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Louis-Pierre Gravelle

Dipchand LLP, Canada

Deputy Secretary General

Study & Work Committee

Session 3:
Global Hot Topics

A series of rapid-fire presentations on global hot topics – including the UPC.

Dr. MaryAnne Armstrong

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Reporter, Group 3

International Patents

Study & Work Committee

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Hot topics from the U.S.

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Background: Practicing since 1995, in the fields of pharmaceuticals, biotechnology, chemistry, and plant patents. Treasurer of FICPI-US and Reporter for the FICPI CET-3 group, Chair of AIPPI-US, AIPPI Pharma Standing Committee, American Chemical Society Fellow

Patent – Hikma Pharmaceuticals v. Amarin (Skinny label) (SCOTUS – arguments April 29, 2026

- Amarin markets a branded drug for two indications, but only one indication patented
- Hikma applied for FDA approval for non-patented indication only, i.e. skinny label
- Amarin sued Hikma for induced infringement based on comments made by Hikma, including
  - referring to the Hikma product as a “generic version” of the Amarin drug without indicating that the approval was only for one indication
  - A press release referring to total sales, not solely sales tied to certain indications
  - Website posting stating a therapeutic equivalence to the Amarin product for a “therapeutic category” broader than Hikma’s approved indication.

- The Court of Appeals for the Federal Circuit found Hikma liable for inducing infringement.
- Hikma's argued in their petition for certiorari to the U.S. Supreme Court that liability for inducing infringement requires *active* encouragement of infringement. Hikma further argued that their statements that never mention the patented indication and describe the product in general terms, which cannot considered to induce infringement.
- Questions under review:

1) When a generic drug label fully carves out a patented use, are allegations that the generic drugmaker calls its product a "generic version" and cites public information about the branded drug (e.g., sales) enough to plead induced infringement of the patented use?

2) Does a complaint state a claim for induced infringement of a patented method if it does not allege any instruction or other statement by the defendant that encourages, or even mentions, the patented use?

Design patents - *LKQ Corp. GM Global Tech. Ops. v. LLC*, 102 F.4th 1280 (Fed. Cir. 2024, *en banc*)

- Overturned the *Rosen-Durling* test for obviousness of design patents
- *Rosen-Durling* - obviousness required (1) a primary reference that was "basically the same" as the patent in question, and (2) prior art that was "so related" to the primary reference that the appearance of certain ornamental features in one would suggest the application of those features to the other.
- held that Supreme Court precedent dictates that a more flexible test than *Rosen-Durling* now applies to design patent obviousness.
- four *Graham* factors should apply to the design patent obviousness analysis: 1) the scope and content of the prior art, 2) the differences between the prior art and the claimed invention, 3) the level of ordinary skill in the art, and 4) any secondary considerations of non-obviousness.

Copyright - *Cox Communications v. Sony Music* (U.S. Supreme Court – Arguments Dec. 5, 2025)

- Cox Communication - internet service provider selling internet, telephone, and cable television in the US. Between 2013-2014, Cox's internet subscribers used peer-to-peer file-sharing networks, to download and distribute copyrighted songs. MarkMonitor was hired by music industry to monitor illegal file sharing and notify internet service providers when infringement was detected. MarkMonitor sent Cox over 163,000 notices of infringement. In response, Cox operated a "thirteen-strike" policy, under which it warned or temporarily suspended subscribers after repeated notices, but in practice it rarely terminated service for copyright infringement.

- Can an internet service provider be held liable, and found to have acted willfully, for copyright infringement just because it knew users were infringing and did not terminate their access?

SCOTUS decision (March 25, 2026)

Contributory liability requires that a provider intended its service to be used for infringement.

- Intent can be shown in two ways. 1) it may be shown that a party affirmatively induced the infringement. 2) it may be shown that the party sold a service tailored to infringement.

Held: The provider of a service is contributorily liable for a user's infringement only if it intended that the provided service be used for infringement, which can be shown only if the party induced the infringement or the provided service is tailored to that infringement; Cox neither induced its users' infringement nor provided a service tailored to infringement; accordingly, Cox is not contributorily liable for the infringement of Sony's copyrights.

The Court distinguished from *Grokster,* where the software was designed specifically for the infringing activity.

Current proposed statutory changes to U.S. laws

Patent Eligibility Restoration Act of 2025 ("PERA") – reintroduced May 2025

- clarify which inventions are eligible for patent protection under 35 U.S.C. § 101 by defining statutory exceptions to patentable subject matter and eliminating any judicially-created exceptions.
  - A mathematical formula that is not part of an invention in one of the following categories: process, machine, manufacture, or composition of matter;
  - A mental process performed solely in the mind of a human being;
  - An unmodified gene, as the gene exists in the human body;
  - An unmodified natural material, as that material exists in nature; and
  - A process that is substantially economic, financial, business, social, cultural, or artistic.

  Courts would be prohibited from creating new judicial exceptions to patent eligibility beyond those expressly defined in the statute

The Promoting and Respecting Economically Vital American Innovation Leadership Act (the "PREVAIL Act") - reintroduced May 2025

limits simultaneous challenges in PTAB and district courts, requiring standing, and aligning PTAB standards with those of district courts.

