

EPO Opposition *vs.* UPC Validity Proceedings

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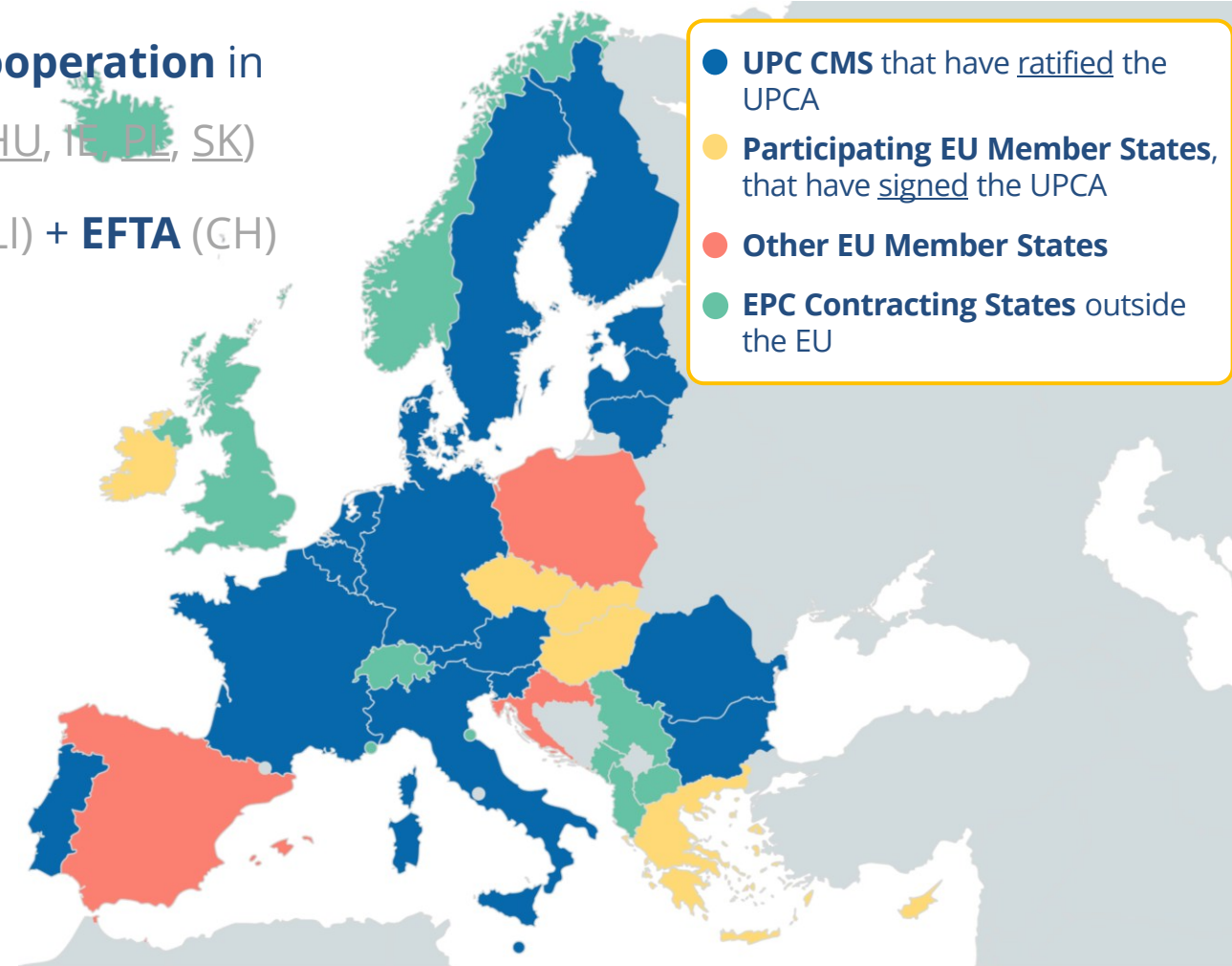
EPO & UPC – State of Play & Statistics



European Unification 2.0



- ▶ **18 UPC Contracting Member States** (as of 1 September 2024)
- ▶ **25 EU Member States participating in enhanced cooperation** in the creation of unitary patent protection (CY, CZ, GR, HU, IE, PL, SK)
- ▶ **27 EU Member States** (ES, HR) + **3 EEA States** (IS, NO, LI) + **EFTA** (CH)
- ▶ **40 EPC Contracting States** (as of 1 June 2026)
 - Includes Third countries: **GB, TR**
 - Non-EU/EEA CEFTA states: AL, MD, ME, MK, RS
 - Non-EU/EEA Microstates: MC, SM
- ▶ [EPO Extension State: BA]
- ▶ [EPO Validation States: MA, TN, KH, GE, LA]



