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PATENT

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Welcome to this bumper edition of our patent newsletter, packed with insights from both the EPO and the rapidly evolving UPC. In this issue, we delve into key recent decisions, comparing how case law from the established EPO is stacking up against the UPC's emerging jurisprudence. As the UPC continues to define its identity, understanding the interplay between these forums is more critical than ever.

Stop Press: We're delighted to share that our team has been recognised as top tier in the recent Legal 500 and IP STARS rankings, a testament to the strength of our expertise in this dynamic legal landscape.

Anthony Albutt, Editor

Events



LSPN Europe

04 November 2025, London, UK

Attending: Rachel Bateman and Garreth Duncan

Female Leaders - Inspiring Innovation

06 November 2025, London, UK

Keynote speaker: Alice Stuart-Grumbar

REACH

11 November 2025, London, UK

Attending: Robbie Berryman & Henry Davies

European Biotech Patent Case Law

18 November 2025, Webinar

Speakers: Simon O'Brien & Tom Pagdin

Formnext Frankfurt Expo & Convention

19-20 November 2025, Frankfurt, Germany

Attending: Anton Baker

CIPA Life Sciences Conference

20 November 2025, Sutton Coldfield, UK

Attending: Simon O'Brien, Tom Pagdin & Rebecca Price

UPC Case Law, Observations & Analysis

10 December 2025, Webinar

Speaking: David Al-Khalili, Rachel Bateman & Laura Jennings

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First UPC injunction covering the UK Fujifilm v Kodak

In *Fujifilm v Kodak* (UPC_CFI_365/2023) the Mannheim Local Division of the Unified Patent Court (UPC) granted a permanent injunction covering the UK (a non-member state of the UPC), confirming that the UPC has jurisdiction to decide upon infringement of the UK part of a European patent (when the defendant is domiciled in a UPC state).

This is a very notable decision, as it represents the first time that the UPC has granted an injunction covering the UK.

In this article, we examine the reasoning behind the decision and explore what this could mean for businesses with operations in the UK.

Fujifilm v Kodak

Fujifilm v Kodak is part of a long running dispute, concerning lithographic printing plates. Fujifilm (claimant) was suing Kodak (defendant) for alleged infringement of EP3511174 B1, relating to a planographic printing plate. EP3511174 B1 is in force in both Germany and the UK.

One key point of issue which arose during the case was the question of jurisdiction. That is, Kodak denied that the UPC had jurisdiction to decide infringement of the UK part of the European Patent, as the UK is not a member state of the UPC.

While, initially, this may appear logical, it was ultimately decided that the UPC does in fact have jurisdiction to decide upon the infringement action as far as it relates to acts infringing the UK national part of the patent-in-suit.

To understand how this decision was reached, it is necessary to look back to early 2025. In *BSH v Electrolux* (handed down in February 2025) the Court of Justice of the European Union (CJEU) decided that a court of a member state of the European Union in which a defendant

is domiciled has jurisdiction to rule on an infringement action based on a patent granted or validated in a non-EU member state (subject to certain restrictions).

Notably, even if invalidity of the patent was raised as a defence during the infringement proceedings, this would not shift the jurisdiction to the national court. However, any decision on invalidity made during the infringement proceedings would have inter partes effect only (and would not affect the status of the patent in its national jurisdiction).

Accordingly, *BSH v Electrolux* opened the door for cross-border enforcement of patent rights in Europe.

Proceedings in *Fujifilm v Kodak* were stayed pending the CJEU's decision in *BSH v Electrolux*, which proved pivotal to the outcome of *Fujifilm v Kodak*.

Indeed, since *Kodak* (the defendant) was domiciled in Germany (a member state of the UPC), the court determined, following *BSH v Electrolux*, that it did have jurisdiction to decide upon the infringement action as far as it relates to infringement of the UK part of the European patent. The fact that invalidity of the UK patent was raised as a defence did not shift the jurisdiction from the UPC.

Having confirmed its jurisdiction in the matter, the Mannheim Local Division then took this decision to its natural conclusion. That is, upon confirming its jurisdiction, a finding of infringement was made and an injunction was granted against *Kodak* in the UK.

Interestingly, enforcement of the injunction

➤ Related UP & UPC resources

We frequently publish UP & UPC related content and cannot always include everything in our newsletters. Recent articles you may find of interest include the following:

Added matter at the UPC: Samsung succeeds in revocation of Headwater patents
dycip.com/upc-samsung-headwater

Don't jump the gun: preliminary injunction granted in 17 UPC states against generic pharmaceutical company:
dycip.com/upc-pi-17-states

UPC CFI 315/2023, GRUR-RS 2024, 30221: NJOY Netherlands/Juul Labs International:
dycip.com/grur-njoy-juul

Our detailed guide to the UPC has been updated to reference the most important and recent case law:
dycip.com/upc-guide



Webinar invitation

UPC case law, observations & analysis

1pm, 10 December 2025

dycip.com/webinar-upc-dec2025

Fujifilm v Kodak concerned a European patent relating to a planographic printing plate



does not require any action by the UK courts. Rather, enforcement of the injunction will be achieved through application of fines in the case of violation of the injunction.

Related cases

While Fujifilm v Kodak was the first time that the UPC had issued an injunction covering the UK, it was not the first time that the UPC had exercised so-called long-arm jurisdiction (jurisdiction extending beyond its member states). Even preceding the ruling of the CJEU in BSH v Electrolux, the Düsseldorf Local Division held, in Fujifilm v Kodak (UPC_CFI_355/2023), that its jurisdiction extended to infringement actions

concerning member states of the EPC, which are non-EU states, such as the UK.

Therefore, following BSH Hausgeräte, perhaps it was only a matter of time until an injunction was issued covering the UK by the UPC.

Furthermore, the injunction imposed in Fujifilm v Kodak does not appear to be an isolated event, with a preliminary injunction also being issued by the Hamburg Local Division in Dyson v Dreame (UPC_CFI_387/2025) which was delivered on 14 August 2025. That preliminary injunction covers the

18 member states of the UPC as well as Spain (which, again, is not a UPC member state), further demonstrating the UPC's capacity for cross-border enforcement of patent rights in Europe.

However, at the moment the UPC decisions are first instance decisions which have not been tested by appeal. It remains to be seen how this situation will develop, both with respect to any further decisions extending the jurisdiction of the UPC beyond its member states and in relation to any appeals of these first instance decisions.

Conclusion

Fujifilm v Kodak demonstrates a willingness of the UPC to engage in cross-border enforcement of patent rights in Europe, a natural consequence of the decision by the CJEU in BSH v Electrolux.

Businesses domiciled in a member state of the UPC but doing business in the UK (or other European non-UPC member, such as Spain) should be aware of this decision.

The UPC now appears to have jurisdiction to hear infringement cases regarding the UK validation of a European patent when the defendant is domiciled in a UPC state. Consequently, there is a possibility that litigation in the UPC could lead to injunctive relief impacting the UK market.

Author:

Simon Schofield



Case details at a glance

Decision level: Local Division Mannheim

Parties: FUJIFILM Corporation

(claimant), Kodak GmbH, Kodak

Graphic Communications GmbH and Kodak Holding GmbH (defendants)

Citation: UPC_CFI_365/2023

Date: 18 July 2025

Decision: dycip.com/upc-ord-33199-2025

Sufficiency of antibody claims defined by discontinuous epitopes

T0435/20 & T0326/22

The European Patent Office (EPO) Boards of Appeal have recently issued two contrasting decisions (T0435/20 & T0326/22), examining the relevant factors for the sufficiency of claims directed to antibodies which are defined by discontinuous epitopes.

Since we discussed T0435/20 & T0326/22 in our July European biotech patent case law webinar, these cases have been added to the latest edition of the Case Law of the Boards. This confirms that these cases are highly relevant and will be taken into account by the EPO when considering the sufficiency of such claims.

Background

In contrast to some other jurisdictions, notably the USA, the EPO generally applies a relatively low bar regarding the level of disclosure required for antibody claims. For example, it is established EPO case law that raising and screening monoclonal antibodies involves only routine experimentation.

The EPO Guidelines for Examination explicitly state that an antibody may be claimed by reference to its epitope (the structurally defined part of the antigen that it specifically binds to). However, the application must enable the skilled person to produce further antibodies having the claimed functional property without undue burden.

T 0435/20: claim was not enabled

In T0435/20, the claim at issue defined the antibody by reference to a discontinuous epitope (by reference to non-adjacent regions of the antigen's primary amino acid sequence).

