IAM

The Patent Prosecution Review

2027

Specialist chapter: A spotlight on UPC revocation actions, validity case law and parallel EPO opposition proceedings

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Specialist chapter: A spotlight on UPC revocation actions, validity case law and parallel EPO opposition proceedings

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SUMMARY
Revocation actions and counterclaims for revocation are an essential measure for accused or potential patent infringers to prevent adverse infringement rulings, either proactively or in response to being sued. By now, almost half of all first-instance filings before the UPC relate to validity. With a growing number of decisions from the Court of Appeal, the case law is gradually stabilising – particularly on validity issues – and outcomes are therefore becoming more predictable than in the early phase of the UPC. Compared to EPO opposition proceedings, the UPC offers faster timelines, but due to its front-loaded approach, it requires strict procedural discipline and careful advance planning. To combine the advantages of both systems, parallel use of EPO opposition and UPC revocation proceedings is gaining importance. This dual-track approach opens up a range of strategic options for challengers to exert pressure on patentees and maximise the chances of invalidation. For patentees, this development makes consistency across proceedings crucial and calls for even more careful planning at an early stage.

DISCUSSION POINTS

- Statistics for revocation cases
- Recent case law relating to validity
- Comparison between UPC revocation and EPO opposition proceedings
- Parallel EPO and UPC proceedings
- Strategic considerations for patentees and challengers

REFERENCES IN THIS ARTICLE

- *Meril v Edwards* (UPC CoA 464/2024 of 25 November 2025)
- *Amgen v Sanofi/Regeneron* (UPC CoA 528/2024 of 25 November 2025)
- *NanoString v 10x Genomics* (UPC CoA 335/2023 of 26 February 2024)
- *expert e-Commerce v Seoul Viosys* (UPC CoA 764/2024 and UPC CoA 774/2024 of 2 October 2025)
- *Abbott v Sibio* (UPC CoA 382/2024 of 14 February 2025)
- *Guardant Health v Sophia Genetics*(UPC CoA 19/2026 of 2 July 2026)
- *Juul v NJOY* (UPC CoA 237/2025 of 28 April 2025)
- *Carrier v Bitzer* (UPC_CoA_22/2024 of 28 May 2024)
- *JingAo Solar v Chint New Energy* (UPC_CFI_425/2024 of 31 March 2025)
- *NJOY v VMR Products* (UPC_CFI_310/2023 of 22 January 2025)
- *Winkelmesseinrichtung* (German Federal Court of Justice decision Xa ZB 14/09 of 21 October 2010)

CASE STATISTICS: UPC CONTINUES TO GROW IN VOLUME, EUROPEAN REACH AND CASE LAW

As the UPC enters its fourth year of operation, its caseload continues to grow. In the first six months of 2026, 268 cases were filed before the Court of First Instance, compared with 223

in the same period in 2025 and 165 in the first half of 2024. This represents an increase of approximately 20% compared with the first half of 2025 and more than 60% compared with the first half of 2024. The figures demonstrate that the UPC has become an increasingly established and widely used forum for European patent litigation.

Validity remains a central feature of the court's work. Of the 268 first-instance filings in the first half of 2026, 117 were counterclaims for revocation and 11 were standalone revocation actions. Validity-related proceedings therefore represented 48% of all first-instance filings. This confirms that the UPC is developing not only as an enforcement court, but also as a major forum for attacking the validity of European and unitary patents.

The German local divisions continue to form the operational backbone of the first-instance system. Düsseldorf, Hamburg, Mannheim and Munich received 156 of the 219 infringement actions and counterclaims for revocation filed during the first half of 2026. At the same time, activity before other European divisions is also expanding, with The Hague emerging as the busiest non-German local division. The figures therefore show growth across the system as a whole: the German divisions continue to increase their absolute caseload, while other European venues are also gaining momentum.