EPO & UPC Statistics



EPO (Data Centre 2023 – 2026) – Total: 105 68 requests / 104 783 UP registered

- ▶ **UP requests – HU:** 148 UP requests / 148 UP registered
- ▶ **UP translation language – HU:** 145 requests



UPC (Annual Report 2025)

- ▶ **Infringement actions** per party country (claimants & defendants) lodged between 01.01.2025 and 31.12.2025 – **HU:** 5 Defendants, 0 Claimants
- ▶ **Revocation cases** per party country (claimants & defendants) lodged between 01/01/2025 and 31/12/2025 – **HU:** 0
- ▶ **Appeals** under R. 220.1(a), (b) RoP, per party country (appellants & respondents) lodged between 01/01/2025 and 31/12/2025 – **HU:** 0
- ▶ **V4 at UPC– Infringement actions:** 35 Defendants, 1 Claimant; **Revocation cases:** 0 Defendants, 1 Claimant; **Appeals lodged:** 0 Respondents, 3 Appellants

EPO *vs.* UPC – EP Validity Proceedings



EPO *vs.* UPC – EP Validity Proceedings

European Patent Office (EPO)

Opposition proceedings (Art.99 EPC) ←

Intervention of the assumed infringer
(Art.105 EPC) —

Limitation procedure (Art.105a EPC)

Revocation procedure (Art.105a EPC)

[Request for a technical opinion (Art.25 EPC)]

Unified Patent Court (UPC)

Revocation actions (Art.32(1)(d) UPCA)

Counterclaims for revocation
(Art.32(1)(e) UPCA)

[DNI actions (Art.32(1)(b) UPCA)]

[‘Arrow’ declarations (Art.32(1)(b / g) UPCA)]

[Nat. courts remain competent for actions *not* within
the UPC’s **exclusive competence** (Art.32(2) UPCA)]

- ▶ Parallel **EPO opposition** & **UPC revocation** proceedings **allowed**
(no German-style inadmissibility during opposition, § 81(2) DE PatG)
- ▶ Parallel (**EPO opposition** &) **UPC revocation** action & **National revocation** proceedings by different legal entities **or** on separate territories (during the transitional regime) seem also **possible**
(see *Quantificare v. Canfield*, UPC_CFI_559/2024 & UPC CFI 106/2025 of 23.04.2026)
- ▶ Parallel **UPC revocation action** & **counterclaim for revocation** by different legal entities also **possible**
(see *Edwards v. Meril*, UPC_CoA_464/2024 *et al.* of 25.11.2025)

EPO Opposition *vs.* UPC Revocation Proceedings

- ▶ **Acceleration of oppositions proceedings** in case of parallel infringement / revocation action before the UPC or National court / competent authority of EPC C.S. (OJ EPO 2023, A99) [GL/E-VIII, 5]



- 1 If EP **infringement / revocation action** is **pending** before the UPC or the National court / the competent authority of an EPC Contracting State → **Party to the opposition proceedings** **may request accelerated processing of the opposition** (request *may* be filed at **any time**, in written reasoned form)
- 2 If EP **infringement / revocation action** is **pending** before the UPC or the National court / the competent authority of an EPC Contracting State & the **EPO is informed by that body** → **EPO will also accelerate the processing of the opposition** (OJ EPO 2023, A99)
 - OD will make every effort to issue the **next procedural action** (e.g. communication, summons) within **3 months** of receipt of such information / request and **oral proceedings** will be (re)scheduled to take place at the **earliest possible date** [GL/E-VIII, 5]
(However, these will **not** be beyond the basic **time-limits** set by the EPC, e.g. R.115 (1) EPC)
 - Requests from the Parties to **extend time-limits** over and above the normal period / to postpone oral proceedings will **only** be granted in **exceptional**, duly substantiated cases.