The patent disclosed an example antibody which bound at the claimed discontinuous epitope. However, the patent did not describe in detail how this example antibody was prepared, which specific antigen should be used for the generation of further antibodies, nor any screening methods to reliably identify further antibodies which bound at the claimed discontinuous epitope.

The appeal board held that the skilled person would not be able to arrive at the

The decisions concern product claims for antibodies defined by discontinuous epitopes



claimed antibodies without an undue burden, for the following reasons:

- The patent does not disclose a suitable antigen for obtaining a pool of candidate antibodies.
- Even assuming the skilled person were able to arrive at such a pool, there was no teaching in the patent regarding pre-screening methods to narrow to a sub-pool of candidates.
- Therefore, the skilled person wanting to perform the claimed invention would have to develop an elaborate screening process and there was no guarantee that even a single antibody having the same specificity would be generated.

T 0326/22: claim was enabled

A similar claim was at issue in T0326/22. Significantly, however, in addition to defining the antibody by reference to a discontinuous epitope, the claim also referred to two additional functional features, which related to pre-screening assays which could be used to narrow to a sub-pool of candidate antibodies.

As in the earlier case, the patent disclosed an example antibody which bound at the claimed epitope. However, in contrast to T0435/20, the patent did disclose in detail how the example antibody was prepared and which antigen should be used for the generation of further antibodies. Moreover, the patent disclosed suitable screening assays, which related to the unique epitope bound by the example antibody.

The Board of Appeal held that the patent described a complete process for generating the example antibody and that the skilled person could repeat the same process to arrive at further antibodies without undue burden. Whilst the generation of further antibodies is based

Related webinars: biotech case law



T0435/20 & T0326/22 were discussed in our July 2025 European biotech patent case law webinar, now available on demand: dycip.com/biotech-patent-jul2025

See page 17 of this newsletter for details of our upcoming 18 November 2025 biotech case law webinar.

on chance, the opponents did not provide any evidence that further antibodies could not be generated merely by repeating the examples.

Summary

These contrasting decisions emphasise that product claims directed to antibodies which are defined by discontinuous epitopes are allowable, but that the bar for sufficiency of disclosure is relatively high compared to other types of antibody claims.

The Board of Appeal in T 0326/22 explicitly confirmed that the fact situation differed from T435/20. To enable product claims directed to antibodies which are defined by discontinuous epitopes, it is crucial to disclose in the patent both:

1. a suitable antigen for raising further antibodies; and
2. (appropriate pre-screening assays for selecting antibodies that specifically bind to the claimed discontinuous epitope.

Whilst the inclusion of an example antibody binding to the claimed discontinuous epitope and a description of a competitive-binding assay supported enablement in T0326/22, the Board of Appeal in T 0435/20 did not consider this alone to be enough to enable such claims.

As a patentee, these cases are a reminder to consider whether functional features which correspond to pre-screening assays can be inserted into the claims to strengthen them against sufficiency attacks. As an opponent, these cases confirm that the bar for sufficiency is relatively high for such claims and a variety of attacks can be raised.

Author:
Nathaniel Wand



G 1/25 referral

Is it necessary to amend the description of the European patent?

In G 1/25, questions have been referred to the Enlarged Board of Appeal to clarify whether it is necessary to “adapt” the description to be consistent with claims that have been amended during opposition (or examination) proceedings. “These questions are not only decisive for the current case, they are also fundamental questions of law that affect the practice of the boards and all other departments of the EPO.” (T 0697/22, R21.4).

The need for description amendment

Patents granted by the European Patent Office (EPO) can be opposed by a third party. This may result in the patentee needing to amend the claims to be more limited, in order to overcome an objection and have the patent maintained.

However, there is a chance that such maintained amended claims may then be inconsistent with the description of the patent as originally granted. For example, the description might state that the invention includes embodiments which are no longer within the scope of the maintained amended claims.

Common practice before the EPO is that the description is therefore “adapted”, usually at the end of the opposition proceedings, to be in line with the maintained amended claims.

For much the same reasons, later stages of examination proceedings where the claims have been amended also commonly tend to involve the amendment of the description, to be in line with the allowed claims.

However, some recent Board of Appeal decisions have questioned the legal basis for this practice. This has led to the following questions being referred to the

Enlarged Board of Appeal in G 1/25:

1. If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, is it necessary, to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency?
2. If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?
3. Would the answer to questions 1 and 2 be different if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?

In short

1. Does one need to amend the description to be consistent with amended claims maintained following opposition proceedings?
2. What would be the legal basis for this requirement?
3. Would this be any different during examination proceedings?

Why these questions have arisen now

The questions referred in G 1/25 stem from the Board of Appeal decision T 0697/22, in which amended claims were maintained following opposition proceedings, with a more limited definition of an “organic binder” than the claims as granted.

However, the description in this case included passages indicating that the binder used in the invention was not as limited as the binder recited in the claims maintained by the Opposition Division. As such, there were considered to be inconsistencies between the maintained claims and the description as granted.

The Board of Appeal then discussed in some detail the case law regarding the need to adapt the description, and considered that there are two clearly diverging lines of case law.

- First line: most commonly followed, finding that there is a need to adapt the description. This derives from various sources of legal basis, including Article 84 EPC (clarity, support) or Rule 42 EPC (content of the description), alone or in combination with other legal provisions.
- Second line: recent decisions in examination-appeal proceedings, finding that there is no need to adapt the description, because there is no legal basis for such a requirement. Article 84 EPC and other provisions are rejected for not providing the requisite legal basis.

In addition, the Board of Appeal referred to the UPC Hamburg local division decision AGFA NV v Gucci Sweden AB et al. This decision upheld a patent with a broader description than the maintained claims, but decided that this inconsistent description could not be used to interpret more limited claims.

This appears to be a clear instance of diverging case law, leading to the need to refer these questions to the Enlarged Board of Appeal.

It will be interesting to see whether the Enlarged Board of Appeal in G 1/25 will reinforce the traditional approach that has long determined the general practice before the EPO, or will be sympathetic to the more recent “radical” decisions that question the legal foundations of description amendment.

Author:
Samuel Smith



Three questions concerning description amendments were referred in G 1/25



Claim interpretation

Emerging trends on what “consulting the description/drawings” in G 1/24 may mean

Decisions applying the ruling of G1/24 are now being issued. In this article, we review some of these decisions and highlight the emerging trends which provide useful guidance on consulting the description/drawings for claim interpretation.

Background

The Enlarged Board of Appeal held in G1/24 that the claims are the starting point and the basis for assessing the patentability of an invention and concluded that the description and any drawings must always be consulted to interpret the claims for this assessment and that this requirement is independent of whether the skilled person finds a claim to be unclear or ambiguous when read in isolation (for an in-depth review of G1/24 see our related article “G1/24 practice points: clarity on claim interpretation principles”).

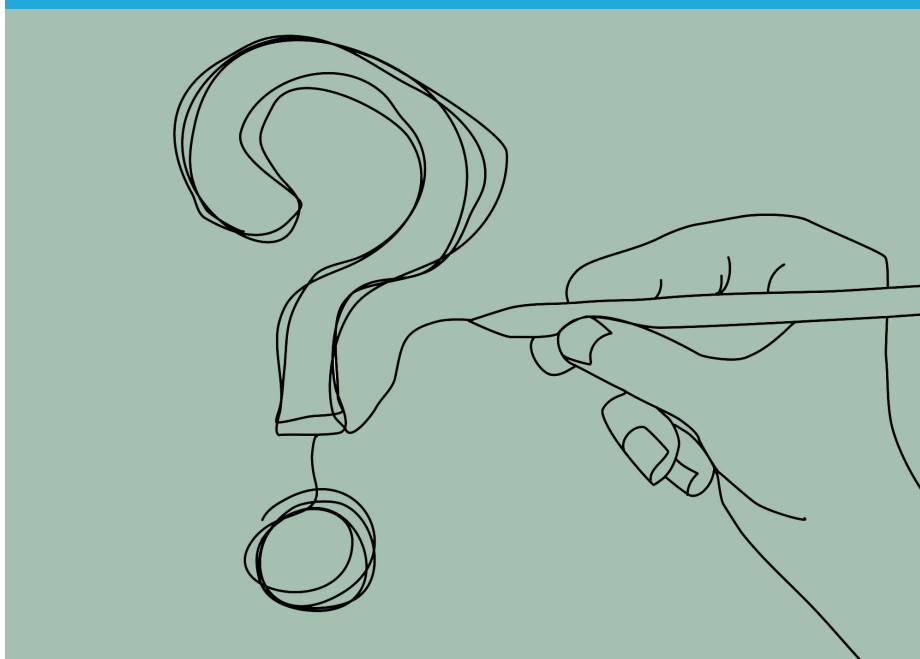
However, there is no specific guidance in G1/24 on how the consultation should be used; this has led to some commentators to assert that the description and drawings can be consulted and disregarded in some circumstances.

