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In this issue:

Second non-medical use claims 04
"Relative improvement" features

EPO practice & procedure 05
Acceptance of colour drawings in applications

Is the appetite for greentech waning? 06
Insights from worldwide patent office statistics

Protecting your after-market 08
Part 1: consumables

Inventive step at the UPC 10
Court of Appeal sets definitive test

UPC Court of Appeal reverses First Instance decision 12
Amgen's patent ruled valid

Also: UKIPO & UPC fee increases and our recent biotech and UPC webinars now available on demand

G 2/24
The ghosts I summoned, I can get rid of

Full Story Page 02

Editorial

We have arrived at the last newsletter of the year again and it has been another unsettled year in the world. Within our world of intellectual property change continues. More clients are showing interest in using the Unified Patent Court possibly encouraged by both the speed and quality of judgments to date. As reported in this issue, the Court of Appeals have taken an important step in setting out how inventive step should be considered in UPC proceedings. The diligent action of the courts (at both first instance and appeal) had seen interesting developments during the course of the year. So from all at D Young & Co we wish you a restful and enjoyable festive season and happy New Year.

Neil Nachshen, Editor

Events

Optica Conference on Optics & Photonics
16-18 December 2025, London UK
Cathrine McGowan will be attending this conference about disruptive advances in optics and photonics across diverse fields.

UPC Litigation Forum
19-21 January 2026, Amsterdam Netherlands
Anthony Albutt, Martin Bicker, and Connor McConchie will be attending the Unified Patent Court Ligitation Forum (and the Pharma & Biotech Patent Litigation Conference, and Tech & Innovation Patent Litigation Conference).

Climate Technology Show
24-26 March 2026, London UK
Andrew Cockerell and Joseph Flood will be attending this high-impact global platform for innovation in climate tech.

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EPO appeal proceedings

G 2/24
The ghosts I summoned, I can get rid of

This ruling confirms the previous decision in G 3/04 that an intervening third party entering proceedings only at the appeal stage cannot continue proceedings following the withdrawal of all appealing parties.

The referring Board of Appeal in T 1286/23 disagreed with the decision in G 3/04, arguing that it is based on a contradiction in the European Patent Convention (EPC) and that the continuation of appeal proceedings by the intervener finds justification in a legal interest extraneous to European Patent Office (EPO) proceedings. In contrast, the Enlarged Board of Appeal in G 2/24 held that intervention is an exceptional legal remedy, the right to which under the EPC has to fit into the legal and procedural framework of the EPC and Boards of Appeal. That framework affords an intervener entering proceedings at the appeal stage the status only as a party as of right under Article 107, second sentence, EPC.

Decision in G 3/04

As a reminder, in G 3/04 the Enlarged Board of Appeal found that the aim of an intervening third party entering appeal proceedings is to challenge the patent and that the intervening third party thus enters appeal proceedings as an opponent that has not filed an appeal. G 3/04 determined that such a party cannot continue appeal proceedings in the absence of an appealing party, and that this agrees with the principle of party disposition under which proceedings are to be terminated if the procedural steps which gave rise to them are withdrawn.

Events leading to situation in T 1286/23

The intervening third party, Geske GmbH & Co KG, had twice unsuccessfully attempted to intervene during opposition proceedings. Most unfortunate for Geske, the inadmissibility of the second intervention was owed to a delay by the Düsseldorf District Court in serving Geske's suit to the patent proprietor, Foreo Limited. This prompted the Board of Appeal to comment that had Geske instead "raised the suit before an administrative court and at the same time requested referral to the competent civil court, the suit would have been considered pending at the time it was raised" (1.2.4 of the Reasons). When Geske eventually filed its admissible third intervention, appeal proceedings were pending.

Reasoning of the board in T 1286/23

In its referral, the Board of Appeal argued that the decision in G 3/04 is based on a contradiction in Articles 105 EPC and 107 EPC (3.5.4 of the Reasons). According to the Board of Appeal, the case law interpreting the scope of Article 105 EPC envisages that a third party can intervene at the appeal stage (see G 1/94), while Article 107 EPC does not foresee a role for an intervener entering appeal proceedings.

The Board of Appeal viewed the decision in G 3/04 as accepting that Article 105 EPC overrides Article 107 EPC in so far that the intervener can acquire a status in appeal proceedings despite not having been party to first instance proceedings. Yet according to the Board of Appeal, under the decision in G 3/04 Article 105 EPC does not override Article 107, first sentence, EPC, baring the intervener from becoming an appellant. G 3/04 thus arrives at the status of "non-appealing opponent" for the intervener (3.7.7 and 3.8.5 of the Reasons; 10 of the decision in G 3/04). The Board of Appeal in T 1286/23 disagreed with this conclusion, arguing that the requirements under Article 107 EPC are "replaced by a legal interest extraneous to the proceedings conducted before the European Patent Office". Finally, the Board of Appeal reasoned that appellant status for an appeal stage intervener is not in conflict with the principle of party disposition, since party disposition does not automatically afford an individual appellant the right to terminate proceedings through their withdrawal (3.13.4 to 3.13.6 of the Reasons).

Basis for reasoning in T 1286/23

The Board of Appeal based its arguments on the reasoning that, contrary to the view in G 3/04, the intervener's aim is not to challenge the patent in the sense of an opposition, since an opposition may be filed "just in case" (3.4.2 of the Reasons). Rather, the justification for an intervention

Case details at a glance
Jurisdiction: EPO
Decision level: Enlarged Board of Appeal
Parties: FOREO LIMITED (patent proprietor), Beurer GmbH and GESKE GmbH & Co KG (opponents)
Citation: G 2/24
Date: 25 September 2025
Decision (PDF): dycip.com/epo-g224

Intervening third parties enter proceedings as opponents that have not filed an appeal

is derived from a legal interest extraneous to the EPO proceedings, namely being sued for infringement or only threatened therewith. In the eyes of the Board of Appeal, this justification should extend to appeal proceedings. The Board of Appeal considered that it was the patentee's own choices that lead to another party becoming an intervening third party and so "[h]ere, just as elsewhere in life, one has to face the music one has orchestrated" (3.4.4 of the Reasons).

Admissibility of the referral

Readers may wonder why the Enlarged Board of Appeal admitted the referral in T 1286/23 at all, given that the referred question had already been answered in G 3/04. Indeed, the Enlarged Board of Appeal noted that it does not find the prospect of such a type of referral "particularly appealing in terms of safeguarding consistent case law". Nevertheless, it admitted the referral in light of the Board of Appeal's criticism of the legal reasoning in G 3/04 and the referral's support by the President of the EPO as well as four *amicus curiae* briefs.

Reasons for the decision in G 2/24

The Enlarged Board of Appeal in G 2/24 first assessed whether there had been any substantive changes in the legal framework since G 3/04. Having found none, the Enlarged Board of Appeal then turned to considering the legal concept of appeals.

The Enlarged Board of Appeal clarified that the purpose of the appeal procedure was that of a judicial review of the decision under appeal, with a view of eliminating any adverse effect that any party of the first instance proceedings may have suffered as a result of a decision deviating from a request made by said party (28 to 34 and 40 of the decision). According to the Enlarged Board of Appeal, only a party adversely affected in such a way can appeal.

In contrast, by virtue of Article 105(2) EPC an intervening third party enters in proceedings as an opponent at the stage the proceedings are at on the date of intervention, making them an accessory party. Given this exceptional nature of intervention (which already supersedes the 9-month rule under Article 99 EPC), the Enlarged Board of Appeal found that its use as a legal remedy under Article 105 EPC could not be applied extensively.