- **Standing Requirement:** Only parties with a real interest, such as licensees or accused infringers, allowed to file PTAB challenges, preventing misuse of the process by unrelated third parties.
- **Limits Repetitive Challenges:** restrict multiple PTAB petitions against the same patent, requiring parties to choose whether to challenge a patent's validity before the PTAB or in district court, but not both.
- **Aligns PTAB and Federal Court Standards:** PTAB would be required to apply the same claim construction and burden of proof ("clear and convincing evidence") used in federal courts, leading to more consistent outcomes and reduce manipulation and forum shopping.

The Realizing Engineering, Science, and Technology Opportunities by Restoring Exclusive Patent Rights Act of 2025 (the "RESTORE Patent Rights Act")- reintroduced February 2025

- "establishes a rebuttable presumption for injunctive relief in patent infringement cases," = a patent holder would be entitled to a permanent injunction upon the final judgment in a patent infringement court decision.[1]

- reverses Supreme Court decision in *eBay v. MercExchange* (2006), which held "that patent holders do not have an automatic right to a permanent injunction in a patent infringement case."

The Leadership in Critical and Emerging Technologies Act (the "Leadership in CET Act") – introduced May 2025

creates a pilot program at USPTO to expedite patent review for certain critical and emerging technologies: AI, semiconductor or electronic design automation tools, and quantum information science.

The goal is to encourage U.S. innovation and leadership by prioritizing covered applications in these key areas.

Katsumori Iseki

CP Japan IP Attorneys, Japan

Chair, Group 3

International Patents

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Asian IP Perspectives

-Patent filing strategies for faster patent grant in East Asia using the latest accelerated and deferred examination system in Japan, China, Korea and Taiwan-

1. Request for Examination (Standard Procedure)

This is the basic requirement to start the examination process.

Jurisdiction	Deadline (from Filing Date)/ FA pendency	Third-Party Request	Key Features / Remarks
Japan (JP)	**3 Years** / about 10 months (FA)	**Allowed**	Deemed withdrawn if not requested.
China (CN)	**3 Years** / 15-16months (FA)	**Not Allowed**	"Ex-officio" examination by CNIPA is also possible. Deemed withdrawn if not requested.
Korea (KR)	**3 Years** **/** 14-15 moths (FA time)	**Allowed**	Deemed withdrawn if not requested.
Taiwan (TW)	**3 Years** **/** 8 months (FA time)	**Allowed**	Deemed withdrawn if not requested.

2. Accelerated Examination (Fast-Track Options)

Jurisdiction	Availability	Main Requirements	Lead Time (to First Action)
Japan (JP)	✓	**Foreign-related applications**, SMEs, or green technology.	**Approx. 2–3 Months**
China (CN)	✓	Strategic emerging industries (AI, Biotech, etc.).	**Approx. 1–2 Months**
Korea (KR)	✓	Venture companies or working the invention.	**Approx. 1–2 Months**
Taiwan (TW)	✓	Published abroad or commercial exploitation.	**Approx. 2–4 Months**
Common	**PPH (Patent Prosecution Highway)**	Based on "patentable" results from a partner office.	Prioritized in all jurisdictions. IP5 PPH expanded to 2029 (2026)

3. Deferred Examination (Strategic Delay)

Systems used to intentionally delay the start of examination to align with business strategy or foreign results.

Jurisdiction	Availability	Max. Deferral Period	Timing & Features
Japan (JP)	**(N/A)**	-	No formal deferral system; can wait until the 3-year deadline.
China (CN)	✓	**Max. 3 Years (total: 3+3= 6 years from filing)** *divisional application as well	Must be filed **simultaneously** with the request. The request can be withdrawn.
Korea (KR)	✓	**Up to 5 years** from filing *divisional application as well	Must be filed **within 9 months from the request date**. The period can be changed. The request can be withdrawn.
Taiwan (TW)	✓	**Up to 5 years** from filing *divisional application as well	**Expanded in 2026** for better flexibility and duration. The period can be changed. The request can be withdrawn.

Patent filing strategies for faster patent grant in East Asian countries:
EPO-Hub vs. JP-Hub - Strategy A: EPO as the "Primary Hub" (The Standard Route)

This strategy focuses on finalizing the claims at your "home" office (EPO) before exporting them to Asia.

1. PACE Request at EPO: On the other hand, wait/defer the examination request in JP, CN, KR, TW

2. Obtain Positive Result at EPO: Secure a positive Communication or "Intent to Grant" from the EPO examiner

3. PPH Filing in JP/CN/KR/TW: start the examination request in JP and withdraw the deferred examination in CN, KR, TW.

Synchronize all Asian filings by applying for PPH based on the EPO results.

Patent filing strategies for faster patent grant in East Asian countries:
EPO-Hub vs. JP-Hub - Strategy A: EPO as the "Primary Hub" (The Standard Route)

- **Pros:** EPO's rigorous examination is highly respected globally. Claims granted by the EPO are often given significant weight by examiners in JP, CN, KR, and TW. (For grant in JP, CN, KR and TW, the next strategy B can be combined in the strategy A)
- **Cons:** PACE rules are strict; any extension of time limits will result in removal from the PACE program. It may take longer than the JPO route to get the final grant.