Decisions providing some guidance on the ruling in G1/24

The applicant in T1561/23 referred to G1/24 in connection to the disputed interpretations of terms in the claims. Here, the Board of Appeal noted that G1/24 does not define what it means to use the description and drawings in an individual case. In particular, the Board of Appeal highlighted that the requirement from G1/24 to “consult” the description does not even explicitly require that a definition of a term from the description must be used for the interpretation of a claim. The Board of Appeal reasoned, following a consultation of the description and drawings, that in this case it did not justify a narrower interpretation of the wording of the claim.

Citing G1/24, the proprietor in T1069/23 argued that the description and a figure meant that the claim should be interpreted to exclude certain embodiments. The Board of Appeal, however, disagreed and held that there is no reason to deviate from

Should definitions in the description be consistent with terms in the claims?



the wording of the claim and cut down its scope by implying into it additional features which appear only in the description of a specific embodiment. The Board of Appeal went on to explain that this is particularly true given that the broader/unrestricted interpretation of the wording of the claim also makes technical sense and is also encompassed by the description as a whole. The Board of Appeal went on to point out that according to the established case law of the Boards of Appeal, only technically illogical interpretations should be excluded.

In T1999/23 the Board of Appeal noted that G1/24 made it clear that the description is to be used when interpreting claims, but otherwise referred to the principles developed by case law. One of these principles is that a restrictive definition of the term in the description may not be used to limit the subject-matter of the claim, which is otherwise clearly broader to the skilled person (See Case Law of the Boards of Appeal, 10th edition, II.A.6.3.4). The Board of Appeal held that this principle remains valid even after decision G1/24 because the Enlarged Board of Appeal in

G1/24 had emphasised that interpretation begins with and is based on the claims. As a consequence, the Board of Appeal found that the patentee had created ambiguity by the inconsistent use of a term, with the term in the claim being without restriction, and the term in the description with a restriction that is unusual for the subject. The Board of Appeal held that there is no objective reason why a patent proprietor should be allowed to deviate from the established technical terminology in the formulation of the subject-matter, the use of which third parties are to be excluded, without any discernible justification and to refer to this only in the description. The Board of Appeal held that a glance at the description merely reveals that there is a conceptual deviation from the common technical terminology in the description, which is not reflected in the claim. Resolving this ambiguity to the detriment of the party who created it without objective necessity is consistent with the principle of legal certainty and the primacy of the patent claims as affirmed in decision G 1/24. T1465/23 confirms T1999/23 and notes that the disputed terms in this case typically have a stable and well-understood

➤ Related articles

G1/24 practice points:
clarity on claim interpretation principles:
dycip.com/g124-claim-interpretation

Claim interpretation: more clarity on claim construction at the UPC, 12 June 2025:
dycip.com/upc-claims-agfa-insulet

➤ G 1/24 decision

Jurisdiction: EPO
Decision level: Enlarged Board of Appeal
Parties: Philip Morris Products SA (applicant) and Yunnan Tobacco International Co Ltd (opponent)
Citation: G1/24
Date: 18 June 2025
Decision: dycip.com/epo-g1-24

➤ Related Technical Board of Appeal decisions

T1561/23, time monitoring function,
23 June 2025: dycip.com/epo-t1561-23
T1069/23, disposable wearable article,
01 July 2025: dycip.com/epo-t1069-23
T1999/23, photothermal measuring device),
18 July 2025: dycip.com/epo-t1999-23
T1465/23, isolated islands of cryptography,
24 June 2025: dycip.com/epo-t1465-23
T2027/23, turnable ladder, 30 June 2025:
dycip.com/epo-t2027-23

meaning; therefore these terms are not to be re-interpreted or understood in a more limited way in the light of the specific embodiments of the patent description, which, in addition, contain subject matter that is more limited than that claimed.

The Board of Appeal in T2027/23 provides a comprehensive commentary on G1/24. In this case, the patentability of the claims was dependent on whether the claims could be interpreted narrowly in the light of the description. The patentee argued that “consulting” the description and drawings meant the definitions of a claim feature provided in the description and drawing should be read into a claim. The Board of Appeal however, disagreed and went on to identify the following three major takeaways from G1/24:

1. The wording of the claims forms the “basis” for its interpretation and, for the purpose of interpreting the claims, the description and the drawings should always be “consulted” or “referred to”. The Board of Appeal noted that G1/24 is silent as to purpose of the “consultation” or “reference”.
2. Discrepancies in claim interpretation practice between national courts, the Unified Patent Court (UPC) and the Boards of Appeal are undesirable and should thus be avoided.
3. It is up to a patentee to remedy discrepancies between the description and the claims.

The patentee further argued that a feature of the claim must be interpreted in a more limited manner based on features set out in the embodiments of the invention as disclosed in the patent description. The Board of Appeal, however, held that it found no authority for interpreting a claim more narrowly than the wording of the claim as understood by the person skilled in the art would allow for the following reasons:

1. “Consulting the description” does not imply any specific result of such consultation: a

consultation of two conflicting authorities does not a priori determine who is master. Decision G1/24 does not require the Boards of Appeal to give the description preference over the wording of the claim. To the contrary, according to G 1/24, “the claims are the starting point and the basis for assessing the patentability of an invention”. The Board of Appeal added that the claims are the “decisive basis”.

2. Such an interpretation would contradict the well-established jurisprudence of the Boards of Appeal.
3. Such an interpretation would directly contradict the second takeaway from G1/24.

The Board of Appeal concluded that in order to do justice to the second takeaway from G1/24 decision and align the judicial practice of the Boards of Appeal with that of the national courts and the UPC, a claim should not be interpreted, based on features set out in embodiments of an invention, as having a meaning narrower than the wording of the claim as understood by the person skilled in the art. The Board of Appeal further pointed out that in cases of discrepancy between the claim language and the description, it falls upon the patentee to remedy this incongruence by amending the claim and that it is not the task of the Boards of Appeal to reach such alignment by way of interpretative somersaults.

Takeaways & practice points

A common theme of the above decisions is that the parties had tried to use definitions from the description to narrow the meaning of the claims.

The Boards of Appeal in these decisions acknowledge that G1/24 is silent as to the purpose of consulting the description/drawings. Notably, the above decisions highlight that there is no requirement in G1/24 for the Boards of Appeal to give the description preference over the wording of the claim. Further, these Boards of Appeal showed that they were willing to follow existing European Patent Office (EPO) claim interpretation jurisprudence.

Specifically, there is no reason to interpret a claim more narrowly than the wording of the claim as understood by the person skilled in the art would allow, such as by implying into it additional features which only appear in a specific embodiment in the description. In particular, it is highlighted that where there is a discrepancy between the claim language and the description then it is up to the patentee to remedy the situation by amending the claim.

Additionally, the Board of Appeal in T2027/23 confirms that harmonisation on claim interpretation practice between the Boards of Appeal and the national courts and the UPC is desirable. However, some commentators consider that UPC case law is placing a greater emphasis on the description than the case law being developed by the EPO Boards of Appeal; for example, the UPC Court of Appeal in NanoString Technologies Inc v 10x Genomics Inc (UPC_CoA_335/2023) sets out the principle that the description and drawings must always be used as explanatory aids for interpretation, not just to resolve any ambiguities in the claim language, such that only after examination of the description and drawings does the scope of the claims become apparent.

Summary

In these decisions there has been no divergence from existing EPO case law on claim interpretation after G1/24. The decisions discussed re-affirm the need to ensure definitions in the description are consistent with terms in the claims.

It will be interesting to see how this area of EPO case law develops in light of G1/24 and what divergences, if any, from the existing body of EPO case law emerge. In particular, we eagerly await the resolution of the key issue in T0459/22 (the referring decision of G1/24), namely: the impact of a term used in the claim having a broader meaning in the description than the meaning normally assigned to the term.

Author:
Stephanie Wroe



Permissibility of new arguments and facts during proceedings

Comparing EPO and UPC practice

For patentees and opponents alike, the ability to put forward new arguments is a valuable element of any opposition or appeal action at the European Patent Office (EPO), or during infringement and validity proceedings at the Unified Patent Court (UPC).

