HOFFMANN EITLE

5th Anniversary Issue

HOFFMANN EITLE QUARTERLY

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Editorial

Five years. Twenty issues. Over one hundred articles. When we published the first Hoffmann Eitle Quarterly in June 2021, the UPC was still a promise on paper, AI patentability was uncharted territory, and "plausibility" remained an unresolved riddle at the EPO. Looking back, these pages have chronicled a remarkable transformation of the European IP landscape – from Austria's ratification of the PPA to the UPC's first decisions on provisional measures and equivalents, from G 1/19 on computer-implemented simulations to the UK Supreme Court's landmark *Emotional Perception* ruling reshaping patent eligibility.

Throughout it all, one conviction has guided us: content matters. Sharing knowledge – clearly, promptly, and generously – is how we serve our clients and our profession. Every article represents a commitment to making complex developments accessible and actionable.

None of this would be possible without our authors, who carve time out of demanding practices to write, and the team behind the scenes – editors, designers, and coordinators – who bring each issue to life.

As we celebrate this anniversary with eight new articles, we look forward to hearing from you. Your feedback shapes what we cover and how we grow. Here's to the next five years – and to more content, more sharing, more dialogue.

Happy reading!

The Editor-in-chief

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The FRAND Dance Revisited: Commitment, Not Choreography

The German Federal Court of Justice (FCJ) has further refined the conditions under which implementers of standard-essential patents may rely on the FRAND defence. In FRAND-Einwand III, the Court emphasises that an implementer's willingness to take a licence must be demonstrated throughout the negotiations and cannot be reduced to a formal declaration. The decision further strengthens the German courts' attractiveness for SEP holders, on par with, if not surpassing, that of the Unified Patent Court.

SEPs, FRAND and abuse of power

Modern telecommunication standards such as 4G, 5G and Wi-Fi incorporate patented technology that cannot realistically be avoided by anyone wishing to offer compliant products. Patents indispensable for implementing such standards are standard-essential patents (SEPs). Their owners have significant leverage in licence negotiations, because these SEPs are difficult or impossible to design around. EU competition law addresses this issue: where an SEP holder seeks an injunction against an implementer while refusing to offer a licence on fair, reasonable and non-discriminatory (FRAND) terms, the injunction must be denied as an abuse of a dominant position under Article 102(1) TFEU.[1]

The underlying tension is well known: SEP holders must remain able to enforce their rights, while implementers that are genuinely prepared to take a FRAND licence should not be forced into an unfair licence under threat of removal from the market by abusive injunction strategies.

This is the essence of the FRAND defence (*kartellrechtlicher Zwangslizenzeinwand*): an implementer may argue that injunctive relief is incompatible with competition law, because the SEP holder failed to offer a licence on FRAND terms. In practice, the difficulty is determining when an implementer is sufficiently licence-willing to invoke that defence. In *FRAND-Einwand III*, the FCJ further develops its case law in this regard.[2]

The facts of the dispute

The dispute featured VoiceAge against HMD, whose Nokia-branded smartphones were alleged to implement the EVS standard without a licence. EVS ("Enhanced Voice Services") is a speech codec standard designed to improve voice quality and call performance in modern mobile communications. VoiceAge sued first for information and damages, and later expanded the action to seek injunctive relief, recall and destruction. In parallel, the parties negotiated over a portfolio licence covering EVS-related SEPs but failed to reach agreement. The circumstances of those negotiations formed the backdrop to the legal question at the heart of the case: what an implementer must do to preserve the FRAND defence when the SEP holder's opening offer is said to fall short of FRAND.

The FRAND dance: a step-by-step framework

The point of departure remains the CJEU's landmark decision in ***Huawei v. ZTE***, which set out a negotiation framework for SEP disputes.[3] In broad terms, the SEP holder must notify the alleged infringer and make a concrete FRAND licence offer once the latter has indicated willingness to take a FRAND licence. The implementer must then respond diligently, without delay tactics, submit a counteroffer if necessary and, once that counteroffer is rejected, provide appropriate security.

[1] Treaty on the Functioning of the European Union.
[2] FCJ, Judgment of 27 January 2026, KZR 10/25 - FRAND-Einwand III.
[3] CJEU, Judgment of 16 July 2015, Case C-170/13 – Huawei/ZTE.

The central argument raised by HMD in *FRAND-Einwand III* was that because the SEP holder has failed to make an offer that meets the FRAND test, HMD does not have to further engage in the licence negotiations until the SEP holder performs their step in the dance. However, *Huawei v. ZTE* never expressly addressed this issue. So, if the SEP holder's initial offer is arguably not FRAND, must the implementer still respond, make a counteroffer, and post security? Or can they simply point to the defective offer and walk away?

The Commission's view: follow the steps, in order, strictly

Before the FCJ, HMD was supported by the European Commission, which filed an *amicus curiae* brief.[4] Therein, it argued for a strict sequential reading of *Huawei/ZTE*. If the SEP holder's offer was not FRAND, the implementer's subsequent duties would not arise. On that approach, the dance would pause at the first failed step.

The Commission's position was that the CJEU in *Huawei/ZTE* has designed respective obligations which must be followed in **strict sequential order**. Courts must assess each step and stop their analysis if a party fails to meet their obligation. If a court finds that an SEP holder's initial offer (Step 3) does not fully meet the FRAND test, because of a commercial or legal term, then, in the Commission's view, the implementer's obligation to make a counteroffer (Step 4) simply never arises. The implementer could, following this logic, challenge the FRAND-compliance of the initial offer and, if successful, defeat the injunction claim without ever having engaged substantively in negotiations or posted any security.

Focus on good-faith negotiation

The FCJ rejects the strict sequential approach argued by HMD and the Commission. Its reasoning has immediate practical consequences for any company that manufactures or sells standard-compliant products in Germany. In the FCJ's view, *Huawei/ZTE* does not impose a rigid choreography, but establishes a negotiation model directed at reaching a fair and efficient licensing outcome based on both parties committing to the negotiations.

The Court's central reasoning is that the implementer's **willingness to take a licence is a continuing requirement**. It must be reflected throughout the negotiations by timely responding, seriously engaging with the offer, submitting a concrete counteroffer and providing adequate security once a counteroffer has been rejected.

Importantly, the FCJ held that these obligations do not depend on the patent holder's initial offer being fully FRAND-compliant. Once the SEP holder has made a "*substantially complete*" offer and explained the royalty structure, the implementer must engage and articulate their objections. The SEP holder's offer is merely the starting point for the parties to voice their respective interests. The parties must discuss all factual and legal aspects that at least one of them considers relevant for the negotiation of a FRAND licence.

For the FCJ, FRAND compliance or non-compliance emerges from the parties' negotiation behaviour. An implementer who merely invokes the non-FRANDness of the SEP holder's offer while delaying meaningful engagement risks being seen as unwilling to take a licence. Conversely, an SEP holder insisting on terms that are not FRAND may be considered to abuse their dominant position.

[4] Accessible at: https://competition-policy.ec.europa.eu/document/download/811b3b4d-db5e-4617-b7f0-49459ea72e9e_en?filename=2025_HMD_VAES_Amicus_Curiae_submission.pdf.

What went wrong for HMD: a case study in what not to do

The FCJ's ruling reads like a catalogue of negotiating missteps which may be defensible when assessed individually, but taken together, strongly suggested bad faith to the court:

- **Delayed responses:** HMD reacted to licence offers and related steps in the negotiation process only after several months.
- **Slow progress on confidentiality arrangements:** this delayed the information exchange needed for good-faith negotiations, particularly to assess non-discrimination by reference to comparable licence agreements.
- **Inconsistent positions:** HMD shifted between different royalty structures during the negotiations.
- **Inadequate security:** the amount initially provided was plainly insufficient and was increased only at a very late stage.

On that basis, the FCJ concluded that the implementer had not shown the continuing licence-willingness required to rely on the FRAND defence.

Key takeaways for implementers

For implementers, the decision provides a clear practical message as to the conduct expected in Germany when relying on the FRAND defence.