Patent filing strategies for faster patent grant in East Asian countries: EPO-Hub vs. JP-Hub – Strategy B: Japan as the "Acceleration Hub"

This strategy leverages Japan’s unique "Foreign-Related Application" status to obtain the first patentable result quickly.

1. **Filing at EPO:** (Month 0)
2. **Filing & Accelerated Exam in Japan:** File in Japan within 1 year via Paris route or within 30 months via PCT. Request **Accelerated Examination** based on "Foreign-Related Application" status.
3. **Grant in Japan:** Receive the first office action or notice of allowance within approx. 2–3 months from the request.
4. **PPH Filing in CN/KR/TW:** Use the "patentable" claims from Japan to trigger **PPH** in CN, KR, and TW where the deferred examination is requested.

Patent filing strategies for faster patent grant in East Asian countries: EPO-Hub vs. JP-Hub – Strategy B: Japan as the "Acceleration Hub"

Pros: JPO’s examination is highly predictable and fast. It is the quickest way to get the first "certified" claim set in East Asia.

Cons: If the JPO examiner requires narrow claims, you may be forced to proceed with those narrower claims in CN/KR/TW due to PPH requirements.

THANK YOU !!

Richa Pandey

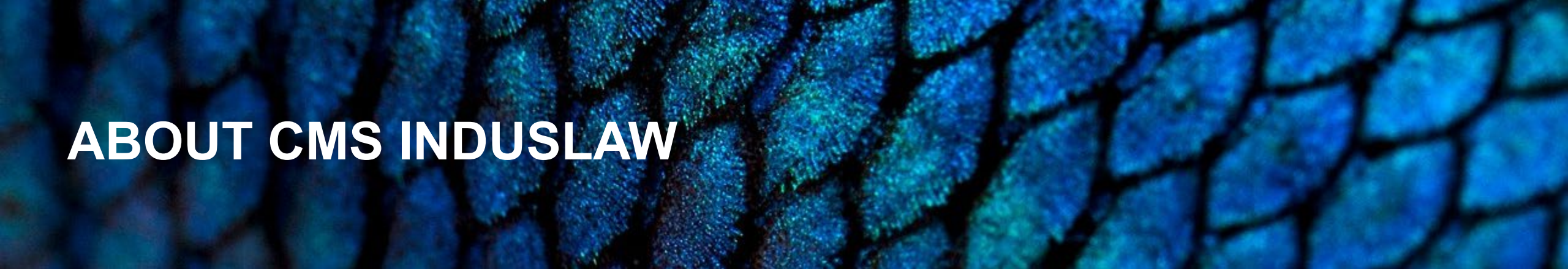
CMS Indus Law, India

Reporter General

Study & Work Committee

Generative AI & Copyright

-Analysis of Hybrid Model, TDM, and Licensing Framework
-Focus: Balancing Innovation, IP Rights & Digital Commons



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We advise domestic and international clients on transactions, regulatory matters, and disputes, working collaboratively across practice areas, sectors, and jurisdictions. Our focus is on delivering practical and commercially aligned legal solutions that help clients navigate complex legal landscapes in India and beyond.

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24 PRACTICE AREAS AND SECTORS

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CMS is a multi-jurisdictional organisation of law firms providing full-service legal and tax advice across 50 countries. CMS has 7,200 lawyers in 87 cities with 91 offices. The total Partner count of CMS is over 1300. CMS is one of the largest global law firms.

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Introduction

- Working Paper (Dec 8, 2025) addresses AI–copyright intersection
- Core policy challenge:
  - Incentivizing creativity
  - Protecting IP rights
  - Enabling AI innovation (India AI Mission)
- Problem:
  - Property rules → high transaction costs
  - Liability exceptions → undervalue creators

Core Argument

- Hybrid Model is useful but incomplete
- Needs refinement for:
  - Open-Source ecosystem
  - Digital commons protection
- Proposed approach:
  - Contextual Copyleft
  - Alternative Compensation Systems (ACS)

Regulatory Models Overview

- Hybrid Model features:
  - Blanket licensing for AI training
  - Royalties post-commercialization
- Combines:
  - Voluntary licensing
  - Statutory licensing
  - Collective licensing

Regulatory Models Overview

- Ensures creator consent and autonomy
- Enables fair price discovery
- Ideal for:
  - High-value datasets
  - Premium content (archives, journals)

Voluntary Licensing – Pros

- Impractical at scale:
  - Millions of rights holders
  - High transaction costs
- Risks:
  - “Anti-Commons” effect
  - Data gaps → bias in AI
  - Entry barriers for startups
- Encourages reliance on pre-scraped datasets

Impact on Workforce & Innovation

- AI reduces roles (writers, coders)
- Creators forced to train systems replacing them
- Direct licensing:
  - Favors large tech firms
  - Harms startups & OSS community

Risks of Strict Licensing

- Encourages:
  - Opaque datasets
  - “Data laundering” practices
- Legal uncertainty:
  - Fair dealing not yet settled

TDM vs Generative AI

- Traditional TDM (Text and Data Mining):
  - Non-expressive analysis
- Generative AI:
  - Substitutes original works
- Conclusion:
  - Requires compensation, not exemption

Collective Licensing

- Benefits:
  - Reduces transaction costs
  - Ensures royalty distribution
- Challenges:
  - Bias toward large creators
  - Transparency issues

