- informing on actions available in the *sunrise period*
- no practical experience on the new system

## OUR KIT



- **UP checklist:**  
for assisting in deciding whether using the new system or not
- **UPC checklist:**  
for assisting in deciding whether staying in or *opting-out*

## UP CHECKLIST



- ✓ territorial coverage at the start and in the future
- ✓ costs of classical validations vs. UP (at grant, annual fees)
- ✓ relevance of the invention (in terms of sales volume)
- ✓ strength of the patent
- ✓ object of the invention
- ✓ exploitation (transferral / license)

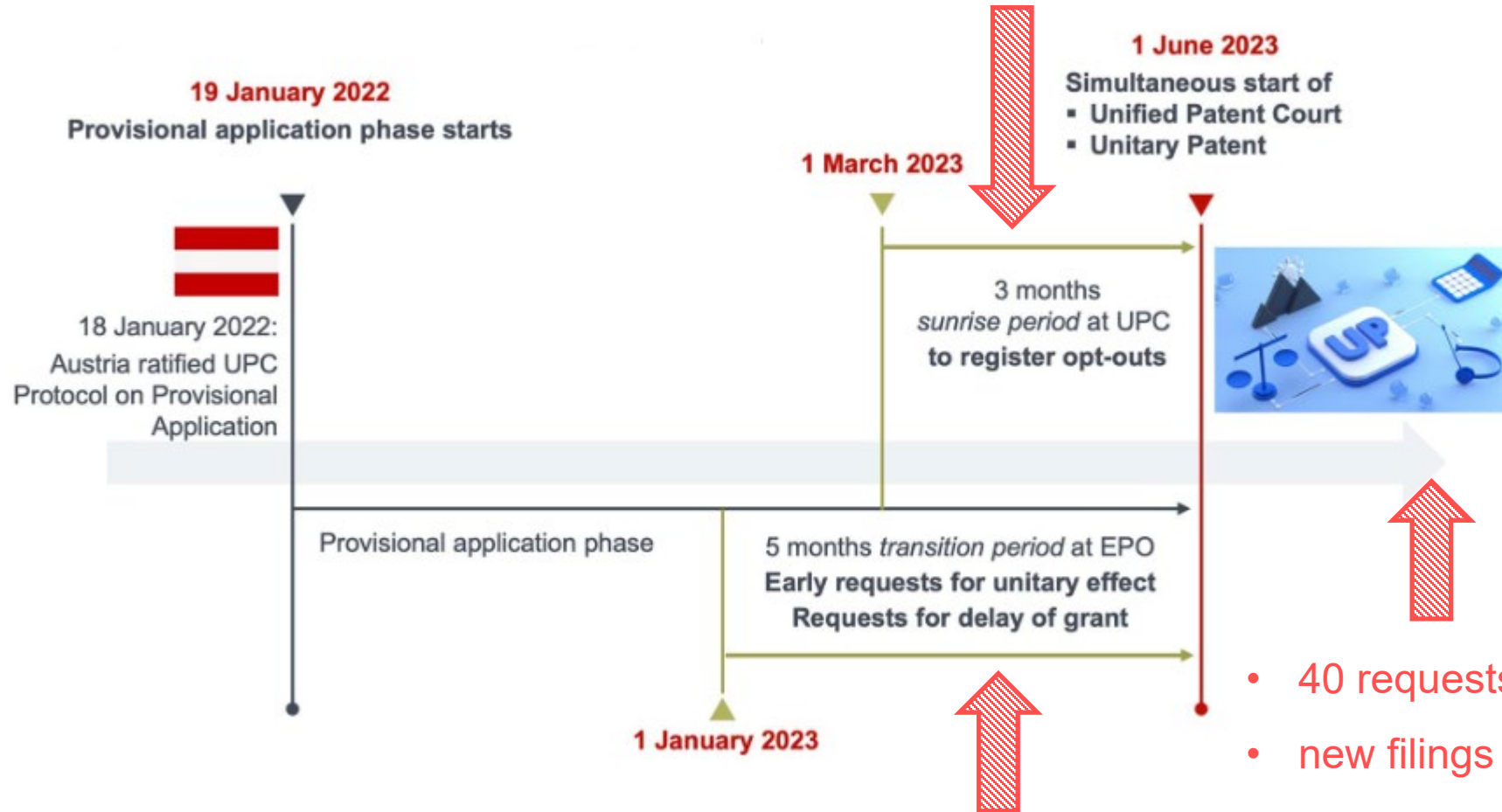
## UPC CHECKLIST

- ✓ main competitors and their location
- ✓ likelihood of litigation
- ✓ UPC costs
- ✓ relevance of the invention (in terms of sales volume)
- ✓ strength of the patent
- ✓ object of the invention