EPO Opposition *vs.* UPC Revocation Proceedings

- ▶ **Acceleration of appeal proceedings before the Boards of Appeal (BoA)** (Art.10(3) – (6) RPBA 2020)
 - Conditions for accelerating proceedings are set out in Art.10(3) - (6) RPBA 2020
- 1 **Party *may* request acceleration of appeal proceedings before the BoA** (Art.10(3) RPBA) – shall provide reasons (e.g., that infringement / revocation proceedings for same EP are *pending* before the UPC, national court, or other competent authority in the EPC C.S.)
- 2 **UPC, national court, or other competent authority** in the EPC C.S. *may* request acceleration of appeal proceedings (Art.10(4) RPBA) **without providing reasons** → BoA **will**, as a rule, grant such request
 - **BoA have discretion to accelerate proceedings *ex officio*** (Art.10(5) RPBA), in particular when they become aware of infringement / revocation proceedings *pending* before the UPC, national court, other competent authority in the EPC C.S. **without an explicit request**
 - Proceedings are accelerated by giving a case *priority* over others
 - BoA *may* also adopt a **strict framework** for the purpose of case management, keep *time-limits* to the legally **allowable minimum**, and issue early summons to oral proceedings (Art.10(6) RPBA)



EPO Opposition *vs.* UPC Revocation Proceedings

► **UPC: Discretionary power to stay UPC proceedings** when a parallel EPO opposition / limitation is pending

(Art.33(10) UPCA, R.295 RoP)



- **Stay** is an **exception**; **General principle** is that the UPC will **not stay** proceedings (*Carrier v Bitzer*, UPC_CoA_22/2024, 28.05.2024) – commitment to conduct oral hearing within **1y** from the statement of claim (point 2 of the RoP Preamble)
- **Procedural provisions in RoP**: (*Meril v Edwards*, UPC_CoA_511/2024 21.11.2024)
 - **Prior case** being **ready for a decision** (in particular during written and interim phase):
R.295(a) RoP: UPC **may** stay proceedings “where a decision in such proceedings may be expected to be given **rapidly**” – does **not** require a **final** decision of the EPO; depends on the balance of Parties’ interests & specific circumstances of each case
 - Accelerated opposition proceedings **not** in itself sufficient (R.298 RoP *juncto* R.295(a) RoP)
 - **Post case** being **ready for a decision** (after oral proceedings):
R.295(g) RoP: stay pursuant to R.118.2(b) RoP – if, while UPC infringement proceedings are **pending**, also EPO opposition is **pending**...
 - UPC **may** stay infringement proceedings **pending** EPO decision
 - UPC **shall** stay infringement proceedings if there is a **high likelihood** that the relevant claims will be held **invalid** by **final** decision in opposition, and the decision may be **expected rapidly**
 - R.295(m) RoP: “in any other case where the proper administration of justice so requires” (*lex specialis derogat legi generali*)
 - **N/A for parallel opposition proceedings**

EPO Opposition *vs.* UPC Revocation Proceedings

- ▶ **EPO Opposition** proceedings *vs.* **UPC Revocation** proceedings: Risk of **conflicting validity decisions** between the EPO opposition & the **UPC** revocation proceedings (*external bifurcation*)
 - **UPC:** **No risk** of irreconcilable decisions, EP valid *vs.* EP revoked → latter decision will prevail, stay is **not** required (*Carrier v Bitzer*, UPC_CoA_22/2024 of 28.05.2024, at [25])
- ▶ **EPO Opposition** proceedings *vs.* **UPC Infringement** proceedings
 - **UPC:** **Risk** of irreconcilable decisions → stay of proceedings **may** be used to avoid this (*Meril v Edwards*, UPC_CoA_511/2024 of 21.11.2024)
- ▶ **Finding of EPO (in)validity** *vs.* **UPC (non)-infringement** → consequences, if the EPO ultimately **revokes EP** during opposition-appeal proceedings, that was **earlier** held (**valid**) & **infringed by the UPC** in a (**final**) **decision**, and that **may** have already been **enforced** against the accused infringer [EP is revoked *ex tunc* under Art. 68 EPC]
 - Compensation claim for a wrongfully enjoined Defendant? Damages for recall / destruction of allegedly goods? Liability regime under Art. 9(7) IPRED for PIs (C-688/17 *Bayer*, C-473/22 *Mylan*)
 - **UPC:** **No** suspensive effect for appeals in infringement actions, **unless** decided otherwise by the UPC CoA (Art.74(1) UPCA)
 - **UPC:** Often a conditional waiver of the revocation counterclaim if **no** infringement is found (*Emboline v Aorticlab*, UPC_CFI_125/2025; *Messerle v Sabert*, UPC_CFI_26/2025; *Emboline v AorticLab*, UPC-CoA-40/2026 – **permissible**)