- **An allegedly non-FRAND offer does not pause the dance:** The implementer must still engage with the offer, identify objections and respond constructively.
- **Promptness is crucial:** Extended periods of silence risk being interpreted as delaying tactics rather than good-faith negotiation.
- **Counteroffers must be serious and consistent:** A merely tactical or shifting position will undermine any assertion of licence-willingness.
- **Security must be meaningful and timely:** Token security, or security provided only with substantial delay, may itself indicate an absence of genuine licence-willingness.
- **Courts will assess the negotiations as a whole:** documentation, consistency of positions, and responsiveness remain central.

Key takeaways for SEP holders

If upon the offer, the implementer engages with the offer and raises reasonable legal or factual aspects for discussion, SEP holders must seriously engage with such objections and either adapt the offer or explain why, in their view, the implementer's objections are not calling the FRANDness of the SEP holder's offer into question.

What remains to be danced

The judgment brings certain clarity to German SEP practice and sits comfortably alongside recent decisions of the UPC and other European courts, all of which have likewise rejected a strictly formalistic reading of the *Huawei/ZTE* steps in favour of a holistic assessment of the parties' negotiating conduct.[5] Yet, the decision also leaves a number of important questions unanswered, which will keep courts and practitioners busy.

Most importantly, the FCJ expressly left open the amount of security an implementer must post. Notably, the Munich Regional Court I has recently gone so far as to require implementers to make an actual interim partial payment equivalent to their own last counteroffer as a separate and additional condition of licence-willingness.[6] Whether that obligation survives appellate scrutiny, and how it relates to the FCJ's apparent preference for security alone, remains contested. For now, implementers face diverging standards between the Regional Court and the Higher Regional Court in Munich.

[5] To support its position, the FCJ invokes: Court of Appeal of The Hague, 7 May 2019, Philips v. Asus; Court of Appeal of The Hague, 2 July 2019, Philips v. Wiko; High Court of England and Wales, Unwired Planet v. Huawei [2017] EWHC 711 (Pat), § 708; LD Mannheim, 22 November 2024, UPC_CFI_210/2023 – Panasonic v. Oppo; LD Munich, 18 December 2024, UPC_CFI_9/2023 – Huawei v. Netgear.

[6] LG München I, 8 January 2026, 7 O 5007/25, GRUR-RS 2026, 791.

Another issue that was not subject of the dispute before the FCJ is how royalties accrue for periods *before* a patent holder sends their first formal licensing demand. In this respect, the Munich Regional Court I has signalled that full back-royalties may not always be recoverable, where enforcement was slow or where the implementer could legitimately have believed that licensing was not actively pursued.[7] The precise trigger for that limitation, and the question of how far back legitimate claims may reach, await further judicial clarification.

The broader message of *FRAND-Einwand III*, however, is unambiguous: an implementer that engages seriously, responds promptly, makes a credible counteroffer and posts adequate security is in a fundamentally different position from one who does not. What remains clear: the courtroom is not the place to demonstrate licence-willingness for the first time.

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[7] Ibid.

Effective Patent Protection for Consumables: A Case for Use Claims

Consumables such as ink cartridges, test strips, coffee capsules or filters are typically sold and used with a corresponding device and often play a key role in the business models of various industries. In many cases, such consumables are relatively simple, while the corresponding device – such as a printer, coffee machine or medical test device – tends to be more sophisticated.

This relative simplicity of the consumable can make it difficult to obtain patent protection without unduly limiting the scope of protection by very specific features. Such features, in turn, tend to create numerous possibilities for design-around by competitors which makes patent protection ineffective.

As an alternative strategy, patent protection can be sought for a combination or system of a consumable and the corresponding device, for example an ink cartridge and the corresponding printer. In such a case, a competitor supplying a compatible ink cartridge will under certain circumstances indirectly infringe the system patent. Establishing indirect infringement is not difficult in itself. However, if the patent proprietor has put the system – in this case a printer including a cartridge – on the market in the EU, the alleged infringer may raise the objection that the rights conferred by the system patent have been exhausted.

Depending on the circumstances of the case, the patent proprietor may be able to counter this by arguing that the patent is not exhausted because replacement of the consumable amounts to a new manufacture of the system rather than a mere repair.[8] However, the outcome of such a strategy depends on many factors, including the subjective perception of the consumers, and is therefore difficult to predict. Furthermore, indirect infringement requires that both the supply (or offer) and the intended use of the consumable take place within the domestic territory (so-called double domestic connection), which is another limiting factor when relying on indirect infringement.

These challenges associated with product and system claims, respectively, can often be addressed by drafting use claims that define the use of a specific consumable in or with a particular device. In contrast to system claims, such claims can be enforced under direct infringement against a supplier of the consumable (e.g., cartridges), provided that it is evident at least from the circumstances that the consumable is intended for the claimed use.[9] In this way, the issues of exhaustion and double domestic connection can be avoided.

At the same time, use claims can play a vital role in strengthening patentability as compared to product claims. The main reason is that, in a product claim, the interaction between the consumable and the corresponding device can only be claimed in terms of the suitability of the consumable for the interaction. Such suitability will often exist in the prior art from an objective point of view which makes it difficult to rely on the interaction for establishing novelty and inventive step in a product claim. In contrast, this interaction is the very nature of a use claim so that features claiming the interaction between the consumable and the corresponding device will make a strong contribution to distinguishing the invention from the prior art. A recent decision of the German Federal Patent Court confirms that such interaction features, and even features of the corresponding device, are taken into account for novelty and inventive step.[10]

[8] Decision of UPC LD Düsseldorf of 16 April 2026 – UPC_CFI_779/2024.
[9] Decision of UPC LD Düsseldorf of 13 May 2025 – UPC_CFI_505/2024.
[10] Decision of German Federal Patent Court of 4 February 2026 – 6 Ni 14/24.

As a result, use claims often allow one to obtain the best of both worlds for consumables, namely to enjoy – contrary to product claims – the distinguishing effect of the interaction between the consumable and the corresponding device without facing – contrary to system claims – legal challenges such as exhaustion and double domestic connection.

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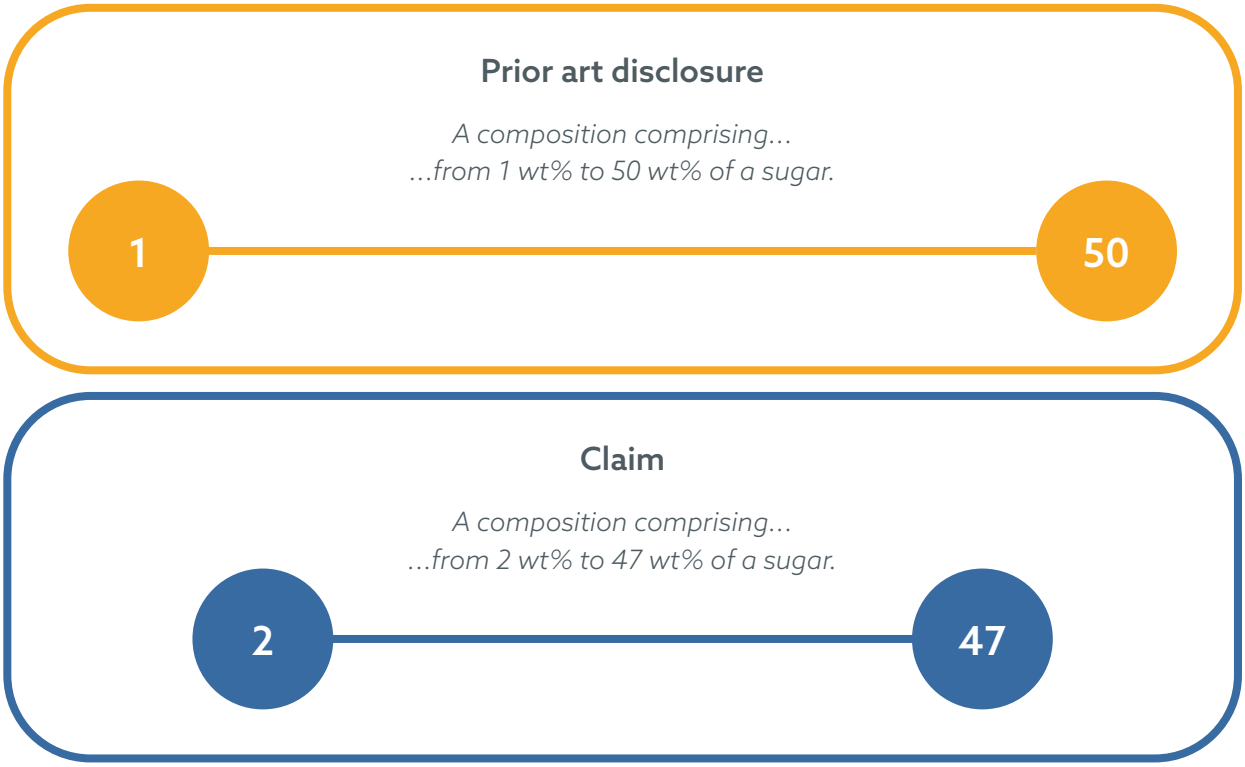
Numerical Subranges at the EPO: From Special Treatment to Gold Standard

