



**BARDEHLE
PAGENBERG**

Impact.
Passion.
IP.

FIRST EXPERIENCES AT THE UNIFIED PATENT COURT

Johannes Heselberger

Partner, UPC Representative,
Attorney-at-Law, European Patent
Attorney

Dr. Ronja Schregle

UPC Representative, Attorney-at-Law

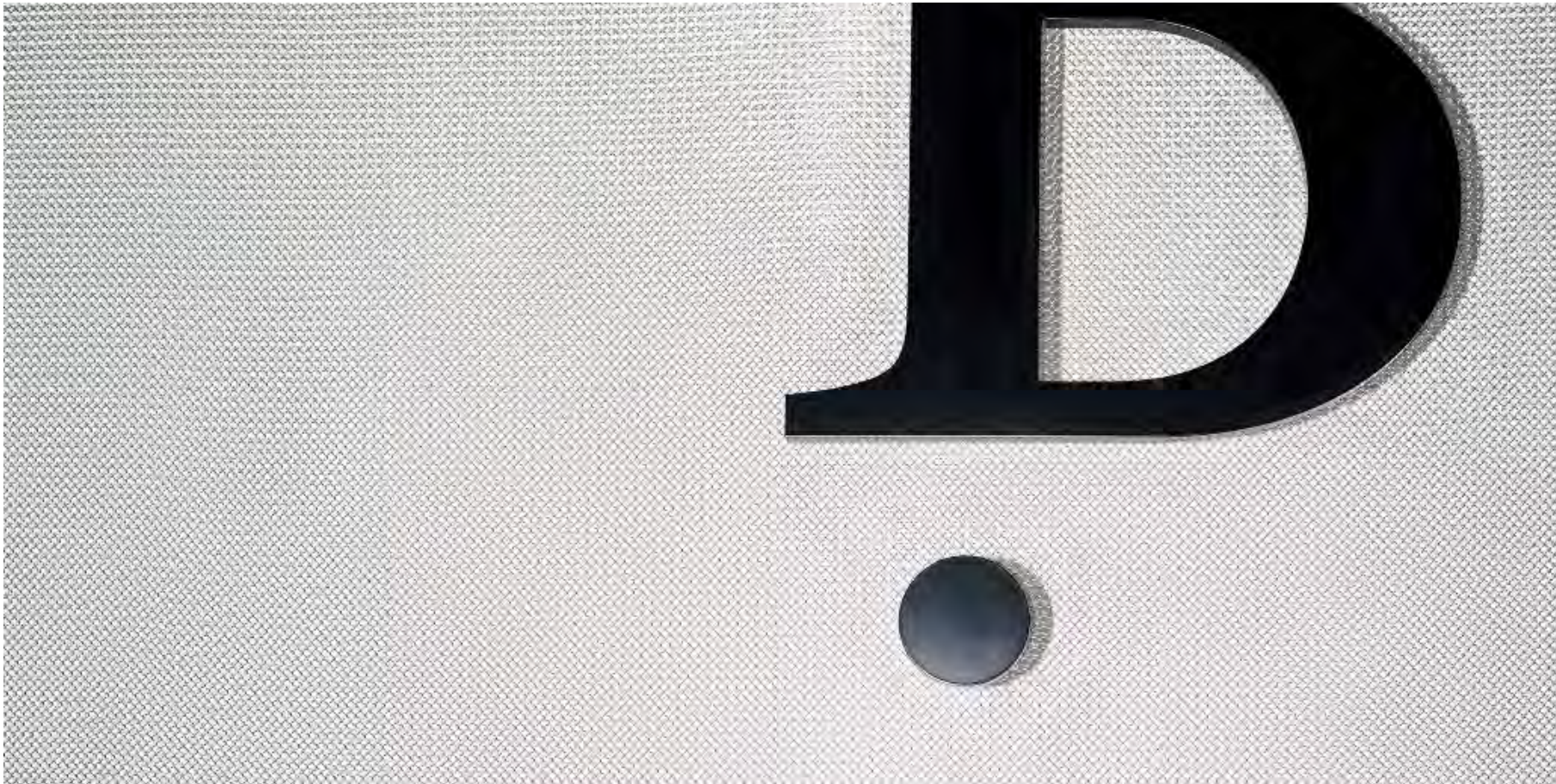
AGENDA



- I. Statistics**
- II. The Case Management System (CMS)**
- III. Service of the Statement of Claim**
- IV. How are deadlines handled at the UPC?**
- V. Oral hearings**
- VI. Language of the proceedings**
- VII. Preliminary injunctions: lessons learned**
- VIII. Has the UPC met expectations so far?**