EPO Limitation *vs.* UPC Revocation Proceedings

EPO: Parallel EPO Limitation & UPC Revocation proceedings

- ▶ Precedence of opposition proceedings: **Limitation / Revocation** request shall be **deemed *not* to have been filed, if opposition** proceedings in respect of the EP are **pending at the time of filing the request** (Art.105a(2), R.93(1) EPC)
 - **UPC:** *Natural person & Chainzone v Swarco* (Paris CD, UPC_CFI_425/2025 of 25.06.2026):
 - Art.105a(2) EPC has ***no*** bearing on **revocation proceedings** before the UPC – independent administrative act
 - If EP is limited by EPO **during** UPC revocation proceedings, UPC shall assess the EP validity in its **limited form**
- ▶ Conversely, ***no* precedence of opposition proceedings** while **revocation proceedings** are **pending** → **Revocation proceedings** are to be concluded before opposition proceedings proceed [GL/D-X, 7.1]
- ▶ In ***Huawei v Netgear*** (UPC_CFI_9/2023 of 11.12.2023) – *obiter dictum*:

Irrespective of the fact that the courts of some EPC states do not permit the assertion of a limited patent claim before the conclusion of limitation proceedings and that **it remains to be clarified** what the situation is at the Unified Patent Court, the plaintiff would have been forced, in the event of such an action, depending on the outcome of the limitation proceedings, to adapt the action to the events in the limitation proceedings by way of an amendment to the action. The
- ▶ What if **different amendments** are sought before EPO *vs.* UPC ?
 - Limitation / Revocation at EPO applies **retroactively** (Art.68 EPC; Paris CD at [20-21] in UPC_CFI_425/2025)

EPO Limitation *vs.* UPC Revocation Proceedings

EPO: Parallel EPO Limitation & UPC Revocation proceedings

When **same amendments** sought at EPO and UPC?

- ▶ **Fujifilm v Kodak** (UPC_CoA_473/2025, UPC_CoA_474/2025, UPC_CoA_873/2025, UPC_CoA_881/2026 of 13.07.2026)
 - EPO decision on EP limitation **during** UPC appeal proceedings – combination of original claims 1, 2 and 7
 - Claim as limited was already the subject of UPC proceedings at first instance and requesting a central EPO limitation **cannot** be considered to be an abuse of process
 - Request for limitation mentioned in the Statement of Grounds of Appeal & *Fujifilm* stated that it was expected to be granted **prior** to the oral hearing, as has indeed been the case
 - *Kodak* has therefore **not** been unduly hindered in its defence
 - Whether a **request for limitation / revocation** (Art.105(a) EPC) **during** UPC proceedings **can be contrary to due process**, as *Kodak* submits, can be left aside
 - Whether a **request for central limitation** at EPO (Art.105(a) EPC) **is compatible with the UPC framework**, and in particular R.30 RoP (*Application to amend the patent*), can also be left aside, since this Rule does **not** apply if the Proprietor merely relies on granted dependent claims and combinations encompassed thereby

EPO Opposition *vs.* UPC Revocation Proceedings

► Territorial scope of decisions

European Patent Office (EPO)

EPC Contracting States, in which the EP has effect (Art. 99(2) EPC) – 40 EPC CS

EPO Extension States [BA]

EPO Validation States [MA, TN, KH, GE, LA]

Countries with **EP recognition regime**
[e.g., **HK**]

Unified Patent Court (UPC)

UPCA Contracting Member States, in which the EP has effect (Art. 34 UPCA) – 18 CMS

BSH Hausgeräte (C-339/22): *Inter partes* validity decision for *non*-EU EPC CS [GB, TR, ...]

[*BSH Hausgeräte* (C-339/22): *No* validity decision for EU / LC *non*-UPCA EPC CS (Art.24(4) *BRIBIS*)]

- **UPC** – extension of territorial scope: *When a UPC Signatory State ratifies and accedes, the application of Art.34 UPCA should be **automatic** and **not subject to limitations, from the day of accession*** (*Syngenta v Sumi Agro*, UPC CoA, UPC_CoA_523/2024 of 3.5.2025 – infringement action)
 - Should apply *mutatis mutandis* also to **revocation actions / counterclaims for revocation ?**
- EPO's **Strategic Plan 2028**: Explore new validation agreements in Africa, Latin America and other regions (**CR**: Validation Agreement signed 13.12.2024) – **KPI** for 14 validation agreements in force / under negotiation

EPO Opposition *vs.* UPC Revocation Proceedings

► Grounds for EP invalidity

EPO Opposition Grounds (Art.100 EPC)

Patentability under Art.52 to 57 EPC (incl. **only** '*EP prior rights*' under Art.54(3) EPC)

Insufficient disclosure of the invention
(Art.83 EPC)