The EPO's treatment of numerical subranges is undergoing a significant shift. Following T 1688/20 and the 2026 Guidelines update, novelty of numerical subranges is now assessed using the gold standard of direct and unambiguous disclosure, replacing the traditional "narrow and sufficiently far removed" criteria. This alignment with the standard used for other types of features has implications for applicants, patentees and opponents defending or attacking numerical subranges.

What are numerical subranges?

Some inventions are defined by numerical ranges. This is particularly common in chemistry, where ingredient concentrations may be expressed by a lower and upper limit, for example "from 2 wt% to 47 wt%". Sometimes, however, the prior art discloses a broader range that fully encompasses the claimed range without disclosing the claimed endpoints, for example "from 1 wt% to 50 wt%".

A recurring question is whether a claimed numerical subrange is novel over a broader prior-art range. For decades, numerical subranges were treated as a special case when assessing novelty.



Is this range novel?

Background: "narrow and sufficiently far removed"

In the 1980s, the Boards of Appeal of the EPO developed a three-step approach for assessing the novelty of a claimed subrange over a broader prior art range that fully encompassed it without explicitly disclosing its endpoints.[11] Under this approach, the claimed subrange was considered novel if it met three criteria: first, it had to be narrow compared to the known range; second, its endpoints had to be sufficiently far removed from the endpoints of the known range and from the examples of the prior art; and third, the selected area had to represent a purposive selection, i.e. another invention rather than an arbitrary embodiment of the prior art.

In more recent years, however, the Boards began to consider the question of "purposive selection" to be a matter of inventive step rather than novelty, because it concerned the presence of a technical effect of the claimed invention.[12] Following T 261/15, the third criterion was removed from the list of criteria set out in the Guidelines for Examination at the EPO.

Until 2025, in order to be considered novel, a subrange thus only had to be "narrow" compared to the prior art range and "sufficiently far removed" from any specific example disclosed in the prior art. The meaning of "narrow" and "sufficiently far removed" had to be determined on a case-by-case basis. However, T 261/15 did not completely remove the skilled person's judgment from this assessment: until 2025, the Guidelines still stated that "it must be assessed whether the skilled person, in the light of the teaching of the prior art, would seriously contemplate working in the selected subrange".[13]

At the same time, novelty of other claimed features is, in principle, assessed based on the "gold standard". Subject-matter is disclosed if, from the standpoint of the skilled person, it is directly and unambiguously derivable from the prior art. According to the Boards of Appeal, the gold standard must be applied uniformly when assessing novelty, the validity of the priority claim (i.e. whether the priority application relates to the same invention as the subsequent application) and added matter (i.e. whether the claimed invention is directly and unambiguously derivable from the content of the application as filed).[14]

A question then emerged: does the "narrow and sufficiently far removed" approach, under which a subrange may lack novelty without an explicit disclosure of its endpoints, align with the "directly and unambiguously derivable" standard?

T 1688/20 and the recent update of the Guidelines

In T 1688/20, the Board of Appeal answered this question in the negative. According to the Board, "the relative terms 'narrow' and 'sufficiently far removed'" do not "provide objective, solid and consistent criteria for establishing novelty of a selected sub-range". The terms are "generally open to such a broad interpretation that the decision whether criteria (a) and (b) are met not only depends on the factual circumstances of each case, but could also depend on the subjective perception of the deciding body on which values are to be considered 'narrow' or 'sufficiently far removed'".[15] The Board held that the gold standard should also be applied to subranges. In other words, for a claimed subrange to lack novelty, it must be directly and unambiguously derivable from the range disclosed in the prior art.

This decision had sufficient impact on European practice that the 2026 update to the Guidelines for Examination replaced the previous "narrow and sufficiently far removed" criterion with a reference to the gold standard.[16] Several subsequent decisions have already followed the reasoning outlined in T 1688/20,[17] suggesting that the age of special treatment for numerical subranges is over.

[11] T 198/84, Headnote, and T 279/89, Reasons 4.2.
[12] T 261/15, Reasons 2.2.2.
[13] Guidelines for Examination at the EPO, April 2025 Ed., G-VI, 7.
[14] G 2/10, Reasons 4.6.
[15] T 1688/20, Reasons 3.2.1.
[16] Guidelines for Examination at the EPO, April 2026 Ed., G-VI, 7.
[17] T 667/23, T 1132/22, T 989/22, T 377/22.

What does this mean for applicants, patentees and opponents?

To the extent that a numerical subrange was previously considered to lack novelty in view of a broader prior art range that did not disclose its endpoints, the alignment of the assessment of novelty with the gold standard has important consequences.

A subrange is novel if neither its endpoints nor values within the subrange are disclosed. This may render such subranges more difficult for opponents to attack.

The other side of the coin, however, is that applicants and patentees may face challenges when it comes to amendments: an amendment extracting a subrange from a broader range may be difficult to defend under the already strict EPO standards for added matter if the subrange is not explicitly disclosed in the application as filed. A similar challenge may apply to the validity of priority.

Inventive step may also become more central.[18] A subrange that previously was not considered novel may now become the sole distinguishing feature. Patentees and applicants may therefore face the challenge of showing a technical effect linked to the selection of specific endpoints, as opposed to the remaining part of the broader range disclosed in the prior art.

Applicants should keep this in mind when drafting new applications. If the claimed range is central to the invention, it may be useful to collect experimental data showing a technical effect compared with values outside the claimed range but close to its endpoints. Such data may prove helpful if prior art later emerges disclosing a broader range. To preserve amendment flexibility, it is also advisable to include explicit basis for further subranges in the description.

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[18] This applies where the prior art reference is full prior art under Article 54(2) EPC, rather than prior art under Article 54(3) EPC, which is not available for inventive step.

When a Picture Says More Than a Thousand Words

In German patent practice, it is rarely possible to derive size ratios from patent drawings. This article presents a recent decision by the German Federal Patent Court, in which the Court found that size ratios could exceptionally be derived from drawings when there is a close correspondence between the size ratios in the description and the drawings.

Sometimes, a patent or patent application defines its subject-matter by reference to a size ratio. In such cases, particularly in mechanical engineering, a prior art patent document may be found with drawings showing, when measured, dimensions that fall within the claimed range. This raises the question of whether such a document is considered to disclose the claimed size ratio.

Under German case law, as established by the Federal Court of Justice (BGH X ZB 10/11, "Steckverbindung"), such a size ratio is rarely deemed disclosed. This is because patent drawings typically only disclose the functional principle of the described subject-matter, rather than specific dimensions. However, the decision makes clear that this principle only applies in most, but not all, cases and thus acknowledges that exceptions exist. We discuss a case in which the Federal Patent Court (FPC) identified an exception to this rule.