In this article we will review the statutory requirements for “late filed submissions” before the Opposition Division and Boards of Appeal of the EPO and compare those requirements to recent decisions regarding case amendments in proceedings before the UPC. Namely, the recent orders in *Sunstar Engineering Europe GmbH (Sunstar) v CeraCon GmbH (CeraCon)* (UPC_CFI_745/2024) and *Fingon LLC (Fingon) v Samsung Electronic GmbH and Samsung Electronics France SAS (Samsung)* (UPC_CFI_750/2024).

The permissibility of late-filed submissions before the Opposition Division

Before the Opposition Division, the permissibility of “late-filed submissions” is governed by Article 114(2) and implemented by Rule 116(1) of the European Patent Convention which together permit:

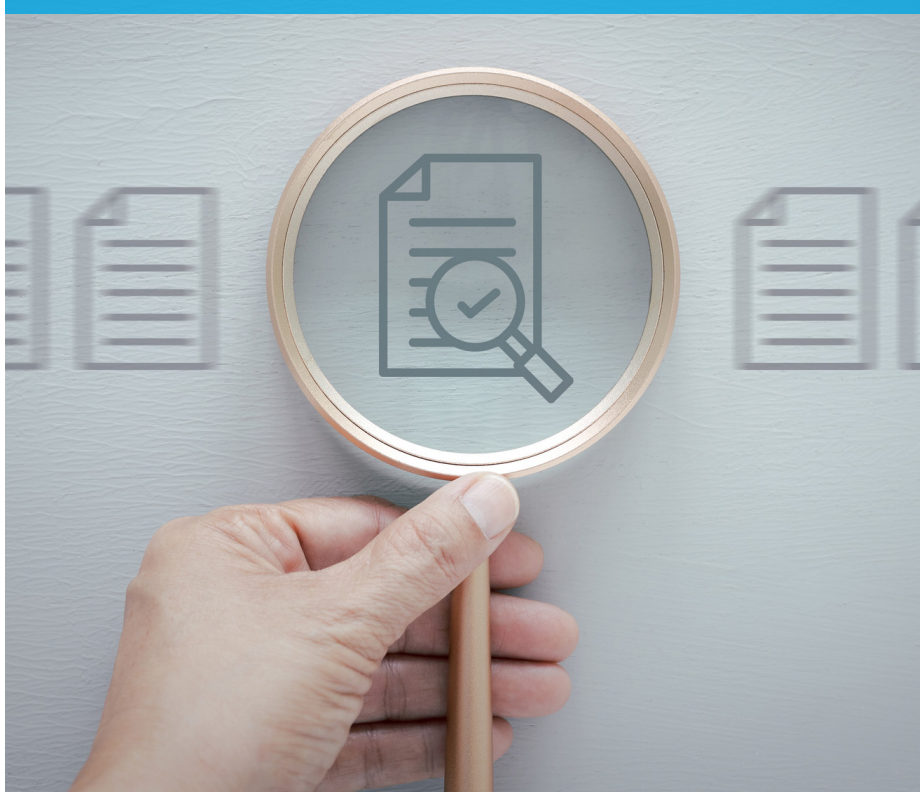
- the EPO to disregard facts or evidence which are not submitted in due time by the parties concerned; and
- new arguments and evidence to be filed up until the date specified in the summons to oral proceedings, and subsequently at the Opposition Division’s discretion.

The permissibility of “late-filed submissions” before the Boards of Appeal

In contrast to the generous provisions governing submissions before the Opposition Division, the Boards of Appeal apply a much stricter approach to the permissibility of “late-filed submissions”, governed by the Rules of Procedure of the Boards of Appeal, which state:

- that the statement of the grounds of appeal must contain the party’s complete appeal case;

Late filed submissions: comparing EPO and UPC practice



- that the Board of Appeal shall not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion, or unless the circumstances of the appeal case justify their admittance; and
- that any amendment may be admitted only at the discretion of the Board of Appeal.

The permissibility of “case amendments” before the UPC

In comparison to the strict requirements before the Board of Appeal, the requirements at the UPC more closely resemble those in proceedings before the Opposition Division, and are governed by Rule 263 of the UPC Rules of Procedure, which state:

1. A party may at any stage of the proceedings apply to the court for leave

to change its claim or to amend its case, including adding a counterclaim. Any such application shall explain why such change or amendment was not included in the original pleading.

2. [...] leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot satisfy the court that: (a) the amendment in question could not have been made with **reasonable diligence** at an earlier stage; and (b) the amendment will not **unreasonably hinder** the other party in the conduct of its action.

The requirements of reasonable diligence and unreasonable hindrance play a key role in the assessment of the orders discussed in this article.

Sunstar Engineering Europe GmbH v CeraCon GmbH (UPC_CFI_745/2024)
In ORD_22156/2025, CeraCon sought to

➤ Related articles

Unified Patent Court: auxiliary claim requests:
dycip.com/upc-auxiliary-requests

➤ Case details at a glance

Decision level: Mannheim Local Division
Order: ORD_25877/2025
Parties: Fingon LLC v Samsung Electronics France SAS and Samsung Electronics GmbH
Date: 05 June 2025
Decision: dycip.com/UPC-ORD-25877-2025

Decision level: Mannheim Local Division
Order: ORD_22156/2025
Parties: Sunstar Engineering Europe GmbH v CeraCon GmbH
Date: 06 June 2025
Decision: dycip.com/UPC-ORD-22156-2025

amend its counterclaim for revocation by introducing a new novelty attack, based upon a new patent document (EP3868480).

CeraCon argued that EP3868480 (nor any of its family members) had been located in its prior art search, which a well-known search service provider had undertaken. Instead, the document and its relevance to the proceedings had only been brought to its attention after filing its counterclaim for revocation; by one of their attorneys reporting on a search unrelated to the counterclaim at hand. CeraCon pointed out that, upon discovering the document, it reanalysed the search strings used in a well-known search software, and obtained EP3868480 as the fifth hit.

CeraCon therefore argued that Rule 263 should be applied generously (if at all) in the present case. In particular, because it had been diligent in carrying out a specialised search and the search should have picked up on EP3868480. Furthermore EP3868480 is a patent application of Sunstar, and was filed by the same attorneys representing Sunstar in the UPC proceedings (and therefore would not unreasonably hinder Sunstar in its rejoinder), and EP3868480 was of *prima facie* relevance.

The court disagreed.

When making its decision the court weighed up the interests of the parties; but considered that the interests of the party in not having to defend itself for the first time in its rejoinder regularly outweighs other considerations. The court also noted that such decisions must take into account all the circumstances of the individual case.

However, the court was clear in its finding that the individual circumstances of the present case did not render the amendment allowable. In particular, it noted that, as demonstrated by CeraCon, EP3868480 should have been found in the initial search, and that the mere fact that EP3868480 was a patent of Sunstar did not mean that formulating a response to its inclusion did not unreasonably hinder Sunstar in its rejoinder.

Fingon LLC v Samsung Electronic GmbH and Samsung Electronics France SAS (UPC_CFI_750/2024)

In ORD_25877/2025, Samsung objected to Fingon's reply in the infringement proceedings, which it argued, based the infringement actions on new facts, without having requested leave to amend the case.

In particular, Samsung argued that Fingon relied on new models (of mobile phone) which only released this year. These were different products than those originally attacked in Fingon's statement; and furthermore that the newly introduced Trusted Applications (a mobile phone application which runs inside a trusted execution environment) also constituted amendment of the case. Samsung argued that these new factual allegations and products required a comprehensive analysis and assessment, thus the requirements of Rule 263 were not met.

The court disagreed.

In laying out its decision, the court noted that not every new argument constitutes an amendment of the case within the scope of Rule 263. Instead, amendment of a case occurs when the nature or scope of the dispute changes (for example, if a new patent document is invoked or a new product is objected to).

Despite pointing out that objection to a new product would normally constitute a change in the nature or scope of a dispute, the court held that the new references by Fingon were to "illustrative examples" of how the attacked embodiment allegedly works, rather than distinct products themselves.

This point particularly rested upon the facts of the case, where infringement was formulated in relation to [a group of] products which implemented infringing functionalities rather than specific infringing products; and neither Fingon nor Samsung argued that the new products differed in the allegedly infringing features. This also appeared to be the deciding factor in the Board of Appeal not allowing Samsung an extension of the time period pursuant to Rule 29 of the Rules

of Procedure, as the specific functionalities referred to in said examples had already been included in Fingon's initial claim, and thus available for counter in Samsung's rejoinder.

