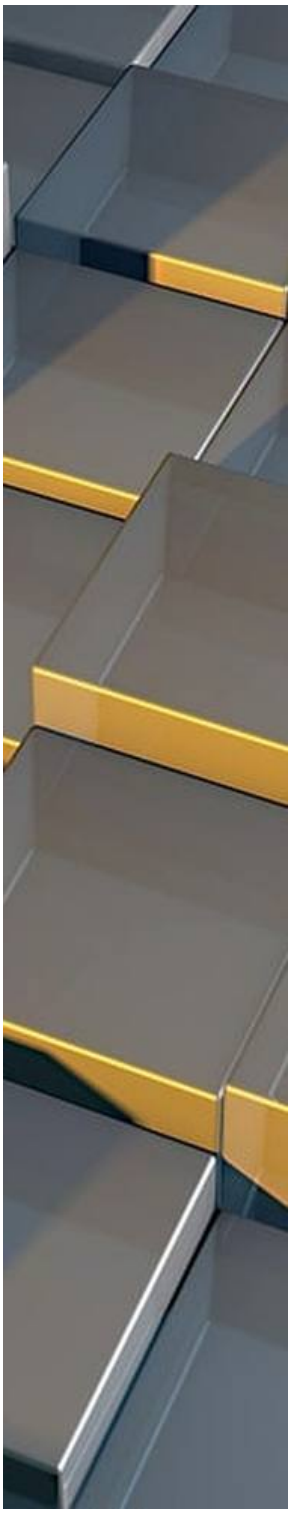


ARTICLE

1ST DECISIONS ON THE MERITS ISSUED BY THE UPC CENTRAL DIVISION (2/2): KEY FINDINGS FROM THE CD PARIS DECISIONS OF 19 AND 29 JULY

Patent Law | 01/08/24 | Lionel Martin Geoffroy Thill Anaïs Pallut

On 19 July, we published the first part of our study on the assessment of inventive step by the UPC Central Division. On the same day, the Central Division (Paris) (hereinafter the CD Paris) issued three identical decisions in *Meril v Edwards Lifesciences*.[1] On 29 July, the CD Paris issued a fourth decision on the merits in *Bitzer Electronics v Carrier*.[2] These decisions provide key findings on UPC specific procedural features, the admissibility of applications to amend a patent, added matter, priority claim and inventive step.

Front-loaded procedure and need to justify the grounds for revocation

In *Bitzer Electronics v. Carrier*, the CD Paris emphasized the **importance of front-loaded character of the UPC proceedings**: before the UPC, one must not assume that he/she will still have time to supplement his/her initial written pleadings. Any grounds and arguments that can be raised to challenge the validity of the patent as granted must be raised in the initial statement for revocation. In this case, the UPC declares inadmissible new attacks raised by the claimant in its reply brief because they "*could (and should)*" have been opposed from the outset, as they do not specifically respond to the patentee's arguments in defense or to the patentee's application to amend the patent.

In addition, the UPC stresses that **each ground for revocation must be sufficiently substantiated**: the claimant for revocation cannot merely assert that the invention was disclosed in a prior art document without substantiating his/her allegations. It is not the UPC's role to compensate for parties' lack of argumentation.

Applications to amend a patent

Inadmissibility of amendments to unchallenged claims

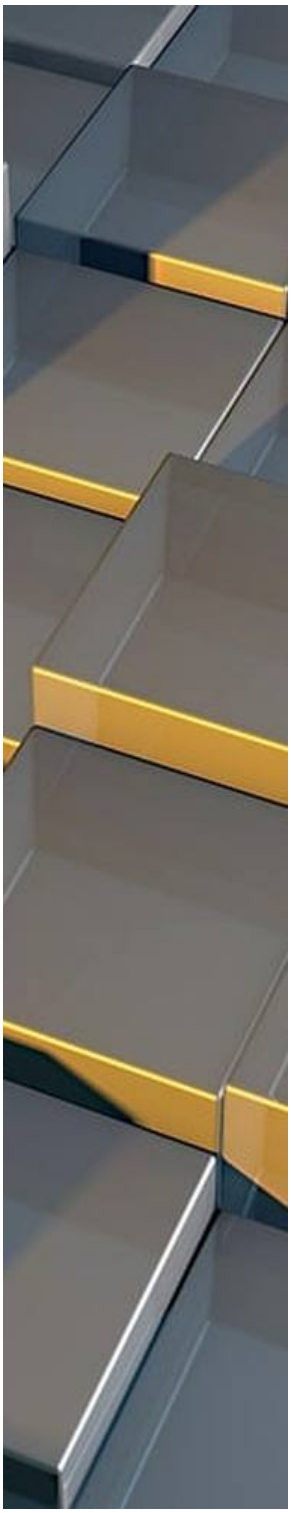
In the *Bitzer Electronics v Carrier* decision, the CD Paris reminds that, in its decision of 30 April 2024 issued in the same case,[3] it had already dismissed applications to amend unchallenged claims (i.e. claims which are not concerned by the revocation action). It points out that **no independent action for a declaration of validity of the patent is available before the UPC**, whether for the patent as granted or an amended version. It also stresses that UPC cannot rule *ultra petita* on revocation grounds that would have not been raised.[4] However, it is not because unchallenged claims are out of the scope of the discussion on validity that the patentee cannot pick in those unchallenged claims features to amend the challenged claims.