The Enlarged Board of Appeal then considered what this meant in the context of the appeal procedure. Citing from point 7 of the Reasons in G 1/94 that "ambiguity remains as to the interpretation of Article 105 EPC in respect of intervention in appeal proceedings", the Enlarged Board of Appeal determined that intervention at the appeal stage has to fit into the legal and procedural framework of the Boards of Appeal. This framework is governed, *inter alia*, by the principles of party disposition, *ne ultra petita* and *reformatio in peius*. According to the Enlarged Board of Appeal, the intervener is, in the absence of specific legal provisions to the contrary, bound by these principles and thus becomes a party as of right under Article 107, second sentence, EPC (60 to 66 of the decision). This is in contrast to the Board of Appeal's view in T 1286/23 that the legal interest extraneous to EPO proceedings on which the intervention is based should take precedence over the requirements of Article 107 EPC.

Finally, the Enlarged Board of Appeal reviewed the legal basis for intervention in several EPC contracting states and the UPC "to ensure harmonised application of the EPC". From this review the Enlarged Board of Appeal concluded that, where not governed otherwise by way of specific statutory provisions, "an intervention is considered an accessory to the proceedings and ceases to have effect if the proceedings are terminated by the main parties" (97 of the decision). In view of such national jurisprudence, the Enlarged Board of Appeal concluded that the decision in G 3/04 is still in line with the legal framework of appeals and that an explicit legal provision in the EPC would be required to award an intervener an independent party status, that is, a status other than that of a party as of right (102 of the decision).

Final thoughts

The decision reflects the careful balancing act performed by the procedural and legal framework of the EPC and Boards of Appeal, which weighs up third parties' interests to have a patent's validity examined centrally against the need for legal certainty. In the present decision, the Enlarged Board of Appeal decided that granting an intervening third party entering appeal proceedings anything other than the status of a party as of right could not be reconciled with this framework.

Authors:
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Second non-medical use claims
Guidance on using "relative improvement" features

Case details at a glance
Jurisdiction: EPO
Decision level: Technical Board of Appeal
Parties: Sun Chemical Corporation (applicant), Schlenk Metallic Pigments GmbH and ECKART GmbH (opponents)
Citation: T 2387/22
Date: 24 June 2025
Decision: dycip.com/epo-t238722

T 2387/22 contains useful insights into the clarity of "relative improvement" features in second non-medical use claims at the European Patent Office (EPO) and provides some practical guidance on drafting such claims.

Background

It is established EPO case law that a claim directed to the use of a known compound for a particular purpose (a second medical use claim) should be interpreted as including that technical effect as a functional technical feature and such a claim is novel provided the technical effect has not previously been made available to the public, even if that effect may have been inherently achieved in a known use (G 2/88 and G 6/88).

T 2387/22 concerns European patent no. 3325559 in which the granted claims related to a vacuum metallised pigment (VMP) pigment slurry comprising pigments, solvents and specific dispersing additives. Both parties appealed the decision of the Opposition Division to maintain the patent in an amended form. Whilst the Technical Board of Appeal ultimately revoked the patent, of particular note is the reasoning of the board in relation to the second non-medical use claims of auxiliary requests 9-11 in which the board addressed was whether a feature defining a relative improvement was clear. Whilst clarity objections are not permissible as a ground of opposition at the EPO, claim amendments made post-grant require that clarity is considered.

Relative improvement features in use claims

Claim 1 of each of auxiliary requests 9-11 in T 2387/22 was directed to use of a VMP pigment in a flexographic ink formulation for providing the technical effects: "fewer print defects, higher hiding and stronger colour and allowing a lower volume anilox".

The patentee argued, citing G 2/88, that when a use claim defined technical purposes or effects, these were to be interpreted as functional features restricting the scope of protection. They further argued that it was a well-established practice of the boards to allow the definition of effects or purposes in non-medical use claims using broad and/or relative terms.


EP 3325559's granted claims related to a VMP pigment in a flexographic ink formulation

Conversely, the opponent argued that since the functional features were defined using relative terms, they did not meet the requirement of clarity under Article 84 EPC. In particular, the opponent emphasised there was no way to objectively determine whether a given use met the requirement of "providing fewer printing defects" because it was not even clear how the printing defects should be identified or measured and/or what the reference was for concluding whether the relative condition "fewer" was met.

In its decision, the Board of Appeal pointed out that the limiting functional features of a use claim are not exempt from the clarity requirement under Article 84 EPC or somehow exposed to lower standards; it acknowledged that the mere breadth of protection does not in itself imply a lack of clarity. The Board of Appeal went on to emphasise that the decisive consideration is whether the feature in question gives rise, or could plausibly give rise, to legal uncertainty when assessing whether a particular subject matter falls within or outside the scope of protection conferred by the claim. Where a claimed invention is defined by the use of a known entity to achieve a known technical effect or purpose, and the alleged technical contribution lies in a "relative improvement or enhancement of that effect or purpose", the requirement of clarity under Article 84 EPC generally demands that the feature defining such relative improvement or enhancement be expressed in "objectively verifiable terms", thereby ensuring legal certainty regarding the scope of protection. In these "relative-improvement" scenarios, any imprecise functional language can blur the distinction between claimed and known uses, giving rise to the very legal uncertainty that the clarity requirement is intended to prevent.

In T 2387/22, the Technical Board of Appeal found that the prior art already discloses the use of the same additive for the same, or at least very similar, technical purposes and, thus, the claimed technical effects are neither hidden nor unrecognised in the prior art. Further, the board noted that the use claim does not define distinct technical effects, but rather relative improvements in the achievement of such effects. The Technical Board of Appeal held that the subject matter of claim 1 of auxiliary requests 9-11 cannot be assessed objectively in relation to the prior art, which gives rise to legal uncertainty and, thus, the claim lacks clarity.

Key takeaways and practice points

Novelty and inventive step of a second non-medical use claim can be based on technical effects that constitute relative improvements of effects of the prior art.

"Relative improvement" features must be expressed in "objectively verifiable terms" so that the distinction between claimed uses and known uses is clear.

Vague or imprecise definitions of such "relative improvement" features can lead to legal uncertainty and, thus, clarity objections.

Author:
Stephanie Wroe

EPO practice & procedure
Acceptance of colour drawings in EPO applications

From 01 October 2025, the European Patent Office (EPO) accepts colour or greyscale drawings in all electronically filed European patent applications.

The change applies to all electronic filings of European patent applications via the EPO (Online Filing 2.0, ePCT, the EPO Contingency Upload Service and MyEPO), including divisional applications. Although colour drawings are not permissible in PCT applications, colour/greyscale drawings may be available online for a PCT application and noted in the application itself (see below).

> The EPO states that this change is based on user demand, the ability to deal with such applications in view of end-to-end electronic processing and publication, and aligns more broadly with general digitalisation goals.

European patent applications

Colour and/or greyscale drawings can be included in European patent applications and divisional applications. However, for divisional applications, the drawings will be examined for compliance with Article 76(1) EPC to ensure that subject matter does not extend beyond that found in the parent application.

Similarly, if there are missing parts or corrections to drawings under Rules 56(3) or 56a(4) EPC, the drawings should correspond directly to those of the priority application. Accordingly, the applicant is limited to the drawings filed in the priority application.

PCT applications for which the EPO is receiving office

Colour drawings do not currently fulfil formality requirements for PCT applications, although this is currently in discussion as outlined in PCT/WG/17/12.

Nevertheless, the EPO as receiving office will accept colour drawings. These will be converted to black and white by the International Bureau, but the colour drawings will remain available to the public and national offices on PATENTSCOPE and will be noted on the front of the application.

This becomes relevant to PCT applications entering the European regional phase.

For Euro-PCT applications entering the European phase from 01 October 2025, the EPO will process colour drawings that are both: 1) available on PATENTSCOPE; and 2) mentioned on the front page of the application. If either criterion is not fulfilled, the drawings will be processed in black and white. For Euro-PCT applications entering the European phase before 01 October 2025, the possibility of amendment is mentioned in the Official Journal (EPO OJ 2025, A57, point 11), noting that such drawings will be assessed for compliance with Article 123(2) EPC.

