

Los Lunes de Patentes/The Patent Mondays

UPC in Action: Recent Experiences from an Industry Perspective

Conor Wilman

Barcelona

29 September 2025

Topics to be covered

- 00 Introduction
- 01 Service
- 02 Revocation/infringement action timelines
- 03 Stays
- 04 The Interim Procedure
- 05 The Oral Hearing
- 06 Decisions
- 07 Lessons Learned

00: Introduction

UPC in Action: Recent Experiences from an Industry Perspective

About Dehns

00: Introduction

- Founded in 1920
- One of the largest IP law firms in Europe (275+ people)
- London, Munich, Oslo + 5 other offices
- Patents, Trade Marks, Designs
- Extensive EPO Oppositions/Appeals experience
- Dispute Resolution, Litigation, IP Consulting, Trade Secrets



Conor Wilman

Associate, Dehns

**European and UK Patent
Attorney, UPC Representative**

cwilman@dehns.com

01: Service

UPC in Action: Recent Experiences from an Industry Perspective

What is it?

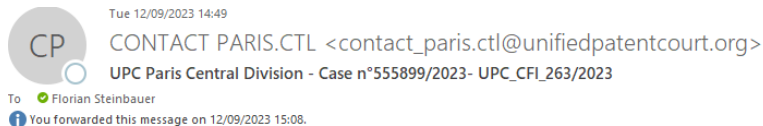
01: Service

- Providing documents to the other party
- Generally, parties can serve on one another via post or email
- Deadlines calculated from date of *effective* service
- But at the UPC, the Court itself serves



Bitzer v Carrier – Accepting Service

01: Service



Dear Mister STEINBAUER,

Following your request to our IT team, we send you again the secret code (that you should have had received to this email address : mail@dehns.com) in order to gain access to the case n°555899/2023 on the Case Management System :

9c3c44f0-f22b-4272-bd79-bd6e30892bb3

In order to use it, please go on the CMS website (<https://cms.unified-patent-court.org>), go to the “Representation” section in the main menu and click on the “Access CMS case” menu item.

We would also like to remind you the following rules :

You shall lodge a Statement of defense within two months of service of the Statement of claim (Rule 49 of the Rules of Procedure).

The Statement of defense shall contain the information specified in Rule 50 of the Rules of Procedure.

If you fail to answer within the stated time, a decision by default may be issued against you (Rule 355 of the Rules of Procedure).

Receiving a
“secret
code” for
CMS access

Bitzer v Carrier – What's Public?

01: Service

Proceeding Search

No.	555899/2023
Patent Number	EP
Party type and description	Only use letters and numbers and omit two words.
	- Select Type
Representative	Representative name and/or surname
Case Visibility	Public cases
Proceeding Type	- Select
Action / Application Type	- Select
Court Division	- Select Division
Language	- Select language
Your Internal Reference	
Keywords for Orders and Decisions	Enter keywords separated by semicolon
Date of lodging	From

Number	Proceeding Type	Court Division
ACT_555899/2023	Revocation Action	Paris central

Looking up a new
action no. to view basic
details

Bitzer v Carrier – What's Public?

01: Service

The screenshot shows a legal proceedings interface. At the top left, the case number 'No. ACT_555899/2023' and 'UPC_CFI_263/2023' are circled in red. To the right is an 'Actions' button. Further right are buttons for 'Related Proceedings' and 'Calendar'. Below the case number, there is a 'Revocation Action' section with a 'Written Procedure' dropdown menu. The menu is open, showing options: 'Statement for revocation / Declaration of invalidity', 'Panel', 'Service on Carrier Corporation, CT', and 'Defendant Data Carrier Corporation, CT'. At the bottom of this menu is a 'Party's Details' button with a person icon and a right-pointing arrow. To the right of the 'Revocation Action' section is a tabbed interface with tabs: 'Overview', 'Patents', 'Personal details', 'Judges', 'Documents', 'Opt-out status', and 'Procedural Data'. The 'Patents' and 'Personal details' tabs are circled in green. A large 'X' is drawn over the 'Documents' tab. Below the tabs is a table with the following data:

Registry Number	ACT_555899/2023
Proceeding Type	Revocation Action
Documents	14
Court Division	Paris central division - First Instance
Language	English
Court Division agreed with defendant	no
Single judge request	Not Requested
Value of the action	250,000.00 EUR

Technisches Management
computer system from
jurisdiction within
de dehn

UPC Case Management System

Dashboard FIRST INSTANCE APPEAL Applications and Requests REGISTER and Search Register