German patent DE 10 2012 008 690 B4 was granted for a piston for use in a combustion engine. The patent defined the piston in question by reference to the size ratios of its parts. Within the opposition period, two oppositions were filed.[19] During the first instance proceedings, the German Patent and Trademark Office (GPTO) revoked the patent due to a lack of inventive step. The patentee appealed the revocation to the FPC, which upheld the revocation due to a lack of both inventive step and novelty (BPatG 12 W (pat) 26/23). As no further appeal was filed, the revocation of the patent is final.

A critical point during the appeal proceedings was whether a prior art patent document disclosed all of the claimed size ratios. This document mentioned one of those size ratios explicitly in the description. However, two other claimed size ratios could only be deduced by measuring the drawings that were part of the document. While the GPTO found that not all of the ratios were disclosed, the FPC came to a different conclusion, finding that the patent document did disclose all of the claimed size ratios. Consequently, the patent was found to lack novelty.

The FPC held that the prior art document explicitly emphasized the importance of the piston's dimensions. Its description mentioned several size ratios, which were in line with what could be obtained from measuring its drawings. From this, the Court found that other size ratios not mentioned in the description could also be inferred from the drawings. This led to the subject-matter of claim 1 being deemed disclosed. While the FPC acknowledged the aforementioned case law of the German Federal Court of Justice, it was made clear that this case law allowed for exceptions. In the case at hand, the FPC found that such an exception existed given the close correspondence between the drawings and the size ratios in the description of the prior art document, which implied that, exceptionally, the drawings were not to be understood as schematic.

The FPC emphasized this further by including a headnote in its decision that, while patent drawings are usually schematic, a close correspondence between the size ratios in the description and the drawings can imply that the drawings are not to be understood as schematic. This approach is similar to that adopted in EPO case law (cf. T 748/91), according to which, in some cases, drawings can be used to deduce size ratios.

The implications of the present case are clear when it comes to attacking a patent that relies on size ratios in its claims. Rather than dismissing out of hand a prior art patent document that shows such size ratios in its drawings, it is worth checking whether any indications exist that the drawings are not meant to be schematic. As the above-reported case demonstrates, this could involve reviewing the description to see if size ratios that are also shown in the drawings are mentioned. If

[19] One of the opponents was represented by Hoffmann Eitle.

so, it may be possible to rely on the present decision when challenging such a patent.

The situation is different for a patentee who wishes to defend a patent against a corresponding challenge. In this case, it is worth reviewing whether the measurements are accurate and whether they can be challenged in any other way. For example, the thickness of an object may vary depending on where it is measured. If so, one could argue that the measurements do not "directly and unambiguously" disclose the size ratio, as required by the German case law (BGH X ZR 8/22, "Aufbaupfosten").

This line of case law also opens the door to the allowability of potential amendments to a patent or patent application based on its drawings. Namely, if patent drawings can be seen as anticipating size ratios, then such measured size ratios can also be seen as part of the content of the application as filed when it comes to amendments. Using the criteria in this decision, one may argue that the patent drawings provide basis for adding to a claim a size ratio that is not disclosed in the original description or claims, but is only part of the drawings. However, the resulting scope may well be very limited, given that only a single such size ratio can often be inferred from a drawing.

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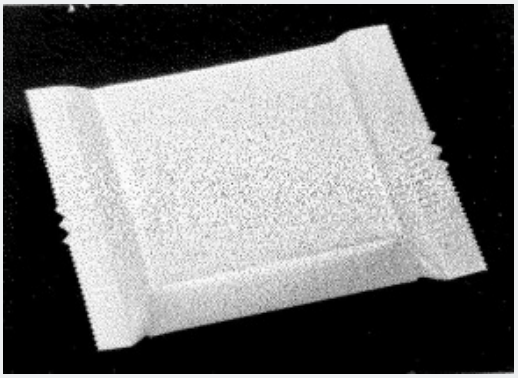
3D Trade Mark Case: Relevance of European Decisions for the Assessment of the Similarity of Goods

1. The judgment

The judgment of the Stuttgart District Court of 13 January 2026 in case 17 O 192/25 concerns a three-dimensional packaging mark for square chocolate bars that has been protected since 2001.[20] The plaintiff regarded the packaging of a fruit bar distributed by the defendant as an infringing imitation of their three-dimensional trade mark.

DE Nr. 398699704 (3D)	Contested sign[21]
	

The court dismissed the action in full. It denied both a likelihood of confusion and any unfair exploitation or impairment of the plaintiff's trade mark. There are reasons to question the decision in several respects. Particularly problematic is the assessment of the similarity of goods between table chocolate and cereal bars. In addition, the question arises whether decisions from European case law on the similarity of goods should be taken into account as an indication.

2. Similarity of goods

The assessment of similarity of goods, according to established case law, requires an overall evaluation of all circumstances characterising the relationship between the goods. The decisive factors include, in particular, nature and characteristics of the goods, commercial origin, distribution channels, intended purpose, economic significance, and whether the

[20] District Court of Stuttgart, judgment of 13 January 2026, case no. 17 O 192/25.
[21] Petra, Warum es Streit ums Quadrat gibt, RITTER SPORT Blog, 24 November 2025.

products compete with or complement each other.[22] In addition, it must be taken into account whether the goods are typically manufactured by the same companies or under the control of the same companies.[23] The assessment requires consideration of whether consumers would expect a common commercial origin.

The judgment does not meet these requirements. While it does identify certain differences between chocolate and cereal bars, it fails to adequately assess their substantial similarities. Moreover, it remains unclear what degree of similarity the court actually assumes. On the one hand, the reasoning suggests that the goods are not dissimilar. On the other hand, the judgment later explicitly refers to "dissimilarity of goods." This inconsistency is significant, as the likelihood of confusion largely depends on the degree of similarity between the goods.

There are arguments in favour of similarity based on their common intended purpose. Both products typically serve as a small intermediate meal or "snack". The court attempts to relativise this shared purpose by referring to the allegedly healthy character of cereal bars and the unhealthy character of chocolate. This distinction is not convincing. It is based on marketing perceptions rather than a sufficiently reliable understanding of consumer perception. Today's much more informed consumers are largely aware that cereal bars often contain substantial amounts of sugar (up to 40%) and therefore compete functionally with traditional confectionery.

The nature and composition of the goods also do not clearly call into question their similarity. Cereal bars often contain cocoa-based ingredients and are often combined with or coated in chocolate. In addition, manufacturers frequently overlap. Large confectionery companies today offer both chocolate products and cereal bars, protein bars, or fruit bars:

Manufacturers of chocolate and "healthy snacks"

1. Mars Inc.

Snickers

BE-KIND Honey Roasted Nuts & SeaSalt Riegel

Snickers Fruit & Nut

Snickers Protein

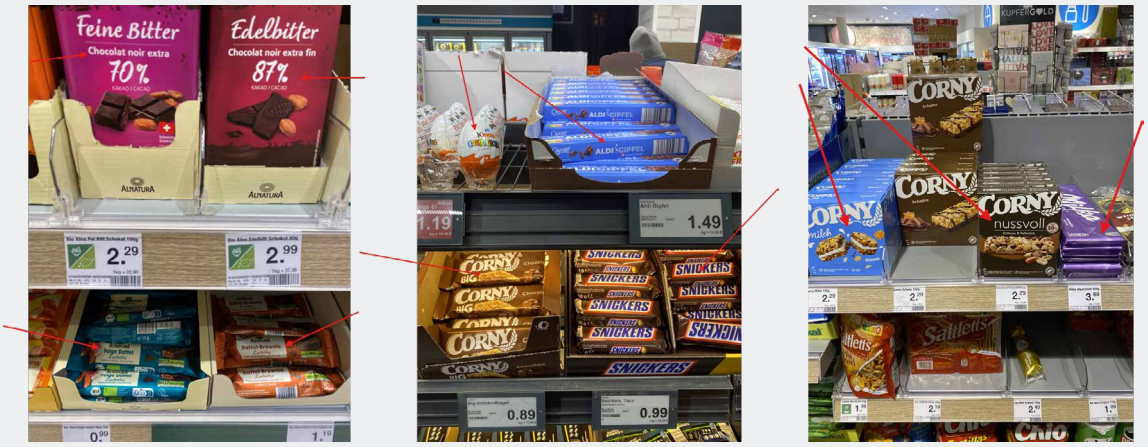
[22] ECJ (First Chamber), judgment of 18 December 2008, Case - C-16/06 P, para. 65 et seq.
[23] GC (Seventh Chamber), judgment of 15 May 2024 Case – T-316/23, ECLI:EU:T:2024:317, para. 54.