The concentration of proceedings in the German local divisions became the subject of political discussion during the first half of 2026. However, following an extensive consultation, the UPC Presidium and the Administrative Committee confirmed that the claimant's freedom of forum choice should remain untouched and declined to introduce any proactive redistribution of cases. The continued prominence of the German local divisions is therefore the result of litigants' own forum choices, and reflects both Germany's longstanding position as one of Europe's leading patent litigation venues and users' confidence in the experience, expertise and predictability of the judges in Germany who have brought that tradition into the UPC system.

The expansion of judicial capacity reflects this sustained demand. Munich has operated with two panels since 2024. Düsseldorf added a second panel with effect from 1 March 2026, bringing the total number of panels at the four German local divisions to six: two each in Düsseldorf and Munich, and one each in Hamburg and Mannheim. The additional panels demonstrate the court's ability to adapt its resources to the growth of its busiest venues.

The geographical concentration of proceedings in Germany is accompanied by an increasingly international choice of language. English was used in 42% of first-instance cases at the end of 2023, rising to 58% by the end of 2025 and to 68% of cases filed in the first half of 2026. German accounted for 27% during the latter period. This is a particularly notable development: although the German local divisions remain the most active venues, proceedings are increasingly conducted in English.

The growth of the Court of Appeal is equally important. The number of main appeal cases increased from 117 in 2024 to 157 in 2025, with a further 79 main appeal cases filed during the first half of 2026. The Court of Appeal has expanded from two to three panels, with the third panel having become operational in January 2026. As more substantive infringement and validity decisions reach the appellate stage, the Court of Appeal to an increasing extent can clarify the relationship between UPC, EPO, its Boards of Appeal and national court case law.

RECENT CASE LAW ON VALIDITY ASPECTS

UPC case law on patent validity has developed significantly over the past year. The most prominent and potentially most consequential developments concern inventive step. In two coordinated judgments,***Meril v Edwards*** and ***Amgen v Sanofi/Regeneron***, issued on the same day by the Court of Appeal's then two active panels, the court set out a structured but distinctly UPC-specific framework for assessing obviousness. In doing so, it marked an important step away from a mechanical, formalistic application of the EPO's problem-solution approach while confirming that the underlying substantive assessment remains closely aligned with established European patent law principles.

The Court of Appeal made clear that the different approaches used across Europe – including the EPO's problem-solution approach and more holistic national approaches – are guidelines rather than mandatory legal tests. The decisive question remains whether, taking into consideration the prior art, the claimed invention would have been obvious to the skilled person.

The court's analysis starts with identifying the problem addressed by the invention. Unlike the EPO, however, the UPC does not derive this problem primarily from the differences between the claim and the closest prior art. Instead, the problem is determined from the patent itself, looking at the claim as a whole in the context of the description and drawings, and considering the technical teaching and contribution that the skilled person would understand from the patent.

Once that problem has been identified, the court asks whether there was a realistic starting point in the prior art. A prior-art document may qualify if it would have been of interest to the skilled person seeking to solve the problem. Importantly, there may be more than one realistic starting point, and the claimed invention must be inventive over each of them. This is a notable difference from the EPO's tendency to focus the analysis on the "closest" prior art.

From there, the court requires a pointer or motivation that would have led the skilled person from that realistic starting point towards the claimed solution. It is not sufficient that the skilled person could have arrived at the invention; the question is whether they would have done so, prompted by the prior art.

For litigants, the message is clear: EPO-style arguments should not simply be copied into UPC proceedings. A successful UPC validity attack must explain why the cited prior art was a realistic starting point and why the skilled person had a concrete reason to take the next step towards the invention.

Added matter is another area in which the UPC is beginning to develop its own jurisprudential approach within the familiar framework of the EPC. The legal starting point is unsurprising: the Court of Appeal applies a direct-and-unambiguous disclosure test corresponding to the EPO's "gold standard", asking whether the skilled person can derive the claimed subject matter directly and unambiguously from the application as filed, read as a whole. The more interesting development lies not in the articulation of the legal test itself, but in the manner in which the court applies it in practice.