Translated applications

For European applications originally submitted in a non-EPO language and then translated (Article 14(2) and Rule 6(1) EPC), the drawings must correspond to those of the original application.

For Euro-PCT applications that require translation (Article 153(4) and Rule 159(1)(a) EPC), as with other Euro-PCT applications, if colour drawings are available on PATENTSCOPE and noted in the application, these will be processed.

Priority

Later applications claiming the priority of an earlier application can, within the bounds of Articles 87 and 88 EPC, utilise colour drawings where the priority application includes colour drawings.

Changes to the implementing regulations

Decision of the President of the EPO dated 07 July 2025 under Rule 49(2) EPC provides: "(2) Drawings shall be executed as follows: (a) Drawings shall be executed without colourings in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes. When filed by means of electronic communication, **drawings may also be executed in colour or in greyscale**, in **durable**, **uniformly thick** and **well-defined lines**, strokes or areas. They must also be **sufficiently rich in contrast and suitable to be clearly displayed** at a resolution of 300 dpi." (Emphasis added)).

The meaning of "sufficiently rich in contrast and suitable to be clearly displayed" is open to interpretation, but the acceptance of colour and/or greyscale drawings clearly offers the opportunity to convey more detailed technical information.

Other jurisdictions

Colour drawings are not widely accepted in other jurisdictions. In the IP5, only Korea generally accepts colour drawings. The USA and China only accept colour drawings if necessary for explaining the technical content of an application. Japan accepts only black and white or greyscale.

Closer to home, the UKIPO only accepts black and white drawings, although photographs which inherently include greyscale are also allowable.

Risks and best practice

Although there are likely to be some practice points to iron out, the change to accept colour and/or greyscale drawings appears to be a step forward. That said, the biggest risk to applicants submitting colour drawings is loss of information if the drawings need to be converted to black and white. For cautious applicants, particularly where the application is to be submitted in jurisdictions that do not allow colour, best practice may be to continue to prepare and submit black and white drawings. For other applicants, particularly where the application is to be submitted in jurisdictions generally allowing colour or allowing colour where justified, best practice may be to submit drawings in colour, with the potential fallback of readability if converted to greyscale.

Author:
Tegan Stockdale

Is the appetite for green technology waning? Insights from worldwide patent office statistics

On 18 April 2025 the United States Patent and Trademark Office (USPTO) formally terminated its Climate Change Mitigation Pilot program, with the Trump administration also cancelling billions of dollars of funding into green projects. Does this mark a turning point in the global landscape or is the USA an outlier?

USA picture

In June 2022, the Climate Change Mitigation Pilot program was launched by the USPTO. The program sought to accelerate the examination of patent applications for innovations that mitigate climate change and would last one year or until 1,000 grantable petitions had been received. A year later, having only received 354 petitions, the program was expanded to include innovations in any economic sector designed to make progress toward achieving net zero. The deadline was extended until 2027, or until 4,000 grantable petitions had been received. At the time of its suspension in January this year, however, only 1,399 petitions had been filed and 898 of them granted.

The initial program was very limited in scope, since the applications had to contain one or more claims to a product or process that mitigates climate change by reducing greenhouse gas emissions. Whilst the requirements were relaxed when the program was extended in 2023, the scope was still narrow with many applicants finding it difficult to file applications which met the requirements, so the low number of petitions is not necessarily indicative of a lack of green innovation in the USA.

President Trump has, however, reportedly cancelled nearly $8 billion in funding for climate-related projects as part of his administration's 2026 budget to eliminate funding for the "Green New Scam", such as direct air capture hubs that were awarded during the Biden administration. Green innovators in the USA will therefore face additional challenges during the Trump administration.

UK picture

In the UK, the Intellectual Property Office (UKIPO) introduced the Green Channel in 2009 to allow applicants to requested accelerated processing of their application if the invention has an environmental benefit. Applicants need only make a reasonable assertion the invention has some environmental benefit.

The UKIPO publish the number of Green Channel requests with its annual statistics. Figure 1 (below, left) shows the percentage of patent applications at the UKIPO that have requested use of the Green Channel each year since its inception. There is an upward trend in the percentage of Green Channel requests, with a noticeable increase since 2019. Although one fewer request was received in 2024 compared to the record number in 2023, overall applications at the UKIPO fell by 5% in 2024 compared to 2023, so the percentage of Green Channel requests still increased.

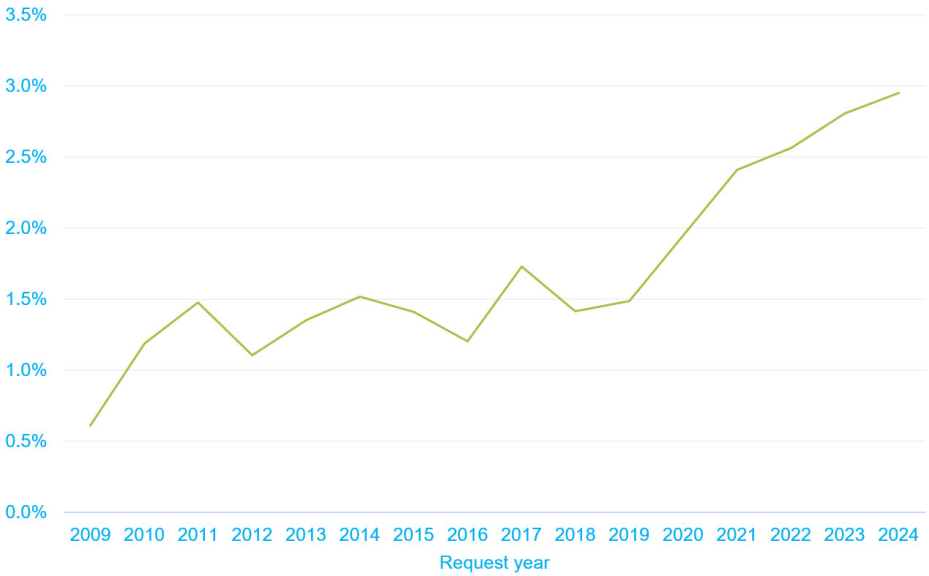
Global picture

Other countries, such as Japan, China, Canada and Australia also have schemes similar to the UKIPO Green Channel but unlike the UKIPO they do not publish detailed statistics. The number of Green Channel requests is not a foolproof indicator of "green" filings as the criteria is very broad and applications with only a loose link to an environmental benefit can be accepted. A more generally accepted approach is to look at "green patents", which are typically considered to be patents with a Y02 Cooperative Patent Classification (CPC) classification (technologies or applications for mitigation or adaptation against climate change).

Much of the literature on green innovation uses data up until 2020, so does not give a complete picture of the impact of the Covid pandemic and the years following. Equally, patent applications typically publish at least 18 months after their filing date, so there is a lag in the data when considering patent publications. Last year the China National Intellectual Property Administration (CNIPA) produced a report looking at trends in green patents from 2016 to 2023. In this period, nearly 1.28 million green patents were published worldwide with 45% from Chinese applicants. The overall annual growth rate of 4.8% was largely due to 10% growth from Chinese applicants.