Whilst the court did not comment on the point, one could infer that a product not yet having been released prior to the initial case submissions, and therefore being impossible to include, would meet the requirement of reasonable diligence.

Summary

It is clear that the individual circumstances of each case will be a key factor in any permissibility of claim amendments before the UPC.

However, it appears that any party wishing to put forward new arguments will face serious hurdles in overcoming the interests of a party not having to defend itself for the first time in a rejoinder. Practitioners should take note that new attacks based on new documents, no matter how *prima facie* relevant or well known, are unlikely to be allowed if they are considered to unreasonably hinder the opposing party.

Accordingly, as far as possible, a party's complete set of arguments should be contained in its initial case, similar to the need to put all arguments forward before the Board of Appeal.

On the other hand, further evidence of potential infringement, such as the release of a new product by a party, may be allowable depending on the facts of the case, and careful attention should be paid to the formulation of the initial allegation of infringement; in view of any potential upcoming disclosure or product release.

If you are considering initiating a legal action before the UPC or want more information on the potential permissibility of case amendments at the UPC, please contact your usual D Young & Co representative for further information.

Author:
William Hutton



Patent landscape in the agrifood sector

Innovation trends and insights

As the global population rises and climate change impacts how and where we grow food, innovation in agriculture and food production has never been more important. A patent landscape report from the World Intellectual Property Organisation (WIPO) shines a spotlight on innovation trends in the rapidly evolving sector, offering valuable insights for businesses, policymakers and IP professionals.

The report draws on 20 years of patent filing data in the vast agrifood sector, which includes two domains: agritech and foodtech.

- Agritech involves the use of technology, for example, to improve crop yields, optimise water usage, manage livestock, and improve soil health.
- Foodtech involves the use of technology, for example, to develop new and innovate solutions for food production, processing, and delivery.

Between 2004-2024, over 3.5 million agrifood-related inventions were identified. Notably, only around 12% of these (approximately 450,000) were filed internationally, that is, outside the country of first filing. A large proportion of the non-international filings originate from Asia. These findings demonstrate that many patent applicants are more likely to seek protection locally within their home countries, suggesting that many inventions are market specific. Of the 450,000 international patent families, agritech accounts for 66% of inventions and foodtech makes up the remaining 34% of inventions.

International agritech patent filings have grown steadily, with a compound annual growth rate (CAGR) of 6.9% between 2017-2021. While pest/disease management and crop adaptation and genetics lead agritech research, the growing interest in agricultural automation and internet of things (IoT) technologies is driving innovation in areas such as robotics and drones, mapping/imagery, automation and precision agriculture technologies.

International foodtech patent filings have shown slower growth, with a CAGR of 3.3% between 2017-2021. While supply chain leads foodtech research, there has been strong recent growth in the areas of food chemistry and food services. This trend appears to align with the recent surge in innovation in the area of alternative nutrient source for human food.

The report also highlights plant variety protection (PVP), which provides rights to breeders of new, distinct, uniform and stable plant varieties, as another indicator of agricultural innovation. Between 2004-2022, the number of PVP applications and granted titles have more than doubled.

Five innovation hotspots to watch

The report presents in-depth analysis on five highly regarded technology areas shaping the future of food and farming:

1. Soil and fertiliser management

This technology area, which includes solutions aimed at improving soil health and fertility, has seen a moderate CAGR of +5.6% between 2017-2021, indicating a growing interest. North America is a global leader in innovation in this area, followed by Europe. There is growing interest in the areas of autonomous guidance of agricultural machines and Fertiliser formulations.

2. Non-pesticide pest and disease management

Non-pesticide pest and disease management (which include the use of living organisms, compositions that act as repellents, devices (such as traps, sprayers and dispensers) and genetic modifications) has shown consistently strong activity over the last ten years. Formulation technologies dominate the patents in this field, but the use of microorganisms as an alternative to conventional pesticides is growing.

However, this field appears to be mature, with very little growth or emergence of disruptive technology. The absence of disruptive technology is attributed to the high specificity of biocontrol agents against pests or diseases. Interestingly, Asia is emerging as a key player in this field as

Useful links

[WIPO agrifood patent landscape report: dycip.com/wipo-agritech-report](#)

[Agritech innovation: how IP is cultivating the farms of the future: dycip.com/agritech-ip-future](#)

[The engine of precision farming - AI and agritech at the EPO: dycip.com/agritech-ip-ai-epo](#)

[Agritech: farm use exemptions to patent infringement in the UK: dycip.com/agritech-infringement-farming](#)

[Agritech prototyping - the risk of public disclosure: dycip.com/agritech-prototyping-disclosure](#)

activity in the USA and Europe plateaus.

3. Alternative nutrient sources for human food

Driven by growing demand for sustainable and ethical protein sources, this area has seen a rapid rise in innovation between 2019-2021. Key technologies include plant-based alternatives, insect proteins, precision and biomass fermentation, cell-based meat, and molecular farming. Cell-based meat (also known as cultured meat or clean meat) is an area of intense activity, which recorded a remarkable CAGR of +97% from 2017-2021.

4. Predictive models in precision agriculture

Predictive models in precision agriculture (which includes the use of artificial intelligence (AI) and software development) have shown exceptional recent growth, with a CAGR of +27.1% between 2017-2021. There has been growing use of predictive models to improve soil management, plant culture and animal husbandry.

5. Autonomous devices in precision agriculture

The use of autonomous machinery and robotics in precision agriculture is showing growing interest as it leads to increased efficiency of crop planting, management, irrigation, harvesting and yield and a reduction in manual labour.

Final thoughts

WIPO's report shines a light on emerging technology trends in the agrifood sector. Population growth, climate change and dietary shifts are putting increasing pressure on global food security, and this is driving innovation in this sector. The report also highlights that fifteen of the seventeen UN sustainable development goals (including improved standards of living, equality and good health) may be improved by growth in this sector. Ongoing investment, international collaboration, supportive patent systems and effective regional and international policies are essential in achieving these goals and supporting a more sustainable future.

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Peter Quinn



Related guide: [UPC opt-out FAQs](#)

Our recently updated and detailed guide to the opt-out can be found on our website: dycip.com/upc-opt-out-faqs

Temporal limitations of the Unified Patent Court

XSYS v Esko

The Unified Patent Court (UPC) Court of Appeal has answered questions relating to its jurisdiction before entry into force of the Agreement on a Unified Patent Court (UPCA) and after an opt-out but before withdrawal of the opt-out.

Background

Esko-Graphics Imaging GmbH (Esko) is the proprietor of European patent 3742231 which granted on 30 June 2021. On 12 May 2023, the patent was opted-out of the jurisdiction of the UPC. On 26 August 2024, Esko withdrew the opt-out.

Court of first instance, Munich Local Division

Esko brought an action for infringement of the patent against XSYS the day after the opt-out withdrawal at the Munich Local Division in relation to acts which were alleged to have taken place:

- Before and after the entry into force of the UPCA on 01 June 2023; and
- Before and after the withdrawal of the opt-out of the patent in dispute.

XSYS responded with a preliminary objection raising that the UPC has no competence to decide on infringement acts:

- Before entry into force of the UPCA; and
- Between the date of entry into force of the agreement and the date of withdrawal of the opt-out.

The court rejected the preliminary objection and granted leave to appeal, finding that:

- The UPC has jurisdiction over the action without temporal limitation;
- Esko could decide to bring the action for infringement before the UPC since, following the withdrawal of the opt-out, there was again a concurrent jurisdiction between the national court and the UPC; and
- The UPC has competence over the entire period asserted in the action, and that said competence is without prejudice to the determination of the applicable law to acts that have taken place before entry into force of the UPCA or before withdrawal of the opt out.

Court of Appeal, Luxembourg

XSYS brought an appeal against the order by the court of first instance. XSYS raised a variety of arguments in their grounds of appeal. Specifically, it objected that the UPCA does not have retroactive effect pursuant to the general principle of non-retroactivity of treaties and the Vienna Convention on the Law of Treaties. It also referred to the North American Free Trade Agreement (NAFTA), according to which arbitral tribunals have consistently declared themselves to have competence only over events that occurred after the entry into force of the NAFTA. The appellant also made reference to the Protocol of the UPCA and asserted that the UPC lacks competence for the duration of the opt-out until its withdrawal.