Building on ***NanoString v 10x Genomics***, the Court of Appeal applies a single approach to claim interpretation for both infringement and validity: the claims are interpreted in light of the description and drawings. That same approach was then applied in the added-matter context in ***Meril v Edwards*** and ***expert e-Commerce v Seoul Viosys***. The court first identified the technical meaning of the claim before assessing whether that subject matter was directly

and unambiguously disclosed in the application as filed. The sequence is significant because it determines the subject matter against which compliance with article 123(2) of the EPC is assessed. For litigants, claim interpretation has therefore become a gateway issue: the way in which the claim is construed may determine not only infringement and validity, but also whether the claim survives scrutiny under article 123(2).

The UPC's treatment of intermediate generalisations illustrates how differences in application may emerge despite a common legal standard. Here too, the UPC appears to apply the gold standard through a contextual assessment of the technical teaching disclosed to the skilled person in the application, rather than through a more formal comparison of feature combinations. In ***Abbott v Sibio***, the court accepted the omission of a specific elastomeric sealing feature because the application taught the need for sealing, but did not present the precise sealing material as essential to the invention. In ***Meril v Edwards-***, the court took the same contextual approach, asking whether omitted features were structurally or functionally linked to the disclosed technical teaching. Thus, the UPC is not applying a simple rule that features disclosed in combination must always remain combined. Instead, it asks whether the omitted feature belongs to the technical contribution disclosed in the application. Compared with the EPO's generally critical approach to intermediate generalisations, under which features disclosed in combination will often need to remain combined, the UPC's approach may lead to a more narrative, holistic analysis in practice.

In ***Guardant Health v Sophia Genetics***, the UPC made the same broader point in a different added-matter setting. The issue here was not so much omission of a feature from an embodiment, but whether the claimed combination resulted from impermissible selections from the original disclosure. The Court of Appeal rejected the first-instance added-matter finding and held that the combination was directly and unambiguously disclosed when the application was read as a whole, including the original claims, the description and an example.

UPC REVOCATION ACTIONS AND EPO OPPOSITION PROCEEDINGS

Whereas a nullity action in the German national patent system is inadmissible during the opposition period and during pending opposition proceedings, the UPC offers greater flexibility. A revocation action – whether standalone or as a counterclaim – can be filed with the UPC while the opposition period is still running and while opposition proceedings at the EPO are pending, provided of course that the patent is a unitary patent or a European bundle patent that has not been opted out. This remains the case even where the same party pursues both the revocation and opposition actions, thus allowing challengers to choose between the two routes or pursue them in parallel as part of a coordinated invalidity strategy.

Advantages Of EPO Opposition Proceedings

The introduction of UPC revocation actions is unlikely to ever displace EPO opposition proceedings. One fundamental reason is their different territorial reach. While a UPC revocation only has effect for the 18 member states currently participating in the unitary patent system, an EPO opposition extends to all 40 EPC member states, notably including countries like Switzerland and the United Kingdom, plus – if applicable – extension and validation states. Further, the total expenses for EPO opposition proceedings are, as a rule, considerably lower than for a UPC revocation action. It must be noted however that in UPC proceedings, a substantial proportion of costs can generally be recovered and claimed from the losing party, which is not the case at the EPO. A third consideration is the potential

divergence in the practical application of EPC validity standards. In particular, the EPO's traditionally strict approach to added matter, including intermediate generalisations, may result in patents being revoked in opposition proceedings that might survive a validity challenge before the UPC. This provides a further strategic reason for pursuing both routes, offering challengers two opportunities to attack the same patent before different forums.

