

Key insights after two years of the UPC and UP: Q&A for IP managers

Michael Pfeifer and Dirk Schüßler-Langeheine of HOFFMANN EITLE reflect on the two years since the Unified Patent Court and Unitary Patent came into effect, providing strategic guidance for navigating and optimizing UPC/UP approaches.

The launch of the Unified Patent Court (UPC) and the Unitary Patent (UP) on June 1, 2023, marked a turning point for patent litigation and protection in Europe. Now, with two years of real-world experience behind us, companies can draw more concrete conclusions about how to best use or respond to this new system. This article highlights the key takeaways and provides pragmatic guidance for developing UPC/UP strategies.

Practical experience after two years

Who is using the UPC – and for what purposes?

The UPC has quickly become a prominent and strategically important litigation forum in Europe. In the first two years, 351 infringement cases and 72 requests for provisional injunctions were filed. Conversely, a smaller number of cases were standalone central revocation actions (68 in the first two years). This shows that patentees primarily use the UPC to assert their patents across multiple countries simultaneously, which is a key advantage of the UPC system.

Cases have been brought in all industries, but digital and medical device companies seeking to efficiently enforce European patents are the most frequent users. So far, pharmaceutical companies have been more hesitant to use the UPC for their core patents, largely due to the risk of central revocation. Nonetheless, there are signs that this cautious approach is changing.



Michael Pfeifer



Dirk Schüßler-Langeheine

More pharmaceutical companies appear to be tailoring their patent portfolios to allow them to use the UPC for enforcing future patents.

What are the practical advantages of the UPC?

The UPC allows patent holders to obtain injunctions and damages that are enforceable in all 18 participating member states through a single action. This reduces litigation costs and coordination efforts as compared to parallel national proceedings and prevents inconsistent national decisions. It also speeds up enforcement. In main infringement actions, the UPC's Court of First Instance (CFI) has delivered decisions within an average of 399 days, which is much faster than many national courts.

Importantly, the proceedings are adjudicated by multinational panels of highly motivated and skilled judges with legal or technical qualifications, many of whom are experienced patent judges from national courts. This ensures a high level of competence and reliable, thorough, and well-reasoned decisions.

How far does the UPC's international jurisdiction reach?

If the defendant is domiciled in any country within the UPC's territory, the UPC has international jurisdiction to rule on infringement of European patents, including relating to non-UPC parts. The Court of Justice of the European Union (CJEU) confirmed this in its landmark *BSH Hausgeräte*

v. Electrolux decision on February 25, 2025. Based on this ruling, it is possible to conduct truly pan-European litigation extending beyond the UPC territory. Some companies have already filed patent infringement claims covering the Spanish, UK, or Swiss parts of a European patent, for example. The validity of those parts can only be challenged in the national courts of the concerned party, leading to a de facto separation of the proceedings.

How fast and under what conditions does the UPC grant provisional injunctions?

The UPC has demonstrated that it can issue preliminary injunctions within two to four months and, in exceptional cases, even *ex parte* within days. To succeed, the patent must be likely both valid and infringed, and the applicant must show the need "to jump the queue" and obtain an injunction in urgent proceedings.

Regarding validity, the UPC's practice is more favorable to the patentee than the approach taken by the German national courts. The UPC's Court of Appeal has confirmed that the defendant bears the burden of proof regarding invalidity.

Can the UPC also help obtain evidence of infringement?

Yes. There have been 21 cases in which patentees (or licensees) have filed applications for orders to inspect or preserve evidence. The UPC allows patentees to obtain evidence through inspection orders, modeled on the *saisie-contrefaçon* procedure known in French law. This is a significant advantage when the details of an alleged infringement are not publicly known. The ability to request early disclosure or inspection enables patentees to build a case even without full public knowledge of the allegedly infringing product.

What are the main risks and disadvantages of the UPC?