Statistics

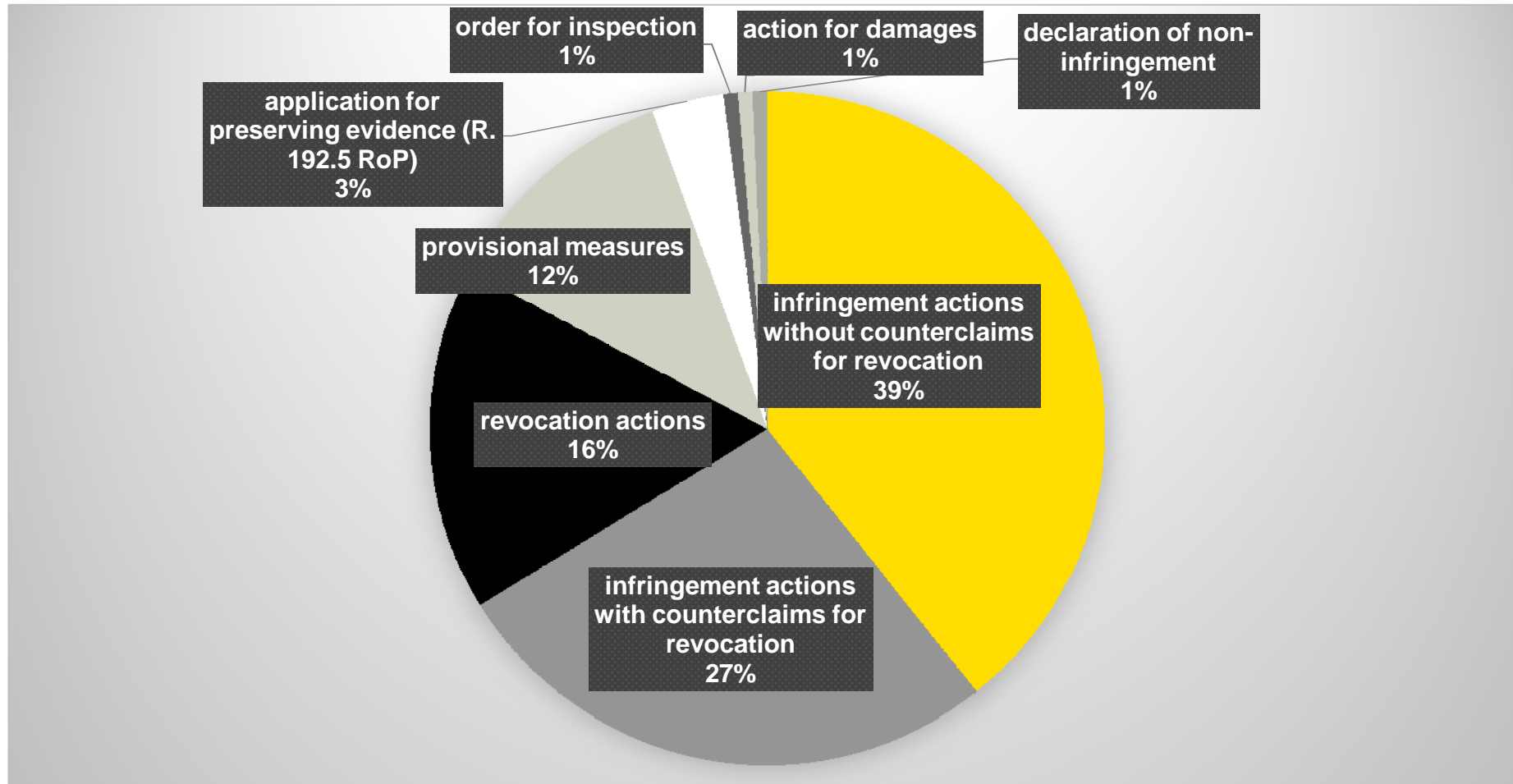
ḅ



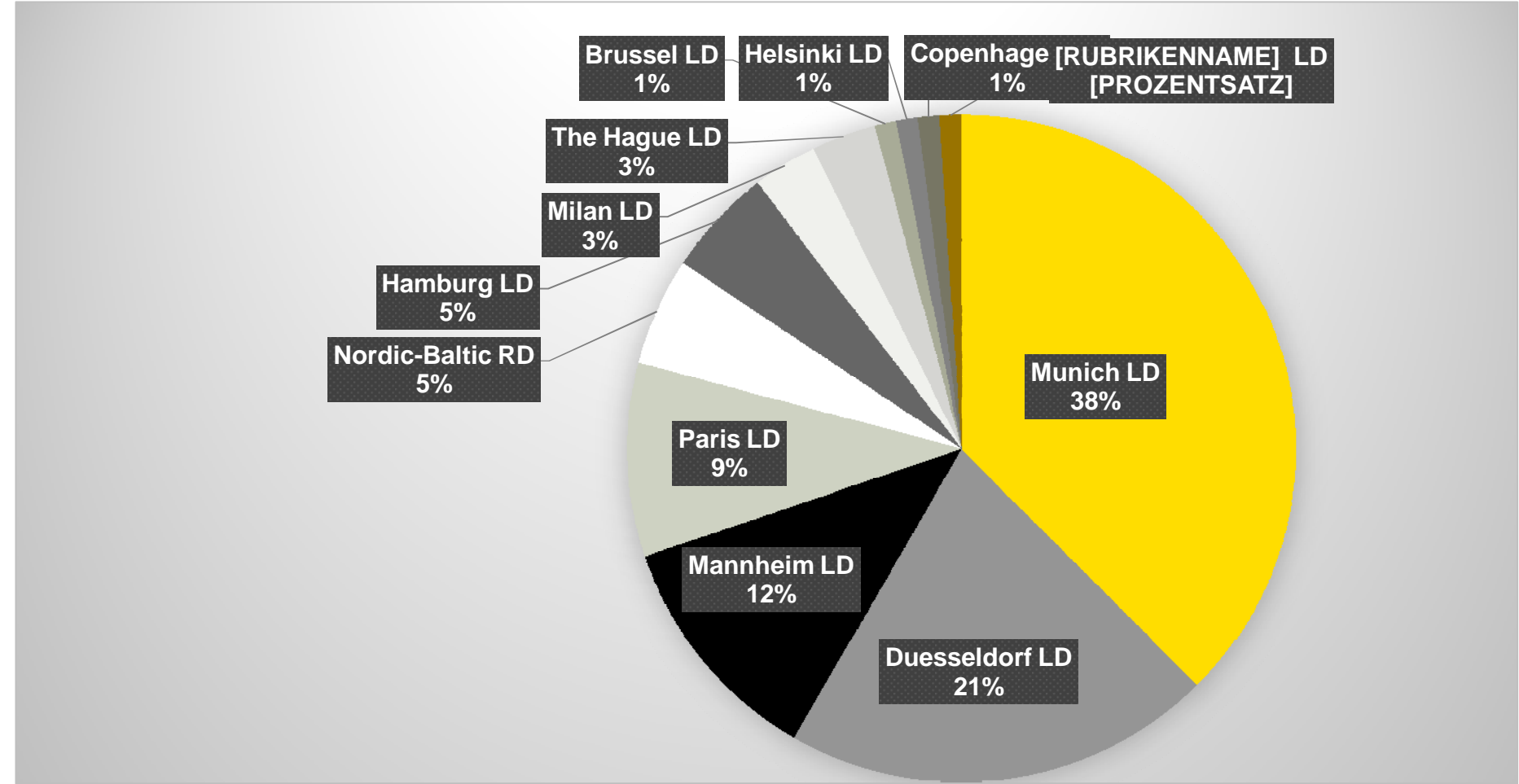
Lunes de patentes
19/03/2024

slide 3

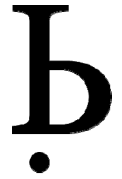
Types of actions



Infringement actions



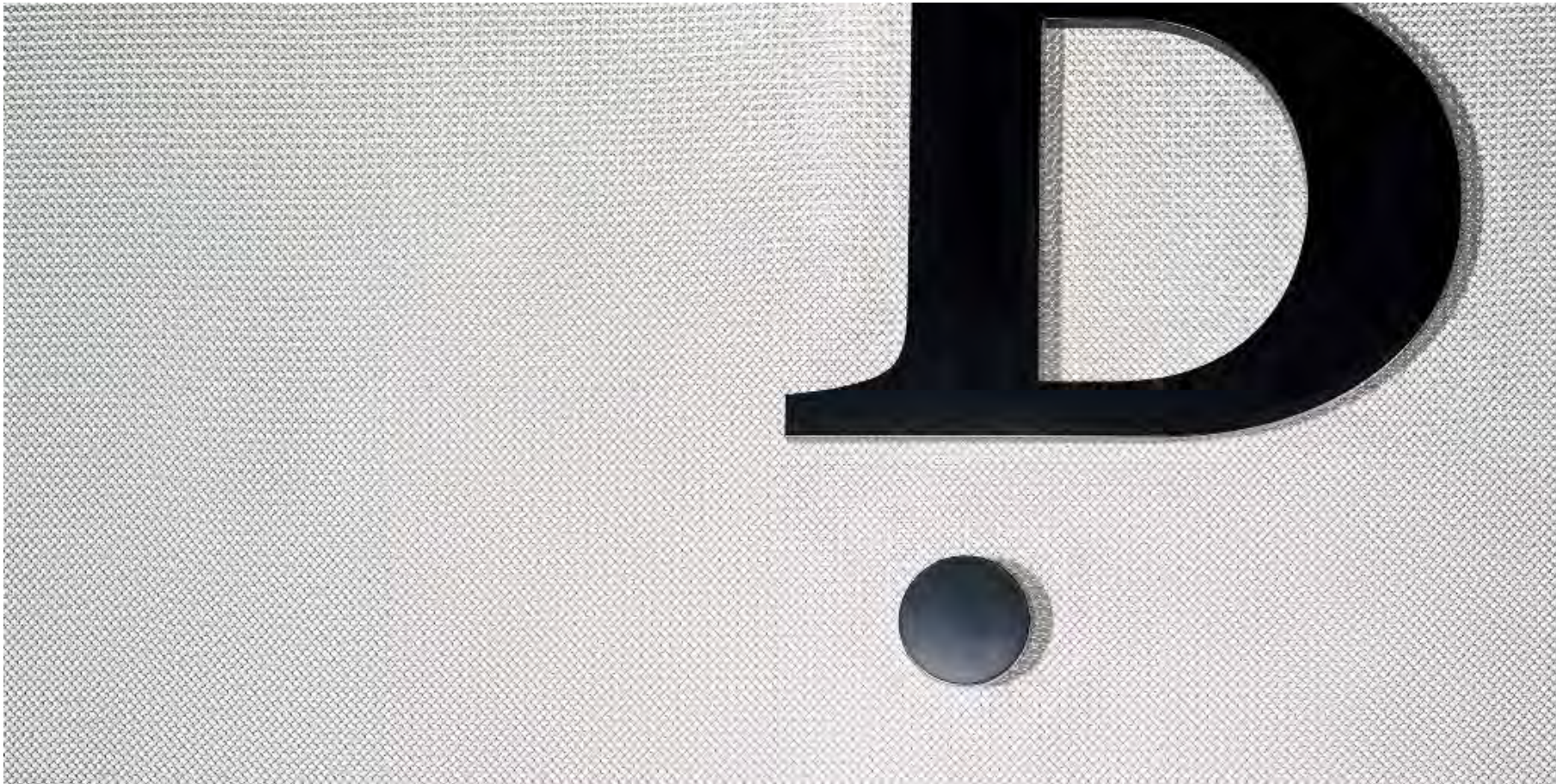
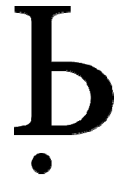
Case load of the Court_end Feb 2024_clean_final.pdf (unified-patent-court.org)



- We strongly believe in the UPC
- **We filed 6** of the initially filed 19 cases **on day 1** as reported by the court (2 PI requests, 4 main infringement actions and many protective letters). They include the **very first cases** filed at the Munich and Hamburg local divisions as well as the Munich central division.
- As of February 29, 2024, **274 cases** were pending at the UPC (case load of the Court), of which we handle over **70 cases, i.e. over 25%**.

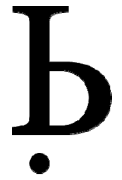


The Case Management System (CMS)



Lunes de patentes
19/03/2024

slide 7



» The Unified Patent Court ...
will be a success story and become
a global patent litigation hotspot! «

The Case Management System (CMS)



-----Ursprüngliche Nachricht-----

Von: upc-cms-sa@unifiedpatentcourt.org <upc-cms-sa@unifiedpatentcourt.org>

Gesendet: Montag, 25. September 2023 09:31

An: [REDACTED]@bardehle.de

Betreff: Communication from UPC - Application no. [REDACTED]/2023

Dear Party,

Please note that your protective letter has been received on 01/01/1970 and registered with Case no. [REDACTED]/2023.

A receipt is available for downloading in the Case Management System.

Your internal reference number: Not provided.

Your case may be accessed on the UPC Case Management System: [https://eur02.safelinks.protection.outlook.com/?url=\[REDACTED\]](https://eur02.safelinks.protection.outlook.com/?url=[REDACTED])

Yours sincerely,

The Unified Patent Court

The Case Management System (CMS)

b

Notice of the UPC – Order No. [REDACTED] 2023



upc-cms-sa@unifiedpatentcourt.org

An [REDACTED]

↩ Antworten

↩ Allen antworten

→ Weiterleiten



So 23.07.2023 00:00

Übersetzt aus: Deutsch [Original anzeigen](#) | [Automatische Übersetzung aktivieren](#)

Dear Party,

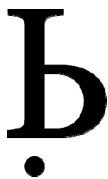
We would like to inform you that you are in default in relation to any action to be taken by you in connection with the case prior to UPC No. [REDACTED]/2023.