Whilst this shows there is a high level of green innovation in China, most of these patent applications were national rights

Figure 1: percentage of total applications at UKIPO requesting Green Channel



Useful links and references

USPTO, Climate Change Mitigation Pilot Program CLOSED: dycip.com/uspto-climate-program

Reuters Trump administration scraps $8 billion for climate-related projects: dycip.com/reuters-trump-climate-2025

UKIPO, official statistics, facts and figures for patents, trade marks, designs and hearings, 2024: dycip.com/ukipo-stats-2024

CNIPO, information and resources, report on statistical analysis of green and low-carbon patents (2024): dycip.com/cnipa-green-patents-2024

EPO, new EPO-EIB study, EU single market is a key catalyst for scaling clean and sustainable inventions: dycip.com/epo-eib-clean-tech-study

Green Power Denmark: dycip.com/green-power-denmark

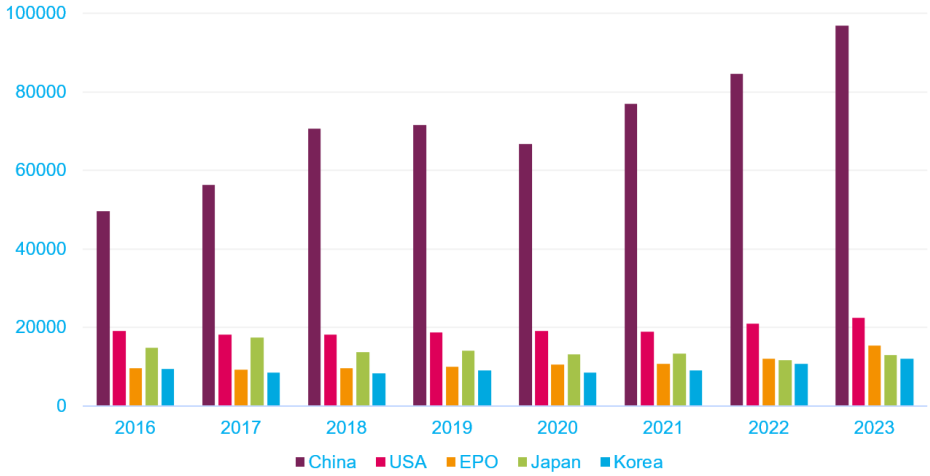
IFC, Innovation in Green Technologies report, 15 July 2025: dycip.com/ifc-innovation-green-tech

IMF, The Drivers and Macroeconomic Impacts of Low-Carbon Innovation – a Cross-Country Exploration: dycip.com/imf-low-carb-innovation

WIPO, Patents in the green transition - trends in the global development of future technologies: dycip.com/wipo-green-patents

only filed in China. Between 2016 and 2023 there were 573,000 green patents publications in China but only 18,000 green PCT publications from Chinese applicants compared to 27,000 from Japanese applicants and 17,000 from US applicants. The number of green PCT publications from Chinese applicants is, however, growing over twice as quickly as domestic filings, suggesting a change in strategy from Chinese applicants and a more global outlook. There was also growth in green PCT publications from Korean, Japanese and UK applicants, whereas there was a reduction from US applicants over this period.

Figure 2: green patent publications at IP5 offices



European picture

Green patent publications at the European Patent Office (EPO) grow by an average of 9% between 2016 and 2023, resulting in the EPO overtaking the Japan Patent Office in 2022. The EPO also saw year-on-year growth over the whole period, whereas the other IP5 offices each saw a downturn at some point during the period.

A joint study from the EPO and the European Investment Bank (EIB) published in 2024 found, between 2017 and 2021, 26.6% of all green PCT publications were from applicants from EPO member states, followed by Japanese (21.1%) and US (20.2%) applicants. Although 15.6% were from Chinese applicants, there was a 70% increase in green PCT publications from Chinese applicants compared to 16% from applicants from EPO member states over the same period.

Whilst USA applicants remain the largest filers of green patent applications at the EPO followed by German applicants, both have seen a reduction in filings over the last ten years. There are, however, regional pockets of strong green innovation, such as the Nordics. Data from the Danish Patent and Trademark Office (DKPTO) in 2023 showed Denmark, Sweden and Finland had 90, 37 and 33 green patent publications per million inhabitants at the EPO in 2021, compared to less than 10 for both the USA and China. Denmark in particular has a clear strength in wind energy (CPC classification Y02E), with 60% of all Danish green patent applications coming from this field.

Future of green innovation and patents

The data we have discussed in this article shows despite the downturn in green patent publications from USA, Japanese and German applicants, globally the outlook is more buoyant. Equally, despite the reductions in funding in the USA, global funding for green innovation is increasing. In 2023 the EU increased the value of its Innovation Fund by nearly 18% to be potentially worth 40 billion Euros. Last year, the Chinese Government launched eight green bond funds valued at $7.9 billion whilst the Danish Government launched a EUR 670 million “Green Fund” to advance green initiatives by 2030. In the UK, the Net Zero Innovation Portfolio has committed £1.3billion over 4 years.

An International Finance Corporation (IFC) report in July 2025 showed there is a significant link between climate laws and green innovation; countries that pass more climate laws tend to produce more green patents. This link was also demonstrated in an International Monetary Fund (IMF) working paper published in June 2025. This working paper also showed an acceleration in green patent filings boosts real economic activity (GDP), with a peak occurring after three years, compared to a peak of similar magnitude within five years for non-green patents. Green innovation therefore not only positively affects economic growth, but its impact is at least the same as for non-green innovation.

A Danish Patent and Trademark Office (DKPTO) study published in 2024 showed, in the period from 2011 to 2020, just over half the Danish companies filing green patent applications were micro entities and 32% SMEs, but these companies only accounted for around 10% of Danish green patent applications. A similar picture across all EPO member states was shown in the EPO-EIB study, demonstrating larger companies have more comprehensive patent portfolios. In Europe at least, green innovation is being driven by micro entities and SMEs, but they may not be fully realising the value of their innovations or maximising they intellectual property assets. The EPO-EIB study also highlighted smaller companies are more reliant on commercial partners to commercialise their technology and emphasised the value of patents to facilitate access to financing. More can therefore be done to help smaller companies realise the value of their green IP and access funding to allow them to build on their innovative activities and positively impact the global green movement.

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Protecting your after-market
Part 1: consumables

In many industries a manufacturer's device serves to create a market for a consumable of that device, and often (for example, in the case of printers) this is the main source of profit, to the extent that the device itself may be sold as a loss-leader. Consequently it is desirable for the manufacturer to protect the consumables, in order to protect their after-sales market.

In some cases technological gatekeeping such as authentication codes or digital rights management can ensure the use of authorised consumables, or enable enhanced functionality when used; however these are often unpopular with end users and vulnerable to workarounds. Furthermore, there will be many cases where such technological approaches are not appropriate due to their cost or the use case of the consumable, or the functionality of the device. Consequently, more legally robust protections are desirable.

> Where the consumable itself comprises an invention, the simplest solution is to patent it so that the consumable is independently protected. However this is not always possible, and so other options may need to be considered to avoid third-party supply and/or adversarial interoperability by competitors.

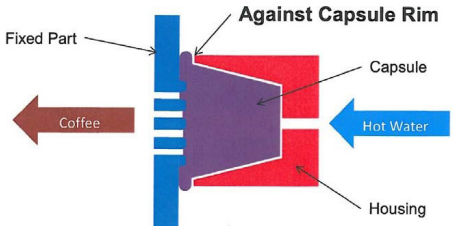
The design of the consumable may also be protected, although registered design protection typically excludes elements driven by a technical function or that are necessary to connect to another thing. This can reduce the ability of designs to protect consumables from compatible versions, although they are still very useful to protect design features associated with a brand, for example alongside trade marks.

Often however, an invention lies in how the main device uses a consumable, either in terms of efficiency, ease of use, speed, reliability or the like; but as a result the device only has the specific technical effect when operating as a system with the consumable in place. In this case, can the consumable be protected **indirectly** as part of the wider system?

In the case of Nestec v Dualit [2013] EWHC 923 (Pat), this issue was discussed at length.