The main objection to using the UPC remains the risk of a central attack. A European patent that has not been opted out or has been registered as a UP can be invalidated throughout the entire UPC territory via one central revocation action. This risk has led many patentees to opt out their most valuable patents from the UPC jurisdiction.

However, we are seeing a changing trend. All European patents are already at risk of a central validity attack in EPO opposition proceedings, and, in practice, there are only a small number of proactive revocation actions before the UPC. Users also appear to have more confidence in the UPC's decisions, and the ratio of opted-out patents is now lower than it was at the beginning of the new system.

Another challenge is the procedural intensity. The UPC follows a front-loaded model with

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tight deadlines and strict late-filing rules, due to the objective of holding the oral hearing within one year of filing the legal action. Parties must prepare their entire case, including evidence, legal arguments, and witness declarations, early on. This requires significant resources and preparation. On the other hand, tight deadlines typically favor the claimant who has the time to prepare before bringing the legal action. The defendant must react quickly.

Do we already know how the UPC will deal with substantive law issues?

So far, the Court of Appeal has not issued any decisions on the merits in main infringement actions. We are thus awaiting guidance from the Court of Appeal on essential questions of substantive law, such as the doctrine of equivalents and second medical use claims, which are crucial for assessing infringement. The cases decided by the CFI thus far suggest that, regarding substantive law issues as well, the UPC is inspired by the case law and practices of the national courts. Nonetheless, the UPC develops its own tests, standards, and approaches.

From the Court of Appeal's decisions in provisional injunction proceedings, we have guidance on claim construction and the need to apply the same standards to the assessment of validity and infringement.

How is the UPC's approach to inventive step different from that of the EPO?

While the UPC approach to inventive step is not yet settled, some decisions have taken a

Résumés

Dr Michael Pfeifer is a German Attorney-at-Law, UPC Representative, and partner in Hoffmann Eitle's Patent Litigation and Contracts Group. Since joining Hoffmann Eitle in 2017, Michael's work has focused on litigation in pharmaceutical and biotechnology matters, in addition to medical devices and food products, before the German courts. He has been involved in high-stakes UPC litigation from the very first day of the new court. With an academic background in Japanese law, Michael is fluent in Japanese and regularly advises Hoffmann Eitle's Japanese clients on all IP-related matters, including employee invention law.

Dr Dirk Schüßler-Langeheine is a German Attorney-at-Law, UPC Representative, and Business Mediator. As a partner and key UPC strategist of Hoffmann Eitle, he is co-head of the firm's Patent Litigation and Contracts Group. Dirk frequently acts as lead counsel and coordinator of pan-European patent enforcement projects in all areas of technology. His legal acumen and creativity are also reflected in his strong track record of pharma patent litigation for originators. He regularly leads international dispute resolution, licensing and IP contract negotiation projects. His exceptional proficiency in Japanese is an invaluable asset for Japanese companies.

different approach from that of the EPO. The EPO often begins the assessment of inventive step with a single closest prior art document, whereas the UPC tends to consider any realistic starting point when evaluating inventive step. The different divisions of the CFI generally emphasize the evaluation of obviousness, but they do not yet follow a uniform structure in their assessments. Their reasoning often resembles that of German courts.

There are many cases in which validity challenges are pending at both the EPO and the UPC. Initially, the UPC seemed to prioritize the speed of its procedures over harmonization with the EPO. Now, however, the UPC considers the EPO's rulings in its decisions and emphasizes the need for harmonization. However, different approaches to assessing inventive step may result in inconsistent decisions. In the *Sanofi v. Amgen* case, for example, the UPC has invalidated Amgen's patent for lack of inventive step, where the EPO did not find a reasonable expectation of success and confirmed inventive step.

What is the trend in the UPC's decisions on claim amendments?

Early decisions by the CFI aligned with the EPO's strict approach to added matter and intermediate generalizations. However, in its February 2025 ruling on *Abbott v. Sibus*, the Court of Appeal permitted certain generalizations based on a holistic reading of the patent, suggesting a more flexible approach.