Reports Support center

Access to CMS case

To obtain access to your case provide the following details:

Case number and year **555899** 2023

Access code * 9c3c44f0-f22b-4272-bd79-bd6e30892bbd

Revocation action
no. 555899/2023

No. 572661 / 2023
UPC CFI 263/2023

Actions menu

Access to case

Party's details TO DO

Overview Personal details Documents

Proceeding number 572661

Proceeding Type Access to case

Documents

Access to case

Party's details ✓

Representative's Detail

Representative's Detail - Access to case - Access to case - 572661 / 2023

* indicates required data
Data available in precompiled fields is retrieved from user profile and company data

Nature of representation * Sole representative

First Name * — Select

Last Name * Sole representative

Company/Firm Member of a team

Contact e-mail * In-house representative

glees@dehns.com

Bitzer v Carrier – Case Access

01: Service

Separate CMS
workflow for
access to case

Dehns

Bitzer v Carrier – Ready to Accept Service?

01: Service

The screenshot shows the 'Access to case' sidebar on the left with three items: 'Party's details' (checked), 'Representative's Detail' (checked), and 'Voluntary acceptance of service' (marked 'TO DO' and circled in green). The main area is the 'Overview' tab, which displays a table with case details:

Proceeding number	572661
Proceeding Type	Access to case
Documents	0

Below the table, the 'Case Data' section shows the 'Main action case number' as ACT_555899/2023.

This screenshot shows the 'Voluntary acceptance of service' form. The sidebar on the left now shows 'Voluntary acceptance of service' as completed. The main form area has a title bar 'Voluntary acceptance of service - Access to case - Access to case - 572661 / 2023' and a close button (X). The form contains the following text:

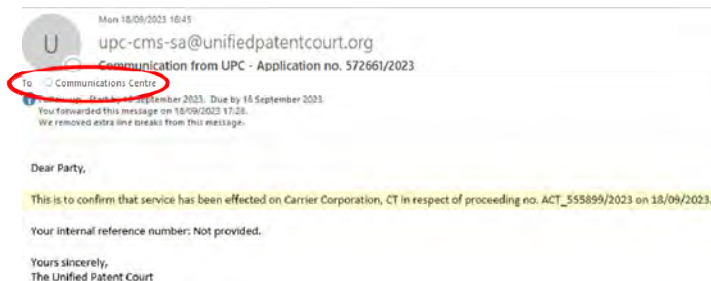
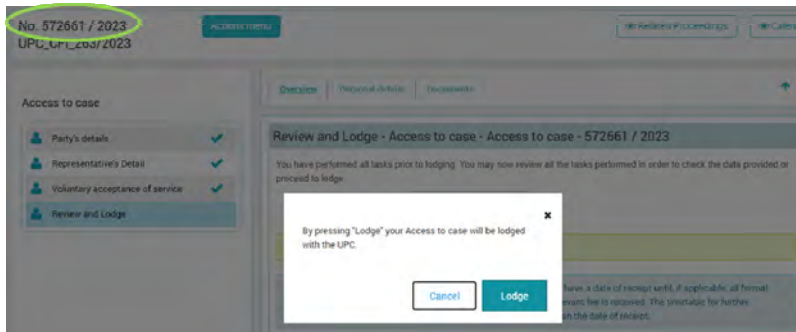
If you are authorised to accept service on behalf of Carrier Corporation in Case no. CT check the box below. When you click on "Complete" and lodge the authorisation to accept service you will be given access to the case detail. The date and time of service is when you lodge.

☐ I voluntarily accept service on behalf of Carrier Corporation in Case no. CT.

At the bottom right, there are three buttons: 'Cancel', 'Save', and 'COMPLETE'.

Bitzer v Carrier – Service Accepted!

01: Service



Bitzer v Carrier – Finally! Full Access

01: Service

Access to case

- Party's details ✓
- Representative's Detail ✓
- Voluntary acceptance of service ✓
- Review and Lodge ✓

Overview Personal details Documents

Registry Number	PR_572661/2023	Main proceeding	555899 view
Proceeding Type	Access to case		
Documents	0		

Case Data

Main action case number	ACT_555899/2023
-------------------------	-----------------

