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British Group of the  
Ligue Internationale du Droit de la Concurrence  
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## UPC Webinar Series: Part III - Practice Points

**Speakers:** Siddharth Kusumakar, Powell Gilbert  
Dr. Christopher Stothers, Freshfields Bruckhaus Deringer  
Agathe Michel-de-Cazotte, Carpmaels & Ransford

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### INTRODUCTION

As UPC case law has developed, a number of practice points have emerged. The third webinar in the UPC series gave the speaker the chance to address some interesting points of practice.

### OPT-OUTS

During the first 7 years of its operation, the UPC exists under a transitional regime, with concurrent jurisdiction of the UPC and national courts. Under Article 83 of the Agreement on a Unified Patent Court (**UPCA**), patentees may '*opt out*' of the UPC, though these opt outs can subsequently be withdrawn. The intention behind of these provisions was to avoid forcing parties to enter an unknown system. These provisions have already been the subject of UPC Case Law.

#### **Article 83(3) – *Cup&Cino Kaffeestem-Vertrieb v Alpina Coffee System***

In this case before the Local Division in Vienna, a preliminary injunction was sought by the patentee, followed by an opt out of the patent-in-suit. Despite the fact the filing of this opt out was seemingly an error by the patentee, the Court considered Article 83(3) UPCA, which prevents opt outs where "*an action has already been brought before the Court*". In this case, the Court held the opt out was ineffective as there was already pending UPC action.

#### **Article 83(4) – *AIM Sport v Supponor***

This case before the Local Division in Helsinki concerned the interpretation of Article 83(4), which provides that an opt out may withdraw, "*unless an action has already been brought before a national court*". There were pending national proceedings in Germany when the UPC came into force, after which the patentee opted out, then withdrew the opt out, then sought a preliminary injunction before the UPC. The patentee argued that Article 83(4) should not apply to pre-UPC litigation, otherwise it would unfairly disadvantage patentees with patents subject to pending actions. The court disagreed and held that the opt out was ineffective due to the pending national proceedings.

As the Court noted, the scenario where national litigation had concluded was not addressed, so the position remains open for historic national claims. This decision is under appeal, so the UPC may provide further guidance.

### PARALLEL PROCEEDINGS

The UPC has the power to join parallel proceedings relating to same patent, including under Rule 340 of the Rules of Procedure.

## ***Edwards v Meril***

In this case, Edwards brought an infringement claim before the Munich Local Division. After this, a different Meril entity, brought a revocation claim before the Paris Central Division (if had been the same entity, it would have been obliged to bring the claim as a counterclaim before the Munich Local Division). Edwards sought to consolidate the claims, Meril wanted them separated.

On 28 March 2024, the Munich Local Division referred the counterclaims to Paris, effectively bifurcating the proceedings. Notably, the two panels could not agree on the operation of Rule 340. On 22 April 2024, the Paris Central Division ordered that the revocation counterclaims (referred by the Munich Local Division) be heard on the same day as the trial of the revocation claim brought before the Paris Central Division.

## **TRANSPARENCY**

### ***Ocado v Autostore***

The UPC is said to be transparent and recent case law has put this to the test. Dr Christopher Stothers of Freshfields Bruckhaus Deringer, as a third party, filed requests to see the pleadings in this case. After a series of interactions between Dr Stothers, the Court and the parties, a decision by the Nordic-Baltic Regional Division granted access, though this was subsequently appealed to the Court of Appeal, with suspensive effect. Access was subsequently provided to the Compliant 241 days after the initial request.

Several practice points emerged from this case, both before and after the appeal decision:

- The Court is entitled to a vacation, though once in session it provides rapid responses.
- Suspensive effect is available for appeals pursuant to Rule 220.2, in spite of apparent conflict with Rule 223(5).
- US-style amicus briefs are not permitted – intervenors must have a direct interest in the proceedings.
- Member of the public must be represented.
- The Court of Appeal can sit as three legal judges where there are no technical issues.
- In general, UPC proceedings (including written) are public.
- The Court must balance interests, promoting justice and avoiding external interference.

However, a number of other questions remain unanswered, including the handling of confidential information.

## **CONFIDENTIALITY**

Confidential information is protected under Article 58 UPCA. Rule 262A deals with restricting access to confidential information in submissions among the parties to proceedings. Rule 262A requires this application to be made at the same time as lodging the document, which presents practical difficulties before the result of the application is known. In practice, it appears you can first file a non-confidential version, followed by a confidential version. Several Local Divisions have considered this issue.

### ***Panasonic v Oppo*<sup>1</sup>**

This decision in the Mannheim Local Division helpfully sets out the 13 steps for managing the UPC case management system (CMS) regarding confidentiality, though more steps may be involved.

### ***Fujifilm v Kodak*<sup>2</sup>**

This decision by the Dusseldorf Local Division, highlighted that the Court will not always grant confidentiality request applications. In this case, prior use was raised as a defence to infringement. The technology, acquired by the applying party in 2017, was no longer in a sold product and was not cutting edge, so a wider confidentiality club was ordered.

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<sup>1</sup> UPC\_CFI\_210/2023

<sup>2</sup> UPC\_CFI\_355/2023

### **C-Kore v Novawell<sup>3</sup>**

This decision of the Paris Local Division granted an *ex parte* order for a seizure. The seized evidence was partly confidential, to the seized party (Novawell) requested it remain confidential. A limited '*attorneys' eyes only*' confidentiality club was organised, conflicting with the Dusseldorf Local Division's decision in *Fujifilm v Kodak*.

### **LANGUAGE**

In the UPC, for revocation actions, the language of proceedings is the language of the patent. For any other proceedings, the parties can choose, either the language of the patent, English or the local language. Various provisions govern the choice of language. Under Article 49(3) UPCA, the parties may agree the language, though subject to the judge's discretion. Under Article 49(5) UPCA, the President of the Court of First Instance may decide upon the language, considering relevant circumstances, particularly the defendant's circumstances.

### **10x v Curio<sup>4</sup>**

This appeal decision (not signed by the President of the Court of First Instance) focused on the fact that the defendant was a small company, operating in English and based in the US, with no employees that spoke German. The claimant was also a US company. Crucially, the Court held that is all else is equal, the defendant's interests should be favoured under Article 49(5) UPCA.

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<sup>3</sup> UPC\_CFI\_397/2023

<sup>4</sup> UPC\_COA\_101/2024