

# Unified Patent Court: one year in

**After one year of existence,  
is the UPC a patent killer?**

Page 11

**A changing landscape: German  
courts in the maelstrom of the UPC**

Page 15

**UPC's first year: emergence of  
a purely civil law system?**

Page 25



**Launch**  
interactive document

# UPC preliminary injunctions: insights from Vienna

**Jia Schulz-Cao of CMS Austria details the requirements for preliminary injunctions under the UPC system and offers insight into the first preliminary injunction decision of the Local Division Vienna.**

The Unified Patent Court (UPC) has brought many changes to patent litigation. One of the most important legal measures that can be taken within the UPC framework are preliminary injunctions, which have already played a significant role in the decisions of various Local Divisions.

Within the UPC framework, preliminary injunctions are an essential legal instrument that enables immediate protection of the rights of patent holders. Preliminary injunctions allow the court to take fast actions to prevent ongoing or imminent patent infringements as well as to secure the evidence needed to enforce patent rights. Under the UPC system, the ability to obtain preliminary injunctions is essential to maintaining the effectiveness of patent protection and ensuring that remedies are available in a timely manner during legal disputes.

## Preliminary proceedings

The Agreement on a Unified Patent Court (UPCA) stipulates several provisional measures that can be issued by the UPC. These include provisional measures for the preservation of evidence and the inspection of premises. Additionally, the UPC



Jia Schulz-Cao

may issue "freezing orders" that prevent a party from removing any assets from its jurisdiction. Injunctive relief may also be granted against the alleged infringer or an intermediary, under threat of periodic penalty payments, or with the order that the continuation of the infringement may only occur if security is provided to ensure compensation to the right holder. Finally, applicants may apply the UPC to order the seizure or delivery of products suspected of patent infringement, along with the precautionary seizure of movable or immovable property of the alleged infringer, including the freezing of bank accounts.

## Structure and requirements of preliminary injunctions according to Art 62 UPCA

The structure and requirements for the application of preliminary injunctions before the UPC are mainly set out in Art 62 UPCA.

Art 62.2. UPCA explicitly mentions the court's discretion to weigh up the interests of the parties before rendering a decision in preliminary injunction matters, considering the possible damages that could occur to each of the parties. Art 62.4. UPCA establishes the same standard of proof and pleading as Art 9.3. of the Enforcement Directive, namely a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed, or that such infringement is imminent. Art 62.5. UPCA refers to Art 60.5.-9. UPCA, which states that interim measures may be ordered, if necessary, *ex parte*, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed. Hence, it sets out the general permissibility of *ex parte* provisional measures.

In a nutshell, the application for preliminary injunctions requires an imminent or continuing infringement of the applicant's rights. The applicant must provide reasonable evidence for the imminent and continuing infringement, whereby rather high standards apply, as all evidence and facts must be set out in the application.

Art 62 UPCA is accompanied by Rules 205 to 213 Rules of Procedure (RoP). First and foremost, preliminary injunction proceedings are written procedures and start with the application for a preliminary measure by the right holder.

The application for preliminary measures has to include a description of the action that will be initiated before the UPC, including facts and evidence relied upon in this action. The application has to be filed together with the legal grounds for the interim measures, setting out why they are necessary to prevent an imminent infringement or prohibit its continuation. The court has to examine and decide at its discretion whether to hear the infringing party or to hold an oral hearing.

The court can also order the applicant to provide adequate security for appropriate compensation for any injury likely to be caused to the defendant which the applicant may be liable to bear in the event that the court revokes the order for provisional measures.

## Urgency requirement

Neither the UPCA nor the RoP explicitly specify an urgency period within which an applicant has to initiate preliminary proceedings. Rule 211.4 RoP merely stipulates that the court must consider any unreasonable delay in the application for a preliminary injunction. Thus, the court may assess whether an application for a preliminary injunction has been made in a timely manner, meaning that a certain time period with regard to the urgency of a preliminary injunction is present. Consequently, the urgency of the matter as a criterion for granting a preliminary injunction therefore arises from Rule 211.4 RoP.

Concerning the duration of the urgency

## Résumé

**Jia Schulz-Cao** has been an attorney-at-law with CMS' IP team in Austria since 2018. His areas of practice are patent, trademark and unfair competition law matters for clients, mainly in the sectors life sciences, luxury goods, consumer goods, food and beverages. Jia's expertise covers infringement cases as well as transactional and licensing matters. Jia has gained comprehensive patent law experience as a trainee lawyer at the European Patent Office in Munich, Germany. He was a Senior Visiting Scholar at Tsinghua University, Beijing, and thus has extensive knowledge of Chinese IP law. He holds a PhD in Chinese trademark law.

period, it was anticipated that decisions by the Local Divisions could reflect practices of the national jurisdictions and that an urgency period would subsequently be established by case law. In a recent decision in *Dyson Technology v. SharkNinja* by the Local Division Munich, the filing of an application for interim measures within two months of first becoming aware of the potential infringement was deemed timely. This could set a precedent for subsequent preliminary proceedings also at other Local

“  
**The application for preliminary injunctions requires an imminent or continuing infringement of the applicant's rights.**  
 ”

“  
**Neither the UPCA nor the RoP explicitly specify an urgency period within which an applicant has to initiate preliminary proceedings.**  
 ”

Divisions. Regarding the beginning of the urgency period, the applicant's knowledge of (imminent) patent infringement and of (possible) defendant(s) is decisive.