No. ACT_555899/2023
UPC_CFI_263/2023

Revocation Action

Written Procedure

Statement for revocation / Declaration of invalidity

Panel

Service on Carrier Corporation, CT

Defendant Data Carrier Corporation, CT

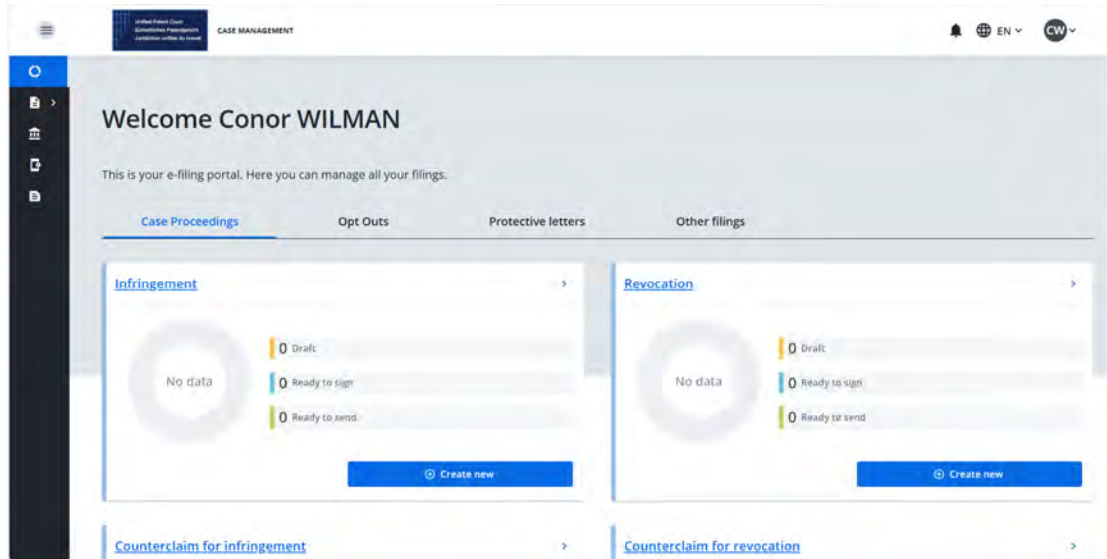
Party's Details

Overview Patents Personal details Judges Documents Opt-out status Procedural Data

Registry Number	ACT_555899/2023
Proceeding Type	Revocation Action
Documents	14
Court Division	Paris central division - First Instance
Language	English
Court Division agreed with defendant	no
Single judge request	Not Requested
Value of the action	250,000.00 EUR

The new CMS

01: Service

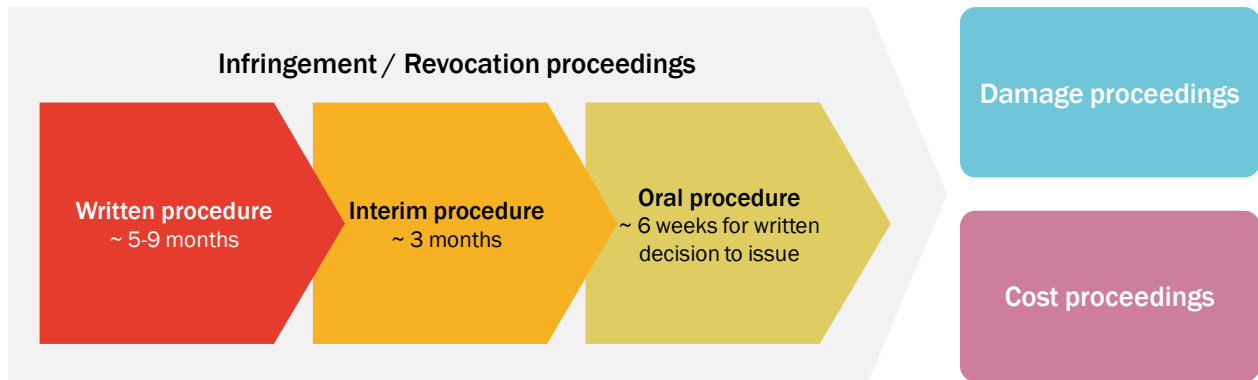


02: Revocation/infringement action timelines

UPC in Action: Recent Experiences from an Industry Perspective

What do the stages of UPC proceedings look like?

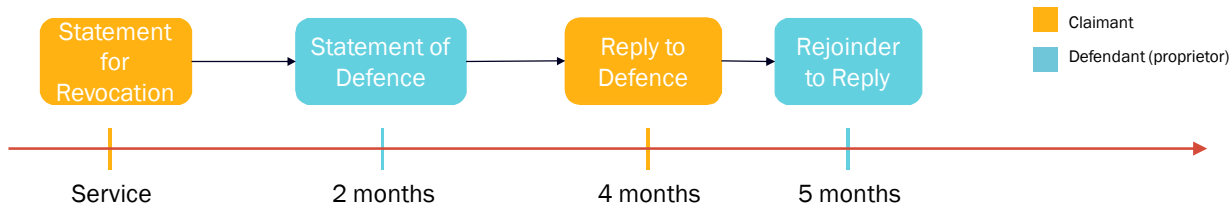
02: Revocation/infringement action timelines



What does the written procedure look like?