A minimum of explanations concerning the compliance of the amendments with Articles 84 and 123(2) and (3) EPC is sufficient for the application to amend to be admissible; however, when an application to amend the patent is inadmissible, the same applies to any subsequent application to amend.

In *Meril v Edwards Lifesciences*, claimants in revocation challenged the admissibility of the applications to amend the patent. In their view, the first application to amend did not explain the reasons why the proposed amendments would comply with Articles 84 and 123(2) and (3) EPC, contrary to what is required by Rule 30.1(b) RoP, and the subsequent applications to amend were an attempt to circumvent the admissibility problems suffered by the previous applications.

According to the UPC, a distinction must be made between a lack of explanations and an insufficiency of explanations regarding compliance with Articles 84 and 123(2) and (3) EPC:

- In the first case, the application to amend is inadmissible and, **if an application to amend is found inadmissible, then any subsequent application is also inadmissible**. The rule is in line with the UPC's front-loaded character of the proceedings: a patent owner who files an application to amend the patent which does not comply with UPCA and RoP requirements cannot circumvent its original failure by filing other subsequent amendment applications.
- In the second case, the application to amend is admissible but could be unfounded. However, **an unfounded amendment application does not prevent the patentee from filing another amendment application** in



accordance with Rule 30.2 RoP.

It should be kept in mind that at the EPO, Boards of Appeal are generally stricter than Opposition Divisions on the admissibility of auxiliary requests. It will be interesting to see what will happen before the UPC Court of Appeal.

An excessive number of amendments is not necessarily unreasonable

According to Rule 30.1.c) RoP, the proposed amendments must be reasonable in number in the circumstances of the case. In the *Meril v Edwards Lifesciences* decisions of 19 July, the CD Paris highlighted that while the "*extremely high"* number of amendments submitted[5] could hinder the efficiency of UPC proceedings, in the present case this number does not seem unreasonable given the extreme complexity of the case (in particular, the number of grounds of invalidity raised), the importance of the patent at issue and the interrelationship with other proceedings, both judicial and administrative, concerning related patents of the same family.

Such an approach is in line with the pragmatic practice of the EPO.[6] Before the EPO, as before the UPC, less attention is thus paid to the number of applications to amend the patent than to the merits of the amendments to be studied, regardless of their combination.

Added matter: adoption of the EPO's gold standard

The *Meril v Edwards Lifesciences* decisions are particularly interesting on this point. Amongst the various added matter attacks raised, the UPC upheld as well-founded only the one directed towards feature 1.5 of amended claim 1, as constituting an intermediate generalization.[7]

The UPC gives a **definition of intermediate generalization**: *"extracting one or more isolated features which, in the initial application, were disclosed only in combination with other features, thereby extending the claimed subject matter, which is no longer limited to this initial combination of features*". This definition is **close to the one used by the EPO**.[8] Moreover, the CD Paris stresses that its analysis is in line with the one adopted by the EPO's Board of Appeal concerning another patent of the same family.[9]

In its decision of 19 June 2024 in *Abbott v. Sibio*[10] , the Hague Local Division (LD) had already **referred to the EPO's gold standard** regarding added matter. However, it would be hasty to conclude that the UPC's gold standard for added matter will always be the same as the EPO's one. Indeed, the Hague LD underlined that the parties had relied solely on EPO case law and that none of them had indicated whether – and if so, how – the UPC should apply a different standard. In other words, the UPC had no reason to depart *ex officio* from the EPO approach chosen by the parties but does not appear to be reluctant to adopt a different approach if invited to do so.