The case in question can be accessed via the UPC's case management system:

[https://eur02.safelinks.protection.outlook.com/?url=\[REDACTED\]](https://eur02.safelinks.protection.outlook.com/?url=[REDACTED])

Yours sincerely,
Unified Patent Court

The Case Management System (CMS)



CMS:

III. Hearing dates

Date of the conference in the interim proceedings	Not available
Place of the conference in the interim proceedings	Not available
Notes on the conference in the interim proceedings	##notes##
Date of the oral hearing	10:00
Venue of the oral hearing	Denisstr.3, 80335 Munich, Room 212, Overflow Room 220b
Notes on the oral hearing	##notes##
More details on each of the negotiations	##details##

Court:

5. The parties are hereby **summoned to an oral hearing on** (9:00 a.m. to 6:00 p.m.) at Denisstrasse 3, 80335 Munich, 2nd floor, meeting room 212. The summons to is only issued as a precautionary measure in the event that the matter cannot be conclusively discussed on

The Case Manager



My Proceedings			Case details	
App_	App_	Generic procedural Application	Munich local	
Number	App_	Generic procedural Application	Munich local	
		Procedural Application	Munich local	
App_			Generic procedural Application	Munich local
			Manage panel	Munich local
App_			Manage panel	Munich local
ORD_	App_	APL_	Appeal RoP220.2	Luxembourg Court of Appeal
	PR_App_	App_	Manage panel	Munich local
PR_	AUTH_	ORD_	Procedural Order	Munich local
App_	UPC_APP_	ORD_	Procedural Order	Munich local
App_	ACT_	App_	Manage panel	Munich local
App_	App_	CC_	Counterclaim for revocation	Munich central
App_	ORD_		EPO case	Munich local
App_	ORD_	ACT_	Infringement Action	Munich local
App_	ORD_	ACT_	Application for provisional measures	Munich local
App_	ORD_	ACT_	Infringement Action	Munich local
App_	App_	ACT_	Application for provisional measures	Munich local
App_	Generic procedural Application	ACT_	Application for provisional measures	Munich local
App_	Application to request confidential information (RoP262.2)	ORD_	Procedural Order	Munich local

Current problems



- Overwhelming amount of workflows without any indication on which workflow is connected to which infringement/nullity action
- Representatives (and the judges!) do not reliably receive notifications on new orders/filings in the CMS
- Uncertainties about deadlines: according to the RoP relevant deadlines are triggered by service of documents (no separate court order) – but time of service/deadline not visible in CMS
- Legal teams function has been introduced, but only one representative receives notifications (if at all)
- Upload capacity of CMS limited to 10Mb

THE CASE MANAGEMENT SYSTEM (CMS)

Improvement in sight...

b.



Information on new CMS Functionality – possibility to download multiple documents at once from a case

Users are informed that a functionality is now available on the CMS to download multiple documents at once from a given case

[ganzen Artikel lesen](#)

07 Dezember 2023



Information on new CMS Functionality – possibility to self-correct representative's data

Users are informed that a functionality is now available on the CMS to correct/update representative data

[ganzen Artikel lesen](#)

05 Dezember 2023

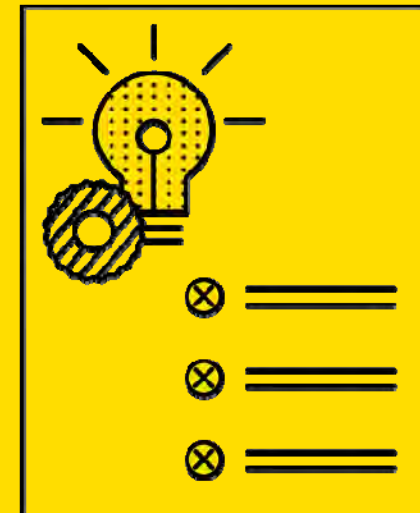


Information on new CMS Functionality - My Legal Team

Users are informed that, as of 28 November 2023, the "My Legal Team" functionality is available on the Case Management System (CMS)

[ganzen Artikel lesen](#)

27 November 2023

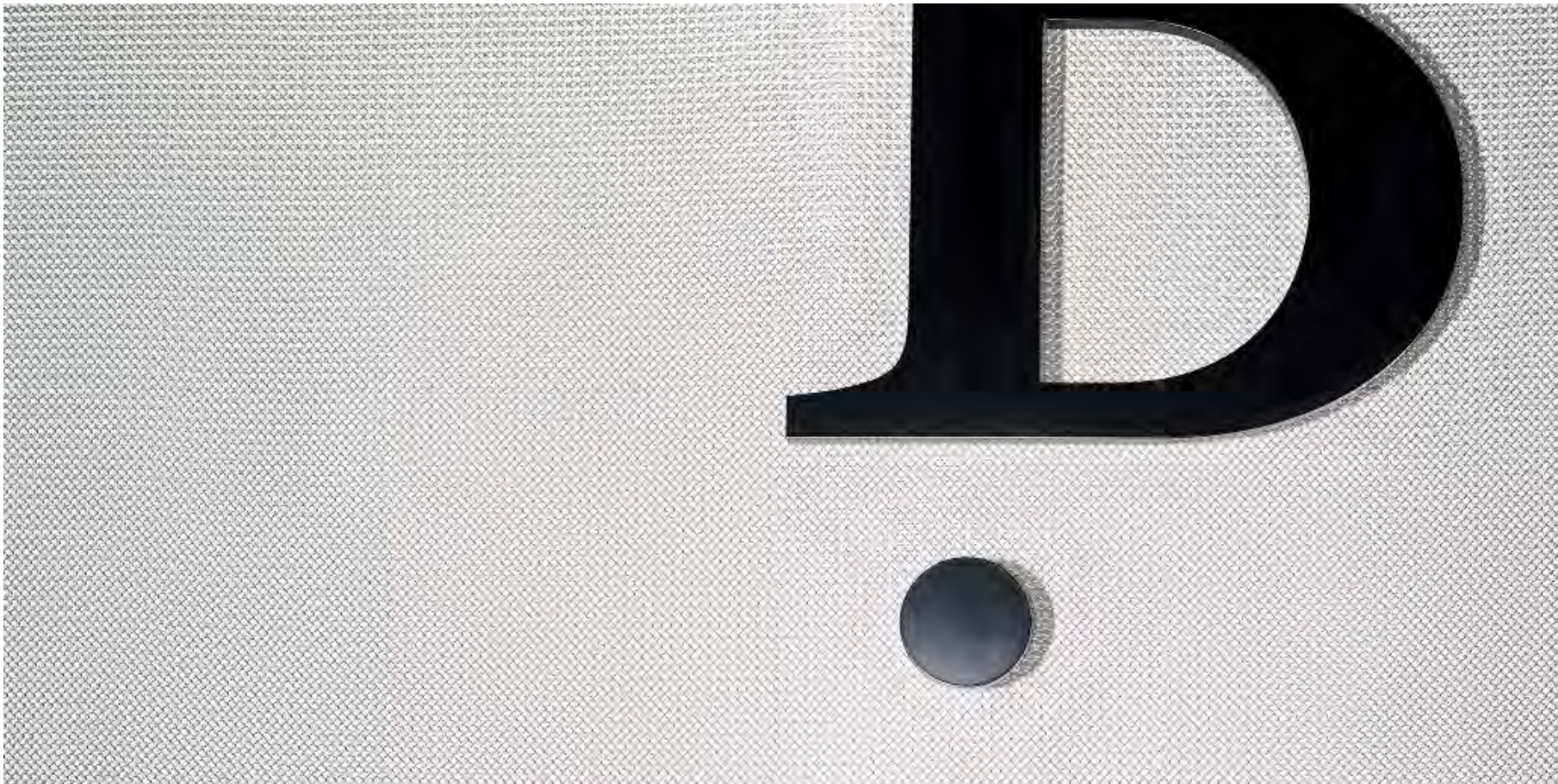


Lunes de patentes
19/03/2024

slide 14

Service of the Statement of Claim

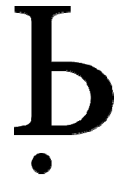
Ḅ



Lunes de patentes
19/03/2024

slide 15

Rules 270 et seqq. RoP



Defendant has
place of business
in UPC-MS

- Electronic means
- Registered letter
- Alternative methods

Defendant lacks
place of business
in UPC-MS

- Hague Convention
- Diplomatic channels
- Alternative methods

To name or not to name an address for electronic service?



Rule 271 – Service of the Statement of claim

1. The Registry shall serve the Statement of claim by electronic means if the conditions referred to in Article 19 of the Regulation (EU) 2020/1784 are met

To name or not to name an address for electronic service?