Mars	Mars Fruit & Nut
	
	Mars Protein
	
2. Nestlé	
Nestlé chocolate	Nestlé Fitness Protein
	
3. Mondelēz International	
chocolate	Cadbury Brunch Nuts Peanut & Almond
	

These product expansions are the result of changing market conditions, such as rising cocoa prices and a growing interest in functional snack products.

Finally, there are also close overlaps in distribution channels. Contrary to the court's finding, both products are offered in supermarkets and similar retail outlets and are aimed at the same general end consumers:

Same place of sale



To sum up, the intended use, market environment, manufacturing practice, and distribution all point to at least an average degree of similarity between the goods.

3. The indicative effect of European decisions

Of particular interest is the question whether European decisions (EUIPO, national offices and courts) on the similarity of goods may have an indicative effect for national courts and IP offices of member states. According to established case law of the CJEU, foreign trade mark decisions generally have neither binding effect nor indicative value.[24] This is convincing for cases in which linguistic or conceptual particularities of the relevant national public play a role, for example with regard to the conceptual or phonetic impact of a sign.

However, the situation is different for the assessment of the similarity of goods or services. In this context, the assessment is generally not about linguistic understanding, but rather about objective criteria, such as intended purpose, competitive relationship, industry practice or distribution channels. There is much to suggest that decisions of the EUIPO or other Member State authorities should at least be taken into account as indicative factors for analyses of the similarity of goods or services. The EU's objective of harmonisation requires a coherent interpretation of trade mark law.[25] The EU's objective of avoiding contradictory decisions also supports the view that existing European case law should not be disregarded.[26] The CP15 program also

[24] ECJ, judgment of 12 February 2004 - C-218/01, para. 63 et seq. ("In that connection, whilst registration of an identical trade mark for identical goods or services effected in one Member State constitutes a circumstance which may be taken into consideration by the competent authority of another Member State among all the facts and circumstances which it is appropriate to take into account, it cannot, however, be decisive as regards the latter authority's decision to grant or refuse registration of a given trade mark.").

[25] ECJ, judgment of 12 February 2004 - C-218/01, para. 60 et seq. ("As the Court has held, the competent authorities called on to apply and interpret the relevant national law *must do so, as far as possible, in the light of the wording and the purpose of the Directive so as to achieve the result it has in view and thereby comply with the third paragraph of Article 249 EC* (Joined Cases C-71/94 to C-73/94 Eurim-Pharm [1996] ECR I-3603, paragraph 26, and Case C-63/97 BMW [1999] ECR I-905, paragraph 22). The competent authority of a Member State may take account of the registration in another Member State of an identical trade mark for products or services identical to those for which registration is sought."; emphasis added).

[26] REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark, recital 33 ("Contradictory judgments should be avoided in actions which involve the same acts and the same parties and which are brought on the basis of an EU trade mark and parallel national trade marks.").

shows that there is a practical need for harmonization in this area, because it aims to promote a more uniform assessment of the similarity of goods and services.[27]

There are numerous decisions by the German Federal Patent Court (BPatG) and the EUIPO (eight in total) affirming the similarity between chocolate and cereal bars.[28] To accord them a binding effect would go too far. However, disregarding these decisions entirely within the EU would fail to do justice to the harmonization objective of the Trade Mark Directive. An evidentiary value as indicative authority therefore appears to be the more appropriate middle ground.

4. Similarity of the signs

The reasoning on the similarity of the signs is also not entirely convincing. In principle, it is correct that the comparison of signs must be carried out based on the imperfect recollection of the relevant public. Nevertheless, the court should have clearly determined the degree of similarity between the signs. Especially in the case of packaging shapes, it is crucial whether the dominant similarities outweigh individual differences.

According to the court, the main difference lies in the slightly rectangular rather than square shape of the contested packaging. In addition, the judgment refers to wider flaps, a more open design, and differences in grooves and zigzag patterns. However, a significant part of these features is likely to be technically determined or of limited weight in light of the imperfect recollection of the relevant public. To the extent that the overall impression is determined by the abstractly registered basic shape of the 3D trade mark without any branding, the existing similarities – with due disregard for the differing word elements on the allegedly infringing product – suggest that the degree of similarity of the signs should in any event not be regarded as low.

5. Distinctiveness and likelihood of confusion

The court assumes a high degree of distinctiveness of the plaintiff's mark, but at the same time refers to third-party signs to relativise it. It remains open whether these third-party marks are closer to the plaintiff's mark than the contested sign and therefore may be taken into account as weakening elements. This is problematic because, according to case law, dilution of distinctiveness through third-party marks remains the exception and is subject to additional requirements.[29]

Against this background, the rejection of a likelihood of confusion according to Section 14(2) Nr. 2 of the German Trademark Act (MarkenG) appears at least questionable. If one assumes a high degree of distinctiveness of the plaintiff's mark, at least a relevant similarity of the goods, and a not remote similarity of the signs, the court would have had to explain in greater detail why the established differences should be sufficient to rule out a likelihood of confusion. This applies even more so to the additionally asserted protection of reputation under Section 14(2) Nr. 3 MarkenG, which was likewise denied.

[27] https://www.tmdn.org/publicwebsite/#/practices/2718939, accessed on April 24, 2026; EUIPN, Common Communication on the Common Practice on the comparison of goods and services: treatment of terms lacking clarity and precision and common interpretation of Canon criteria and other factors of March 2025, p. 2 et seq. ("The analysis of this topic revealed a lack of harmonisation among the IPOs, in particular with regard to i) the treatment of terms lacking clarity and precision covered either by the earlier or by the contested mark in a comparison, and ii) the consistent application of the factors in the comparison of goods and services. Divergent interpretations were posing significant challenges to rights holders seeking to protect and enforce their trade marks in different jurisdictions. In view of the above, and the interest expressed by the vast majority of IPOs and UAs in improving the level of consistency in this area, the CP15 project was approved for launch by the Management Board in November 2022.").

[28] Federal Patent Court of Germany, decision of 7 April 2022, case no. 30 W (pat) 566/20, p. 12; EUIPO, decision of 8 January 2025, case no. B 3 203 649, p. 3; EUIPO, decision of 29 August 2024, case no. B 3 157 329, p. 5; EUIPO, decision of 23 September 2019, cancellation no. 15 133 C, pp. 4–5; EUIPO, decision of 7 April 2025, case no. R 1876/2024-1, para. 46; EUIPO, decision of 20 May 2015, case no. B 2 282 633, p. 6; EUIPO, decision of 27 January 2020, case no. B 3 073 326, p. 8.; EUIPO, decision of 14 July 2004, case no. B 500 126, p. 7.

[29] General Court of the European Union (Eighth Chamber), Judgment of 20 January 2010 – T-460/07, para. 68; Thalmaier, in: BeckOK MarkenR, 44. Ed. 1.1.2026, MarkenG § 14 Rn. 302.

6. Conclusion

The decision of the District Court of Stuttgart shows how strongly the outcome of an assessment of likelihood of confusion in trade mark law depends on the weighing of individual factors. For this very reason, the established standards must be applied consistently. In the present case, there are compelling reasons to regard chocolate and cereal bars as similar goods. There is also much to suggest that European decisions on similarity of goods should at least be given indicative value. Such an approach would better reflect actual market practice, which, for example on Darts IP or in relevant reference works, also includes decisions of the EUIPO. Moreover, this approach would also further the objective of a more coherent European case law and thereby, ultimately, enhance legal certainty.