02: Revocation/infringement action timelines

Example: First
Instance Revocation
Proceedings



Value of the Proceeding

02: Revocation/infringement action timelines

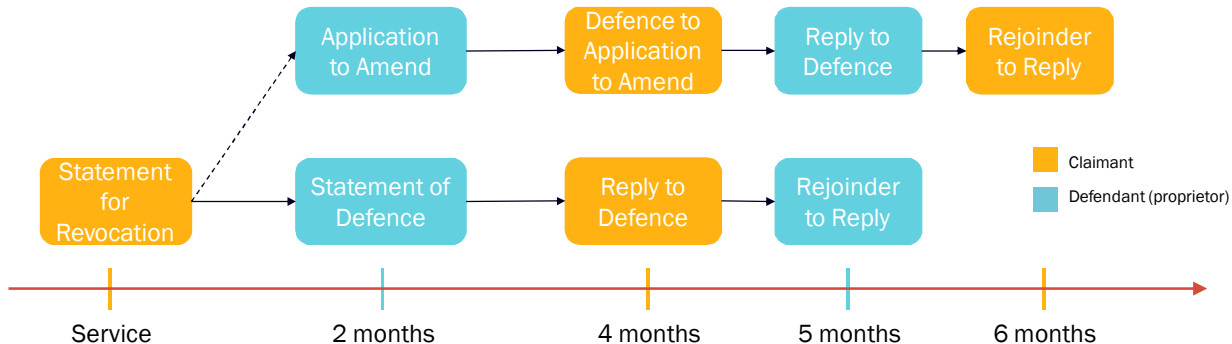
Scale of ceilings for recoverable costs

Value of the proceeding	Ceiling for recoverable costs
Up to and including 250.000 €	Up to 38.000 €
Up to and including 500.000 €	Up to 56.000 €
Up to and including 1.000.000 €	Up to 112.000 €
Up to and including 2.000.000 €	Up to 200.000 €
Up to and including 4.000.000 €	Up to 400.000 €
Up to and including 8.000.000 €	Up to 600.000 €
Up to and including 16.000.000 €	Up to 800.000 €
Up to and including 30.000.000 €	Up to 1.200.000 €
Up to and including 50.000.000 €	Up to 1.500.000 €
More than 50.000.000 €	Up to 2.000.000 €

What does the written procedure look like?

02: Revocation/infringement action timelines

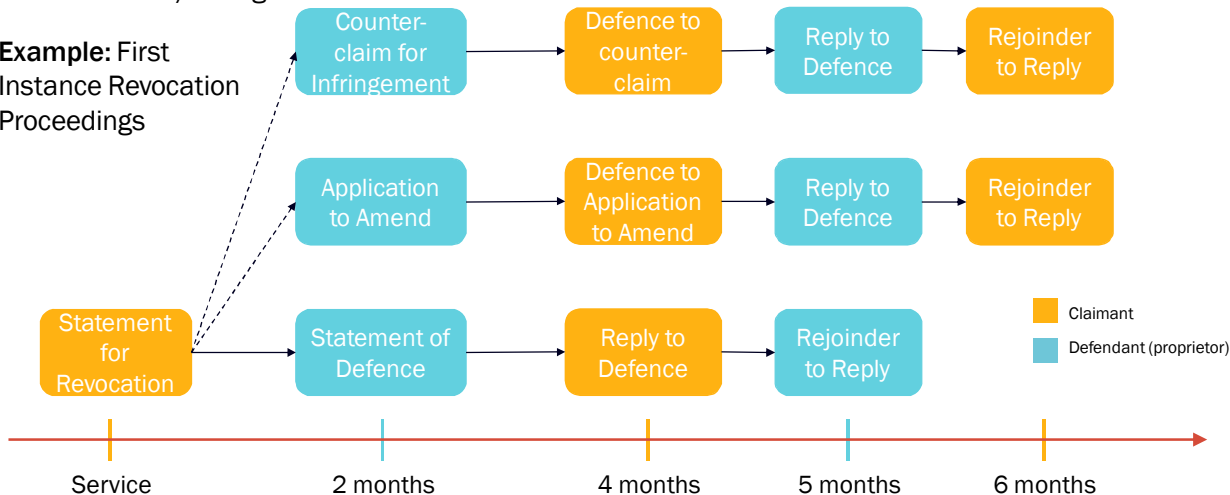
Example: First Instance Revocation Proceedings



What does the written procedure look like?