Claiming priority: rebuttable presumption of assignment of the right to claim priority

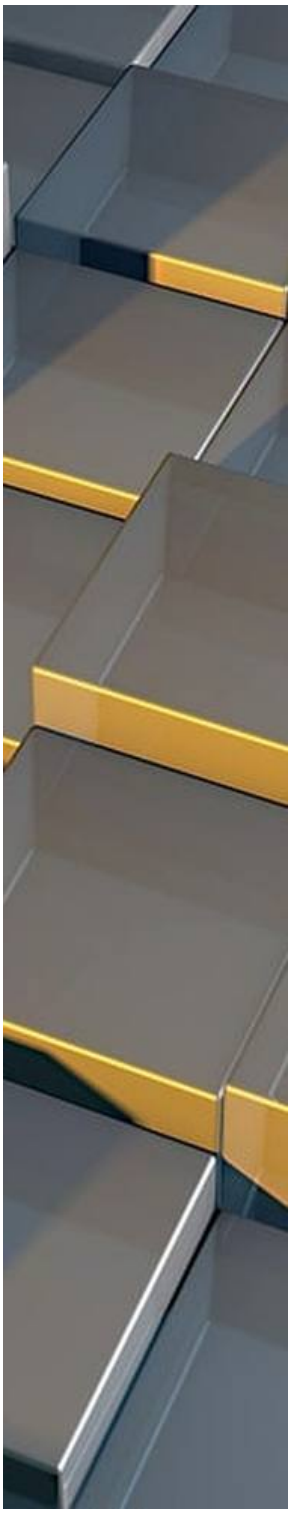
Here again, the *Meril v. Edwards Lifesciences* decisions are particularly interesting on this point.

According to Article 87(1) EPC, the applicant for a European patent who claims the priority of an earlier application must be the applicant for the earlier application or his/her successor in title. Meril challenged the assignment of the priority right by the applicants for P1 and P2 to Edwards Lifesciences. Edwards Lifesciences opposed the rebuttable presumption of assignment of the right to claim priority to the applicant claiming priority, adopted by the EPO's Enlarged Board of Appeal in **decisions G1/22 and G2-22 of 10 October 2023**.[11]

The UPC agreed with the patent owner's defense and **adopted the rebuttable presumption**. It emphasized "*that, under normal circumstances, any party transferring the right to a subsequent application intends for the subsequent applicant to benefit from the priority right, and that in most European national legislation formal requirements for transferring priority rights do not exist*".

These pro-patentee convergent positions of the EPO and the UPC will perhaps inspire the French judges who, for a long time, have adopted a stricter position according to which, in the absence of an express stipulation, the assignment of a patent or patent application does not necessarily include that of the Union priority right.[12]

Assessing the inventive step: a clear move away from the problem-solution approach



In the first part of our study, we had noted that although the UPC had never yet strictly applied the EPO's problem-solution approach, its approach – i.e. analyzing the prior art and the claimed solution objectively, from the point of view of the person skilled in the art – was not so different from the EPO's approach.

The *Meril v. Edwards Lifesciences* decisions of 19 July confirm this trend:

- Firstly, as the LD Paris in *DexCom v Abbott*, the CD Paris focuses its **reasoning on the technical effect of the invention and the technical problem to be solved**.
- Incidentally, it points out that it is up to **the claimant for invalidity to prove the lack of the alleged technical effect**, given the **presumption of validity of the granted patent**.
- In addition, in line with what other LDs have already done,[13] the CD Paris did not limit its analysis to the closest prior art but assessed the inventive step **in view of all the starting points proposed by the claimant for invalidity**.

However, the CD Paris holds an even more clear position than in previous decisions that **the UPC is not bound by the** EPO's **problem-solution approach**, noting that although this is the EPO and certain national courts' gold standard, it is not expressly provided for by the EPC and therefore does not seem mandatory. In any event, the CD Paris explains that in this case, even if it had followed the problem-solution approach, it would have reached the same conclusion. However, this observation is not really satisfying because the reasoning is not detailed.