Nestec v Dualit

Nestec manufacture Nespresso coffee machines that make coffee from single-use capsules. The capsules have a lip so they can be clamped in a fixed manner within the machine, which allows water in one end of the capsule and coffee out the other:



Nestec originally had a patent for the capsule itself but in due course this expired. The patent at issue related to how more recent machines moved the used capsule into an extraction position for easy disposal, and claimed among other features an "Extraction system comprising a device for the extraction of a capsule and a capsule that can be extracted in the device; the capsule comprising a guide edge in the form of a flange […]".

The High Court discussed several issues relating to whether Dualit's sale of compatible capsules was secondary infringement under section 60(2) of the UK Patents Act (UKPA).

The primary infringement Dualit would be enabling in this way is for the owner of the machine to "make" the claimed extraction system when combining the device and capsule. This system comprises the durable Nespresso machine and the perishable single-use capsules, which can be obtained independently of each other. Notably the relevant actions of the machine that characterise the invention are not altered by the presence or absence of the capsule (although clearly no coffee is produced and no capsule is extracted without one). As such the capsule appears entirely subsidiary to the machine. The judge also noted that "it is manifest" that the owner of the machine is not repeatedly making the same system each time they use their coffee machine.

Hence more generally where a consumable does not alter or enable a relevant function of a device (unlike when repairing a device), then it may not be said to make a composite system.

Separately, the judge also considered whether the act of making the claimed extraction system would be an infringing action at all, or was in fact performed by a "person entitled to work the invention". Sale of a machine like the Nespresso results in the exhaustion of the patentee's rights in respect of that individual product, and also confers an implied license on the purchaser to use the machine how they please. More pointedly the purpose of a Nespresso machine is to make coffee and so the purchaser can reasonably expect an implied licence to obtain and use coffee capsules with the machine.

Notably whilst the exhaustion doctrine will leave no patent right to be enforced anyway, an implied licence can be excluded by use of an explicit licence.

Hence in some cases, for example where the device and/or consumables are a specialist long term capital expenditure or leased (for example in the case of heavy plant machinery, assembly line equipment, or agritech machinery), sale of the device **can** include a contractual agreement to use a specific source for the consumable, even if only for a limited period (and subject to anti-competition provisions if applicable). This may be the best option where the consumable is not independently protected and is a wholly subsidiary element of the machine's operation.

Case details at a glance

Jurisdiction: England & Wales
Decision level: High Court
Parties: ESTEC SA (claimants), NESTLÉ NESPRESSO SA, NESPRESSO UK LIMITED and DUALIT LIMITED (defendants), PRODUCT SOURCING (UK) LIMITED and LESLIE ALEXANDER GORT-BARTEN
Citation: [2013] EWHC 923 (Pat)
Date: 22 April 2013
Decision: dycip.com/2013-ewhc-923-pat

Jurisdiction: England & Wales
Decision level: High Court
Parties: GRIMME LANDMASCHINENFABRIK GmbH (claimant), & Co. KG, and DEREK SCOTT (defendant) (T/A SCOTTS POTATO MACHINERY)
Citation: [2009] EWHC 2691 (Pat)
Date: 03 November 2009
Decision: dycip.com/2009-ewhc-2691-pat

Whilst the Nestec case touched on whether a consumable constituted a part of a machine or not, this was a more central aspect to another case, Grimme v Scott [2009] EWHC 2691 (Pat).

Grimme v Scott

Here, Grimme's patented invention was an agritech apparatus for separating potatoes from haulm, soil, and other impurities once dug up. It uses contra-rotating rollers comprising "an elastically deformable shell part", where in each pair the upstream roller has "extension parts (43) which extend beyond the cylindrical shell part and which are constructed as conveyor lips".

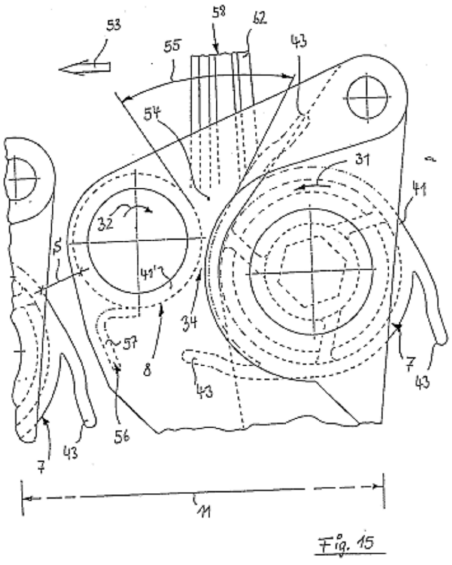


Fig. 15

Potatoes move over the rollers, and the lips push the potatoes forward whilst helping to knock and pull detritus down between the contra-rotating roller pairs.

Meanwhile, Mr Scott's Evolution separator used steel rollers. In principle this meant that it did not infringe the patent with its elastically deformable rollers. However, it was considered clear that these steel rollers could be replaced with rubber ones, reducing the aggression with which the potatoes were handled and cleaned. It was also held that Mr Scott knew and designed his machine with this in mind, and that it was obvious that people would do this.

The after-sales consumables market is often more profitable than the device itself

Hence in effect Mr Scott was supplying everything except an elastomeric version of the rollers, knowing that these would likely be added by end users. As such he was considered to be supplying means relating to an essential element of the invention.

In this case, rather than supplying compatible pods for an existing machine to create a patented system, in effect Mr Scott provided a compatible machine for existing pods – and in doing so stepped over the mark: "Mr Scott went further – in this case, replacing the rollers would be a one-off action that changed the ongoing operation of the device to match that of the patented system".

Action points

The lessons from these cases are that, when developing a product used by a third-party device, or a device that uses third-party consumables, it is advisable to perform a freedom to operate check on whether and to what extent either element is protected by IP.

Similarly, when developing your own system using consumables, consider independent protection of each, and/or where possible an explicit licence for supply.

As a final point, replacing the steel rollers with rubber ones is not an act of repair, as the resulting machine operates differently (it does not restore the original state of the machine); how far the right to **repair** a patented device can go is the topic of the next article in this series.

Author:
Doug Ealey

Inventive step at the UPC
Court of Appeal sets definitive test

The Court of Appeal has adopted a holistic assessment of inventive step and has moved away from the EPO's problem solution approach.

Assessment of inventive step as confirmed by the UPC Court of Appeal

Two landmark decisions have been issued by the first and second panels of the Court of Appeal on the same day, 25 November 2025: Meril v Edwards (Edwards) and Amgen v Sanofi (Amgen).

The decisions have clearly been coordinated and agreed upon between the two panels of the Court of Appeal, with sections of the text common between the two decisions. In both decisions, the Court of Appeal uses the headnotes to provide guidance on various principles to be applied at the UPC. Headnotes 8 to 12 of Edwards and headnotes 11 to 16 of Amgen set out the same inventive step approach, which the Court of Appeal explicitly states is the approach of the UPC.

The assessment of inventive step set out by the Court of Appeal can be summarised as follows:

1. Define the skilled person and their common general knowledge at the effective date.
2. Establish the "objective problem" of the invention from the perspective of the skilled person at the effective date.
3. Assess whether the skilled person, starting from a "realistic starting point" in the art in the relevant field of technology, wishing to solve the objective problem, **would** (and not only: could) have arrived at the claimed solution.

Perhaps owing to the different facts before the Court of Appeal in each case, the two decisions provide further headnotes on inventive step that are unique to each decision. Some comments on these additional headnotes follow below.

Importantly, the Court of Appeal clarifies in headnote 13 of Edwards that "it is not necessary to show improvement of the technical teaching as defined by the patent claims over the prior art" for an inventive step to be present, and confirms that inventive step may also be present if the patent claims "a non-obvious alternative" to solutions known in the prior art.