Esko responded to this appeal, rebutting the submissions and arguing that the court did have competence for infringing acts committed prior to the entry into force of the UPCA and for the time period between the opt-out and its withdrawal. It argued that the Vienna Convention addresses issues of substantive law and does not extend to procedural rules.

The court found the preliminary objection to be admissible but found it to be unfounded and therefore dismissed it. They found that the wording of Article 32(1) UPCA does not provide for any temporal limitation of the exclusive competence of the court concerning the acts of alleged infringements. Furthermore, it stated that the absence of any temporal limitation reflects the object and purpose of the agreement which is to create a common court in order to prevent the difficulties caused by a fragmented market for patents in Europe and the variations between national court systems. The court also found that after withdrawal of an opt-out, the patent is entirely under the exclusive competence of the UPC without any limitation, and that therefore the court is competent to decide on alleged acts of infringement which have occurred during the time period between the effective date of the opt-out and that of the withdrawal.

Key takeaways

Following this case, the UPC Court of Appeal has made it clear that the UPC's jurisdiction includes acts of infringement occurring before the UPCA came into effect as long as the allegedly infringed patent is within the UPC's competence at the time of an action before the UPC. Additionally, the court confirmed that the withdrawal of an opt-out restores competence of the UPC. This avoids fragmentation and aids the creation of a harmonised system which is a goal of the UPCA.

This case provides certainty to patentees looking to enforce a patent using the UPC if they have previously opted out their patent and subsequently withdrawn the opt-out.

Author:
Alice Stuart-Grumbar



The UPC's jurisdiction includes infringement occurring before the UPCA came into effect

UPC procedural case law

Stays of proceedings

As part of our ongoing series discussing the burgeoning procedural case law of the Unified Patent Court (UPC), we take a look at stays of proceedings. How are they being used, when might they be granted, and are there any alternatives?

What is a stay of proceedings?

A stay of proceedings is a well-established legal tool that allows a judicial body to pause the process under certain circumstances, such as pending a related decision from a higher or parallel judicial body.

It is relatively uncommon for the Boards of Appeal or Divisions of the European Patent Office (EPO) to stay proceedings, although this can occur in rare cases, for example where there are ongoing entitlement proceedings in a contracting state or in view of a referral pending before the Enlarged Board of Appeal.

At the UPC, stays of proceedings are governed by Rule 295 of the Rules of Procedure (RoP). This provision allows the court to stay the proceedings relating to a patent or supplementary protection certificate (SPC) that is also subject to ongoing proceedings before the EPO or a national court, or where an appeal against the decision of a Court of First Instance (one of the Local or Central Divisions) is brought before the UPC Court of Appeal.

The UPC is generally reluctant to allow stays of proceedings

Broadly speaking, the UPC is keen to avoid stays of proceedings wherever possible.

For example, in *NanoString v Harvard* (ORD_598480/2023), Harvard requested a stay of proceedings, primarily in view of then-ongoing revocation proceedings against the German part of the patent in question. Although Harvard later withdrew its request, the Munich Central Division held that it would not exercise its discretionary power to stay proceedings anyway. In the Order, the Court noted that the proceedings were already at an incredibly advanced

Case details at a glance

Decision level: Munich Central Division

Citation: ORD_598480/2023

Parties: NanoString Technologies

Europe Limited v President and Fellows of Harvard College

Date: 17 October 2024

Decision: dycip.com/UPC-ORD-598480-2023

Decision level: Hamburg Local Division

Citation: ORD_28786/2024

Parties: F Hoffman-La Roche AG

v Tandem Diabetes Care (Inc and Europe BV) and VitalAire GmbH

Date: 09 September 2024

Decision: dycip.com/UPC-ORD-28786-2024

stage, with the oral hearings having been concluded, meaning that the “procedural economical benefits” of a stay were limited. The Court also observed that staying the UPC proceedings would deprive the parties of a decision within a reasonable time frame in respect of the national parts of the Patent that were still in force but not already the subject of national revocation proceedings.

Furthermore, in *Roche v Tandem* (ORD_28786/2024), the Hamburg Local Division held that the possibility that the UPC and EPO reach conflicting decisions in respect of the same patent is not enough to justify a stay of proceedings. In the Order, the Court held that revocation in either venue would prevail, and that conflicting decisions were therefore “not irreconcilable” and did not justify a stay of proceedings.

In fact, the Hamburg Local Division was keen to emphasise that the UPC’s default position should be against the grant of a stay since this would impede the UPC’s objective of ensuring that a final oral hearing takes place within a year of the onset of proceedings. The Court also highlighted that case management can be used to avoid the need for a stay, and that harmonisation between the EPO and UPC is best served by “ensuring that the body that decides last can take the decision of the body that decides first into account”.

The UPC is amenable to stays under certain circumstances, especially where all parties are in agreement

Notwithstanding the above, the UPC will grant a stay of proceedings in some instances.

For example, in the recent *Juul v NJOY* Court of Appeal decision (UPC_CoA_5/2025), the UPC was more amenable to a stay. In that case, Juul requested a stay in view of parallel proceedings before the EPO’s Boards of Appeal, and NJOY agreed. The Court considered that a rapid decision could be expected from the parallel proceedings, and that there were no concurrent infringement proceedings that would balance against a

Decision level: Court of Appeal

Citation: UPC_CoA_5_2025

Parties: Juul Labs International

Inc v NJOY Netherlands BV

Date: 30 April 2025

Decision: dycip.com/UPC-CoA-5-2025

Decision level: Milan Local Division

Citation: ORD_26013/2025

Parties: Dainese SpA v Alpinestars (SpA and Research SpA) and Motocard Bike Srl

Date: 02 June 2025

Decision: dycip.com/UPC-ORD-26013-2025

stay. The fact that Juul had requested the stay despite having a “primary interest” in a swift decision by the UPC Court of Appeal was also noted in the decision.

The agreement of parties is particularly powerful in convincing the UPC to grant a stay of proceedings, as demonstrated by the Milan Local Division in *Dainese v Alpinestars* (ORD_26013/2025). In that case, the Milan Local Division took a strong view, noting that the Court has no discretion over a stay of proceedings where both parties request it, especially where there are no parallel proceedings to balance against a stay. The Court acknowledged that this lack of discretion is despite the fact that Rule 295 RoP notes that the Court “may” grant the stay.

Other examples of cases where a stay of proceedings was allowed in view of unanimous agreement between parties include *Esko v XSYS* (ORD_28661/2025) and *Amgen v Sanofi-Aventis* (ORD_43914/2024), both at the Munich Local Division.

Instances of the UPC allowing a stay of proceedings despite disagreement between parties are rare, but do exist. For example, in *Sanofi & Regeneron v Amgen* (UPC_CFI_195/2025), the Düsseldorf Local Division granted a stay of the infringement proceedings at the request of Sanofi and Regeneron. The Court also decided to stay the counterclaim for revocation in view of a pending case at the UPC Court of Appeal concerning the parent patent, citing a high degree of similarity in at least the infringement cases. The Court also noted that it is “reasonable and fair that the Claimants [Sanofi and Regeneron] have a chance to present new legal arguments” should the parent patent be revoked on appeal, while Amgen would “have the stage of first instance to demonstrate why this case should be approached differently” to the parent appeal case should that decision go against them.

The UPC prefers flexible solutions

Instead of allowing stays, the UPC

Case details at a glance

Decision level: Munich Local Division

Citation: ORD_28661/2025

Parties: Esko-Graphics Imaging GmbH v XSYS (Germany GmbH, Prepress NV and Italia Srl)

Date: 16 June 2025

Decision: dycip.com/UPC-ORD-28661-2025

Decision level: Munich Local Division

Citation: ORD_43914/2024

Parties: Amgen Inc v Sanofi-Aventis (Deutschland GmbH and Groupe SA), Sanofi Winthrop Industrie SA and Regeneron Pharmaceuticals Inc

Date: 29 July 2024

Decision: dycip.com/UPC-ORD-43914-2024

Decision level: Düsseldorf Local Division

Citation: UPC_CFI_195/2025

Parties: Sanofi Biotechnologies SAS and Regeneron Pharmaceuticals Inc v Amgen (Inc, Europe BV, NV, GmbH, BV, SAS and SRL)

Date: 06 August 2025

Decision: dycip.com/UPC-CFI-195-2025

Decision level: Milan Local Division

Citation: UPC-CFI-472-2024

Parties: Dainese SpA v Alpinestars (SpA and Research SpA), Omnia Retail Srl, Horizon Moto 95, Zund.Stoff Ausburg and Motocard Bike Srl

Date: 15 January 2025

Decision (PDF): dycip.com/UPC-CFI-472-2024

Decision level: Munich Local Division

Citation: UPC_CFI_425/2024

Parties: JinAo Solar Co Ltd v Chint New Energy Technology Co Ltd and Astroenergy (Europe GmbH, GmbH, Solarmodule GmbH, Solar Netherlands BV) and Chint Solar Netherlands BV

Date: 31 March 2025

Decision: dycip.com/UPC-CFI-425-2024

Decision level: Düsseldorf Local Division

Citation: UPC_CFI_499/2023

Parties: Dexcom Inc v Abbot

Date: 20 November 2024

Decision: dycip.com/UPC-CFI-499-2023

Stays of proceedings allow a judicial body to pause the process in certain circumstances



the deadline to file a rejoinder to the counterclaim for revocation, despite Abbott's objections. Interestingly, the court saw the extension as "justified on the grounds of fairness and equity" since a prior deadline for Abbott had also been extended with the consent of DexCom.