Added subject-matter
(Art.123(2), Art.76(1), Art.61(1)(a) EPC)

[Extension of protection conferred by EP
(Art.123(3) EPC)]

UPC Revocation Grounds (Art.65(2) UPCA)

Patentability under Art.52 to 57 EPC (incl. '*national prior rights*' of the CMS under Art.139(2) EPC)

Insufficient disclosure of the invention
(Art.83 EPC)

Added subject-matter
(Art.123(2), Art.76(1), Art.61(1)(a) EPC)

Extension of protection conferred by EP
(Art.123(3) EPC)

Non-entitlement to EP under Art.60(1) EPC
(Art.138(1)(e) EPC)

[Art.138(1) EPC and Art.139(2) EPC]

EPO Opposition *vs.* UPC Revocation Proceedings

UPC: Inventive Step Assessment

- ▶ Leading UPC CoA decisions in **Amgen v Sanofi** (UPC_CoA_528/2024, UPC_CoA_529/2024) and **Meril v Edwards** (UPC_CoA_464/2024 *et al.*) of 25 November 2025; further also **Nanostring v 10x Genomics** (UPC_CoA_335/2023 of 26 February 2024, as rectified)
 - Establishing **objective problem** ($\neq$ OTP) = establish **what the invention adds to the state-of-the-art**, based on patent's own teaching (considering claim as a whole, *not* feature-by-feature) – from the SKP perspective, having CGK, at **date of the patent**
 - **Obviousness assessment**: What would (*not* simply could) the SKP do, starting from the realistic starting point, to take the “*next step*” to reach the claimed invention; Concept of pointers for the SKP (motivation for the SKP to move forward)

EPO – ‘Problem-Solution’ approach

#1 CPA selection

#2 Identify the **Diff. ft.** from the CPA

#3 Assess the **Tech. eff.** of the Diff. ft.

#4 Define the **OTP**

#5 **Obviousness** assessment

=

UPC – “Holistic” approach

#1 Establish the **objective problem** ($\neq$ OTP)

– Object of the invention based on patent's own teaching

– Identify the **Tech. eff.** actually achieved

#2 Identify a **realistic starting point** ($\approx$ CPA)

#3 **Obviousness** assessment

EPO Opposition *vs.* UPC Revocation Proceedings

UPC – Revocation ground: Proprietor of the EP is **not entitled** under Art.60 (1) EPC (Art.65(2) UPCA, Art.138(1)(e) EPC)

- ▶ UPC does **not** seem to be **entitled to decide patent entitlement disputes** (*vindication claims*) – action **not** listed under Art.32(1) UPCA (Nat. courts remain competent for all other actions **not** within the exclusive competence of the UPC under Art.32(2) UPCA) [*cf.* application of POJR during EPO proceedings]
- ▶ **R.8.5(c) ROP: Strong rebuttable presumption** that the registered EP proprietor is entitled, unless the Defendant proves otherwise (*Valeo v Magna*, UPC_CFI_347/2024; *Headwater v Samsung*, UPC_CFI_26/2024)
 - Question whether any (even a **non**-entitled) Defendant *may* bring such **revocation ground** is questionable – was left unanswered by LD Düsseldorf (*Headwater v Samsung*, UPC_CFI_26/2024 of 30.07.2025)
- ▶ **UPC** (*Headwater v Samsung*, UPC_CFI_26/2024): **Vindication claim** has to be brought by the Defendant at the correct forum – UPC applies the relevant nat. law and takes into account the limitation period under the nat. law
 - Classical **EPs** (separate nat. proceedings) *vs.* **EP-UPs** governed by Art.7 UP Regulation: According to Applicants' residence in CMS / DE law (as EPO HQ)
 - **DE** law (§ 8 PatG): **2y** limitation period from the publication of EP grant applies, unless the Claimant can prove that the Proprietor did not act in *good faith* when obtaining the patent

EPO Opposition *vs.* UPC Revocation Proceedings

UPC – Revocation ground: Proprietor of the EP is **not entitled** under Art.60 (1) EPC (Art.65(2) UPCA, Art.138(1)(e) EPC)

► Munich CD in ***Wittenstein v Vestas Wind Systems*** (UPC_523/2025 of 02.09.2026)