In Amgen, the Court of Appeal provides additional guidelines in headnotes 17 to 22 on the assessment of reasonable expectation of success, which was crucial in this case. We discuss this in more detail in our report of this decision (see *page 12* of this newsletter). Notably, the Court of Appeal confirms that the assessment of reasonable expectation of success depends upon the specific facts, assessed on a case-by-case basis. The Court of Appeal also imposes a high burden for the party asserting invalidity of the patent on this basis. This party bears the burden of proof that:

1. results were clearly predictable or the skilled person would have reasonably expected success; and
2. "sufficiently substantiate[d] uncertainties and/or practical or technical difficulties" brought forward by the patentee would not prevent a skilled person from having a reasonable expectation of success.

Applying this approach to the assessment of inventive step, the Court of Appeal concludes that both Edwards' patent EP3646825 and Amgen's patent EP3666797 are valid, upholding the Paris Central Division's decision to maintain Edwards' patent in amended form and overturning the decision of the Munich Central Division revoking Amgen's patent for lack of inventive step.

Comparison with other approaches to the assessment of inventive step

In both decisions, the Court of Appeal refers to the different approaches for assessing inventive step used by the various EPC countries, including the EPO's problem solution approach and the approaches used by jurisdictions such as the UK and Germany that are often referred to as more holistic.

The approach set by the UPC Court of Appeal possesses some similarities to the EPO's problem solution approach, but there are marked differences.

The most notable difference is structural. The UPC's approach set out in Edwards and Amgen first establishes the **objective problem** and then determines a **realistic starting point** in the prior art. By contrast, the EPO's problem solution approach first determines the **closest prior art** and then establishes the **objective technical problem** based on isolated, distinguishing features of the claim compared with this **closest prior art** (which may be a specific embodiment in a document).

This change in the structure of the approach directly affects the establishment of the problem to be solved. In the UPC's approach, the **objective problem** is formulated by establishing what the invention contributes to the state of the art, considering the claim in the context of the application and the inventive concept underlying the invention. Thus, the **objective problem** is derived from the patent itself in isolation of the prior art, thereby aligning the established problem with the teachings of the patent. By contrast, in the EPO's problem solution approach, the **objective technical problem** is established in the second step in view of the differences with the closest prior art determined in the first step. This approach formulates a different **objective technical problem** for each closest prior art document and sometimes results in a problem that is not contemplated in the patent itself. Accordingly, the structural differences in the approaches could, in certain cases, impact on the formulated problem.

A further difference is in the determination of a **realistic starting point** as opposed to the **closest prior art**. The Court of Appeal confirms previous UPC case law in this respect (see *Inventive step at the UPC, two years on*) in that a realistic starting point would have been "of interest" to a skilled person wishing to solve the objective problem. Such a document could disclose "several features similar to those relevant to the invention" and/or address "the same or a similar underlying problem". The Court of Appeal acknowledges that there may

Related articles

UPC Court of Appeal reverses First Instance decision Amgen's patent ruled valid: *see page 12 of this newsletter*

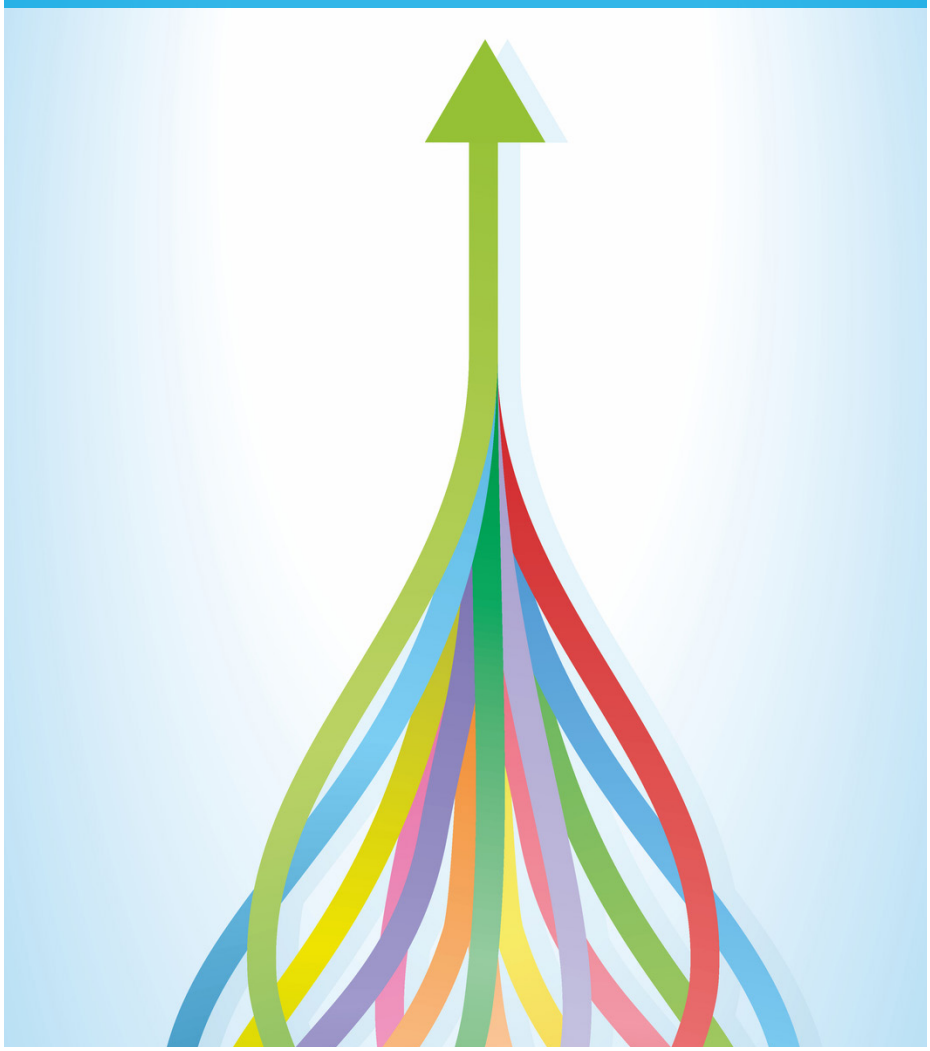
Inventive step at the UPC, two years on, 12 June 2025: dycip.com/upc-inventivestep-year2

Case details at a glance

Jurisdiction: UPC
Decision level: Court of Appeal (Luxembourg)
Parties: Amgen Inc v Sanofi-Aventis Deutschland GmbH, Sanofi-Aventis Groupe and Sanofi Winthrop Industrie SA
Citation: UPC_CoA_528/2024
Date: 25 November 2025
Decision: dycip.com/upc-coa-528-2024

Jurisdiction: UPC
Decision level: Court of Appeal (Luxembourg)
Parties: Meril Italy Srl, Meril GmbH, Meril Life Sciences Pvt Ltd, and Edwards Lifesciences Corporation
Citation: UPC_CoA_464/2024, UPC_CoA_457/2024, UPC_CoA_458/2024, UPC_CoA_530/2024, UPC_CoA_532/2024, UPC_CoA_533/2024, UPC_CoA_21/2025, UPC_CoA_27/2025
Date: 25 November 2025
Decision: dycip.com/upc-coa-meril-edwards

Different UPC Court of First Instance approaches should "lead to the same conclusion"



be more than one realistic starting point. The claimed invention must involve an inventive step when starting from each of these starting points.

The final step is the most similar to the EPO's problem solution approach. Indeed, the Court of Appeal in Amgen specifically emphasises the term "would" in the third stage of the assessment. In line with the could-would approach applied by the EPO, the question is whether the skilled person **would** have arrived at the claimed solution when wishing to solve the objective problem from a realistic starting point: it is not sufficient that the skilled person simply **could** have done so. The Court of Appeal expressly states that "the skilled person has no inventive skills and no imagination and requires a pointer or motivation" that "directs it to implement a next step in the direction of the claimed invention". This aligns with the EPO's assessment of how a skilled person proceeds from the starting point.