02: Revocation/infringement action timelines

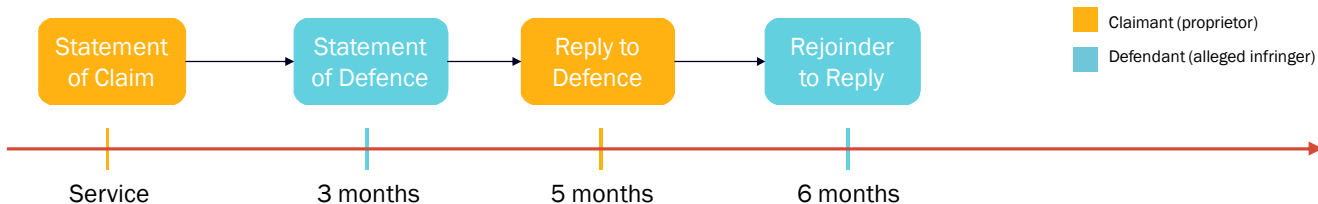
Example: First Instance Revocation Proceedings



What does the written procedure look like?

02: Revocation/infringement action timelines

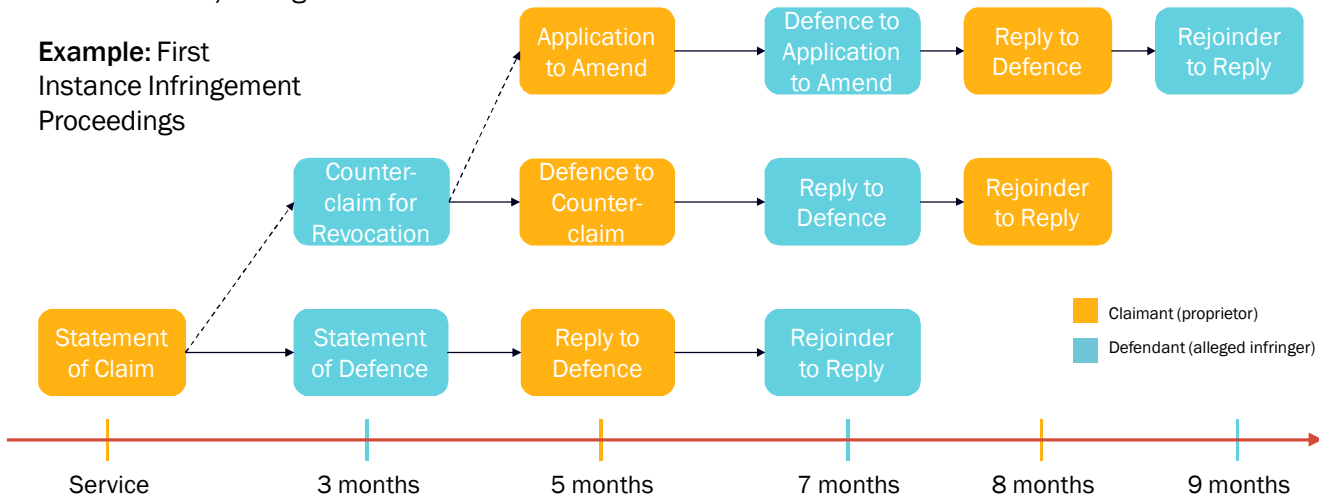
Example: First
Instance Infringement
Proceedings



What does the written procedure look like?

