Kluwer Patent Blog

Unified Patent Court: no second preliminary injunction for 10x Genomics against NanoString

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The Unified Patent Court has refused to grant 10x Genomics a second preliminary injunction against rival NanoString, as it was not convinced of the infringement of 10x's patent.

The case concerned European Patent 2 794 928 B1 (EP 928 patent). In a reaction to the decision, 10x Genomics pointed out: 'the injunctions granted by the Regional Court Munich I in May and by the UPC in September both remain in full force and effect and are not affected by today's decision in terms of scope or duration. The September injunction prevents NanoString from selling or providing services using its CosMx Spatial Molecular Imager (SMI) instruments and CosMx reagents for RNA detection in all 17 countries of the UPC based on NanoString's infringement of European Patent 4 108 782 B1 ("the EP 782 patent," docket No. 459756/2023). The EP 928 patent is in effect in only a subset of the 17 UPC countries – Germany, France and the Netherlands. Had it been granted, the injunction for the EP 928 patent would not have changed the scope of the injunction that is already in effect.'

In September, 10x Genomics won a PI against NanoString for infringing European Patent 4 108 782 B1. That was the UPC's first PI in a case were an oral hearing was held with both parties. NanoString immediately announced it would appeal the order in the UPC Court of Appeal in Luxembourg. 10x Genomics has not yet made clear whether it will appeal the UPC's decision concerning the EP 928 patent.

Reasoned decision in first case

A certified English translation of the reasoned decision on the first PI has become available on the EPLAW website.

As to the validity of the patent in suit, the UPC decision reads: 'The Local Division is also satisfied with a clear preponderance of probability that the patent in suit is valid; (…) The Local Division is also clearly convinced that provisional measures are necessary due to the infringement of a valid patent, both in terms of substance and time. (…) The Local Division also does not see the possibility of longterm harm resulting from the granting of the provisional measures or their refusal

as being one-sided to the detriment of Respondents.'

On the Pinsent Masons website, Julia Traumann writes 'burdens will attach to preliminary patent injunction applications'. 'Stating that the claimants do not bear the initial burden of proof for the validity of the patent in suit, but then asking claimants to provide evidence on the validity of the patent in suit, appears to be inconsistent at first, even when understanding the legal nuance. In any case, it has significant implications for claimants. It means that they must prepare and submit evidence on the validity of the patent in suit, and even other patents belonging to the same patent family if they are under a validity attack, at a very early stage of litigation – specifically, when applying for a preliminary injunction.'

In an analysis for EPLIT, Michael Wallinger also points out: 'The court rejects the Defendants' argument that according to German national case law, the revocation of the patent does not have to be predominantly probable, but only possible, with the remark that "this case law on national procedural rules" is "not relevant in the scope of application of the UPCA and the RoP".'

In his conclusions, Wallinger applauds the court: 'With this judgement, the newly installed Unified Patent Court shows its strength. The streamlined conduct of proceedings established by the Rules of Procedure and, in particular, the technical expertise on the bench allow the court to decide even technically complex matters in a very efficient time frame.'

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