Overall, the UPC's approach to inventive step set out in Edwards and Amgen is more similar to the holistic approaches used by jurisdictions such as the UK and Germany than to the EPO's problem solution approach. This may be a welcome development to UPC representatives in these countries.

Final comments

To date, a mix of approaches to the assessment of inventive step have been applied by the First Instance Divisions of the UPC. This has included the EPO's problem solution approach and the approach applied by the German Federal Court of Justice (see, for example, UPC_CFI_501/2023, UPC_CFI_1/2023, UPC_CFI_315/2023, and UPC_CFI_189/2024 & UPC_CFI_434/2024). Such divergence of approach by the first instance divisions has led to significant uncertainty in, and much discussion of, the approach to inventive step which would ultimately be adopted by the UPC. The clarity the Court of Appeal provides on this issue in these coordinated decisions will be welcomed by patent practitioners and users of the UPC system.

Interestingly, the Court of Appeal comments in both decisions that all of the different approaches to inventive step used by the various EPC countries "are merely guidelines to assist in the establishment of inventive step" and "when properly applied, should and generally do lead to the same conclusion". This implicitly acknowledges that the use of different assessments of inventive step may not always result in the same outcome, which is an uncomfortable situation for any UPC user to deal with, since EPO proceedings pre- and post-grant will likely continue to employ the problem solution approach.

We wait to see whether the different approaches to the assessment of inventive step will lead to the same outcomes in parallel UPC and EPO proceedings as suggested by the UPC Court of Appeal. Certainly, in the case of Amgen, the UPC Court of Appeal's application of the holistic approach to inventive step has aligned the outcome with that of the EPO Opposition Division in the parallel opposition proceedings. However, we await the final chapter of this long running saga, with oral proceedings in the pending EPO appeal T 0716/25 scheduled for April 2026.

Authors:
Rachel Bateman & Rebecca Price

UPC Court of Appeal reverses First Instance decision
Amgen's patent ruled valid

The Unified Patent Court (UPC) Court of Appeal has overturned the order of the Munich Central Division and ruled that Amgen's patent EP 3666797B is valid after all, aligning with the decision of the European Patent Office (EPO) Opposition Division.

The Court of Appeal has also provided valuable insights into the principles applicable to claim construction, added matter, sufficiency and inventive step in the headnotes of the decision.

This decision is particularly relevant for pharmaceutical and biotech inventions concerning second medical use claims, where key considerations often include claim construction, sufficiency of functional features and a lack of reasonable expectation of success for inventive step.

The key takeaways are as follows:

1. Second medical use claims are **interpreted** as inherently requiring therapeutic efficacy by virtue of the formulation as a medical use claim.
2. For **sufficiency** of claims containing one or more functional features, it is "not required that the disclosure includes specific instructions as to how each and every conceivable embodiment within the functional definition(s) should be obtained".
3. The burden of proof for **sufficiency and reasonable expectation of success in the assessment of inventive step** is high and rests with the party invoking invalidity of the patent.
4. The UPC Court of Appeal adopts a holistic approach to **inventive step**.
5. **Inventive step** is generally lacking if "the results of the next step were clearly predictable, or where there was a reasonable expectation of success". For medical use claims, the skilled person would only have a reasonable expectation of success in developing the claimed treatment if it "had a sufficient indication that this would result in a therapeutically effective treatment".

Will the EPO decision in pending appeal T0716/25 align with the UPC Court of Appeal?

The patent

Amgen's patent EP3666797B granted with claim 1 directed to a monoclonal antibody or an antigen-binding fragment thereof for use in treating or preventing hypercholesterolemia or related conditions.

The antibody or antigen-binding fragment was defined solely by its function of binding to a PCSK9 protein and preventing or reducing the binding of PCSK9 to low density lipoprotein receptor (LDLR).

The patent explained that PCSK9 is involved in regulating the levels of the LDLR, which is in turn important in the removal of cholesterol from the bloodstream into liver cells. Thus, the claimed antibodies have a cholesterol-lowering effect.

First Instance decisions

We have previously reported on the diverging approaches to reasonable expectation of success leading to differing decisions of the Munich Central Division and EPO Opposition Division (see "related articles").

The Munich Central Division commented that the requirement for a reasonable expectation of success could be left undecided and revoked the patent in July 2024 for lack of inventive step (UPC_CFI_1/2023). By contrast, the Opposition Division considered that a reasonable expectation of success was crucial for a second medical use claim and was lacking. Hence, the Opposition Division rejected the oppositions in April 2025.

Court of Appeal: sufficiency of disclosure

The Court of Appeal provides useful guidance on the assessment of sufficiency of disclosure for claims containing one or more functional features. The Court of Appeal explicitly states that the disclosure of how to obtain every conceivable embodiment within the claim scope is not required. Notably, the Court of Appeal holds that non-availability of some embodiments of a functionally defined claim is "immaterial to sufficiency, as long as the skilled person… is able to obtain suitable embodiments" within the claim scope. The Court of Appeal also states that the burden of proof that

Related articles

Inventive step at the UPC - Court of Appeal sets definitive test: see page 10 of this newsletter

Differing decisions from the UPC and EPO - Sanofi v Amgen, 12 June 2025: dycip.com/upc-epo-sanofi-amgen-jun25

Lack of inventive step from a "realistic" starting point - Sanofi v Amgen, 04 August 2024: dycip.com/sanofi-amgen-aug24

Case details at a glance

Jurisdiction: UPC
Decision level: Court of Appeal (Luxembourg)
Parties: Amgen Inc v Sanofi-Aventis Deutschland GmbH, Sanofi-Aventis Groupe and Sanofi Winthrop Industrie SA
Citation: UPC_CoA_528/2024
Date: 25 November 2025
Decision: dycip.com/upc-coa-528-2024

Jurisdiction: UPC
Decision level: Munich Central Division
Parties: Sanofi-Aventis Deutschland GmbH, Sanofi Winthrop Industrie SA, Sanofi-Aventis Groupe v Amgen Inc
Citation: ORD_598362/2023
Date: 16 July 2024
Decision: dycip.com/upc-ord-598362-2023

the patent cannot be reproduced without inventive skill and without undue burden rests with the party alleging insufficiency. This is perhaps particularly onerous in the case of broad functional claims.

Applying these principles to the facts of the case, the Court of Appeal considers that Amgen's patent is sufficiently disclosed, since it is possible to obtain suitable embodiments within the claim scope based upon the application and Sanofi has not discharged its burden of proof.

The UPC's approach to sufficiency of disclosure for functional features aligns with that of the EPO, which may be a welcome development to UPC representatives and users of the UPC system. However, this approach is in direct contrast to the USA Supreme Court decision Amgen Inc v Sanofi No. 21-757 for a corresponding USA patent: a broadly defined genus of antibodies lacked enablement across the whole claim scope due to the unreasonable effort required to produce all the claimed antibodies.

Court of Appeal: claim interpretation

Importantly for the pharmaceutical and biotech sectors, the Court of Appeal provides guidance on the principles for the interpretation of medical use claims. The Court of Appeal confirms that it is an inherent claim feature of medical use claims that the claimed product is therapeutically effective, irrespective of whether the skilled person derives "any minimum required effect from the claim or the description". The Court of Appeal clarifies that "therapeutically effective" means a "noticeable improvement of the medical condition" or, in other words, that "the treatment must be meaningful". On the other hand, the Munich Central Division considered that the claimed treatment is not limited to a particular lowering of cholesterol levels as long as there is some reduction of cholesterol levels in vivo. This difference in claim interpretation affects the outcome of the decisions as discussed in more detail below.