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R 16/23: The Right to Oral Proceedings Affirmed at the EPO

In J 6/22, the Legal Board of Appeal of the EPO held that a request for oral proceedings need not be granted if the oral proceedings would serve no legitimate purpose. That line of reasoning has now been rejected by the Enlarged Board of Appeal in R 16/23. The Enlarged Board held that, where oral proceedings had been requested before an adverse decision on re-establishment of rights and the admissibility of the appeal, the Board was required to appoint them under Article 116(1) EPC.[30] By deciding the case in writing instead, the Legal Board committed a fundamental procedural violation, with the consequence that J 6/22 was set aside, the proceedings were re-opened, and the petition fee reimbursed.

Case background

Decision R 16/23 concerns a petition for review of decision J 6/22. In J 6/22, the Legal Board had rejected a request for re-establishment of rights concerning the time limit for filing the statement of grounds of appeal and, as a consequence, rejected the appeal as inadmissible. The applicant had requested oral proceedings in the notice of appeal and again, expressly, in the subsequent request for re-establishment of rights filed after the Board had pointed out that no statement of grounds of appeal had been received in due time.

As in decision T 1874/23,[31] the Legal Board in J 6/22[32] considered that the request for re-establishment had not been immediately and completely substantiated within the relevant time limit. Specifically, the Board found that there had been no sufficient factual assertions regarding substitute arrangements in view of the illness of the professional representative. On that basis, the Board concluded that the request for re-establishment had to fail from the outset and that no further procedural steps were permissible, including the appointment of oral proceedings. In the Board's view, oral proceedings would have served no legitimate purpose.

The appellant then filed a petition for review under Article 112a EPC,[33] relying in particular on Article 112a(2)(d) EPC[34] in conjunction with Rule 104(a) EPC,[35] i.e. the Board's failure, contrary to Article 116 EPC, to arrange for holding the requested oral proceedings. A further objection under Article 112a(2)(c) EPC based on an alleged violation of Article 113(1) EPC[36] was also raised.

Decision of the Enlarged Board

The Enlarged Board found the petition admissible and allowable. It first confirmed that, in the circumstances of the case, the petitioner could not have raised a Rule 106 EPC[37] objection during the appeal proceedings, since the procedural defect only materialised in the written decision that terminated those proceedings.[38]

On the merits, the Enlarged Board held that the Board should have arranged oral proceedings before taking an adverse decision on the request for re-establishment and on the appeal. Referring to the wording of Article 116(1) EPC, the Enlarged Board emphasised that the element of expediency applies only where oral proceedings are arranged by the EPO of its own motion.[39] By contrast, where oral proceedings are

[30] *"Oral proceedings shall take place either at the instance of the [EPO] if it considers this to be expedient or at the request of any party to the proceedings. However, the [EPO] may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same."* – Article 116(1) EPC

[31] Danche Spirkoska Jovanov, T 1874/23 et al: The Right to Oral Proceedings at the EPO Under Attack, Hoffmann Eitle Quarterly, June 2025, pp. 15-17.

[32] The Boards in charge of J 6/22 and T 1874/23 share one member.

[33] *"Any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal."* – Article 112a(1) EPC

[34] *"The petition may only be filed on the grounds that: [...] any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings; or [...]"* – Article 112a(2)(d) EPC

[35] *"A fundamental procedural defect under Article 112a, paragraph 2(d), may have occurred where the Board of Appeal, [...] contrary to Article 116, failed to arrange for the holding of oral proceedings requested by the petitioner, or [...]"* – Rule 104(a) EPC

[36] *"The decisions of the [EPO] may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."* – Article 113(1) EPC

[37] *"A petition under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings."* – Rule 106 EPC

[38] R 16/23 - Reasons 5.

[39] R 16/23 - Reasons 10.2.

requested by a party, the deciding body has no discretion whether to hold them, save for the expressly provided exceptions in the EPC.[40] None of those exceptions applied in J 6/22.

The Enlarged Board also drew support from the legislative history of the EPC 2000 revision. It noted that, when the petition for review procedure was introduced, an earlier proposal to allow the Enlarged Board to reject clearly inadmissible or unallowable petitions in written proceedings without oral proceedings was abandoned because of concerns under Article 116 EPC.[41] The legislator instead confirmed the significance of oral proceedings, and Rule 104(a) EPC was introduced specifically to make a failure to appoint requested oral proceedings a possible ground for review.[42]

Further, the Enlarged Board reiterated the function of oral proceedings as already recognised in the case law: they are intended to allow a party to present its case orally, to allow questions from the Board, and to enable discussion of possibly decisive issues.[43] Importantly, a party is entitled to present orally what it has already submitted in writing.[44] The value of oral proceedings therefore does not depend on whether new submissions can still be validly introduced, but lies in the possibility to make oral submissions on a case before the deciding body, prior to a decision which adversely affects that party.[45]

The Enlarged Board accepted that the case law recognises certain limited situations in which a decision may be taken without oral proceedings despite a request, for example where the requesting party states that it will not attend, where an appellant does not respond at all to a communication pointing out the absence of grounds of appeal, or where the decision is in the requester's favour.[46] However, the Enlarged Board held that the present case did not fall into any of those categories. Specifically, unlike the "obsolete request" line of cases, the petitioner here had responded to the Board's communication and had expressly maintained the request for oral proceedings in relation to the decisive issues.

Most significantly, the Enlarged Board rejected the Legal Board's attempt to rely on a dynamic interpretation of Article 116(1) EPC so as to weigh the party's right to oral proceedings against aspects such as legal certainty in due time, procedural economy or the perceived prospects of success of the case.[47] The Enlarged Board was not persuaded that the considerations invoked in J 6/22 could justify such a balancing exercise and expressly stated that Article 116(1) EPC leaves no room, in a case such as this, for weighing the petitioner's right to present the case orally against the above aspects.[48]

The Enlarged Board was equally unconvinced by the reliance on Article 6(1) ECHR.[49] While acknowledging that Article 6(1) ECHR embodies minimum standards for fair proceedings and is relevant to EPC practice, it held that it cannot be invoked to justify a restrictive interpretation of Article 116(1) EPC. Referring also to Article 53 ECHR, the Enlarged Board stressed that the European Court of Human Rights (ECtHR) sets a floor, not a ceiling, for procedural protection.[50] On that basis, decisions of the ECtHR in which no oral hearing was required could not support the Board's reasoning in J 6/22.

The Enlarged Board therefore concluded that the failure to arrange oral proceedings was contrary to Article 116 EPC and, in the circumstances of this case, constituted a fundamental procedural defect within the meaning of Article 112a(2)(d) and Rule 104(a) EPC.[51] The decisive point was that the requested oral proceedings related directly to the issues on which the adverse final decision was based. The Enlarged Board also made clear that it did not have to examine whether the outcome might have been different had oral proceedings been held. The denial of the opportunity to make oral submissions on the decisive issues was

[40] R 16/23 - Reasons 10.3 and 10.4.
[41] R 16/23 - Reasons 10.4.2 and 10.4.3.
[42] R 16/23 - Reasons 10.4.4 and 10.5.
[43] R 16/23 - Reasons 10.7 (first paragraph).
[44] R 16/23 - Reasons 10.7 (second paragraph).
[45] R 16/23 - Reasons 10.8.
[46] R 16/23 - Reasons 10.9 to 10.10.1.
[47] R 16/23 - Reasons 10.13.
[48] R 16/23 - Reasons 10.14.2 (first paragraph) and 10.14.3 (third paragraph).
[49] R 16/23 - Reasons 10.14.5 (third paragraph).
[50] R 16/23 - Reasons 10.14.5 (sixth and seventh paragraphs).
[51] R 16/23 - Reasons 10.15 and 11.

sufficient in itself.[52] J 6/22 was therefore set aside, the proceedings before the Legal Board were re-opened and the fee for the petition for review reimbursed.[53] The Enlarged Board did not need to decide the separate objection based on Article 113(1) EPC.[54]

Impact on practice

R 16/23 is a clear repudiation of the core reasoning of J 6/22. The Enlarged Board has now confirmed that, outside narrowly defined and already recognised exceptions, a party who has requested oral proceedings is entitled to them before an adverse decision is issued. That is so even in proceedings concerning re-establishment of rights, and even where the deciding Board considers the request insufficiently substantiated or the appeal bound to fail. The right to present the case orally is not lost merely because the Board believes that no new facts can validly be introduced.