Need for Extended Collective Licensing (ECL)

- Covers:
  - “Long tail” of creators
- Advantages:
  - Scalable licensing
  - Includes non-members
- Essential for AI training datasets

Risks in ECL

- “Strategic ambiguity” by creators
- Blanket opt-outs → compliance burden
- Solution:
  - “No identification, no opt-out” rule

Governance Issues in CMOs

- Transparency concerns
- Royalty distribution inefficiencies
- AI challenge:
  - Lack of training data visibility

Orphan Works Solution

- Case-by-case approach impractical
- Proposed:
  - ECL + indemnification fund
  - Digital Commons Fund for unclaimed royalties

Licensing Framework Issues

- Licensing ≠ AI safety
- Bias depends on training
- Mandatory licensing:
  - Doesn’t ensure accuracy

Trade Secret Conflict

- AI training may expose confidential data
- Risk:
  - Loss of trade secret protection
- Recommendation:
  - Confidentiality safe harbour

CRCAT Structure Issues

- Single representative per class problematic
- “Literary work” includes:
  - Books + software (different economics)
- Solution:
  - Federated structure
  - Multiple sub-category representation

Disclosure Framework

- Essential for:
  - Transparency
  - Royalty distribution
- Problem:
  - High compliance burden

CLeAR Principles

- Comparable → standardized formats
- Legible → understandable
- Actionable → usable for claims
- Robust → version tracking

Royalty Rate Issues

- Risk of regulatory capture
- Information asymmetry
- Need:
  - Data-driven rate setting
  - Transparency in decisions

Problems with Flat Rates

- Ignores data value differences
- Leads to:
  - Underpayment (high-value content)
  - Overburden (small firms)

Suggested Rate Model

- Based on:
  - Data utility
  - Model purpose
  - Commercial scale

Commercialization Trigger Issue

- Training phase exempt → unfair
- Risks:
  - Free rider problem
  - “Perpetual beta” loophole

Welfare Fund Issues

- Arbitrary 3-year limit
- Risk of:
  - Loss of rightful claims
- Needs clearer safeguards

Hybrid Model – Key Concerns

- Difficult to quantify creative value
- Flat pricing inadequate
- Moral rights overlooked

Injunction Debate

- Removing injunction weakens enforcement
- Reduces bargaining power of creators

R&D Subsidy Problem

- If model fails:
  - Creators not compensated
- AI gains value during training itself

Institutional Gaps

- CRCAT lacks:
  - Clear dispute resolution
  - Minority protection
  - Defined processes

Final Recommendations

- Adopt **Tiered Framework**
- Implement **Digital-first ECL**
- Ensure **Transparency + Auditability**
- Protect:
  - Open-source ecosystem
  - Small creators
- Balance:
  - Innovation + creator rights

Conclusion

- Need balanced, evidence-based regulation
- Avoid over-regulation & under-compensation
- Goal:
  - Sustainable AI ecosystem
  - Fair creator remuneration


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THANK YOU!

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Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO)

as defined in the Guidelines for Examination at the EPO (GL); GL Part G, Chapter VII, item 5 (G-VII-5-5)

“Holistic Approach” by UPC Court of Appeal (CoA)

In the decisions UPC CoA 528/24 et al. (“Amgen vs. Sanofi and Regeneron”) and CoA 464/2024 et al., (“Meril vs. Edwards”)

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO): Three main stages (EPO GL G-VII-5)

- (i) determining the "closest prior art"
- (ii) establishing the "objective technical problem" to be solved by the invention and
- (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO; GL G-VII-5): Three main stages

- (i) determining the "closest prior art“ (CPA)
  - The CPA discloses, as a single reference, the combination of features which constitutes the most promising starting point for a development leading to the invention
  - It must be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention
  - In practice, the CPA generally corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention
- (ii) establishing the "objective technical problem" to be solved by the invention and
- (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO; GL G-VII-5): Three main stages

- (i) determining the "closest prior art“ (CPA)
- (ii) establishing the "objective technical problem" (OTP) to be solved by the invention
  - Formulation of an OTP based strictly on technical differences (the “distinguishing features” between the invention and the CPA
  - The structural or functional “distinguishing feature(s)” result(s) in a “technical effect” which solves the OTP
  - OTP must be formulated to not contain any “pointers” to the technical solution of the invention (to prevent *ex post facto* assessment)
  - OTP is often reformulated on the merits of each particular case, depending on the “effect”
  - OTP may be regarded as solved only if it is credible that substantially all claimed embodiments exhibit the technical effects on which the invention is based
- and (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO; GL G-VII-5): Three main stages

- (i) determining the "closest prior art“ (CPA)
- (ii) establishing the "objective technical problem" (OTP) to be solved by the invention and
- (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person (“Could-would approach”)
  - Is there any teaching in the prior art as a whole that **would** (not simply could, but would) have prompted the skilled person, when faced with the OTP, to modify or adapt the CPA in the light of that teaching in such a way as to arrive at something falling within the terms of the claims and thus achieve what the invention achieves
  - If the prior art (or common general knowledge (CGK)) provides a clear motivation or hint to modify the CPA in a way that leads to the invention, the inventive step is denied

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO; GL G-VII-5):