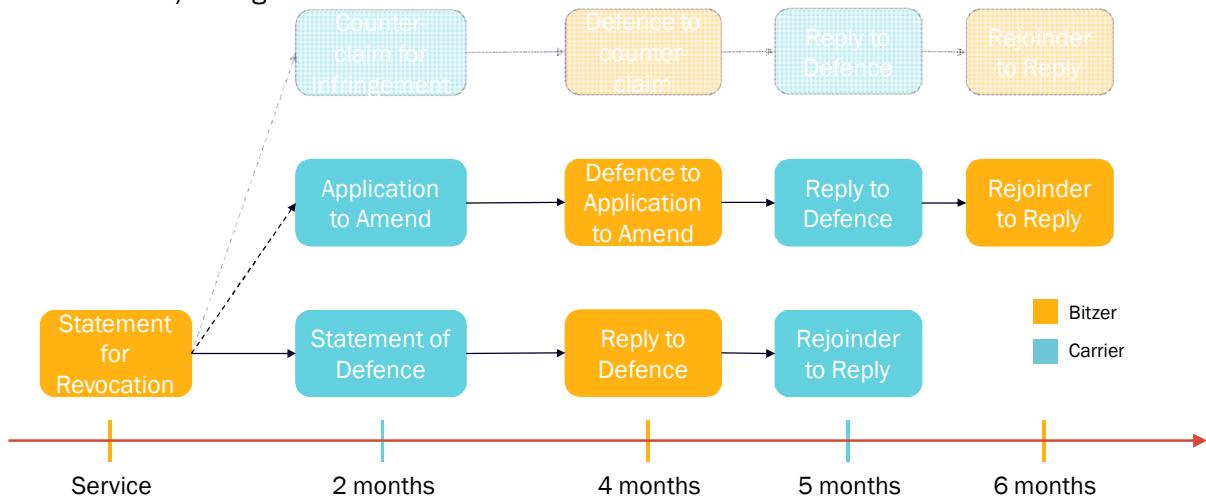
02: Revocation/infringement action timelines

Example: First Instance Infringement Proceedings



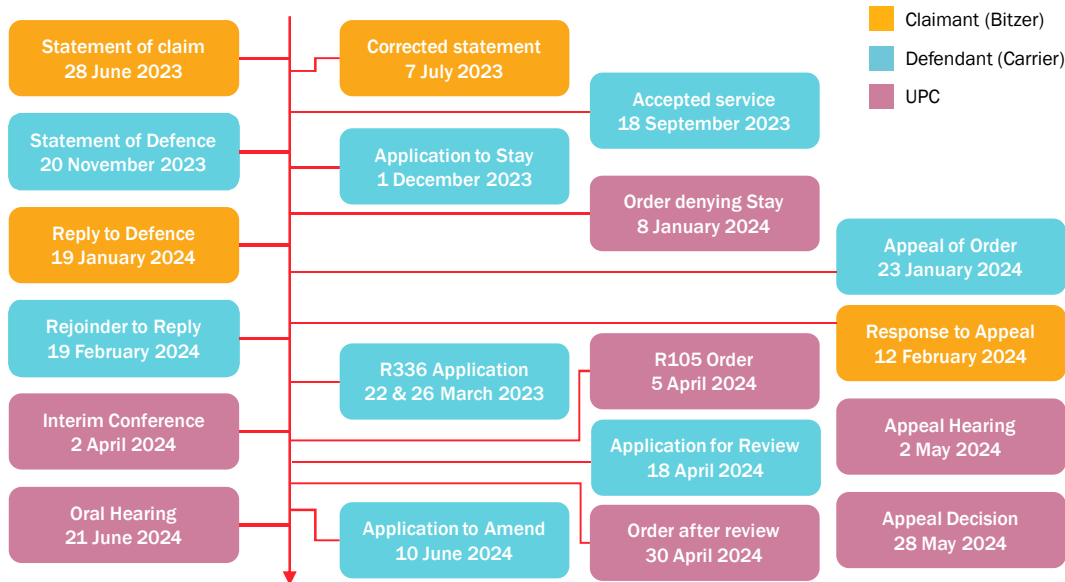
The *Bitzer v Carrier* case

02: Revocation/infringement action timelines



The *Bitzer v Carrier* case

02: Revocation/infringement action timelines



Grounds for Revocation: Statement of Claim

02: Revocation/infringement action timelines

- Only challenged claim 1
- Added Matter
- Lack of Priority Entitlement
- Sufficiency
- Lack of novelty MB2, MB4, MB7, MB8
- Lack of inventive step MB5+MB6

Grounds for Revocation: Reply to Defence

02: Revocation/infringement action timelines

- Only challenged claim 1
- Added Matter + Added matter (amendment)
- Lack of Priority Entitlement
- Sufficiency + Sufficiency (amendment)
- Lack of novelty MB2, MB4, MB5, MB6, MB7, MB8
- Lack of inventive step MB4+MB6, MB4+MB7, MB4+MB10
- Lack of inventive step MB5+MB6
- Lack of inventive step MB6+MB4
- Lack of inventive step MB7+MB10
- Admissibility of amendments

03: Stays

UPC in Action: Recent Experiences from an Industry Perspective

A Parallel Opposition

03: Stays

- Carrier's patent opposed on 28 June 2023 – last day of the opposition period!
- Same day as initial Statement of Claim at the UPC
- We requested acceleration of the opposition

Applying for a stay...