Article 19

Electronic service

1. The service of judicial documents may be effected directly on a person who has a known address for service in another Member State by any electronic means of service available under the law of the forum Member State for the domestic service of documents, provided that:
 - (a) the documents are sent and received using qualified electronic registered delivery services within the meaning of Regulation (EU) No 910/2014 and the addressee gave **prior express consent** to the use of electronic means for serving documents in the course of legal proceedings; or
 - (b) the addressee gave **prior express consent** to the court or authority seised of the proceedings or to the party responsible for service of documents in such proceedings to the use of email sent to a specified email address for the purpose of serving documents in the course of those proceedings and the addressee confirms receipt of the document with an acknowledgement of receipt, including the date of receipt.

Electronic Service



- R. 13.1 (d) RoP: Claimant to name „postal and, where available electronic addresses for service on the defendant“
- If an email address is named, the UPC will try to serve the defendant via that email address (R. 271.1 RoP)
- However, electronic service is only possible, if the defendant agrees (R. 271.1 RoP, Art. 19.1 Reg. (EU) 2020/1784)
- The UPC will wait for ca. 2 weeks for the defendant's acceptance of electronic service, only after expiration without consent it initiates service via registered letter → DELAY
- Claimant: strategically it can be better to opt for physical service right away!
- Defendant: electronic service does not need to be accepted, but...

Translation of all exhibits for service abroad?



STATEMENT OF CLAIM

Rule 13 – Contents of the Statement of claim

2. The claimant shall **at the same time supply** a copy of each of the documents referred to in the Statement of claim.

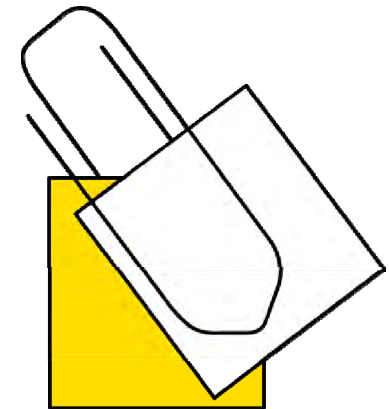
Rule 271 – Service of the Statement of claim

7. The Registry shall advise the defendant that he may refuse to accept a Statement of Claim if it is not written or not accompanied by a **translation into a language that he understands or that is an official language of the place where service is to be effected**, by enclosing with the document to be served form L in Annex I of Regulation (EU) 2020/1784.

Translation of all exhibits for service abroad?



- R. 271.7 RoP: Translation of SoC to official language of the place where service is to be effected (or language that the defendant understands)
- R. 13.2 RoP – „Contents of the SoC“: The claimant shall at the same time (of lodging the SoC) supply a copy of each of the documents referred to in the SoC
- Problem: Translation of extensive exhibits (Costs + Delay)?
- Solution: Filing of SoC and all exhibits via the CMS, translation and service of only the SoC, which needs to be substantiated and conclusive without exhibits
- Order of UPC CoA of October 13, 2023, UPC_CoA_320/2023



How to serve in countries where service is hardly possible?



Rule 275 – Service of the Statement of claim by an alternative method or at an alternative place

1. Where service in accordance with Section 1 or 2 **could not be effected** the Court on an application by the claimant that there is a good reason to authorise service by a method or at a place not otherwise permitted by this Chapter, the Court may by way of order permit service by an alternative method or at an alternative place.
2. On a **reasoned request** by the claimant, the Court may order that steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place is good service.

SERVICE OF THE STATEMENT OF CLAIM

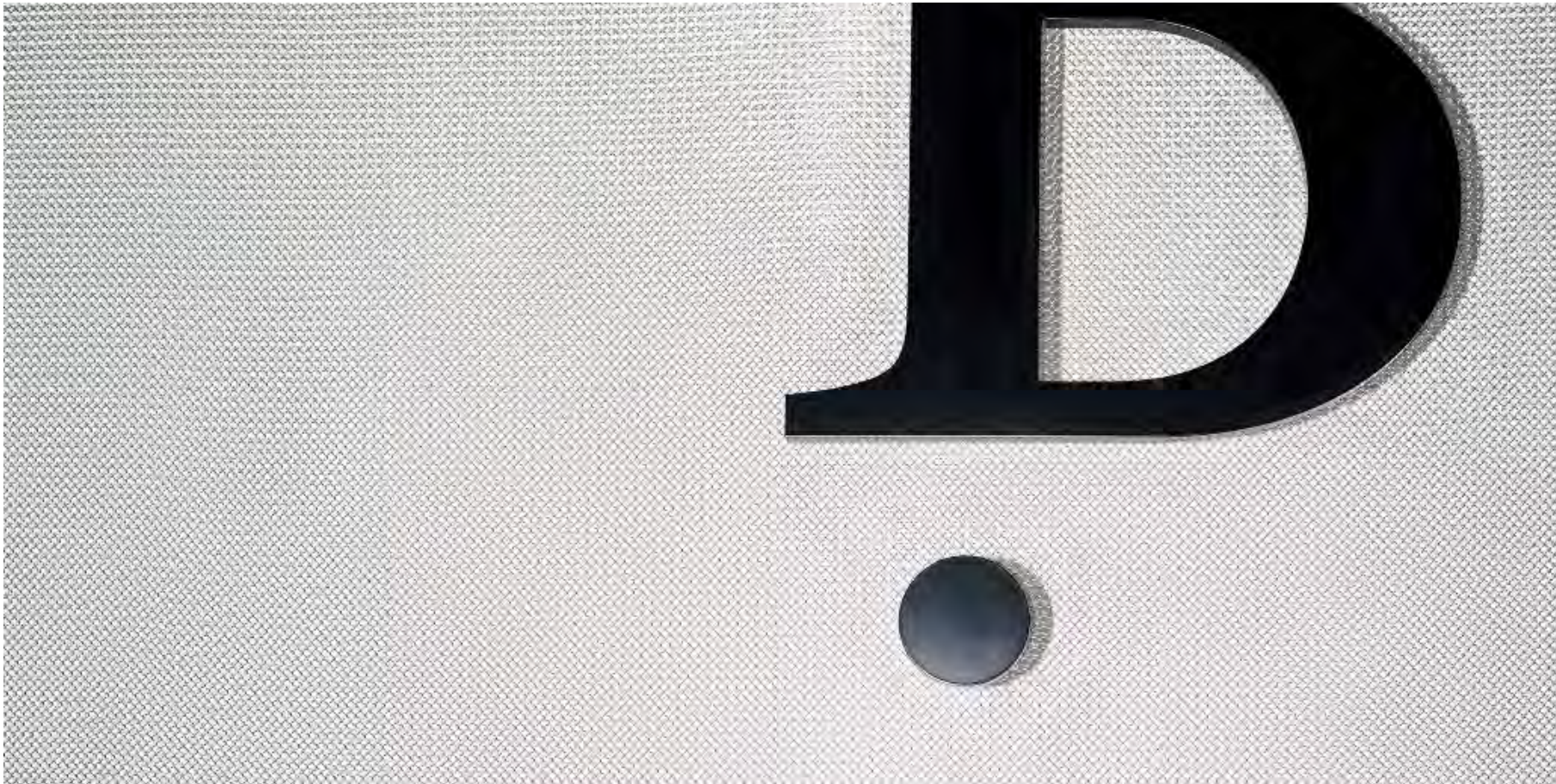
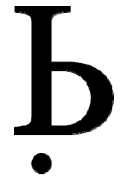
How to serve in countries where service is hardly possible?

b.

- R. 275 RoP
 - R. 275.1 RoP: service of the SoC by an alternative method or at an alternative place
 - R. 275.2 RoP: Court may order that unsuccessful steps to serve the SoC are deemed good service
- BUT:
 - R. 275.1 RoP: alternative service only possible „where service in accordance with Section 1 [Service within UPC MS] or Section 2 [Service outside UPC] could not be effected“
- Strategic advice: consider filing two separate complaints
- Appeal pending at the CoA (UPC_CoA_69/2024)



How are deadlines handled at the UPC?