- Claimant: Claimant in the revocation action is entitled to the EP as the successor in title from a co-inventor employee
- Defendant: Claimant **cannot** invoke Art.138(1)(e) EPC since it has **failed** to demonstrate that **it has itself the right to the EP**
- For EP to be revoked under Art.138(1)(e) EPC... it is **necessary to demonstrate that the proprietor has no rights at all to the patent...** Defendant maintains that the registered inventor Mr. XX is also the inventor of the EP, and that the Defendant has the rights to the EP as his successor in title --> Court finds that it is **not sufficient** for this ground of revocation to be successful that a claimant demonstrates that it has **rights to parts of EP** (e.g., because one of its employees has contributed as a co-inventor)
- *Question whether any (even a non-entitled) Defendant may bring such **revocation ground was left open** – see at [151-153]*

151. Under Art. 47(6) UPCA any natural or legal person who is concerned by a patent, may bring actions in accordance with the Rules of Procedure. According to Art. 65(2) UPCA, the Court may revoke a patent, either entirely or partly, only on the grounds referred to in Art. 138(1) and 139(2) EPC. There are differing views in the legal literature regarding whether in UPC revocation actions, the ground for revocation of Art 138(1)(e) EPC may only be invoked by the inventor or its successor in title, whose interests are directly affected or whether also “unrelated” third parties are allowed to invoke this ground, since it would be in the public interest to eliminate an unjustified monopoly.

EPO Opposition *vs.* UPC Revocation Proceedings

► Standing to file an action

European Patent Office (EPO)

Any person may give notice to the European Patent Office (Art. 99(1) EPC), **except patent proprietor** (G 9/93)

[Limitation / Revocation procedure (Art.105a EPC)]

Opposition on behalf of a third party (strawman opposition) is admissible, **except** if it is to be regarded as circumventing the law by abuse of process (G 3/97, G 4/97)

Intervention of the assumed infringer (Art.105 EPC)

Unified Patent Court (UPC)

Any other natural or legal person, ..., who is concerned by a patent, **may** bring actions in accordance with the Rules of Procedure (Art. 47(6) UPCA)

Revocation action by a 'straw company' seems to be considered **admissible**, for now (Art. 47(6) UPCA as a 'catch-all provision')

Counterclaims for revocation (Art.32(1)(e) UPCA)

- EPO in T1839/18, r.2.12: *"the current system of **allowing any person** to have a patent reviewed by way of opposition proceedings regardless of any specific interest is in line with the function of patents to make a technical contribution to society and the public interest in legal certainty and clearing the register from undeserved or undeservedly broad monopolies. Case law of the Enlarged Board of Appeal in this regard is consistent and without contradiction."*

EPO Opposition *vs.* UPC Revocation Proceedings

Strawman revocation actions before the UPC:

- ▶ In ***Seoul Viosys v. Emporia UK and Ireland Ltd*** (UPC_CFI_258/2025 of 01.09.2025), Paris CD order concerning Defendant's preliminary objection:
 - Definition of a **"straw company"** at [14]:
*"This term refers to a company that exists **only formally**, without any real or significant business activity. Such a company often **lacks its own assets or employees** and is used by a person or entity to **conceal the true identity** of the owner or to carry out activities that the latter does not want to or cannot perform directly."*
 - "Straw company" requirements at [21] *et seq.*
 - **Party that asserts** a company is a "straw company" bears the burden of proof (R.171(1) RoP)
- ▶ Same also in ***Ald v Nanoval*** (UPC_CFI_999/2025 of 26 January 2025), Paris CD order concerning panel review of Defendant's preliminary objection:
 - Existence of an **independent interest** in an action for revocation, in addition to the counterclaim for revocation already brought by an affiliated undertaking, depends on the **applicant's own business activity**
 - Degree of connection / degree of control between the companies is irrelevant; Affiliates parent and subsidiary companies *not* automatically "**the same party**" within the meaning of Art.33(4) UPCA

EPO Opposition *vs.* UPC Revocation Proceedings

Strawman revocation actions before the UPC:

- ▶ In ***Meril Italy v Edwards Lifesciences*** (UPC_CFI_255/2023, order of 13.11.2023), Paris CD at [68]:
 - Concept of '**same parties**' under Art.33(4) UPCA – Meril Life Sciences Pvt. Ltd. (Meril India) and its subsidiary Meril GmbH (Meril Germany) *vs.* Meril Italy srl ("*internal bifurcation*")
 - UPC framework does **not exclude** that a patent may be attacked by different subjects, even if linked by organizational ties or commercial relationships, and by the means of different claims, even if structured in the same grounds of invalidity
 - Reference to the case-law of the EPO Enlarged Board of Appeal at [68]:

68. It may be added that the conclusion reached on this point seems to be **consistent with the case-law of the Enlarged Board of Appeal of the European Patent Office**, according to which an **opposition is not purely inadmissible if the opponent is a straw man** acting for some other person, unless the involvement of the opponent is to be regarded as circumventing the law by abuse of process and the evidence of that has to be given by the person alleging that the opposition is inadmissible (see, EBOA EPO 21 January 1999, G-3/97 and G-4/97).