- Widely applied in EPO proceedings
- Adopted in national practice in many European countries
- “Rigorous”
- “Formalistic”

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO)

as defined in the Guidelines for Examination at the EPO (GL); GL Part G, Chapter VII, item 5 (G-VII-5-5)

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Inventive Step – UPC vs. EPO

- “Holistic Approach” by UPC Court of Appeal (CoA)
  - In the decisions UPC CoA 528/24 et al. (“Amgen vs. Sanofi and Regeneron”) and CoA 464/2024 et al., (“Meril vs. Edwards”)
  - Amgen (EP 3 666 797 B1): monoclonal antibodies against PCSK9 for use in reducing the risk of a recurrent cardiovascular event related to elevated serum cholesterol levels, 2 appeal cases simultaneously decided by CoA
  - Edwards (EP 3 646 825 B1): system comprising a prosthetic heart valve and a delivery catheter; 9 Appeal cases simultaneously decided by CoA

Inventive Step – UPC vs. EPO

- “Holistic Approach” by UPC CoA (CoA 528/24 et al. + CoA 464/2024 et al.)
- Defining the objective problem (OP) first
- Define “realistic starting points” in the prior art to solve the OP
- “Would and not only: could” standard requiring a “pointer or motivation” that directs the skilled person to implement a next step in the direction of the invention
- Was there a “clear predictability” or “reasonable expectation of success?

Inventive Step – UPC vs. EPO

- "Holistic Approach" by UPC CoA (CoA 528/24 et al. + CoA 464/2024 et al.)
- Defining the objective problem (OP) first
  - The UPC assessment begins by establishing the "objective of the invention" from the perspective of a skilled person under consideration of CGK at the priority date
  - What does the invention add to the state of the art?
    - "not by looking at the individual features of the claim, but by comparing the claim as a whole in context of the description and the drawings, thus also considering the inventive concept underlying the invention (the technical teaching), which must be based on the technical effect(s) that the skilled person on the basis of the application understands is (are) achieved with the claimed invention" (CoA 528/24 et al., 127)
  - Unlike the EPO, which identifies the problem after comparing the invention to the closest prior art, the UPC determines the "inventive concept" by considering the claim as a whole within the context of the entire description and drawings.

Inventive Step – UPC vs. EPO

- "Holistic Approach" by UPC CoA (CoA 528/24 et al. + CoA 464/2024 et al.)
- Defining the objective problem (OP) first
  - As the EPO: OP should not contain pointers to the claimed invention
  - "The relevant field of technology is the field relevant to the objective problem to be solved as well as any field in which the same or similar problem arises and of which the person skilled in the art of the specific field must be expected to be aware" (CoA 528/24 et al., 130)

Inventive Step – UPC vs. EPO

- "Holistic Approach" by UPC CoA (CoA 528/24 et al. + CoA 464/2024 et al.)
- Define "realistic starting points" in the prior art to solve the OP
  - "A starting point is realistic if the teaching thereof would have been of interest to a skilled person who, at the relevant date, wishes to solve the objective problem" (CoA 528/24 et al., 132)
  - "There can be more than one realistic starting point and the claimed invention must be inventive starting from each of them" (CoA 528/24 et al., 132)

Inventive Step – UPC vs. EPO

- "Holistic Approach" by UPC CoA (CoA 528/24 et al. + CoA 464/2024 et al.)
- "Would and not only: could" standard requiring a "pointer or motivation" that directs the skilled person to implement a next step in the direction of the invention
  - The claimed solution is obvious when at the relevant date the skilled person, starting from a realistic starting point in the state of 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 (CoA 528/24 et al., 129)
  - The skilled person has no inventive skills and no imagination and requires a pointer or motivation that, starting from a realistic starting point, directs it to implement a next step in the direction of the claimed invention (CoA 528/24 et al., 132)
  - As a general rule, a claimed solution must be considered not inventive / obvious when the skilled person would take the next step prompted by the pointer or as a matter of routine, and arrive at the claimed invention (CoA 528/24 et al., 132)

Inventive Step – UPC vs. EPO

- "Holistic Approach" by UPC CoA (CoA 528/24 et al. + CoA 464/2024 et al.)
- Was there a "clear predictability" or "reasonable expectation of success?
  - A claimed solution is obvious if the skilled person would have taken the next step in expectation of finding an envisaged solution of his technical problem (CoA 528/24 et al., 133)
  - This is generally the case when results of the next step were clearly predictable, or where there was a reasonable expectation of success (DG 133)
  - The burden of proof that the results were clearly predictable or the skilled person would have reasonably expected success, i.e. that the solution he envisages by taking the next step would solve the objective problem, lies on the party asserting invalidity of the patent (CoA 528/24 et al., 134)
  - A reasonable expectation of success implies the ability of the skilled person to predict rationally, on the basis of scientific appraisal of the known facts before a research project was started, the successful conclusion of that project within acceptable time limits (CoA 528/24 et al., 133)