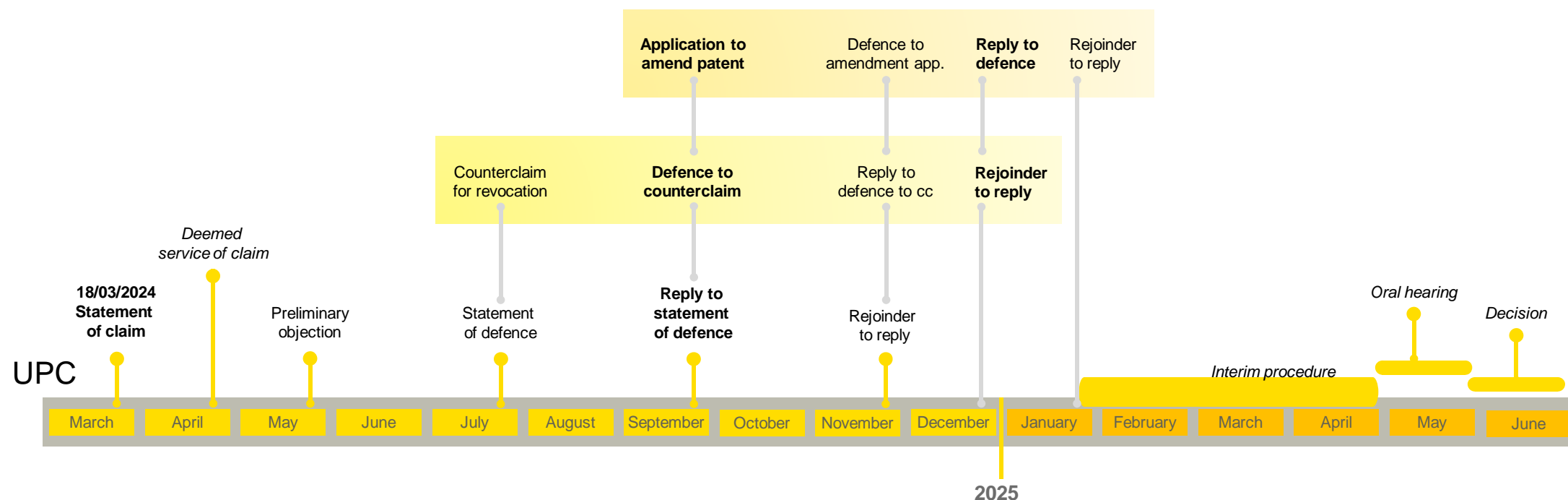


Lunes de patentes
19/03/2024

slide 24



Timeline for UPC infringement action (including counterclaim for revocation)



How are deadlines handled at the UPC?

Rule 9 – Powers of the Court

1. The Court may, at any stage of the proceedings, of its own motion or on a reasoned request by a party, make a procedural order such as to order a party to take any step, answer any question or provide any clarification or evidence, within time periods to be specified.
2. **The Court may disregard any step, fact, evidence or argument which a party has not taken or submitted in accordance with a time limit set by the Court or these Rules.**
3. Subject to paragraph 4, on a reasoned request by a party, **the Court may: (a) extend, even retrospectively, a time period referred to in these Rules or imposed by the Court; and (b) shorten any such time period.**
4. The Court shall not extend the time periods referred to in Rules 198.1, 213.1 and 224.1

Time extensions only under exceptional circumstances



- Exceptional circumstances ✓
 - Declaration of representative to represent all defendants (particularly also foreign defendants, which have not yet been served) in exchange to a „minor“ time extension (LD Dusseldorf, January 19, 2024, UPC CFI 457/2023)/ with the agreement of the other party, if such agreement serves procedural efficiency (LD Munich, 4 December 2023, UPC CFI 213/2023, 220/2023, 224/2023)
 - Beginning of a new court system and difficulties of CMS (LD Munich, 23 August 2023, UPC CFI 15/2023; LD Munich, 10 August 2023, UPC CFI 15/2023)

Time extensions only under exceptional circumstances



- Exceptional circumstances ✓
 - Delayed access of party to unredacted pleading because of attorneys-eyes-only discussions on confidentiality (LD Hamburg, 28 November, 2023, UPC CFI 54/2023)
 - Alignment of deadlines of reply brief (delayed by confidentiality requests included in SoD) and response to counterclaim for revocation (LD Hamburg, 5 December 2023, UPC CFI 54/2023)
 - Delayed filing of exhibits (LD Hamburg, 27 October 2023, UPC CFI 22/2023; CoA, 13 October 2023, UPC CoA 320/2023)

HOW ARE DEADLINES HANDLED AT THE UPC?

Time extensions only under exceptional circumstances



- Exceptional circumstances ✖
 - Subjective reasons concerning the party or its representatives, since meeting the deadline must objectively be impossible or very difficult (CD Paris, February 9, 2024, UPC CFI 412/2023)
 - Representative on vacation (LD Munich, 10 August 2023, UPC CFI 15/2023)
 - Workload of representative (LD Munich, 10 August 2023, UPC CFI 15/2023)

Time extensions only under exceptional circumstances



- Exceptional circumstances ✖
 - Coordination with suppliers based abroad to clarify question of infringement, since such difficulties are taken into account by the deadlines stipulated in the RoP (LD Hamburg, 22 August 2023, UPC CFI 54/2023)
 - Alignment of deadlines regarding various co-defendants, since alignment can also be achieved via shortening of deadlines (LD Munich, 23 August 2023, UPC CFI 15/2023)

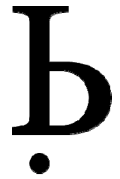
Time extensions only under exceptional circumstances



- Exceptional circumstances ✖
 - Pending preliminary objection re. inadmissibility of complaint, since this is taken into account by the RoP, particularly R. 19.6 RoP (CD Paris, 20 February 2024, UPC CFI 454/2023)
 - General assertion that CMS was unavailable “for a longer period of time” (LD Dusseldorf, 20 January 2024, UPC CFI 363/2023)

HOW ARE DEADLINES HANDLED AT THE UPC?

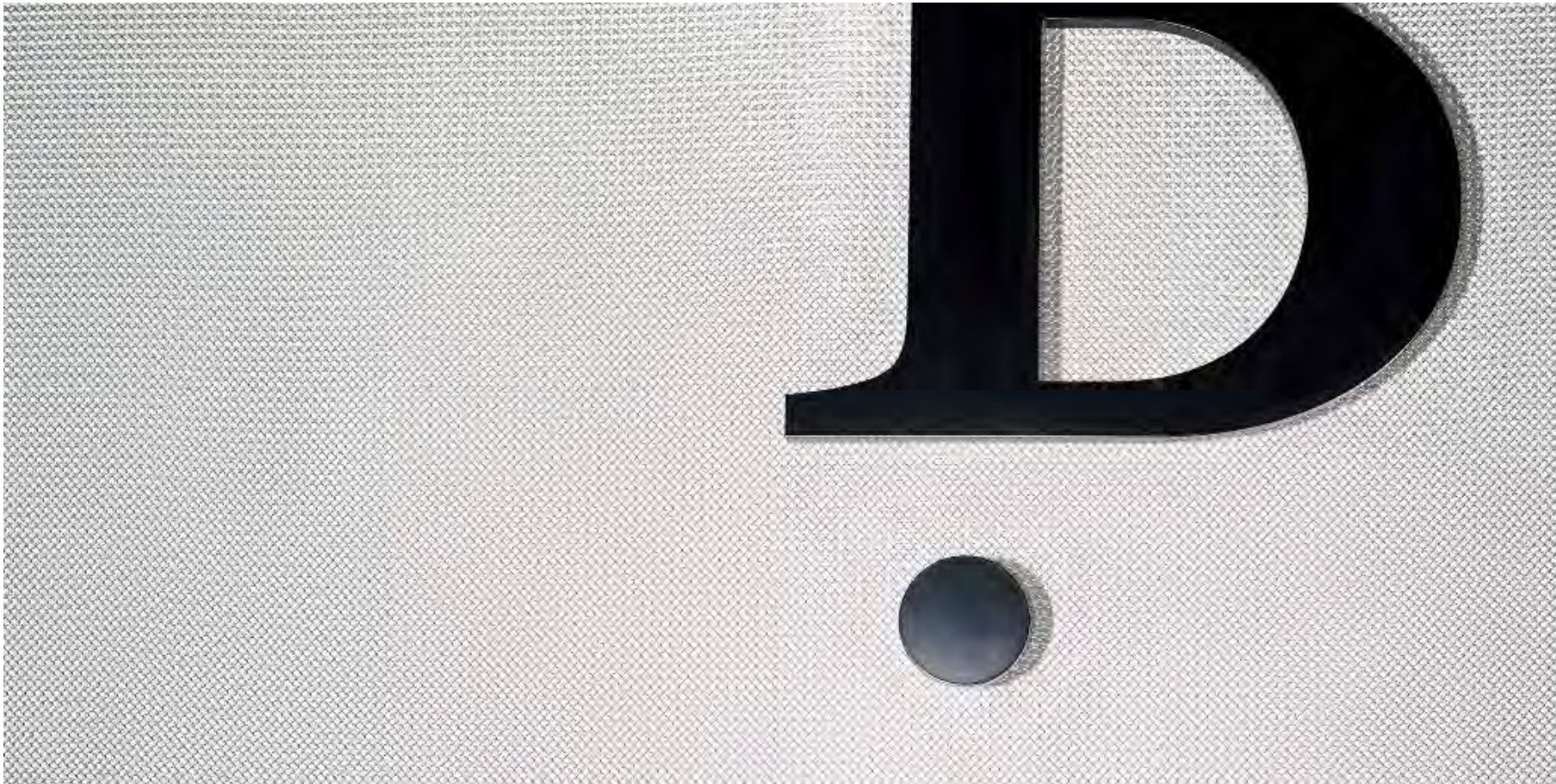
Expected backlog of cases



- UPC increasingly busy, particularly LD Munich
- Legally qualified judges have part-time assignments
- Open, whether UPC will be able to keep up the envisaged timing long-term

Oral hearings

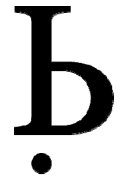
Ḃ



Lunes de patentes
19/03/2024

slide 33

Oral hearings



**Preliminary Order (Hearing Invitation)
of the Court of First Instance of the Unified Patent Court
delivered on 09/08/2023**

4 HEARING INVITATION

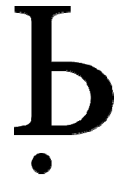
4.1 In view of the foregoing, Parties are hereby invited to an oral hearing on

THURSDAY 17 AUGUST 2023, AT 15.00 CET

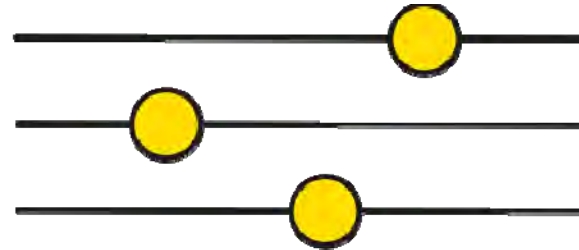
Via the Webex platform by any of the following means:

4.7 The Court is conscious that this hearing is scheduled on short notice and in the summer vacation period. Nevertheless, given the videoconference format and the limited scope of this hearing, requests to reschedule the hearing will in principle not be allowed. The RoP demand a decision on the Preliminary Objection “as soon as practicable” and a decision as soon as possible also appears to be in the interest of the parties.