Advantages Of UPC Revocation Actions

An upside for the UPC is that the streamlined proceedings often lead to a faster decision, and the tight timeline puts substantial pressure on patentees that must prepare their full defence strategy, including any auxiliary claim requests, within two months. This leaves limited time to develop amendments and potentially creates strategic opportunities for the challenger. The UPC's first-instance decision on the revocation action is generally issued around one year after its filing. In contrast, an EPO opposition takes approximately two years from filing the notice of opposition until oral proceedings. If the case goes up to the second instance, the duration is roughly double – the UPC appeal stage takes approximately another year, while the appeal at the EPO typically takes another two years.

Case-specific Aspects

There are further differences between UPC revocation actions and EPO opposition proceedings, which may be an advantage or disadvantage depending on the circumstances of the case. EPO opposition proceedings allow challengers to pursue a broad and technically highly detailed validity attack, often involving numerous lines of attack and extensive combinations of prior-art documents. By contrast, UPC proceedings require a more focused litigation strategy, with the court generally expecting the parties to concentrate on the strongest attacks. This difference may be particularly relevant in technically complex cases: EPO opposition divisions are composed of technical members, whereas UPC panels have a majority of legally qualified judges. As a further example, oral proceedings before the EPO are more fragmented, with individual issues often addressed separately, while UPC hearings involve shorter summary pleadings followed by a single decision. Finally, first-instance oral proceedings before the EPO are generally conducted by video conference, which may be advantageous where cost-efficiency is important but less desirable for high-stakes disputes.

EPO Opposition And UPC Revocation In Parallel

The more important the outcome of a patent dispute, the more advisable it is to file both an EPO opposition and a UPC revocation action. While this naturally increases costs, the party seeking revocation retains a second opportunity to convince a different forum if the first attempt is unsuccessful. A further strategic consideration is the timing of the two proceedings: given the strict rules on late-filed submissions before both the UPC and the EPO, choosing the second forum at a later stage may preserve the possibility of introducing additional prior art or new lines of attack identified only after the first action has been initiated. A specific aspect to consider in parallel proceedings is whether the UPC action will be stayed. If the same party files both the notice of opposition and the revocation action at approximately the same time, the faster UPC proceedings will generally lead to an earlier decision, meaning that the requirements for a stay are unlikely to be met. This applies even though the EPO has introduced measures to accelerate opposition proceedings in cases involving parallel UPC actions (cf OJ EPO 2023, A99). However, parallel proceedings may also occur because another party has already filed an opposition. If in such cases a decision by the EPO is expected rapidly, the UPC may generally stay its proceedings. For example, in

Juul v NJOY, a final decision of the EPO Boards of Appeal was to be expected only some days before or after the possible date for an oral hearing before the UPC Court of Appeal, so the latter stayed its proceedings based on an agreement between the parties. Still, the hurdles for a stay are rather high.

Another aspect in the context of parallel proceedings is the risk of conflicting decisions between the EPO and the UPC regarding the validity of the patent. The UPC Court of Appeal has addressed this point in *Carrier v Bitzer*, clarifying that if either the UPC or the EPO fully revokes the patent in a final decision, no matter in which order the decisions are issued, the patent is at least invalidated for the UPC territory. However, the court has not touched the more complex case where a patent is maintained by the EPO and the UPC in different amended forms (in particular with different independent claims). While the order of decisions may play a role in such constellations, the legal framework remains largely unresolved. Recent case law suggests that the UPC is willing to be somewhat pragmatic to avoid misalignment: In *JingAo Solar v Chint New Energy*, the patentee was allowed to adapt the claims in the UPC proceedings to the claims that had survived the EPO opposition, even though the respective auxiliary requests were late filed in the UPC proceedings from a formal point of view. In this regard, the court emphasised "the aim of the Rules of Procedure to synchronise proceedings before the UPC with those before the EPO".

