

Kluwer Patent Blog

Helsinki division Unified Patent Court clarifies (reversal of) opt-out provision

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The Helsinki division of the Unified Patent Court rejected an injunction request by AIM Sport against Supponor, because the reversal of the opt-out of the patent in dispute was deemed in contradiction with the UPCA.



Article 83 (4) of the Unified Patent Court Agreement reads: ‘Unless an action has already been brought before a national court, proprietors of or applicants for European patents (...) who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment.’

During the sunrise period, AIM Sport had opted out its patent [EP 32 95 663](#) (digitally overlaying an image with another image, a technology which is used for advertising in sports stadiums) from the UPC system. As national litigation in the UK and Germany concerning the same patent is still pending, the panel of judges found that the opt-out could not be reversed. They rejected AIM’s view that article 83(4) only refers to national proceedings filed after the entry into force of the UPC.

The panel was composed of Petri Rinkinen (presiding judge), Melanie Bessaud, Samuel Granata and technically qualified judge Eric Augarde.

According to a JUVE Patent analysis, the decision could affect thousands of opted-out patents and ‘potentially put a brake on the supranational court’s development’. On LinkedIn, Sabine Agé of Hoyng Rokh Monegier commented ‘patent holders should therefore carefully consider whether to opt-out, having in mind the risk of being locked-out of the UPC jurisdiction’.

Access to documents

Another interesting development in these first months of the UPC concerns two decisions of judge-rapporteur András Kupecz at the Munich central division, about transparency at the court and the access to documents, as laid down in Rule 262.1(b) of the Rules of Procedure.

In a decision delivered on 20 September 2023 (case [464985/2023](#)), an applicant requested ‘access to the content of the register for the above identified revocation action against European patent EP3666797, including all written pleadings and evidence filed in the context of this revocation action.’

‘As a (sufficient) legitimate reason for gaining access to the written pleadings and evidence, the wish to form an opinion on the validity of the patent under consideration is brought forward. As a member of the public and a patent attorney, this was both a personal and a professional interest.’

The Munich central division argued that the ‘mere “wish” from a natural person to form “an opinion” on the validity of a patent out of a “personal and a professional interest” cannot be accepted as a sufficiently concrete, legitimate reason to make available all pleadings and evidence in this case. Apart from the lack of concrete and verifiable information in the reason stated by the Applicant, the Court fails to see why access to the written pleadings and evidence in this particular case would be useful, let alone necessary in order to fulfil a wish of forming an opinion on the validity of the patent. The Applicant can study the patent and its (public) prosecution history as well as the prior art without access to what the parties to the proceedings have submitted. The fact that the Application concerns a revocation action concerning a European patent which, as argued by the Applicant, “confers rights on the patent proprietor(s) with erga omnes effect”, does not make this assessment different. The general public can likewise inform themselves based on other sources than the pleadings and evidence filed in this action.’

The next day, in [case 464985/2023](#), the court again declined access to case documents: ‘To be informed of the proceedings before the Unified Patent Court for the purposes of education and training is not a legitimate reason as required by Rule 262.1(b) RoP. It is also insufficiently concrete and verifiable. No legal basis to give access to letter for service.’

Interestingly, in the final paragraphs of this decision the court writes: ‘The Court is aware that Rule 262.1(b) RoP has been met with criticism by a number of commentators in the context of transparency of court proceedings. Hence, a clear and consistent interpretation of a “reasoned request” pursuant to Rule 262.1(b) RoP and a consistent application of said Rule is especially important (also see Preamble RoP, paragraph 8).5.’

Revocation actions

Finally, the number of revocation actions at the UPC has so far been very limited, but this is starting to change, [as Joeri Beetz pointed out](#). Eight revocation actions were filed last week by the Dutch branch of e-cigarette producer NJOY, against Juul Labs and VMR.

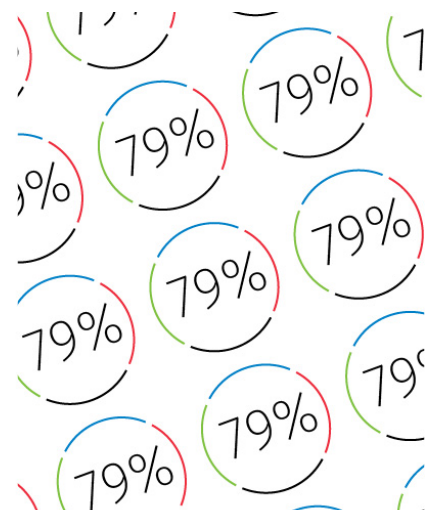
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