### Ex parte preliminary injunctions

Ex parte provisional measures can be granted under requirements set out in Art 60.5-9 UPCA.

In the case that an applicant requests the issuance of provisional measures without hearing the defendant, the application shall additionally contain the reasons for not hearing the defendant and information about any prior correspondence between the parties concerning the alleged infringement.

In fact, the Local Division Düsseldorf has already granted an ex parte preliminary injunction. In the case of *myStromer AG v. Revolt Zycling AG*, the defendant had filed a protective letter according to Rule 207 RoP. Since the court must consider the protective letter filed, it is questionable whether filing a protective letter might result in a higher chance for ex parte preliminary injunctions. In any case, the decision to file a protective letter should be taken carefully, as an insufficiently substantiated protective letter bears the risk of making it easier for the court to issue an ex parte injunction on the basis that it has no conviction in the defendant's argument.

### Validity of the patent in dispute

Generally speaking, Art 62.4 requires the applicants to provide reasonable evidence with a sufficient degree of certainty that they are the right holder. Rule 209.2 (a) RoP states that the court shall take into account whether the patent in dispute has been upheld in opposition proceedings before the European Patent Office or has been subject to proceedings in any other court. The compatibility of Rule 209.2 (a) RoP with Art 9 of the Enforcement Directive has been questioned among scholars since a recent decision of the CJEU that the validity of a patent in dispute shall be irrelevant to the outcome of the preliminary proceedings. (CJEU 28.04.2022, C-44/21 – *Phoenix Contact GmbH & Co KG v. Harting*.)

Regarding the validity of a patent in dispute, the Local Division Munich clarified in its decision in *10x - Genomics Inc. v. NanoString Technologies Inc.* that "sufficient certainty" is understood as "preponderant" likelihood of validity. So far, the UPC deems a patent in dispute as valid if that patent was published many years ago and no opposition or action of revocation has been filed against it.

As Rule 211.3 RoP states that the UPC shall – in the exercise of its discretion – weigh up the interests of the parties, the validity of the patent in dispute is definitely an important aspect regarding the balancing of interests. The burden

“ So far, the UPC deems a patent in dispute as valid if that patent was published many years ago and no opposition or action of revocation has been filed against it. ”

of presentation and proof regarding validity lies with the defendant as they are claiming that the patent is invalid. Irrespective of this, claimants are well advised to submit evidence regarding validity in preliminary injunction proceedings according to Rule 206.2(d) RoP.

### Insight into the first preliminary injunction decision of the Local Division Vienna

The Local Division Vienna has - up to the day of writing - only decided in one provisional measure matter, rejecting an application for a preliminary injunction in the case *CUP&CINO Kaffeeseystem-Vertrieb GmbH & Co. KG v. ALPINA COFFEE SYSTEMS GmbH*.

### Schedule of proceedings

The patent in dispute concerned a milk-frothing device. The defendant planned to promote its device at a trade fair in October 2023. Being aware of this, the applicant applied for a preliminary injunction on June 27, 2023. The action by the applicant was served to the defendant on July 11, 2023, granting the defendant the right to file counterarguments within three weeks. The applicant was given the possibility to file an additional pleading after three more weeks. The parties were summoned to an oral hearing which took place September 13, 2023.

During the oral hearing, the defendant mainly argued that the applicant's patent was not infringed. Additionally, they claimed the matter was not urgent since the defendant's product had been on the market since 2019. It was claimed that the applicant's patent was invalid due to a lack of inventive step. In event, granting preliminary injunction shall be made under the condition that the applicant deposits financial means as security.

During the oral hearing, the court allowed a demonstration of the devices by both the defendant and the applicant, even though evidence of how the device is used was filed at an earlier stage. Demonstrations of the devices were made to specifically showcase the milk-frothing process to provide a clear understanding of the technical details and to contribute to clarifying the facts, which outlined the high technical standard of the court.

Based on the demonstrations and evidence filed by the parties, the court rejected the preliminary injunction during the oral hearing. As a side note, the judges clarified that unitary patents for which a lawsuit has been filed cannot be opted out of the UPC. The court clarified that Rule 5.6 RoP applies to provisional measures as well, therefore, an opt-out request after an application for preliminary injunction is filed is ineffective.



### Learnings from Local Division Vienna

This decision rendered by the Local Division Vienna is likely to be a classic example of the schedule of proceedings in preliminary injunction matters. In particular, when it comes to granting parties in disputes opportunities to submit pleadings, the deadlines granted as well as in which circumstances an oral hearing should take place, very much reflects the UPCA and the RoP.