03: Stays

- Opposition broader than UPC + risk of inconsistent decisions
- Court may stay proceedings where a “rapid” decision is expected
- Applied for stay on 1 December ‘23 – rejected by Paris CD on 8 January ‘24
 - No date set for the opposition hearing, so an absence of a “concrete expectation” of a decision in the near future
 - Balance of parties’ interests – Claimant’s interest to resolve action
 - Granted leave to appeal – 15 days

...Going to Appeal

03: Stays

- Opposition hearing date: 24 Oct 2024
- EPO proposed bringing forward OPs to 25 April
- Couldn't find a date that worked for both parties, so EPO reverted to original date
- Lodged appeal on 23 Jan '24
- Argued on similar grounds as before, but now we have a date

Attending the Appeal

03: Stays

- Patent attorneys, representatives of the parties, as well as party experts and witnesses, shall wear **business attire**. Advocates usually wear robes.
- By video
- 3 LQJs (no TQJs)
- Hearing on 2 May 2024, decision on 28 May



What did the Court of Appeal say?

03: Stays

- Agreed with Paris CD 😞
- Parallel opposition \neq stay
- EPO Appeal could be filed, so no *final* decision for a long time
- Meaning of “rapid” is case-dependent
- For overlapping EPO/UPC decisions, narrower decision prevails

04: Interim Procedure

UPC in Action: Recent Experiences from an Industry Perspective

What is it?

04: Interim Procedure

- For the JR to make preparations for the main hearing
- No longer than 3 months
- Can include an Interim Conference

The Interim Conference (IC)

04: Interim Procedure

- Video hearing
- Possible topics:
 - Pleading timetable for main hearing
 - Points of claim construction
 - Late-filed evidence
 - Clarifying application to amend / ARs
 - Expert evidence
 - Potential for settlement
 - Update on parallel proceedings
 - Agreement on case value / security for costs

**Helps to shape the case and topics for the main hearing.
Make the most of it!**

The Front-Loaded Approach – *Bitzer v Carrier*

04: Interim Conference

- Added Matter + Added matter (amendment)
- Lack of Priority Entitlement
- Sufficiency + Sufficiency (amendment)
- Lack of novelty MB2, MB4, MB5, MB6, MB7, ~~MB8~~
- Lack of inventive step MB4+MB6, MB4+MB7, MB4+MB10
- Lack of inventive step MB5+MB6
- Lack of inventive step MB6+MB4
- Lack of inventive step MB7+MB10
- Admissibility of amendments

The Front-Loaded Approach – In Theory

04: Interim Conference

- Preamble to the Rules of Procedure, Recital 7:
 - “[P]roceedings shall be conducted in a way which will normally allow the final oral hearing on the issues of infringement and validity at first instance to take place within one year [...] Parties shall cooperate with the Court and set out their full case as early as possible in the proceedings.”

The Front-Loaded Approach – *Bitzer v Carrier*

04: Interim Conference

- Added Matter + Added matter (amendment)
- Lack of Priority Entitlement
- Sufficiency + Sufficiency (amendment)
- Lack of novelty MB2, MB4, MB5, MB6, MB7, ~~MB8~~
- Lack of inventive step MB4+MB6, MB4+MB7, MB4+MB10
- Lack of inventive step MB5+MB6
- Lack of inventive step MB6+MB4
- Lack of inventive step MB7+MB10
- Admissibility of amendments

The Front-Loaded Approach – *Bitzer v Carrier*

04: Interim Conference

- Added Matter + Added matter (amendment)
- Lack of Priority Entitlement
- Sufficiency + Sufficiency (amendment)
- Lack of novelty MB2, MB4, ~~MB5~~, ~~MB6~~, MB7, ~~MB8~~
- Lack of inventive step ~~MB4+MB6~~, ~~MB4+MB7~~, ~~MB4+MB10~~
- Lack of inventive step MB5+MB6
- Lack of inventive step ~~MB6+MB4~~
- Lack of inventive step ~~MB7+MB10~~
- Admissibility of amendments

The Front-Loaded Approach – In Practice

04: Interim Conference

- *OrthoApnea*, CoA, 21 November 2024
- Comes down to whether an attack is new or not
 - New grounds of invalidity, or new prior art, not allowed
 - Equivalent attacks are not “new” in Replies
 - "a generous standard is to be applied with regard to submissions in a Reply to a Statement of Defence", but only applies to submissions having a basis in the Rules, not "extra" submissions. (*NJOY v Juul*, Paris CD, 17 Jan '25)