In the *Bitzer Electronics v Carrier* decision of 29 July, the inventive step reasoning is short but, here again, the UPC does not strictly follow the problem-solution approach. It starts from the general technical problem of the invention (and not the objective technical problem) and looks in two prior documents to see whether a person skilled in the art would have been motivated to look for the distinctive features there.

In case of appeal, we'll follow them up.

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[1] UPC, CD Paris, 19 July 2024, UPC_CFI_255/2023 and EPC_CFI_15/2023, Meril v. Edwards Lifesciences.

[2] UPC, CD Paris, 29 July 2024, UPC_CFI_263/2023, Bitzer Electronics v. Carrier.

[3] UPC, CD Paris, 30 April 2024, UPC_CFI_263/2023, Carrier v. Bitzer Electronics.

[4] It refers to Article 76.1 UPCA which states: "*1. the Court shall decide in accordance with the requests submitted by the parties and shall not award more than is requested.*

[5] For information, the first application to amend the patent included 9 amendments which, combined, represented a total of 84 auxiliary requests.

[6] Case law of the EPO Boards of Appeal, V-A 5.12.12.

[7] With regard to the other claims of the first application to amend, the UPC noted that, as this application differs from the patent as granted only in that, dependent claims 2-4, 7-9 and 12 are deleted, it suffers from the same ills as claim 1 as granted. It is therefore dismissed.

[8] EPO Guidelines, H-V 2.2.1 and Case law of the EPO Boards of Appeal, II-E 1.9.1.

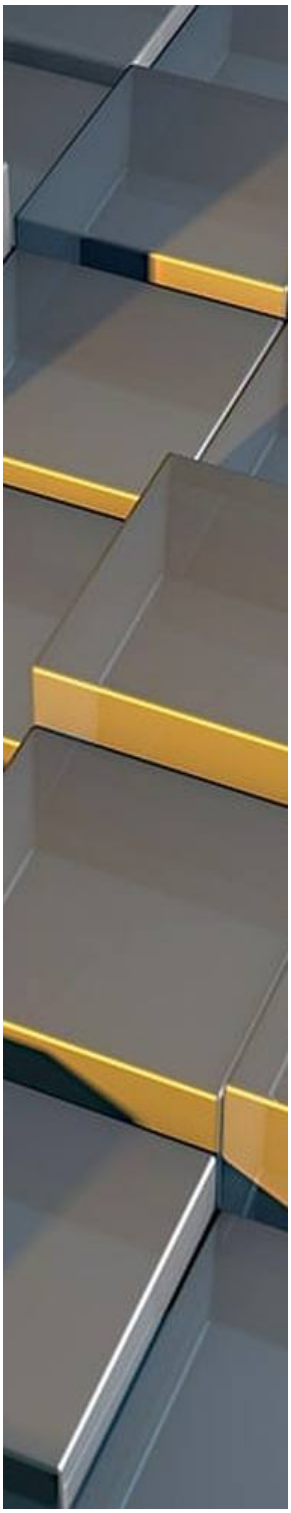
[9] EPO Board of Appeal, 1er Dec. 2023, T0314/23, concerning patent EP 3 583 920 resulting from the same application WO'801 as patent EP'825.

[10] LD The Hague, 19 June 2024, UPC_CFI_131/2024, Abbott v. Sibio.

[11] Enlarged Board of Appeal of the EPO, 10 Oct. 2023, G1/22 and G2/22, Alexion v. Novartis; see also the press release of 10 October 2023 concerning decisions G 1/22 and G 2/22 of the Enlarged Board of Appeal. Prior to this reversal, if the applicant for the European patent application differed from the applicant for the priority, the EPO required a written agreement for the transfer of the priority right, signed before the filing of the subsequent application.

[12] French Supreme Cour, Commercial chamber, 18 June 1996, docket No. 94-18.909.

[13] LD Düsseldorf, 11 December 2023 (*ex parte*) and 9 April 2024 (*inter partes)*, UPC_CFI_452/2023, Ortovox v. Mammut; DL Munich, 19 September 2023, UPC_CFI_2/2023, Nanostring v. 10x Genomics followed by JUB, CA, 26 February 2024, UPC 335/2023, 10x Genomics v. Nanostring; DL Düsseldorf, 30 April 2024, UPC_CFI_463/2023, 10x Genomics v. Curio Biosciences; LD Munich, 21 May 2024, UPC_CFI_443/2



023, Dyson Technology Ltd. v. SharkNinja.