In *NJOY v VMR Products*, the patentee filed two new auxiliary requests after the interim conference, likewise seeking to align the claims in the UPC revocation proceedings with the outcome of parallel EPO opposition proceedings. The Paris Central Division, while acknowledging the interests of legal certainty and procedural efficiency, ultimately refused to admit the amendments as late filed. The court nevertheless noted that even if the auxiliary requests had been admitted, they would not have overcome the lack of inventive step identified for the main request. Ultimately, the UPC panel maintained the patent with a scope of protection different from that upheld by the EPO opposition division, with appeals pending before both forums. The case illustrates that although the UPC may seek alignment with EPO decisions where reasonably possible, patentees must be prepared for divergent outcomes and potentially different claim scopes before the two systems. It will be interesting to see how this interplay develops as the respective appeals progress and, ultimately, which forum reaches a final decision first.

Strategic Considerations

From a practical perspective, parallel EPO opposition and UPC revocation proceedings are increasingly used as coordinated, complementary measures, especially for invalidating a patent with high commercial relevance right after grant. From the challenger's point of view, timing considerations tend to favour the UPC as a "fast track" that drives commercial timelines, whereas the EPO serves as a "deep validity track" with more detailed technical review and broader territorial effect. This constellation can be exploited tactically: filing a UPC revocation action first and an EPO opposition shortly afterwards will usually mean that the UPC is unlikely to stay its proceedings. Thus, the patentee is forced to run at UPC speed while simultaneously having to prepare for the more detailed technical "deep dive" at the EPO. Moreover, since opposition proceedings at the EPO are accelerated in the presence of parallel UPC actions, tighter deadlines can significantly increase pressure on the patentee to organise and present a consistent validity defence in both forums in short succession. In addition, the patentee's submissions at the UPC on claim construction and inventive step can be used as a blueprint for attacks in the later, more detailed notice of opposition.

Nevertheless, there may also be good reasons for staggering filings. Bringing a UPC revocation action after an unsuccessful EPO opposition offers a second attempt at revocation before a different panel and under a different approach to inventive step. A later-filed UPC action is particularly attractive, of course, if relevant prior art only becomes known after expiry of the nine-month opposition period, as this prior art cannot normally be introduced into opposition proceedings but can be fully relied upon before the UPC.

From the patentee's perspective, a key element in parallel proceedings is the auxiliary-request strategy, which will almost always differ between both forums. At the EPO, auxiliary requests can be much more fine graded, with a large number of fallback positions in various combinations being admissible at least in the first instance. This allows patentees to defend the patent across a wider spectrum of amended claim sets. Before the UPC, by contrast, the number of auxiliary requests is more limited and the court expects a streamlined presentation focused on a manageable set of claim variants. Consequently, the respective sets of auxiliary requests used in EPO and UPC proceedings will usually differ in practice, but they must still be aligned to maintain overall consistency of the patentee's defence. The practical message for patentees is therefore that parallel proceedings require careful and coordinated planning. Claim amendment strategies should be designed with both forums in mind from the outset rather than separately to minimise the risk of inconsistency.

OUTLOOK

As the UPC has established itself as a major venue for patent litigation, the foundations of its validity case law have also been laid. Landmark decisions on claim interpretation, added matter and inventive step now provide a predictable framework and demonstrate that the Court of Appeal is developing a distinctly UPC-specific approach rather than simply replicating EPO or national practice. Nevertheless, important questions concerning more specialised validity issues remain open. For example, the so-called "inescapable trap" constellations under articles 123(2) and 123(3) of the EPC, which may lead to full revocation of a patent before the EPO, remain a particularly relevant area of divergence. While the EPO generally applies a strict approach, the German courts have taken a more lenient stance in decisions such as ***Winkelmesseinrichtung***, where the Federal Court of Justice held that an added feature that merely limits the scope of protection without altering the technical teaching of the invention does not necessarily require revocation. This approach is sometimes referred to as the "footnote solution" because the contested feature may effectively remain in the claim with a limitation on its legal effect. It will be interesting to see how the UPC positions itself in relation to EPO and national case law when confronted with these and other specialised validity issues.

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