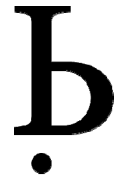
Oral hearings



- Structure of the oral hearing (introduction, speaking time, questions)
- Preparation and collaboration of judges
- Quality of the discussion
- Audio recording!



Oral hearings



- 4.2 At the oral hearing, the Judge-rapporteur will give a brief introduction of the case and may ask parties to comment on certain specific points.
- 4.3 After this introduction, parties will have:
 - 20 minutes each to present their arguments (Defendant, Applicant in the Preliminary Objection, to argue first).
 - 10 minutes each, limited to rebuttals only (Defendant, Applicant in the Preliminary Objection, to rebut first).
- 4.4 The Judge-rapporteur will then address any outstanding issues and close the hearing. An intended date for a decision or order on the Preliminary Objection will be indicated.

ORAL HEARINGS

Audio recordings!

b.

7.

Interpreters and stenographers can join the hearing via videoconference. Participants in the hearing room, the overflow room or in the court's videoconference can listen to the interpretation using own devices connected to the internet and own headphones.

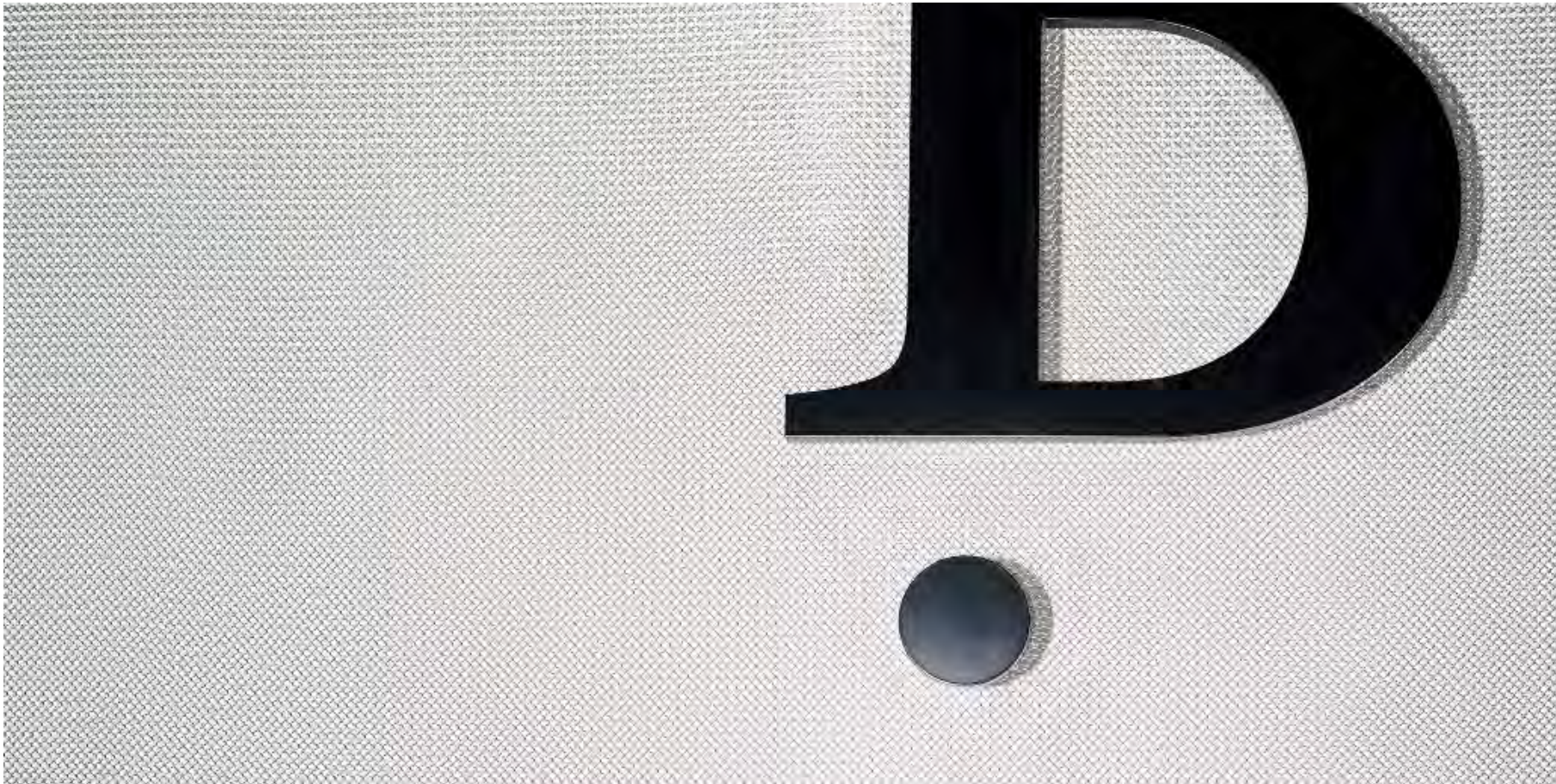
8.

Oral hearings will be audio-recorded according to the rules of procedure. To achieve a good recording and a good transmission to room 220b and/or the video conference the following guidelines should be observed:

- a. Only one speaker at any given time.
- b. Only speak into the microphone when the light is green (green = microphone is on).
- c. State your name and function before your contribution, at least when speaking for the first time and after each break.

Language of the proceedings

Ḕ



Lunes de patentes
19/03/2024

slide 38

Language of the proceedings

Article 49

Language of proceedings at the Court of First Instance

1. The language of proceedings before any local or regional division shall be an official European Union language which is the official language or one of the official languages of the Contracting Member State hosting the relevant division, or the official language(s) designated by Contracting Member States sharing a regional division.
2. Notwithstanding paragraph 1, Contracting Member States may designate one or more of the official languages of the European Patent Office as the language of proceedings of their local or regional division.

Language of the proceedings

4. With the agreement of the parties the competent panel may, on grounds of convenience and fairness, decide on the use of the language in which the patent was granted as the language of proceedings.