Conclusions

In summary, although the UPC is keen to harmonise its proceedings with those at the EPO, it appears that the UPC will only use a stay of proceedings under very limited circumstances.

It seems that a lengthier stay of proceedings is generally considered by the courts to be at odds with the UPC's aim of maintaining procedural economy and efficiency. Thus, the UPC tends to prefer more flexible and expedient solutions, such as short extensions of time.

The cases discussed also serve as a reminder of the benefits of maintaining a degree of communication with the opposing party in proceedings. In many instances, the UPC has been keen to highlight the power of case management in aligning the parties' interests regarding deadlines and procedural matters. This is evident from the UPC's willingness to grant stays and extensions where both parties are in agreement.

It is clear that, as the procedural landscape of the UPC continues to unfold, the interplay with parallel proceedings at the EPO will be an increasingly important practical and strategic consideration for practitioners and parties involved in disputes spanning the two jurisdictions.

The UPC is not allowing parallel proceedings before the EPO to impede its aim of reaching rapid decisions. Therefore, a party to such parallel proceedings should aim to maintain a degree of flexibility in its strategies wherever possible to account for the relatively short deadlines that can be set by the UPC.

Authors:

Corey Chapman and Rebecca Price



is tending towards a more pragmatic approach to harmonise cases with ongoing parallel proceedings, which is in keeping with the UPC's keen focus on procedural economy and efficiency.

Returning to Dainese v Alpinestars, the Milan Local Division (in earlier decision ORD_1495/2025) granted a two-week extension to Dainese's deadline for filing the defence to counterclaims for revocation and the reply to the statements of defence. This was in view of the oral hearing in appeal proceedings at the EPO concerning the same patent being scheduled for the same day. In the order, the court noted that the short extension provided a "flexible solution", avoiding the need for an official stay of proceedings, facilitating "more overall procedural efficiency" and allowing

the court to account for the decision of the Board of Appeal of the EPO.

In a further example of the UPC using extensions to align with proceedings at the EPO, the Munich Local Division in JinAo v Chint (UPC_CFI_425/2024) ruled that JinAo was entitled to introduce into UPC proceedings a dependent claim amended during opposition proceedings at the EPO. In view of this, Chint was granted an extension to the deadline to file a rejoinder, allowing it to react to this change.

Finally, while not related to ongoing EPO proceedings, a further example of the UPC's pragmatic approach can be found in DexCom v Abbott (UPC_CFI_499/2023). Here, the Düsseldorf Local Division granted DexCom's request for an extension to

Hot topics, cool solutions

Patenting air conditioning technology at the EPO

There is a rising demand for air conditioning across Europe, driven by a change in the climate: extreme heat is now more likely to be experienced in Europe than ever before. An increasing number of people are now relying on air conditioning to ensure a comfortable environment at home and in the workplace.

Paradoxically, air conditioning is often viewed as one of the key contributors to climate change, since running air conditioning units can require a large amount of electricity.

Accordingly, there is a need for further development of air conditioning technology. Patents play a critical role in this regard, as they protect investment and encourage further innovation.

In this article we take a look at some of the different ways in which improvements in the efficiency of air conditioning can be achieved. Furthermore, we consider the extent to which these improvements can be protected with patents at the European Patent Office (EPO), offering protection for inventions across European markets.

Areas of development

Air conditioning technology has come a long way since its inception. Traditionally, air conditioning has been achieved through **non-inverter technology**. With non-inverter technology, the compressor operates at a constant speed. The compressor is then switched on and off in a cycle in order to regulate the temperature. However, modern air conditioning units often use **inverter technology**. With inverter technology, the speed of the compressor motor can be controlled (as opposed to merely being

switched on and off) which enables a continuous regulation of the temperature.

Inverter air conditioning technology provides significant efficiency improvements over non-inverter technology. However, even with inverter air conditioning technology, there is still scope for further improvements in efficiency. In particular, there is interest in providing more precise control of the speed of the compressor motor to further increase the efficiency of the air conditioning unit. Furthermore, there is interest in linking the air conditioning unit to the wider Internet of Things, enabling enhanced control of the air conditioning unit and more efficient energy consumption.

The refrigerants which are used by the air conditioning units are also a focus of potential innovation. For example, there is interest in developing more environmentally friendly and efficient refrigerants to those refrigerants which are traditionally used in air conditioning units (such as R-410A). Indeed, some of these changes are being driven by government regulation.

In the remainder of this article, we will focus on the first two of these areas of innovation (precise control of the speed of the compressor motor and integration of air conditioning units with the Internet of Things).

Patentability at the EPO

To successfully patent inventions at the EPO an applicant must demonstrate that their invention is both novel and involves an inventive step.

The requirement for an invention to be novel means that the invention must be different than what has been previously disclosed in the prior art. In an area of technology such as air conditioning (an active area of innovation) there can be a significant amount of prior art cited against an invention. However, a single point of difference is sufficient to demonstrate novelty over the prior art. Many inventions are based on incremental improvements on previous technology.

Therefore, a new way of controlling the speed of the compressor motor would

likely be sufficient to demonstrate novelty of the invention (even though control of the speed of the compressor motor itself may be known from the prior art). Likewise, a new way of controlling an air conditioning unit by connection, through the internet, to environmental sensors or by connection to an application stored on a user device (such as a smart phone) may also be sufficient to demonstrate novelty of the invention.

On the other hand, inventive step at the EPO is a question of whether the invention would be obvious for the skilled person in view of the prior art. At the EPO, inventive step is assessed through the so-called problem-solution approach. An examiner will assess whether the novel features of an invention provide a technical effect (and thus solve a technical problem). If the novel features solve a technical problem, the examiner will then assess whether the solution to this technical problem would be obvious for the person skilled in the art (for example, an invention may be considered to lack an inventive step if a prior art document teaches these novel features as a solution to the problem). Accordingly, the technical problem being addressed by an invention is very important during assessment of inventive step at the EPO.

For an air conditioning invention, a technical problem may be a problem such as how to improve the efficiency of the air conditioning unit. If a new way of controlling an air conditioning unit through a connection to the Internet of Things improved the efficiency of the air conditioning unit during operation, it may be possible to demonstrate an inventive step. However, if the new way of controlling the air conditioning unit did not provide such an improvement over the prior art, it may be very difficult to demonstrate an inventive step.

Of course, the technical problem being solved is not limited to improvements in efficiency of operation of the air conditioning unit. Other technical problems which could be addressed may include ways of reducing the size or form factor of an air conditioning unit, ways of reducing the noise generated by an air conditioning unit, or ways of improving the

Infringement proceedings

Conflicting EPO & UPC outcomes

reliability of the air conditioning unit. These are all examples of technical problems which may contribute to inventive step at the EPO.

On the other hand, advantages such as aesthetic improvements in the appearance of the air conditioning unit or certain types of improvements to a user interface for controlling the air conditioning unit may not necessarily be considered to provide a technical effect solving a technical problem which can contribute to inventive step at the EPO.

Therefore, when drafting a patent application to protect an invention, it is crucially important to focus on the technical problem which is being solved by the invention to increase the chances of that invention being favourably considered by the examiner during the assessment of inventive step. The application should be drafted in such a way to clearly explain how the technical features of the invention address the underlying problem which is being solved.

Final thoughts

Climate change is set to make European markets increasingly important for air conditioning technology. Regulatory pressure will likely drive innovation, as governments introduce restrictions on the energy efficiency of devices in order to comply with climate goals.