Amending the Patent – *Bitzer v Carrier*

04: Interim Conference

- Revocation action against claim 1 only
- Our Auxiliary Requests amended claim 1 based on (non-attacked) dependent claims and to dependent claims themselves
- Bitzer argued that amending on the basis of non-attacked claims and amending non-attacked claims was against the German national approach
- We said no, the Court should follow the EPO instead

Amending the Patent – *Bitzer v Carrier*

04: Interim Conference

- Raised in IC, JR left it to the main hearing
- Lodged R333 review on the basis that dealing with this at the main hearing would be too late and to allow refiling of claims, if necessary
- Panel agreed to make a decision:
 - Said we can't amend non-attacked claims, but allowed us to refile amendments

Amending the Patent – *Bitzer v Carrier*

04: Interim Conference

- In the final decision, the Court landed in the middle:
 - Features from non-attacked claims *can* be added to attacked claims
 - But non-attacked claims *cannot* be amended

Preparing for the IC

04: Interim Procedure

- Highlight issues you want to discuss at the IC in advance
 - This can include asking the Court to strike out arguments/evidence
- Test your set-up with Registry
- Team organisation – know who is doing what
- Have someone ready to take minutes
- Be ready for the IC order

05: The Oral Hearing

UPC in Action: Recent Experiences from an Industry Perspective

What is it?

05: The Oral Hearing

- Last chance to be heard!

***Bitzer v Carrier* – Paris Central Division**

05: The Oral Hearing

- Centrally-located in Paris
- Easily accessible by Metro
- UPC website photo



***Bitzer v Carrier* – Paris Central Division**

05: The Oral Hearing

- However, its entrance is not so obvious...



***Bitzer v Carrier* – Paris Central Division**

05: The Oral Hearing

- Rather small layout...



***Bitzer v Carrier* – Paris Central Division**

05: The Oral Hearing



Nordic-Baltic Regional Division

05: The Oral Hearing

- Central Stockholm
- UPC website photo



Nordic-Baltic Regional Division

05: The Oral Hearing





Nordic-Baltic Regional Division

05: The Oral Hearing



The Main Hearing – What to Expect

05: The Oral Hearing

- Presiding Judge recites procedural history + summarises issues
- Claimant's main pleading
- Defendant's main pleading
- Possible break (if requested/needed)
- Short reply by Claimant
- Short reply by Defendant
- Closure of proceedings

Preparation - Tips

05: The Oral Hearing

- Each Division is unique
- Follow timetable agreed at IC
- Plan your pleadings and focus on key issues
- Practise to time!
- Ask a colleague to stress-test or brainstorm what the panel may ask
 - Consider mock trial
- Will you use a PowerPoint presentation?
- No court minutes

06: Decisions

UPC in Action: Recent Experiences from an Industry Perspective

***Bitzer v Carrier* – The Decision**

06: Decisions

- Issued 29 July 2024 – 5 weeks and 3 days after oral hearing
- Accepted service on 18 September 2023, only 10 months prior!
- Success! Maintained in amended form.
- Costs split 60% to Bitzer, 40% to Carrier
- Decision differed from EPO on added matter

Transparency

06: Decisions

- Used to transparency at the EPO, but not the same at the UPC
- The Court publishes orders and final decisions
- To access pleadings and evidence, file third-party access request (R 262.1(b))
 - Higher threshold for pending actions
 - Court gives 10-14 days for parties to respond
- Audio recordings are made of Interim Conferences and Oral Hearings
 - Available on request, and only if you visit in person and with an appointment

Transparency of the decision-making process

06: Decisions

- Level of detail is aimed at brevity, rather than comprehensiveness
 - *DexCom v Abbott* decision on the validity of EP 3 435 866 plus two auxiliary claim requests runs to 28 pages
 - Compares to two E&W High Court decisions on patents of the same family running to 137 and 93 pages

07: Lessons Learned

UPC in Action: Recent Experiences from an Industry Perspective

Final Thoughts

07: Lessons Learned

- Potential to become key battleground for patents
- Fast – Currently meeting objective for hearings within one year
- Familiar approach – Shaping up to be similar to the EPO
- Case law is still thin, but growing all the time
- “Local flavor” should even out over time
- Reasonable cost?
- Front-loaded procedure – claimant get as much in Statement of Claim as possible; defendant should drop everything and act as fast as possible

Any Questions?

Conor Wilman

Associate

European and UK Patent Attorney,
UPC Representative

cwilman@dehns.com



dehns.com

Dehns