Inventive Step – UPC vs. EPO

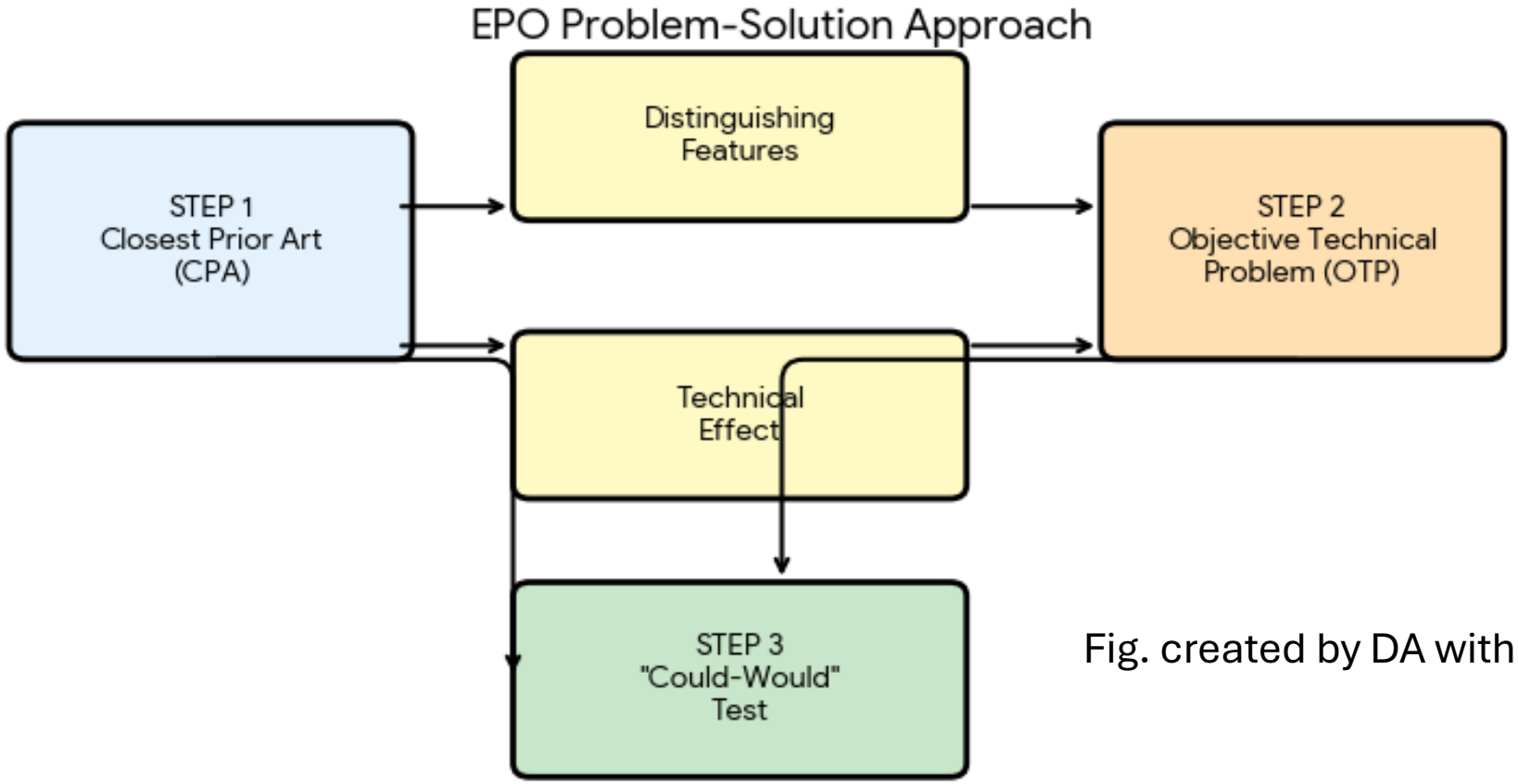

Fig. created by DA with the help of AI

Inventive Step – UPC vs. EPO

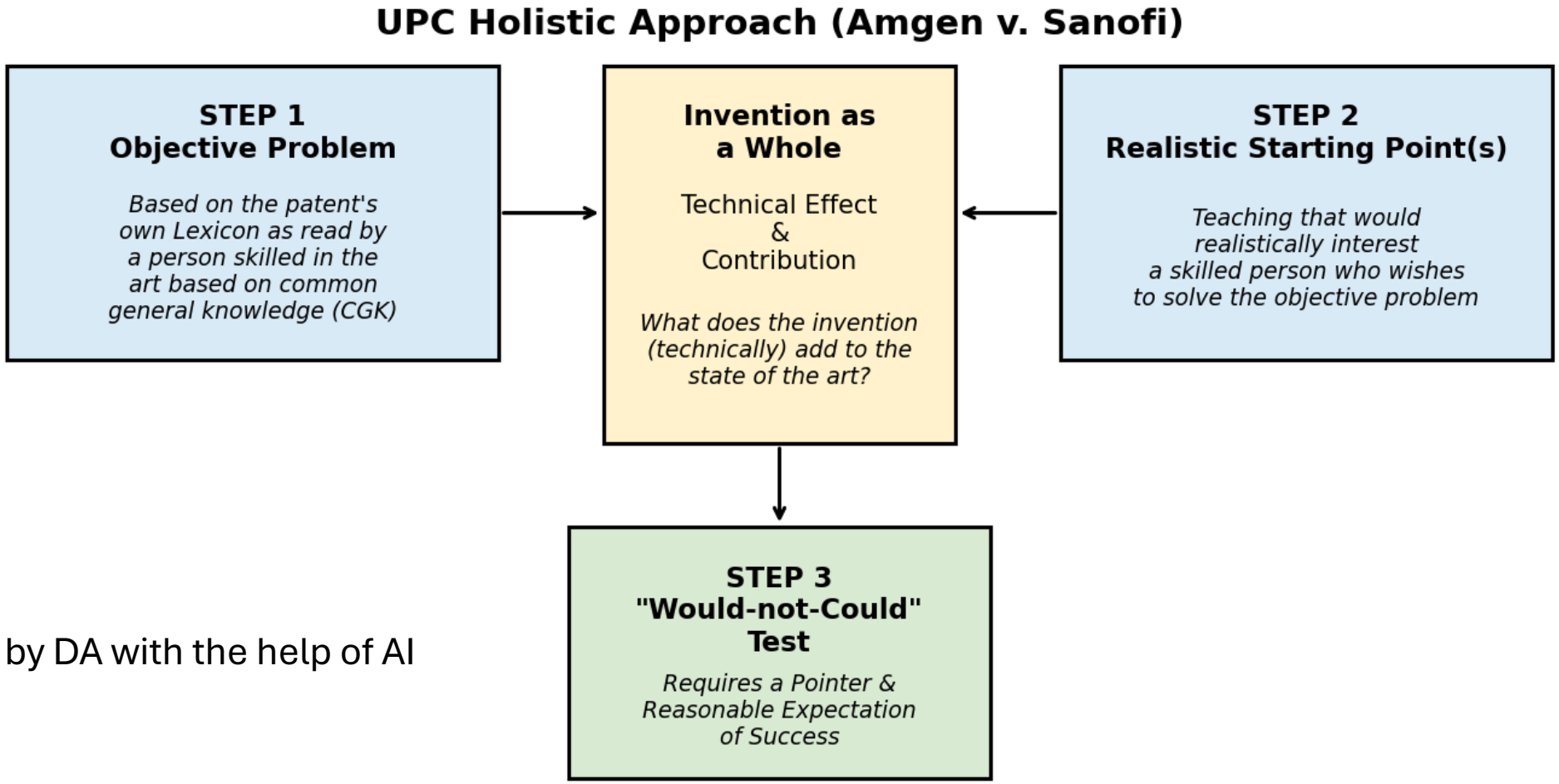

Fig. created by DA with the help of AI

Inventive Step – UPC vs. EPO

Problem-Solution-Approach (EPO)

“Holistic Approach” by UPC CoA

Questions?

Mauro Eccetto

Studio Torta, Italy

Chair, Group 7

IP Enforcement and Alternate Dispute Resolution

Study & Work Committee

Long arm jurisdiction

Legal Framework

Brussels I-bis Regulation (EU) No. 1215/2012

Art. 4(1): EU-domiciled defendant → universal jurisdiction;

1. Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.

2. Persons who are not nationals of the Member State in which they are domiciled shall be governed by the rules of jurisdiction applicable to nationals of that Member State.

Legal Framework

Art. 71: UPC integrated as common court

1. This Regulation shall not affect any conventions to which the Member States are parties and which, in relation to particular matters, govern jurisdiction or the recognition or enforcement of judgments.

2. With a view to its uniform interpretation, paragraph 1 shall be applied in the following manner:

a) this Regulation shall not prevent a court of a Member State which is party to a convention on a particular matter from assuming jurisdiction in accordance with that convention, even where the defendant is domiciled in another Member State which is not party to that convention. The court hearing the action shall, in any event, apply Article 28 of this Regulation;

b) judgments given in a Member State by a court in the exercise of jurisdiction provided for in a convention on a particular matter shall be recognised and enforced in the other Member States in accordance with this Regulation.