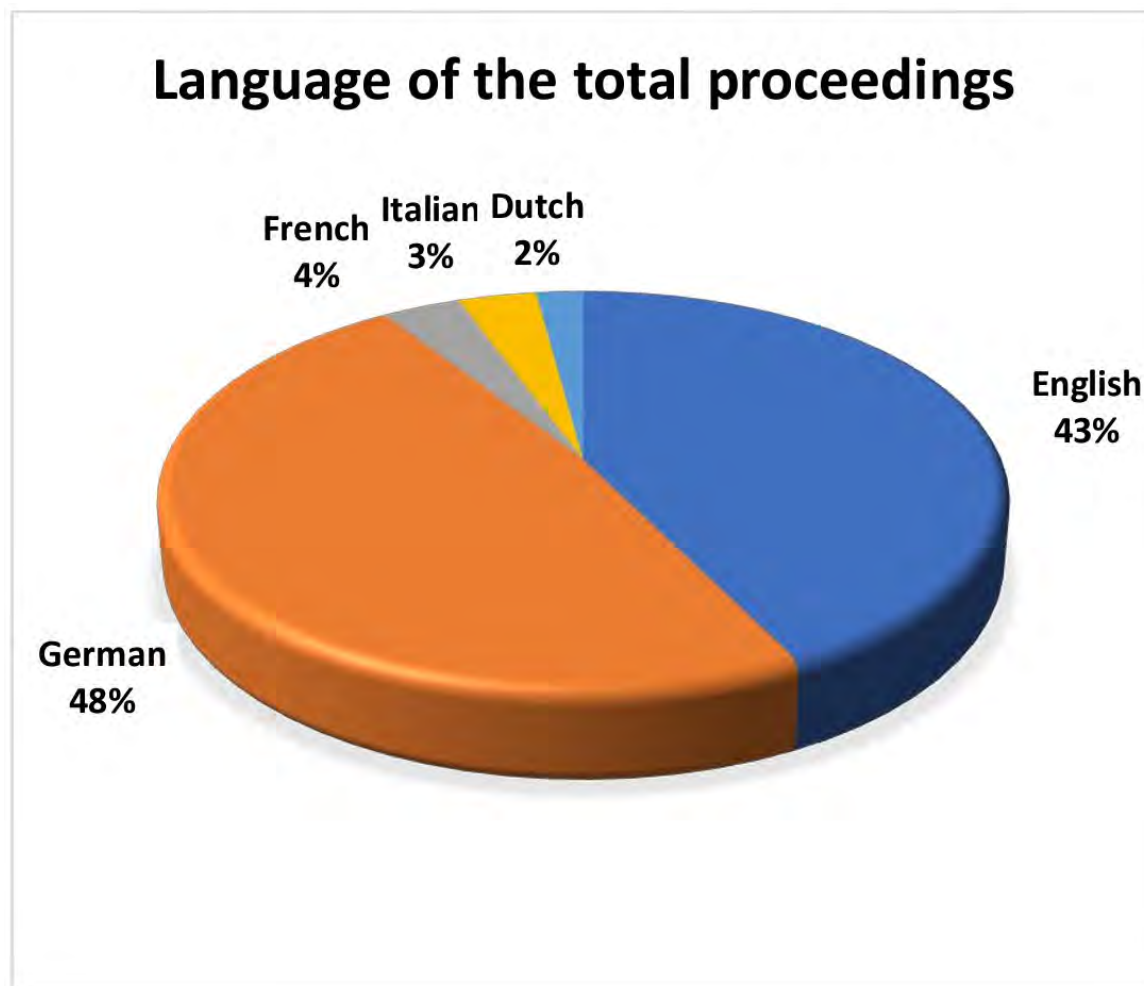
5. At the request of one of the parties and after having heard the other parties and the competent panel, the President of the Court of First Instance may, on grounds of fairness and taking into account all relevant circumstances, including the position of parties, in particular the position of the defendant, decide on the use of the language in which the patent was granted as language of proceedings. In this case the President of the Court of First Instance shall assess the need for specific translation and interpretation arrangements.

Language of the proceedings

ḃ

6. The language of proceedings at the central division shall be the language in which the patent concerned was granted.

Language of the proceedings



Change of language



Sehr geehrte Vertreter in der oben genannten Rechtssache (Berufungsverfahren [REDACTED]),

bezüglich der mündlichen Verhandlung [REDACTED] möchten wir Ihnen mitteilen, dass der Spruchkörper (panel) es sehr begrüßen würde, wenn diese in englischer Sprache abgehalten werden könnte.

Sind Sie damit einverstanden?

Für eine kurze Stellungnahme hierzu wären wir Ihnen sehr dankbar.

Die Kanzlei des EPG

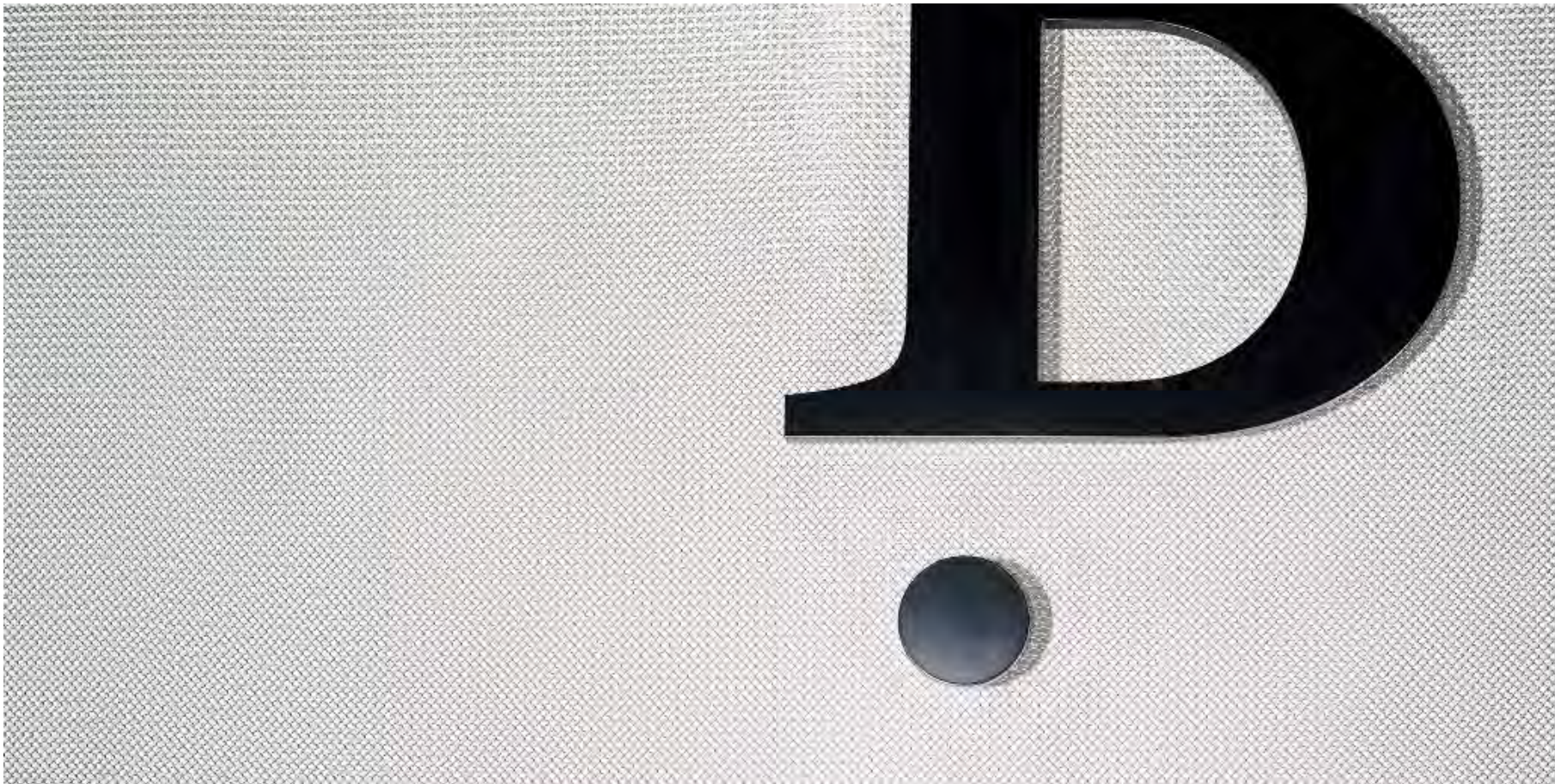
Change of language



- Facilitation of general organisation at the UPC both in first and second instance **cannot** in itself justify a change of language to English
(LD Düsseldorf, February 26, 2024, UPC CFI 463/2023)
- Change of language without agreement of the claimant, if language initially chosen by the claimant is significantly detrimental to the defendant
(LD The Hague, 18 October 2023, UPC CFI 239/2023; LD Dusseldorf, 16 January 2024, UPC CFI 373/2023)

Preliminary injunctions – lessons learned

ᵇ



Lunes de patentes
19/03/2024

slide 45

Preliminary injunctions – lessons learned

Rule 211 – Order on the Application for provisional measures

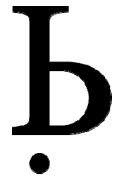
1. The Court may in particular order the following provisional measures:

(a) injunctions against a defendant;

2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a **sufficient degree of certainty** that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.

3. In taking its decision the Court shall in the exercise of its discretion **weigh up the interests** of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.

4. The Court shall have regard to any **unreasonable delay in seeking provisional measures**.



Preliminary injunctions – lessons learned

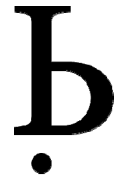
- PIs possible also in technically and legally complex cases
- Schedule depends
 - Oral hearing expected 3 months after filing
 - Decision expected at the end of the oral hearing or about 2 weeks later
 - Quicker in case of trade shows



Preliminary injunctions – lessons learned

- Validity presumption due to the granting act of the patent office (no battle-tested patent needed)
- Sufficient degree of certainty: according to LD Munich “preponderant likelihood” for validity, i.e. “>50 %”
- PI must be necessary (R. 206.2 (c) RoP)
 - Temporal circumstances
(R. 209.2 (b) RoP: “urgency”; R. 211.4 RoP: “unreasonable delay”)
 - Factual circumstances
(R. 211.3 RoP: “potential harm of claimant”)

Balancing of interests – overall assessment



In exercising its discretion, the degree of probability to which the court is convinced of the existence of the individual circumstances to be included in the weighing up is also crucial. The more certain the court is that the right holder is asserting the infringement of a valid patent, that there is a need to issue an injunction due to factual and temporal circumstances and that this is not opposed by possible damages of the opponent or other justified objections, the more justified the issuance of a prohibitory injunction is. Conversely, if uncertainties exist with regard to certain circumstances relevant for the weighing up of interests which undermine the court's conviction, the court may consider as a more lenient measure the alleged infringement to continue subject to the provision of security or even the dismissal of the request.