Court of Appeal: inventive step

We have reported on the significance of the Court of Appeal's approach to the assessment of inventive step (see *page 10* of this newsletter).

In brief, the Court of Appeal sets out the principle that a claimed solution is obvious if the skilled person would (not simply could) have taken the next step in expectation of finding an envisaged solution of the objective problem. The Court of Appeal notes that this "is generally the case when results of the next step were clearly predictable, or where there was a reasonable expectation of success". Hence, the Court of Appeal confirms that, contrary to the position of the Munich Central Division, it is necessary to consider reasonable expectation of success.

In line with the first instance decisions, the Court of Appeal considers Lagace as the starting point for the assessment of inventive step. This research article described the role of secreted PCSK9 in regulating LDLR protein levels in heptaocytes. Lagace also contained a speculative suggestion to explore antibodies blocking the interaction between PCSK9 and the LDLR for the treatment of hypercholesterolemia. Importantly, Lagace caveated that this is dependent upon whether PCSK9 functions as a secreted factor (as opposed to via an intracellular mechanism).

The Court of Appeal agrees with the Munich Central Division that the skilled person, starting from Lagace, had a strong incentive to block PCSK9 activity to reduce LDL levels to be able to treat hypercholesterolemia and similar diseases. Crucially, the Court of Appeal considers that the skilled person would not consider developing antibodies targeting PCSK9 with a reasonable expectation of success based on their knowledge at the effective date. In particular, the mechanism(s) by which PCSK9 functions was(were) unknown at the effective date. Thus, the skilled person could not know whether therapeutic efficacy could be achieved with anti-PCSK9 antibodies.

Here, the divergence in claim interpretation is key, since the Court of Appeal considers that the implicit requirement is that the claimed antibodies must be therapeutically effective. The Court of Appeal explicitly states that the skilled person would only have a reasonable expectation of success in developing the claimed treatment if it had "a sufficient indication that this would result in a therapeutically effective treatment". In a further indication of the high burden faced by the party invoking invalidity of the patent, the Court of Appeal also states that the burden of proof for reasonable expectation of success rests with this party (see *page 10* of this newsletter).

Accordingly, the Court of Appeal has overturned the decision of the Munich Central Division revoking Amgen's patent for lack of inventive step.

Final comments

Patent practitioners and users of the UPC system will welcome the clarity that the Court of Appeal provides on the principles applicable to claim construction, added matter, sufficiency and inventive step in the headnotes of the decision.

In its approach to claim construction and reasonable expectation of success of second medical use claims, the Court of Appeal diverges from the approach of the Munich Central Division and aligns with established EPO jurisprudence. The Munich Central Division set a lower bar for reasonable expectation of success for second medical use claims and placed the onus on the patentee to prove that a skilled person would not have such an expectation. By contrast, the Court of Appeal confirms that attaining a therapeutically effective treatment is a requirement of a medical use claim such that a reasonable expectation of success plays a crucial role in the assessment of inventive step. The burden is then on the party alleging invalidity to show that the skilled person would possess a reasonable expectation of success.

It will be interesting to see whether the Board of Appeal of the EPO aligns with the decision of the UPC Court of Appeal, with oral proceedings in the pending appeal T 0716/25 scheduled for April 2026.

Author:
Rebecca Price

UKIPO

UKIPO fee increases
April 2026

The UK Intellectual Property Office (UKIPO) has announced an increase in its fees for the first time since 2018 for patents, 2016 for designs, and 1998 for trade marks. Subject to parliamentary approval, these changes are due to come into effect from April 2026.

The UKIPO has explained that these fee increases are necessary to address the 32% rise in inflation since 2016 and future cost pressures that cannot be fully offset through further efficiency savings or reserves. It has indicated that these increases will enable it to continue to invest in its systems and provide high quality services.

How much will the fees increase by?

The fees will be increasing by an average of 25%. A summary of the increases on some key actions is outlined in the table below:

Next steps

The UKIPO has indicated that it will publish full guidance early in 2026 to help customers whose fees may be due around the time of the planned changes.

If you are a rights holder, it is worth planning ahead to accelerate any filings or renewals to benefit from the existing lower rates. Renewal fees can be paid up to three months early for patents and up to six months early for trade marks and designs. Across a large portfolio, by bringing forward filing of rights and payment of renewal fees, large savings can be made.

The UK is still a cost-effective place to file rights as fees remain lower than many other European jurisdictions and other major IP offices. Filing a patent at the UKIPO remains an attractive option for first filings. Search results are normally issued within six months from filing (often much quicker) which enables an informed decision to be made on the merits of an application before the more significant investment of filing elsewhere.

If you have any questions on the fee changes and how they may affect you, please contact your usual D Young & Co advisor.

Author:
Alice Stuart-Grumbar

IP right	Service	Current fee (£) up to April 2026	Likely fee (£) after April 2026
UK patent	Application fee (paid on filing online)	60	75
	Request for search (for a UK application, online)	150	200
	Request for examination (online)	100	130
	Renewal fee year five	70	90
	Total renewal over lifetime	4,640	6,160
UK design	Application fee (single application)	50	60
	Application (up to ten designs)	70	85
	Renewal (first)	70	85
	Total renewal over lifetime	410	500
UK trade mark	Application fee (online)	170	205
	Notice of opposition (section 5(1)/5(2) only)	100	125
	Notice of opposition (other grounds)	200	250
	Renewal (online)	200	245

Unified Patent Court

UPC
January 2026

Unified Patent Court (UPC) fee amendments will enter into force on 01 January 2026. The amendments will apply to all applications and actions from that date. Notable amendments include:

1. 33% increase in fixed fees for primary Court of First Instance actions.
2. 10% increase of the value-based fees before the Court of Appeal.
3. Higher fixed-fees for evidence-related procedures.
4. Introduction of a value-based fee for provisional measures and other applications.
5. Adaptation of the scheme for reimbursement of court fees.
6. Measures to limit the effects of the court fee amendments to SMEs.

The UPC has noted that the adjustment of the court fees is in line with inflation since 2016, when fees were first proposed. Respective provisions of the Rules of Procedure and the Guidelines on the determination of court fees will also be amended.

The Chairman of the Administrative Committee, Mr Johannes Karcher, commented that: "The decision is taking into account the principle of fair access to justice, an adequate contribution of the parties for the costs incurred by the court and the financial sustainability of the court aiming at self-financing by the end of the transitional period in 2030."

The introduction of and increase in certain fees brings the UPC's charging structure into closer alignment with that of many national courts. However, the UPC's broad jurisdiction means that litigation at the UPC is still cost effective when compared to those national courts. Users of the UPC should carefully consider how the new fees may affect their filing strategies, with the new fee schedule to take effect imminently. If you have any questions, then please contact your D Young & Co representative for further information.

Author:
David Al-Khalili

And finally...

D Young & Co events

Webinar invitations
UPC & Biotech webinars

UPC Case Law, Observations & Analysis

Our ongoing series of webinars, dedicated to analysing the Unified Patent Court's decisions, continues as Rachel Bateman, David Al-Khalili and Laura Jennings discuss statistics and news, procedural aspects, claim construction, preliminary injunctions and long-arm injunction.

Published December 2025:
dycip.com/webinar-upc-insights-dec2025

European Biotech Patent Case Law

Tom Pagdin and Rebecca Price look at G 1/23 (enablement requirement for products placed on the market forming part of the state of the art) and round up recent decisions T 0709/23, T 0883/23 and T 0867/23.

Published November 2025:
dycip.com/webinar-biotech-nov025

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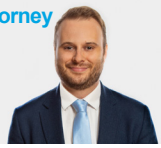

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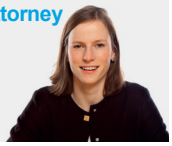

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