What role do Technically Qualified Judges (TQJs) play?

TQJs are a valuable and distinctive part of the UPC system. Appointed based on their technical expertise, they help ensure high-quality decisions in complex cases, informed by a thorough technical understanding. It is not uncommon for proceedings relating to the same patent to be pending before different divisions. For example, there could be two parallel infringement cases before two different local divisions or one infringement action with a revocation counterclaim before a local division and a standalone revocation action against the same patent before the central division. In such cases, the CFI typically appoints the same TQJ to both proceedings to ensure consistency in interpretation and outcome.

Impact on dispute resolution strategies

When should we consider the UPC for enforcement?

The UPC offers powerful enforcement options that are cost-effective and time-efficient across multiple jurisdictions. Claimants can obtain provisional measures and final judgments much

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faster than in many national courts. The availability of procedural tools, such as inspection orders and quick provisional injunctions, enhances the appeal to patentees. The territorial scope of the UPC judgments, as well as the tight timelines and strict procedures, puts significant pressure on defendants in UPC infringement actions.

Impact on portfolio development
How are filing strategies changing under the UPC and UP system?

The availability of the UP and the new litigation framework are increasingly shaping filing strategies. Many patentees are considering mixed portfolios, such as filing for UP while maintaining national validations or opting valuable patents out of the UPC to protect against central revocation.

The UP offers patentees seeking broad territorial coverage an attractive cost advantage. However, even applicants seeking protection in only two or three UPC countries can increase the value of their portfolios by obtaining UPs for their important patents.

What about double patenting and divisionals?

Companies use strategies involving divisionals to mitigate UPC risks. Some companies file divisionals with slightly different claim scopes, retaining one for litigation at the UPC and opting out the other as a safeguard against central revocation by the UPC.

After the transitional period ends in 2030 (unless extended), parallel national patents may become more critical. For instance, German law allows a national patent to coexist with an identical European patent under certain conditions; however, enforcement is restricted if a UPC case has been filed against the same party. Conversely, a divisional European patent that has been opted out faces no restrictions regarding enforcement.

Impact on strategies for protecting a product launch
What does the UPC mean for companies launching products in Europe?

The new system allows patent holders to more easily and broadly assert their rights. Consequently, the risk of preliminary injunctions and inspection orders being filed at short notice increases. Companies planning product launches in Europe must prepare thoroughly in advance.

What precautions should be taken before launch?

A robust freedom-to-operate analysis is essential. It should entail reviewing competitors' patent portfolios, verifying opt-out status, and evaluating the validity of patents as well as the likelihood of UPC enforcement. If risks are identified, companies should consider preemptive actions, such as

filing protective letters with the UPC or initiating national revocation proceedings to block the withdrawal of opt-outs.

Due to the tight timelines and high procedural standards at the UPC, companies should also assemble a response team – including external counsel with UPC experience – well ahead of launch for immediate action in the event of a dispute.

Conclusion and strategic takeaways

After two years of operation, the UPC presents additional strategic opportunities, but it also requires careful planning and legal foresight. The UP simplifies coverage and may reduce costs. The court itself has proven to provide swift and effective enforcement, attributable to knowledgeable judges who are strongly motivated to ensure the UPC's success.

For patent owners: The system rewards those who align filing, validation, and litigation strategies. Consider opting out of the UPC with core patents only while testing it with less critical ones. Use divisionals to diversify risk.

For product developers: The UPC demands readiness. Thorough freedom-to-operate analyses and validity assessments, possibly validity attacks

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and protective letters, as well as legal preparedness, are essential for minimizing risk and disruption.

With prudent planning, both patentees and potential defendants can seize the opportunity and leverage the UPC and UP as powerful tools in their European IP strategies.

Contact

HOFFMANN EITLE
Arabellastr. 30, 81925 Munich
Tel: +49 89 92 40 90
upc@hoffmanneitle.com
www.hoffmanneitle.com

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upc@hoffmanneitle.com | hoffmanneitle.com