EPO Opposition *vs.* UPC Revocation Proceedings

Strawman revocation actions before the UPC:

- ▶ In **LS9 v Bellissa HAAS** (UPC_CFI_860/2025 of 19.08.2026), Milan CD interpreted Art. 47(6) UPCA broadly:
 - UPC held that **'interest'** in Art. 47(6) UPCA must be interpreted broadly (at [61]) → legal entities have "*as a matter of principle, an **interest** in ensuring that patents which should not have been granted because a ground for revocation exists are not maintained*" and that this applies "*irrespective of whether they are already active in a relevant industry*"
 - Claimant is **not** regarded as a **'straw man'** – Defendant has **not** demonstrated that the Claimant has **no** assets and/or **no** employees (as a legal entity, the Claimant is subject to the principle of disclosure and must publish annual accounts) → Claimant has a **legitimate interest in the revocation action**
 - Are **'straw man' actions** in principle **admissible** at the UPC ?

70 In view of this, it **can be left open** whether the UPC Agreement prohibits straw man actions in principle, or whether (only) straw man actions that would result in a circumvention of the Rules of the UPC Agreement and the Rules of Procedure might be regarded as inadmissible, as may be the case according to the case-law of the EPO to which the defendant refers (see, for example, the Enlarged Board of Appeal, G3/97, decision of 21 January 1999, para. 4.1 et seq. – Preliminary objection on behalf of a third party/INDUPACK).

EPO Opposition *vs.* UPC Revocation Proceedings

► Language proceedings

European Patent Office (EPO)

Filing / Translation in any EPO language:
EN, DE, and FR

Oral proceedings held in any EPO language:
EN, DE, and FR – interpretation into any other EPO language provided for by the EPO; into any other language at parties' own costs

Unified Patent Court (UPC)

Stand-alone revocation actions: Language in which the EP was granted

Revocation counterclaims: Default language of proceedings at a local/regional division (subject to possible change of language)

Oral proceedings usually held in language of proceedings (subject to possible change of language) – interpretation means provided by UPC, if appropriate under R.109 RoP (constitutes cost of the proceedings); or at party's own costs

- R.109(2) RoP often relied upon by the Court to **reject** request for simultaneous interpretation if not necessary for active participation – a Party can hire an interpreter at its own expense (R.109.4 RoP)

EPO Opposition *vs.* UPC Revocation Proceedings

► Cost of proceedings

European Patent Office (EPO)

Opposition fee: **880 EUR** + representation costs

Each party normally bears its own costs (exceptions available)

Unified Patent Court (UPC)

Court fee: **26 500 EUR** (options for reduction of court fees) + representation costs

As a rule, the losing party bears the court costs (capped by value-based ceilings – *may* be reduced)

► Time-frame for 1st instance decision

European Patent Office (EPO)

Publication of mention of EP grant + 9 months + min. 15 months (acceleration of opposition proceedings available)

Unified Patent Court (UPC)

Oral hearing is to be held within 1y from filing the statement of claim (proceedings may be stayed pending EPO decision)

EPO Opposition *vs.* UPC Revocation Proceedings

▶ Third-Party Access to Evidence

European Patent Office (EPO)

Public register accessible to Third-Parties **post** publication of the EP application (subject to limited exclusions under R.144 EPC)

Unified Patent Court (UPC)

Decisions and orders are published (R.262(1)(a) RoP)
Written pleadings and evidence available to third parties only upon **reasoned request** (R.262(1)(b) RoP)

UPC – Public access to written pleadings and evidence under R.262(1)(b) RoP

- ▶ Leading UPC CoA case: ***Stothers v Ocado*** (UPC_CoA_404/2023 of 10.04.2024)
 - Contentious proceedings – Adjudication by judge-rapporteur – Requirement for representation
 - **On-going** (direct legitimate interest – protection of the integrity of proceedings) *vs.* **Concluded** (general interest) UPC proceedings
 - Court *may* ex officio impose certain conditions on granting access (*Nicoventures*, UPC_CoA_7/2025 of 25 April 2025)
- ▶ **Parallel EPO & UPC proceedings:** Applicant that is also opponent in parallel EPO opposition-appeal proceedings for the same EP, but is *not* a party to the UPC action has a **direct interest** (*NJOY v Juul Labs*, UPC_CFI_316/2023)
- ▶ In ***Ter Meer v 2Seventy Bio, Johnson & Johnson*** (UPC_CFI_2192/2026 of 23.7.2026) – Request for access to documents in on-going proceedings, as a general request from a law firm, without any specific client, only mentioning it advises pharmaceutical companies, was **refused**