The decision is therefore important well beyond the facts of this case. It restores legal certainty regarding Article 116(1) EPC and rejects the notion that requested oral proceedings may be dispensed with on grounds of procedural economy, efficiency, workload or the Board's own assessment that a hearing would serve no legitimate purpose. In doing so, the Enlarged Board substantially neutralises the broader implications that J 6/22 and T 1874/23 had seemed to open up, as discussed in our earlier article.[55]

At the same time, R 16/23 does not weaken the substantive requirements for re-establishment of rights. Parties should still ensure that requests for re-establishment are fully and convincingly substantiated within the relevant time limit. What R 16/23 makes clear, however, is that deficiencies perceived by the Board in that substantiation do not, by themselves, permit the Board to bypass a valid request for oral proceedings before issuing an adverse decision.

More broadly, the decision is a reminder that Article 116 EPC remains a separate and significant procedural guarantee alongside Article 113(1) EPC. The Enlarged Board expressly relied on the legislative history of Article 112a and Rule 104(a) EPC to underline that ignoring a request for oral proceedings can, in itself, amount to a fundamental procedural defect. Parties faced with an adverse written decision issued despite a maintained request for oral proceedings should therefore carefully consider whether a petition for review may be available.

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[52] R 16/23 - Reasons 11.3.
[53] R 16/23 - Reasons 12 and 14.
[54] R 16/23 - Reasons 13.
[55] Danche Spirkoska Jovanov, "T 1874/23 et al: The Right to Oral Proceedings at the EPO Under Attack", op. cit.

Breaking Borders: The Expanding Reach of UPC Jurisdiction

Since the Court began operating, claimants have been testing the limits of the UPC's jurisdiction, targeting not only single entities, but also entire company groups. Jurisdiction within the European Union is governed by the Brussels I bis Regulation ("**BR**"), for both national courts and supranational courts such as the UPC. Given the existence of competing jurisdictions for questions of patent infringement and validity, a strategic market for forum shopping has developed, with parties assessing which forum is likely to offer the best prospects of success.
At the same time, a significant trend towards expanding jurisdiction can be observed across the courts, which is currently shaping the patent litigation landscape in Europe. The CJEU's decision in *BSH v Electrolux*[56] confirmed the jurisdiction of the national courts at the defendant's domicile to hear infringement cases beyond their own territory, marking the start of a new era of cross-border injunctions.[57]
One year on, it is time to revisit this development, its implications for litigation at the UPC and the national courts, and its possible limits.

Quick and comprehensive uptake at the UPC

BSH v Electrolux arose in the context of national proceedings. Within months, the decision has already had far-reaching consequences for the way litigation is conducted before the UPC. Various divisions of the UPC have already confirmed their international jurisdiction and competence to hear infringement cases

- if the defendant is based in a Contracting Member State of the UPC ("**CMS**"): on infringement of the national parts of an EP patent in the CMS, in EU and Lugano Convention member states other than the CMS ("**EU/LC**"),[58] and in countries that are subject to neither instrument ("**Third States**") such as the UK.[59] This case pattern closely follows the reasoning in *BSH v Electrolux* (universal jurisdiction of the courts at the domicile under Article 4(1) BR) and has recently been confirmed by the Court of Appeal ("**CoA**").[60]
- if the defendant is not based in a CMS but acting jointly with at least one (so-called "anchor" defendant) in the CMS: infringement in the CMS and EU/LC.[61] Under Article 8(1) BR, a defendant can be sued before courts other than its domicile if there is a risk of irreconcilable judgments that would arise from separate proceedings. The limits of this approach are currently being tested and have already given rise to the CoA's first referral to the CJEU.
- if none of the defendants is based in a CMS: the UPC only has jurisdiction for acts of infringement committed in the CMS (Article 7(2) BR).[62]

In any case, the UPC has no jurisdiction to assess or rule on the validity of the EU/LC national parts of an EP patent (see below).

The CoA refers suitability of intermediaries as anchor defendants to the CJEU

Claimants often seek to target not only a single defending entity, but also the entire supply and distribution chain. These cases typically evolve around

[56] CJEU, Judgement of 25 February 2025, Case C-339/22 - BSH Hausgeräte v Electrolux.

[57] For a first summary, see Michael Pfeifer, BSH v Electrolux – The Gateway to a New Age of Cross-Border Litigation?, Hoffmann Eitle Quarterly, March 2025, pp. 22–24.

[58] Herein, we use the term "EU/LC" to cover all EU member states that are not contracting members of the UPCA as well as the member states of the Lugano Convention (CH, NO, IS), which are subject to very similar rules under the Lugano Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters of 21 December 2007.

[59] E.g. LD Düsseldorf, Decision of 28 January 2025, UPC_CFI_355/2023, p. 21 et seq. and LD Mannheim, Order on 16 July 2025, UPC_CFI_365/2023 – Fujifilm v Kodak; LD The Hague, Decision of 10 October 2025, UPC_CFI_386/2024 – HL Display v Black Sheep.

[60] CoA, Decision of 2 June 2026, UPC_CoA_312/2025, Fujifilm v Kodak.

[61] E.g. LD Paris, Procedural Order on 21 March 2025, UPC_CFI_702/2024, margin 11, 18 – Mul-T-Lock v IMC: including infringement of the Swiss part by a Swiss defendant; LD The Hague, Procedural Order on 23 May 2025, UPC_CFI_191/2025 and 192/2025 – Genevant/Arbutus v Moderna concerning infringement throughout the EU and in Switzerland mediated through Dutch and Swiss defendants; LD Hamburg, Final Order on 14 August 2025, UPC_CFI_387/2025 – Dyson v Dreame et al.

[62] CoA, Order of 13 March 2026, UPC_CoA_922/2025 – Adobe v OpenAI.

a so-called "anchor defendant" which is centrally involved in the infringement both within and outside the UPC territory and provides the basis ("anchor") for jurisdiction. Furthermore, when dealing with large multinational company groups, the specific role of each national entity in patent infringement often remains opaque to the claimant.

The case law is not without contradictions and some cases predate the fundamental shift introduced by the *BSH v Electrolux* decision. Therefore, it came as no surprise that the CoA's first referral to the CJEU concerned precisely questions of jurisdiction and the application of case law to multiple defendants.[63] The first and most fundamental question concerns the application of Article 8(1) BR in conjunction with Article 71b(2) to an anchor defendant who is not accused to act as an infringer, but only as an intermediary (e.g., as the EU representative, by creating the regulatory basis for the product to be placed on the EU market). The CoA is seeking guidance on whether such a situation carries a risk of irreconcilable judgments that would justify the concentration of proceedings for a defendant domiciled in a Third State also with respect to the infringement in the rest of the EU/LC.[64]

No referral would have been necessary in a situation where two or more companies were each separately alleged to have committed infringement of the *same national part* of an EP patent regarding the same product. The CJEU ruled in 2012 in *Solvay v Honeywell*[65] that a (foreign) co-defendant can be included in the same infringement action to avoid irreconcilable judgments. It also seems clear that irreconcilable judgments must be avoided where different CMS within the UPC territory are concerned. Consequently, parallel acts of infringement in various CMS by different group entities (irrespective of whether all or only some of them are domiciled in the CMS) can be adjudicated by the UPC in the same legal action.