Where a convention on a particular matter to which both the Member State of origin and the Member State addressed are parties lays down conditions for the recognition or enforcement of judgments, those conditions shall apply. In any event, the provisions of this Regulation on recognition and enforcement of judgments may be applied.

ECJ on Swedish case C 399

ECJ 25 February 2025 BSH v Electrolux

EU courts may hear worldwide EP infringements;

validity remains territorial (Art. 24(4)) Brussels I-bis Regulation

The court of the defendant's domicile remains competent to hear a patent infringement action, even where the defendant raises a validity challenge by way of defence concerning a patent granted or validated in another Member State.

However:

Exclusive jurisdiction over validity lies with the courts of the State of grant/validation of the patent (Article 24(4) Brussels I bis);

The infringement court may not declare the patent invalid, even incidentally.

The Court expressly accepts a possible procedural split:

Infringement → court of the defendant's domicile

Invalidity → courts of the State of grant/validation

ECJ on Swedish case C 399

ECJ 25 February 2025 BSH v Electrolux

EU courts may hear worldwide EP infringements;

validity remains territorial (Art. 24(4)) Brussels I-bis Regulation

Patents validated in third States (e.g. Turkey)

Key findings

Article 24(4) Brussels I bis does not apply to third States
→ it does not confer exclusive (or any) jurisdiction on courts of third countries.

The decision has inter partes effect only;

It does not affect the existence, content, or register of the patent in the third State.