Market leaders will therefore want to continue to protect their commercial interests in Europe, and patents can play a key role in achieving this. When drafting a patent application, a key focus must remain on the technical problem being solved by the invention: does it provide more advanced cooling or further improvements in energy efficiency, for example?

Ultimately, as demand for efficient and sustainable cooling grows, the role of patents at the EPO remains central, not only in protecting innovation but also in helping to shape a cooler, more sustainable future, for homes, workplaces and beyond.

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www.dyoung.com/newsletters

On 21 July 2025 the UPC released its decision (ORD_598566/2023) on the long-running Edwards Lifesciences Corporation v Meril Life Sciences Pvt Ltd infringement proceedings. The decision, handed down by the Nordic-Baltic Regional Division of the UPC, brings this case one step closer to a conclusion, whilst also raising further questions regarding the interplay between the EPO and the UPC.

In this article, we discuss the outcome of the proceedings, in particular the implications of conflicting outcomes from concurrent EPO and UPC proceedings.

Background

Edwards Lifesciences Corporation specialise in artificial heart valves. Edwards produce the SAPIEN family of transcatheter heart valves (THVs) as well as catheter systems for their implantation. Catheter systems allow heart valves to be implanted through minimally invasive procedures, removing the need for open heart surgery. Edwards is the proprietor on a number of patents relating to the implantation of transcatheter aortic valves including **EP3769722**, which is the subject of these proceedings.

Meril Life Sciences PCT limited is based in India with a European subsidiary, Meril GmbH, which is based in Germany. Meril also produce a transcatheter heart valve which uses a balloon catheter delivery system marketed as the **Navigator THV delivery system**.

Edwards' SAPIEN THV was the only balloon expandable THV on the market until Meril released its Myval system.

Meril initially distributed the Myval system across Europe. However, cease and desists and/or injunctions (for example, UPC_CFI_501/2023) limited its sale to only a few countries.

On 27 October 2023 Edwards initiated an action for infringement against Meril Life Sciences PCT and Meril GmbH claiming it infringed EP3769722 by placing the Navigator system on the market in UPC member states including Estonia and Lithuania. Edwards also initiated an action of infringement against SMIS International OÜ, Sormedica, Interlux and VAB-Logistik UAB who were Meril's distributors in Lithuania and Estonia.

Meril denied infringing EP3769722 and counterclaimed for revocation. The panel decided to hear the action for infringement and the counterclaim for revocation together.

Opposition proceedings at the EPO were ongoing when the UPC actions were initiated. The oral hearing before the UPC was scheduled for 16 January 2025, one day before the EPO oral proceedings, which were scheduled for 17 January 2025. Given the proximity of the two hearings, a petition to stay the UPC proceedings was raised but subsequently denied. The UPC requested the parties to inform the court of the outcome of the EPO's oral proceedings.

CONTINUED OVERLEAF (PAGE 16)

Edwards Lifesciences v Meril Life Sciences concerns patents relating to heart valves





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During the EPO oral proceedings, the Opposition Division found the claims of EP3769722 as granted to be unallowable on the grounds of added subject matter. **The patent was eventually upheld** on the grounds of auxiliary request AR1'. AR1' comprised an amended claim 1 as well as the deletion of dependent claims 7 and 9 to 11.

Revocation proceedings

The auxiliary request which the patent was upheld on during the EPO oral proceedings was **not** submitted in the UPC proceedings. During the written proceedings, Edwards submitted 22 auxiliary requests, along with a detailed explanation as to the order in which to move through the requests. During the UPC oral proceedings, Edwards argued that if the court agreed with the EPO Opposition Division then it could uphold the patent on the grounds of auxiliary request 1 with further amendments to delete claims 7 and 9 to 11, to bring the claims in line with the claim set deemed allowable during the EPO opposition proceedings. These specific amendments did not align with any auxiliary request submitted during the UPC proceedings.

Meril argued that it should move through the requests in order. The court stated Edwards had made it clear how to proceed through the auxiliary requests and denied Edwards' petition.

Initially, in line with the EPO, the court ruled that claim 1 and multiple dependent claims added subject matter. However, the court upheld the patent on the grounds of AR1' which contained the same amended claim 1 as the allowable EPO auxiliary request, but with **all** dependent claims deleted.

Conflicting outcomes

It is currently unknown how the conflicting outcomes of the UPC and EPO opposition proceedings will affect the scope of EP3769722. Appeal proceedings at the EPO are currently ongoing, therefore there is still a chance the claims will end up aligned.

It is clear the claims deemed allowable by the EPO will be in-effect in EPO member states which are not UPCA signatories (UK, Spain, Switzerland, Poland, and so on). It is not

clear which decision will take precedence in UPC member states. The UPC has stated in *Carrier v Blitzer* (ORD_25123/2024) that if one body upholds a patent and the other revokes, then the revocation will take precedence.

No case law currently exists relating to patents upheld on differing claim sets, however there are other ongoing proceedings with the same issue. One example is *NJOY Netherlands BV v VMR Products LLC*. The patent in question, EP3613453, was maintained with differing claims in concurrent UPC and EPO opposition proceedings. The EPO decision has been appealed, with oral proceedings scheduled for 11 November 2025.

Infringement proceedings

The infringement proceedings centred on the first section of the one remaining claim of EP3769722, which reads as follows: "An apparatus for indicating the flex of a distal end of a catheter comprising an elongated shaft (152); at least one pull wire (174) connected to a distal end portion (188) of the elongated shaft (152); a handle portion (158) comprising a flex activating member (154), activating member (154) being coupled to the at least one pull wire (174) such that adjustment of the flex activating member (154) causes the distal end portion (188) of the elongated shaft (152) to flex; [...]"

During the revocation proceedings, the parties argued over the term "elongated shaft". Meril argued the "elongated shaft" must be understood to belong to the guide catheter, which is to be distinguished from the balloon catheter.

Meril further argued during the infringement proceedings that the Navigator does not infringe EP3769722 as it consists solely of a single balloon catheter, without a guide catheter. The single catheter consists of an inner and outer shaft, and where the valve is crimped directly onto the balloon.

Edwards argued that the elongated shaft does not necessarily belong to the guide catheter and that Meril was simply quoting an exemplary embodiment.

The court ruled that it is clear to the skilled

Case details at a glance

Decision level: Nordic-Baltic Regional Division

Citation: ORD_598566/2023

Parties: Edwards Lifesciences Corporation v Meril Life Sciences PVT Limited, VAB-Logistik, UAB, SMIS International OÜ, Meril GMBH, Sormedica, Interlux

Date: 21 July 2025

Decision: dycip.com/UPC-ORD-598566-2023

person in the art that the elongated shaft comprised in the apparatus for indicating flex of a distal end of a catheter as claimed can be, but is by no means mandatorily a guide shaft of a guide catheter.

Edwards replied stating that although the Navigator system comprises a single catheter with two shafts, the distal end of the outer shaft is in direct communication with the device's balloon. Edwards argued this feature constitutes an "elongated shaft".

The court found the Navigator system infringes claim 1 of EP3769722.

The court concluded that claim 1 covers both a guide catheter and a balloon catheter, and balloon catheters that do not comprise a guide catheter. The court also found the Navigator comprises an elongated (balloon catheter) shaft that is comprised of an outer and an inner elongated shaft, as found in amended claim 1 of EP3769722.

The court ordered the recall and destruction of all infringing products placed on the market in the relevant member states. The court further ruled that information on the distribution channels of the infringing articles be provided to Edwards. Edwards was awarded an interim award of €500,000, with the total amount of damages to be decided in a separate proceedings. Edwards was also awarded 100% of its costs for the infringement action and 75% of the costs for the counter claim for revocation.

Conclusions

This decision by the UPC brings us one step closer to the conclusion of this long-running case. However, appeal proceedings at the EPO are still ongoing with oral proceedings set for 03 March 2026.

We will continue to keep our eye on future developments in this case, to see how conflicting outcomes between the EPO and UPC are resolved. If you are seeking any advice with respect to infringement at the UPC, please contact your usual D Young & Co representative for further information.

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UPC Case Law, Observations & Analysis Wednesday 10 December 2025

Our ongoing series of webinars, dedicated to analysing the Unified Patent Court's decisions continues in December. Expert speakers, UPC representatives David Al-Khalil, Rachel Bateman and Laura Jennings, will present their most up to date UPC observations and analysis. Early booking is advised to secure your webinar seat: dycip.com/webinar-upc-dec2025

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