## SO FAR...



- requests for delay of grant
- cumulative filings of *opt-out*

- 40 requests for unitary effect
- new filings of *opt-out* after publication

- requests for delay of grant

## OUR FACTS AND FIGURES – big companies



### Before June 1<sup>st</sup>:

- almost all domestic clients have chosen a cumulative *opt-out* for the existing portfolio, no matter the geographical extension, technical field and former litigation experiences
- almost all domestic clients have chosen classical validations, no matter the number of countries
- a few foreign clients (DE, KR) have chosen to stay in the new system

## OUR FACTS AND FIGURES – big companies



### After June 1<sup>st</sup>:

- almost all domestic clients are going on with single requests of *opt-out* after EP publication
- a few foreing clients (DE) are choosing the unitary effect for selected applications

## OUR FACTS AND FIGURES – SMEs



### Before June 1<sup>st</sup>:

- most SMEs have chosen UPC, no matter the geographical extension, technical field and former litigation experiences
- most SMEs have chosen the unitary effect for applications close to grant

### After June 1<sup>st</sup>:

- SMEs are keeping on choosing UPC and UP

## OUR LEGAL / CONTRACT ACTIVITIES



- normal trend of oppositions before the EPO
- normal trend of nullity/infringement actions and preliminary injunctions in Italy
- some big companies have increased monitoring competitors' portfolio
- some big companies have revised former contracts in relation to specific technologies
- **no actions before UPC**

## WHERE ARE WE NOW...



- as usual in IP, there is no «one-size-fits all» strategy
- the system is new for everyone, so no safe recipes are known but we have developed our own travel kit and we know most of EPAs also did
- conservative approach with some attempts to become familiar with UPC at least for big companies, whereas the SMEs are already more open to the new system
- stay update on case law
- be ready to adjust the strategy since companies' attitude towards the new system has already changed so far



***“A person who never made a mistake never tried anything new”***

Albert Einstein

**THANK YOU!**

**Silvia Dondi**

[silvia.dondi@bugnion.eu](mailto:silvia.dondi@bugnion.eu)

[www.bugnion.eu](http://www.bugnion.eu)

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## Discussion

Panel: Dr. Stefan Luginbühl – Dr. Klaus Grabinski – Dr. Silvia Dondi

Moderator: Dr. Daniel Alge



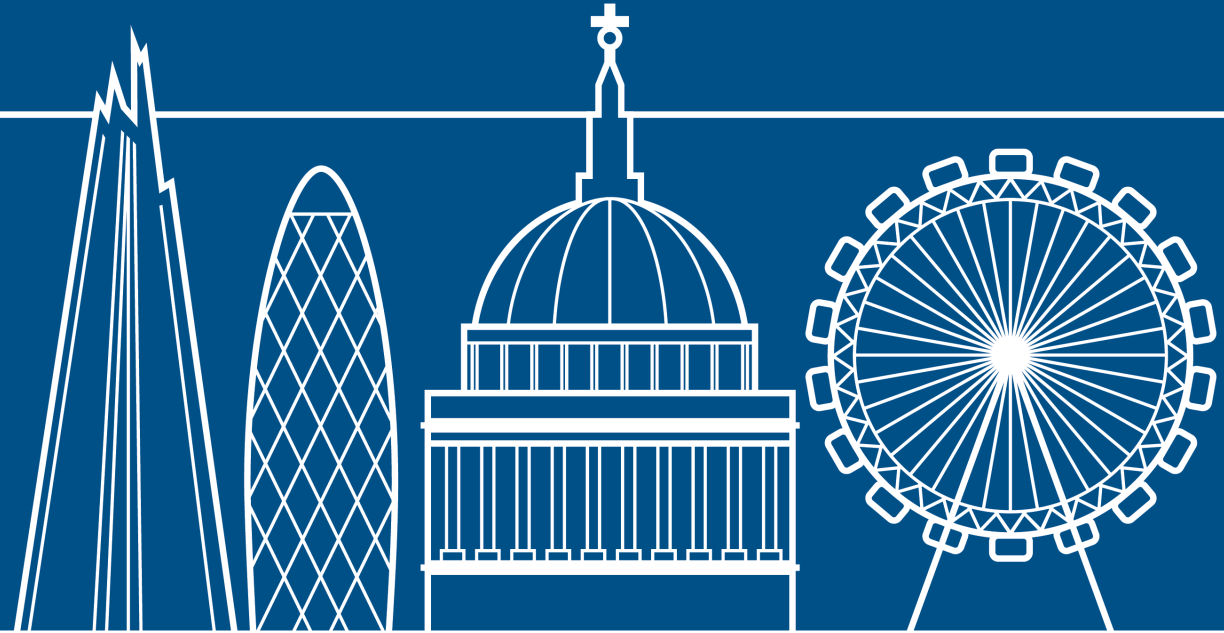
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