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The Court of Appeal of the Unified Patent Court Sets a High Bar for Preliminary Injunctions

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The Unified Patent Court opened its doors on 1 June 2023 and its case load has grown steadily.¹ In February 2024, the Court of Appeal handed down *10x Geomics v Harvard*² where it addresses, for the first time, some key questions: the standard of proof for preliminary injunctions, scope of protection, and who must determine compliance with the application requirements.

Standard of proof

It is likely that the most important aspect of the Court of Appeal's decision relates to the standard of proof that must be met in terms of establishing validity and infringement of the patent before any preliminary measures (interim injunction) can be granted. The court accepted that the opportunity to present facts and evidence is limited at the preliminary stage and requiring too much at this point may prejudice the patent holder.³ Conversely, the court also acknowledged that setting the bar too low could cause the defendant to be harmed should the measures (interim injunction) be revoked later where, for instance, the applicant loses at trial.

The rules state that to grant provisional measures the applicant must provide "reasonable evidence to the Court with a sufficient degree of certainty" that the applicant is entitled to start proceedings and the patent is valid and infringed.⁴ Initially, the court confirmed that the burden of proof when seeking an injunction falls upon the applicant/patent holder.⁵ This is provided in the UPC Agreement itself⁶ and so the finding is hardly surprising. Much more significant is the Court of Appeal set out the degree of certainty required to obtain an interim injunction pending trial, namely that it is "at least more likely than not" that the patent is valid *and* infringed and if the court considers "on the balance of probabilities" that the patent is invalid (or is not infringed) no measures should be granted.⁷

The Court of Justice in C-44/21 *Phoneix Contact*⁸ held that from the date of publication of the grant of the patent it enjoys a presumption of validity. On the other hand, the applicant is required by the procedural rules⁹ to inform the court where the validity of a patent at issue (or a member of the patent family) is being attacked.¹⁰ Nevertheless, as the Court of Appeal made clear in *10x Geomics*, the burden of proof in respect of validity falls on the defendant.¹¹ A defendant therefore needs to show on the balance of probabilities that the patent in question is invalid.

The standard of proof being the balance of probabilities at the *preliminary/interim* stage appears to present very high hurdles for each party to clear. Indeed it is a very different approach to that adopted in the United Kingdom, Ireland and New Zealand where all that needs to be shown is that

¹ By the end of February 2029, there had been 274 cases started and 96 infringement actions started 72 of these infringement actions were started across four local divisions in Germany (in second place is France with 9 actions being started at the Paris local division).

² UPC CoA 335/2023 (26 February 2024).

³ *10x Geomics*, p 27.

⁴ Rule 211(2); this is a slightly more tightly worded version of UPC Agreement, art 62(4).

⁵ *10x Geomics*, p 28

⁶ UPC Agreement, art 54 (albeit there can be a reversal in the limited circumstances set out in art 55).

⁷ *10x Geomics*, p 27.

⁸ EU:C:2022:309 at [41].

⁹ Rule 206(2)(d) and 211(2).

¹⁰ *10x Geomics v Harvard*, CFI 2/2023 (19 September 2023), p 57 [3(b)].

¹¹ *10x Geomics*, p 28.

there is a “serious question to be tried”:¹² a standard often described as “very low”.¹³ The UPC is applying a standard even higher than the *prima facie* standard applied in Australia.¹⁴ Indeed, something being proved on the balance of probabilities is usually, in common law civil proceedings, the standard applied at trial for a final determination. This suggests the Court of Appeal’s decision imposes a *much* higher standard of proof to obtain an injunction pending trial.

The requirement to establish infringement and validity on the balance of probabilities might suggest that preliminary hearings become “mini-trials”. The court only able to be satisfied of something to the relevant standard where there is sufficient evidence lead to make a decision. Alternatively, it could be the courts simply balance the evidence before it – however inadequate - to determine whether the facts are established on a balance of probabilities. But this outcome would be subject to what it said in relation to the application requirements, discussed below. Finally, it might be that what common lawyers view as the balance of probabilities is different from those words when uttered by civilian lawyers or the UPC. Indeed, the Boards of Appeal at the European Patent Office has used a wide variety of phrases to explain the standard of proof but ultimately taken the view it is for each Board to decide the standard based on the free evaluation of the evidence.¹⁵

So it may be that, in due course, another composition of the Court of Appeal adopts a different standard. Indeed, the Court of First Instance in the same case highlighted various possibly meanings for “sufficient certainty”: “some likelihood”, “preponderant likelihood”, “substantial likelihood”, “high likelihood”, “likelihood bordering on certainty” as well as merely “possible”.¹⁶ But each of these alternatives seems to suggest that “certainty” – what common lawyers might see as “beyond reasonable doubt” – might be the appropriate standard applied to findings of infringement and validity during the final determination on the merits. This present real challenges for claimants, seeking to establish infringement, and defendants seeking to demonstrate invalidity.