Generally, special attention should be paid to oral hearings as the judges being technically qualified may increase focus on the demonstration of devices potentially infringing the patent in dispute.

### Key takeaways

From the preliminary injunction decisions so far rendered by the UPC, it is apparent that Local Divisions may act very quickly and are not reluctant to grant preliminary injunctions on an ex parte basis. In that regard, parties should carefully consider the pros and cons before filing a protective letter.

Also, patent holders should act quickly if they

“ It is apparent that Local Divisions may act very quickly and are not reluctant to grant preliminary injunctions on an ex parte basis. ”

identify potential infringements of their patents. Merely identifying a patent infringement alone is not sufficient to obtain a preliminary injunction as urgency is an essential requirement.

Lastly, defendants should bear in mind that a simple attack on the validity of the patent in dispute is not necessarily a sufficient means of defense. The court has to be convinced that the patent in dispute lacks validity in order to reject a preliminary injunction application based on this argument.

In general, preliminary injunctions continue to be a strong instrument to enforce patents.

### Contact

#### CMS Austria

CMS Reich-Rohrwig Hainz  
Rechtsanwälte GmbH  
Gauermannngasse 2  
1010 Vienna  
Austria  
Tel: +43 1 40443-0  
Email: vienna@cms-rrh.com  
www.cms.law/en/aut/



# After one year of existence, is the UPC a patent killer?

Jean-Baptiste Thiénot of CMS France addresses the rigorous nature of the UPC, offering insight into the first decisions affecting the validity of patents.



If you can formulate it,  
we'll work to protect it.

From chemical breakthroughs to digital milestones, CMS is ready to advise on and actively defend your ideas, creativity and expertise. Supported by over 450 intellectual property specialists across more than 40 countries, see how your best thinking can remain your most valuable asset.

CMS is an international law firm that helps clients to thrive through technical rigour, strategic expertise and a deep focus on partnerships.

**cms.law**

**W**ith the upcoming entry into force of the Agreement on a Unified Patent Court (UPCA), many companies wanted to protect their European patents from a 'central attack,' i.e., an action for revocation before the UPC. Indeed, a single decision by the UPC can destroy a patent in all European countries participating in the new system. This is a clear break from the previous system under which patentees were familiar with the 'patent-friendly' jurisdictions where patents generally managed to survive.

The fears raised by a 'central attack' were, therefore, understandable, especially since this new jurisdiction, as well as the approach - which would be adopted to assess the validity of a patent - were unknown.

A little over a year after its launch, the UPC's case law is beginning to take shape. Without claiming to be exhaustive, we offer here a quick presentation of the first decisions affecting the validity of patents.

## Which patents can the UPC revoke?

The UPC has jurisdiction over actions based on 'classic' European patents and European patents with unitary effect. For 'classic' European patents, patentees can choose to opt out of the UPC's jurisdiction for a transitional period, which is expected to last at least until 2030, meaning that the UPC will not have jurisdiction over the patents in question for which the patentees opted out. Many companies have made this choice to protect their patents from a central attack before the UPC. National patents are completely outside the jurisdiction of the UPC. In certain circumstances, national patents could thus represent an interesting 'fallback' solution for patentees.



Jean-Baptiste Thiénot

## Revocation action

The UPCA offers the possibility of initiating an action for patent revocation. This allows any interested person to obtain a court decision invalidating a patent in all countries that have ratified the UPCA, i.e., 18 EU Member States as of September 2024. These procedures fall under the jurisdiction of the Central Division of the UPC, which sits in Paris, Munich, and Milan. This procedure is already meeting with some success, with no less than 41 procedures initiated between June 1, 2023, and July 26, 2024. The most involved industrial sectors are life sciences and electronics. Most actions (36) were filed with the Paris Central Division.

This success is easily explained, in particular by the following reasons:

- The UPC has been able to attract the best judges in Europe. The 'Legally Qualified Judges' (LQJs) benefit from the reputation they have previously

## Résumé

**Jean-Baptiste Thiénot** is Partner in the IP/IT team of CMS Francis Lefebvre. He mainly advises on industrial property law, particularly patent law. His activity covers litigation (infringement and nullity actions, employee invention issues) as well as advice and drafting of contracts (R&D contracts, assignment and licensing, and audit of rights portfolio) in various industrial sectors, particularly in the life sciences, mechanical, and electronic fields. He is frequently involved in cases relating to products subject to specific regulations (health products, cosmetics, spraying, etc.). Jean-Baptiste has also developed particular expertise in the protection of business secrets/know-how (litigation, implementation of internal protection policies) and the regulation of health products (medicines, medical devices, etc.). Jean-Baptiste Thiénot has been a lawyer since 2008. He joined CMS Francis Lefebvre in 2018 after practicing with the law firms Simmons & Simmons (2008-2011), Allen & Overy (2011-2013), and Bird & Bird (2013-2018).