EPO Opposition *vs.* UPC Revocation Proceedings

► Appeals / Extraordinary remedies

European Patent Office (EPO)

BoA – *quasi*-judicial appellate procedure;
Suspensive effect of appeal (A.106(1) EPC)

EBoA – exceptional judicial review under
limited grounds (Art.112a EPC); **No** suspensive
effect for petition for review (Art.112a(3) EPC)

Unified Patent Court (UPC)

CoA – judicial appellate procedure; Appeals in direct
actions / counterclaims for revocation always have
suspensive effect (Art.74(2) UPCA); **No** suspensive
effect for appeal in infringement actions, unless
decided otherwise by CoA (Art.74(1) UPCA)

Rehearing – exceptional CoA review under limited
grounds (Art.81 UPCA); No suspensive effect, unless
decided otherwise by CoA (Art.81(3) UPCA)

EPO Opposition *vs.* UPC Revocation Proceedings

► Claim amendments

European Patent Office (EPO)

Amendments occasioned by grounds for opposition, even if *not* invoked (R.80 EPC)

AuxR: Much more lenient approach to AR's (especially at OD)

OD – R.116(1) EPC *date* set before OP (but often admitted even later); Restrictive before BoA (*convergent approach*, Art.12-13 RPBoA)

Unified Patent Court (UPC)

Amendments *only* to the extent that are necessary to react to the invalidity challenge (*Carrier v Bitzer*)

AuxR: Reasonable no. of AR's (R.30.1(c) RoP) – 80 excessive *vs.* 10-12 reasonable (*Kunststoff v Häfele*; *NJOY v Juul*)... but 84 AR's also held reasonable in complex cases (*Edwards v Meril*)

Along with defense to counterclaim / revocation, subsequently *only* with the Court's permission (R.30(2) RoP – often very restrictive)

- **UPC's alignment with EPO proceedings** – Opposition proceedings one of circumstances to take into account under R.30(1)(c) RoP (*10x Genomics v NanoString*, UPC_CFI_298/2023)
- **UPC:** 'R.295(a) RoP aims to **synchronise EPO & UPC proceedings**... only if it is possible to introduce claim versions amended by the EPO proceedings into UPC proceedings' (*JingAo v Chint*, UPC_CFI_425/24)

EPO Opposition *vs.* UPC Revocation Proceedings

- ▶ **UPC's alignment with EPO proceedings** – Opposition proceedings one of circumstances to take into account under R.30(1)(c) RoP (*10x Genomics v NanoString*, UPC_CFI_298/2023)
 - If UPC proceedings are **stayed** to await the EPO opposition outcome, the patentee **must be allowed to adapt its auxiliary requests after the EPO decision**
 - Court expressly stated that it would be **absurd** to **stay UPC proceedings for the EPO outcome** and then **prevent the patentee from introducing the claim version emerging from the opposition proceedings**
- ▶ **UPC** – Munich LD in ***biolitec v. Light Guide Optics*** (UPC_CFI_714/2024): Request for **stay was refused**, despite parallel EPO opposition, since the UPC hearing was scheduled before the EPO hearing – **late filed AuxR** (same as at EPO after receipt of OD's preliminary opinion) **were allowed**
 - Stay under R.295(a) RoP e.g., when **different AuxR** in EPO opposition & UPC action have been filed

EPO Opposition *vs.* UPC Revocation Proceedings

So, which one do you prefer?

Will, eventually, one exist without the other?

- ▶ **EPO Opposition** proceedings still seem as a first-to-go option (if still available) – favourable costs, territorial scope; ... but also longer time-lines and uncertainty
- ▶ **UPC Revocation** proceedings as a 2nd layer (if available) – quicker decision; earlier certainty; more favourable case-law / uncertainty advantageous ?; new prior art; no time-limitation; ... but high costs
- ▶ **UPC Revocation** proceedings (as Counter-claims for revocation) will always be filed as a response to infringement proceedings... parallel UPC **standalone revocation actions** (concept of “*same party*”)
- ▶ **Parallel actions** – different amendments sought before EPO *vs.* UPC ?

Questions, Thoughts, Comments,... your own experience?

Thank you

Any questions?

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