Scope of protection

The Court of Appeal also addressed another central question, how to interpretation the scope of protection granted for a patent. It stated:¹⁷

“The patent claim is not only the starting point, but the decisive basis for determining the protective scope of a European patent. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used (see also the German and

¹² *American Cyanamid Co v Ethicon* [1975] AC 396, 407; which has been largely followed in New Zealand, *Pasquarella v National Australia Finance Ltd* [1987] 1 NZLR 312, 313–14. It is also the standard applied in Ireland, which is presently seeking to become a party to the UPC: *Merck Sharpe and Dome v Clonmel Healthcare Ltd* [2019] IESC 65, [30].

¹³ *Abdul Mojib v Mujibur Rahman Chowdhury* [2020] EWHC 2732 (Ch) at [2]; *Pasture Properties v Evans*[2013] IEHC 205; *Skibsted v. Canada (Environment and Climate Change)*, 2021 FC 301 at [38];

¹⁴ In Australia, it appears the correct standard has returned to a “prima facie” based on *Beecham Group v Bristol Laboratories* (1968) 118 CLR 618. But this appears to have been qualified downwards by the High Court in *Australian Broadcasting Corporation v O’Neill* [2006] HCA 46 [65].

¹⁵ Phillip Johnson, Ashley Roughton and Trevor Cook, *Roughton, Johnson and Cook on Patents* (5th Ed, 2022), [2.52] and [17.25]; also see Phillip Johnson “It’s all very plausible: the free evaluation of evidence at the European Patent Office” (2023) 131 Intellectual Property Forum 94.

¹⁶ *10x Geomics v Harvard*, CFI 2/2023 (19 September 2023), p 55[4] (the reference to possibility was to contrast it with German procedure).

¹⁷ *10x Geomics*, p 24.

French language versions of the Protocol on Interpretation: “aus dem genauen Wortlaut der Patentansprüche”, “sens étroit et littéral du texte des revendications”). Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim.

However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.

The patent claim is to be interpreted from the point of view of a person skilled in the art.

In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties. “

This appears to be a gloss on the Protocol of Interpretation on Article 69 of the European Patent Convention with some words being slightly different (eg “fair protection” vs “adequate protection”; “reasonable degree” vs “sufficient”). It therefore provides little guidance to litigants as to the correct approach to claim interpretation in the future and, critically, it does not deal with Article 2 of the Protocol which provides for equivalents. Nevertheless, the Court of Appeal did make it clear that the scope of protection for validity is the same as for infringement.¹⁸ But when it applied its own rules on the scope of protection, it did little more than evaluate the consistency between the description and the claims.

The Court of Appeal did, however, give an indication as to the importance of technical judges. It appears the court will rely on them both for technical information¹⁹ and also, if the Court of First Instance was right, as a representative of the skilled person.²⁰ This raises interesting issues as to the weight given to expert evidence in the future. Overall, however, the explanation given by the Court of Appeal on the approach to claim construction is just as problematic as the Protocol itself. The correct approach falls between two poles but where precisely it falls in that range is simply unknown.

Compliance with application requirements

An application for provisional measure must include certain things each of which is set out in rule 206(2). These fall into two types. There are things which are purely formal,²¹ such as names and addresses of parties, and this can be considered solely by the registry.²² But the other type of information, namely indicating what provisional measure is being sought, the reason why the measure is necessary to prevent an infringement, the facts and evidence relied upon in support of the application and a description of the action which will be started before the court are substantive. Accordingly, it is for the court to consider whether these have been complied with or not. Critically, however, the compliance with these requirements goes to the *merits* of the application for provisional measures.²³ So the court will evaluate the information (and its sufficiency) when deciding whether or not to impose provisional measures. This means the

¹⁸ *10x Geomics*, p 25.

¹⁹ *10x Geomics*, p 33.

²⁰ *10x Geomics v Harvard*, CFI 2/2023 (19 September 2023), p 57 [4].

²¹ See rule 206(2)(a).

²² *10x Geomics*, p 21.

²³ *10x Geomics*, p 21.

requirements are not a gateway – admissibility requirement – which the court has to be considered before moving on to consider the application itself.

Concluding thoughts

The Unified Patent Court does not have a system of precedent, and so this decision of the Court of Appeal might not be the last word. The guidance on scope of protection – although thought to be significant enough to make the Headnote – elides many tricky questions and is largely restating the Protocol on Interpretation itself. The decision's lasting significance is more likely to be its determination of the standard of proof, if followed, it could have a lasting and profound effect on the availability of preliminary measures before the Unified Patent Court.