UPC Decision UPC_CFI_355/2023

UPC Düsseldorf 28 Jan 2025

FUJIFILM vs Kodak GmbH

Validity and infringement are distinct objects of jurisdiction

Courts may hear infringement actions even where validity is challenged, but only the State of grant may rule on validity erga omnes (*GAT* confirmed; *BSH* clarified).

Invalidity as a defence does not deprive infringement jurisdiction
Raising invalidity does not strip the infringement court of jurisdiction; it only excludes its power to determine validity (*BSH* decisive clarification).

Article 24(4) Brussels I bis is narrow and exceptional
It applies only to disputes directly concerning validity, not to infringement lawsuits (*BSH*; followed by UPC Düsseldorf).

Procedural bifurcation is lawful and structural
Infringement and validity may proceed in parallel before different courts, with stays as a coordination tool, not a jurisdictional bar (*Solvay* → *BSH*).

UPC Decision UPC_CFI_355/2023

UPC Düsseldorf 28 Jan 2025

FUJIFILM vs Kodak GmbH

Centralised multi-state infringement is legitimate
A single court (including the UPC) may adjudicate pan-European infringement, including non-UPC States, where the defendant is EU-domiciled (*BSH*; UPC Düsseldorf fully aligned).

Third-State patents (e.g. UK) are not excluded per se
EU/UPC courts may assess validity defensively and inter partes only, without affecting the foreign register (*BSH*; applied by UPC Düsseldorf).

No “torpedo” via validity objections
Defendants cannot neutralise infringement proceedings simply by asserting invalidity (*BSH* corrective to overly expansive post-*GAT* readings).

Strategic implications

For claimants, **centralised enforcement is now a realistic default option**, not an exception.
A single action may cover:

multiple EU States;

and, in suitable cases, non-EU designations of European patents.

For defendants, **validity is no longer a jurisdictional shield**.
It remains a powerful substantive defence — but it cannot be used to derail infringement proceedings ab initio.

The UPC is emerging as a genuine **European hub for patent enforcement**, with a reach that — while carefully constrained — extends beyond the UPC territory itself.

UPC Long arm jurisdiction – cross-border claims

- UPC CoA 789/2025 and CoA 8132025 of 6 March 2026 (“Dyson vs. Dreame”)
- Dyson EP 3 119 235 B1: Hair treatment devices
- CoA issued provisional measures for the territories covered by the UPC
- CoA stayed the proceedings regarding Spain (a non-UPCA member) and the liability of Eurep GmbH (an authorized representative of the Dreame products)
- CoA referred four fundamental questions to the CJEU to clarify the reach of the UPC's jurisdiction.
- Can the UPC issue cross-border injunctions for countries outside its direct treaty territory
- Can companies serving as “authorised representatives” for product safety be legally targeted as “intermediaries” in patent litigation

UPC Long arm jurisdiction – cross-border claims

- UPC CoA 789/2025 and CoA 8132025 of 6 March 2026 (“Dyson vs. Dreame”)
- 1. Must Article 8(1) in conjunction with Article 71b(2) of Regulation 1215/2012 be interpreted as meaning that a situation where, in proceedings before a common court within the meaning of Article 71a(2) of Regulation 1215/2012, a first company that is established in a third State is alleged to have committed an infringement of a national part of a European patent which is in force in an EU Member State that is not party to the instrument establishing the common court, and a second company that is established in an EU Member State that is party to the instrument establishing the common court is alleged to be an intermediary whose services are used by the first company to infringe in the EU Member State that is not party to the instrument establishing the common court, is capable of leading to “irreconcilable judgments” resulting from separate proceedings as referred to in Article 8(1) Regulation 1215/2012?

UPC Long arm jurisdiction – cross-border claims

- UPC CoA 789/2025 and CoA 8132025 of 6 March 2026 (“Dyson vs. Dreame”)
- 2. Must Article 71b(2), second sentence, of Regulation 1215/2012 be interpreted as meaning that a common court has jurisdiction in relation to an action for provisional measures against a company established in a third State that is alleged to have infringed a European patent in force in an EU Member State that is not party to the instrument establishing the common court, and in some or all EU Member States that are party to the instrument establishing the common court by offering the same products in all those EU Member States through websites that are identical apart from the language?
- 3. Is the fact that the company uses the services of a company that is established in an EU Member State that is party to the instrument establishing the common court in order to infringe a relevant circumstance in answering this second question?
- 4. Does Article 9(1)(a) of Directive 2004/48 or any other provision of Union law preclude case-law of a national or common court under which an interlocutory injunction aimed at preventing or prohibiting infringement of a patent by a third party by placing products on the market to which Regulation 2023/988 and 2019/1020 apply may be granted against an authorised representative that performs the tasks laid down in these Regulations on behalf of the third party?

UPC Long arm jurisdiction – cross-border claims

- UPC CoA 789/2025 and CoA 8132025 of 6 March 2026 (“Dyson vs. Dreame”)
- Now pending at the CJEU under C-196/26 (Dreame International, 11 March 2026)
- Result of this Referral: How does the UPC interact with EU Member States that have not joined the unified system?

Schedule

15:00 **Session 4**: Patents

16:15 An introduction to FICPI

16:30 Closing Remarks

17:00 Cocktail Reception

Seminar Cocktail Reception
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