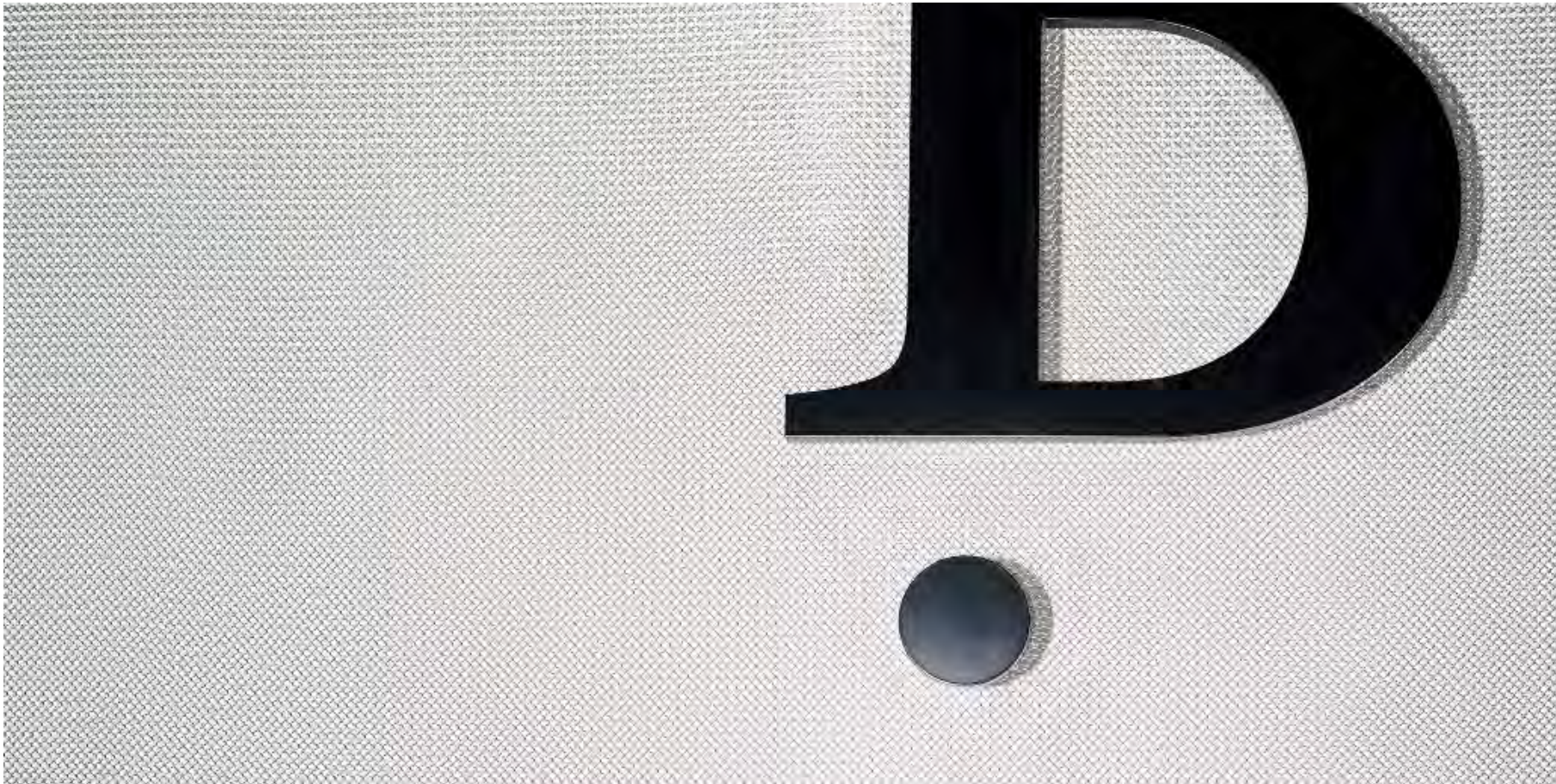
Enforcement



- Immediate enforcement of PI without bond, if claimant is
 - “good for the money“ and
 - domiciled in a country where the recovery of lost profits does not cause serious issues
- PI for all UPC-MS at once – but enforcement according to national law of MS where enforcement takes place
- Be mindful of potential practical difficulties, particularly in the initial phase of this new court!

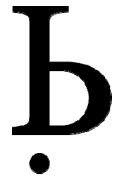
Has the UPC met expectations?

ᵇ



Lunes de patentes
19/03/2024

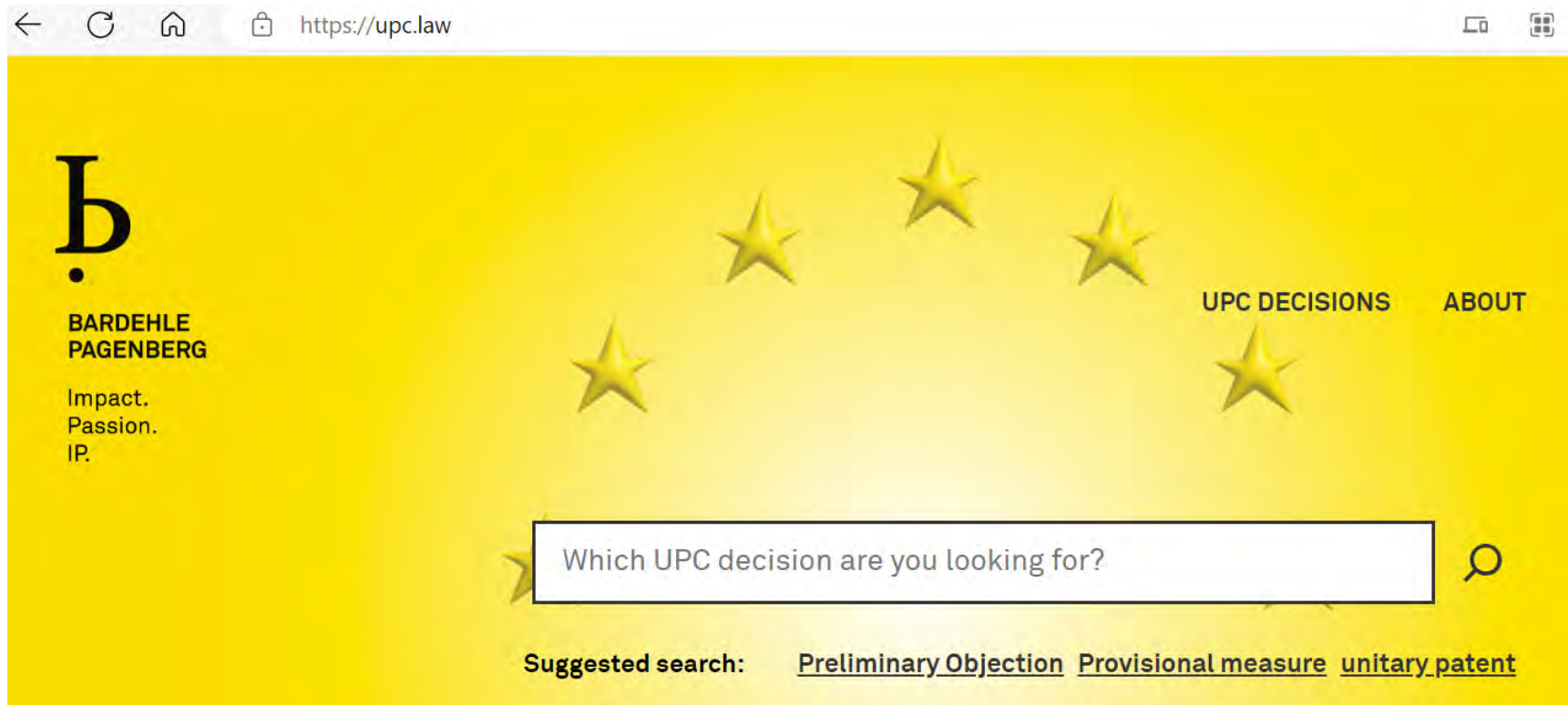
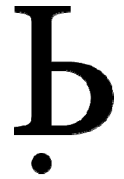
slide 51



Has the UPC met expectations?

- Ca. 100 infringement actions after 9 months
- Expected wave of central revocation actions failed to materialize
- Brain drain – the best national judges join the UPC
- Judges motivated to make the UPC a success
- LD and CD seem to aim for harmonized approach
- UPC cases require time commitment and a large team

Useful links



Thank you!



Johannes Heselberger
heselberger@bardehle.de



Dr. Ronja Schregle
ronja.schregle@bardehle.de

BARDEHLE PAGENBERG
Partnerschaft mbB
Prinzregentenplatz 7
81675 München

Best European IP Firm Patent Litigation and Best IP Advisor Germany & Austria 2022 – Leaders League
Firm of the Year for Trademarks in Germany 2021 – Managing IP
Law Firm of the Year 2020 for Intellectual Property Law – Best Lawyers® and Handelsblatt
Europe's Leading Patent Law Firms 2022 – Financial Times
TOP-KANZLEI Patentrecht 2022 – WirtschaftsWoche



**BARDEHLE
PAGENBERG**

Impact.
Passion.
IP.



bardehle.com