For the moment, it thus remains open under what circumstance the idea of the need to avoid irreconcilable judgments can be extended beyond the boundaries of the CMS. Recent first-instance decisions suggest a more cautious approach in handling Article 8(1) BR and have, for example, also looked at whether the circumstances giving rise to a party's inclusion in an action before the UPC had been foreseeable for the co-defendant.[66]

Important guidance from the CoA on handling validity

Under the procedural framework of the BR, the courts of the CMS and EU/LC in which the EP patent is in force have exclusive competence in validity matters, irrespective of whether validity is challenged in the context of a revocation action or as a defense (Article 24(4) BR and Article 22(4) Lugano Convention). In *BSH v Electrolux*, the CJEU held that a court may stay its proceeding "where it takes the view that there is a reasonable, non-negligible possibility of that patent being declared invalid by the court of that other Member State that has jurisdiction."[67] The CJEU further indicated that such constraints on jurisdiction do not apply with respect to the validity of patents of Third States. A decision on validity by the EU court on such Third States patents would only have an *inter partes* effect and under no circumstances require the administrative bodies of the Third State to cancel the effects of the concerned patent.

Taken literally, defendants to an action broadly asserting patent infringement both within and outside the EU risk their non-validity arguments not being heard as far as EU/LC patents are concerned, unless they file a revocation action before each competent EU/LC court. In contrast, the UPC can, for example, reject a request for an injunction covering a Third State such as the UK based on a lack of validity *inter partes*.

[63] CoA, Order of 6 March 2026, UPC_CoA_789/2025 and UPC_CoA_813/2025 – Dyson Technology Ltd v Dreame International (Hongkong) Ltd and Others.

[64] In full, the question reads: Must Article 8(1) in conjunction with Article 71b(2) of Regulation 1215/2012 be interpreted as meaning that a situation where, in proceedings before a common court within the meaning of Article 71a(2) of Regulation 1215/2012, a first company that is established in a third State is alleged to have committed an infringement of a national part of a European patent which is in force in an EU Member State that is not party to the instrument establishing the common court, and a second company that is established in an EU Member State that is party to the instrument establishing the common court is alleged to be an intermediary whose services are used by the first company to infringe in the EU Member State that is not party to the instrument establishing the common court, is capable of leading to "irreconcilable judgments" resulting from separate proceedings as referred to in Article 8(1) Regulation 1215/2012?

[65] CJEU, Judgement of 12 July 2012, Solvay v Honeywell, C-616/10, ECLI:EU:C:2012:445.

[66] LD Hamburg, Final Order of 7 April 2026, UPC_CFI_2255/2025 – Dyson v Dreame et al. ("II"); LD Milan, Decision of 21 April 2026, UPC_CFI_472/2024, 792/2024, 831/2024 and 182/2025 (Dainese v Alpinestars et al.).

[67] C.f. CJEU, Judgement of 25 February 2025, Case C-339/22, paragraph 51.

In *Fujifilm v Kodak*, the CoA recently provided extensive guidance on how it intends to deal with validity for both EU/LC and Third States in situations in which no revocation action is pending in those countries.[68]

- If the UPC considers the patent to be *infringed* and *valid* in the CMS, it may issue a decision including its orders under the condition subsequent that the patent is not held to be wholly or partially invalid in the concerned EU/LC state or Third States (in view of comity[69]).
- If the UPC considers the patent to be *infringed* but *invalid* in the CMS, the UPC will first allow the patentee the opportunity to withdraw an infringement action as far as it also concerns EU/LC and Third States. While the UPC can dismiss the infringement action with effect for Third States in view of validity, it cannot do so with effect for the EU/LC. Instead, it will give the defendant the opportunity to file a revocation action with the relevant competent national EU/LC court(s) within an appropriate period of time and then stay the revocation action pending the final decision of the EU/LC state.

The decision not only provides clarity to the parties, it also releases some of the pressure from defendants to a cross-border infringement action before the UPC. They have now certainty that the UPC will not issue an injunction lightly for EU/LC states based on a patent it considers invalid for the CMS. Depending on the case (and the budget of the defendant), national revocation actions may however remain a tool of tactical choice, rather than need.

Enforcement may be more complex than thought

In theory, enforcement of injunctions issued by the UPC should be straightforward, at least as long as the defendant has sufficient assets within any of the CMS or EU/LC.[70] The UPC has not been shy to issue massive coercive payments for violations of an order. However, when it comes to cross-border injunctions extending to acts in Third States, other factors may come into play.

Most prominently, the LD Mannheim took the opportunity of an enforcement order in the *Fujifilm v Kodak* to set out its "general considerations" on enforcement of injunctions extending to infringement in third countries, also with the clear intent "to de-escalate the current jurisdictional conflict and to enter into a respectful discussion"[71] with the UK courts. In the absence of instruments such as the BR or bilateral treaties that provide for mutual recognition of judgments, it held that an injunction in such country "is only enforceable and will only be enforced, after the UPC's decision was recognized by the competent national courts in accordance with the national principles to be applied."[72]

While the diplomatic handling of the delicate interplay between cross-border jurisdiction and territoriality of patent rights can only be applauded (and the judges are not to be envied in this particular case), the legal basis for such self-constraint seems rather doubtful. As the CoA lifted the injunction for material reasons, it may be some time before this is clarified.

Broad options: the RC Munich makes a strong case for national cross-border enforcement

The UPCA limits the UPC's jurisdiction and competence to EP patents, i.e. classic bundle patent and EP patents with unitary effect. Such constraints do not apply to national courts and, applying the reasoning of *BSH v Electrolux*, the national courts' jurisdiction at least in theory extends to any infringement of any patent by a defendant having its domicile in the country of the court. The Regional Court Munich made clear that it will not shy away from making use of the competences confirmed by the CJEU.

In a premier decision concerning biosimilars of the macular degeneration drug Eylea by Regeneron and Bayer from 23 October 2025, the RC Munich ordered a cross-border injunction covering Germany and 19 additional EPC countries on the basis of the doctrine of equivalents, thereby granting injunctive relief extending well beyond the court's own national

[68] CoA, Decision of 2 June 2026, UPC_CoA_312/2025, headnotes 11 to 18 – Fujifilm v Kodak.

[69] Comity denotes the principle in private international law whereby courts, out of mutual respect, may defer to or take account of the jurisdiction and decisions of foreign courts, in order to promote the harmonious resolution of cross-border disputes and avoid conflicting judgments.

[70] Or – as the BR sets forth the principle of mutual recognition and enforcement of decisions – the EU Member States.

[71] LD Mannheim, UPC_CFI_365/2023, Order of 30 January 2026, margin 40 – Fujifilm v Kodak.

[72] Ibid, margin 47, see also 39 to 42 – Fujifilm v Kodak.

territory.[73] The case illustrates the challenges and legal complexity that comes with handling such matters. The RC Munich differentiated between

- material law aspects (infringement, validity, doctrine of equivalence), which are governed by the law of the country in which infringement is asserted, and
- procedural law aspects (registration requirements, urgency, relief etc.), which are governed by the law of the forum.

As for validity, the RC Munich relied on the "lighthouse effect" of a first-instance validity ruling of the Federal Patent Court, assuming that assessment by the authorities for each respective national part would yield no other results. The RC Munich used the opportunity to further refine its theory in follow-up cases addressing other judicial constellations. The final word on this rather creative approach however is still out, with the matter having settled before a decision could be issued at appeal.

It was only a question of time until defendants found themselves confronted with asserted infringement of US patents before a national court in Europe. Onesta's campaign against BMW for infringement of two US SEPs before the RC Munich[74] received much attention. According to public sources, the case quickly settled after BMW obtained an anti-suit injunction from the US District Court for the Western District of Texas.[75]

Outlook: strategic foresight essential

After a year in which almost every angle of jurisdiction has been tried before the UPC and the national courts, we clearly see the impact of a new age of cross-border litigation. Certain details, in particular the handling of anchor defendant constellations and enforcement, still awaits clarification by the highest instances. While the options are (almost) limitless in theory, some decisions may already show a certain self-restraint. It is becoming clear that cross-border infringement does not come without costs, as it expands the legal complexity of the case and raises questions for which there may not be a straightforward answer.

More than ever, claimants thus need to consider their objectives when asserting and weigh up their options accordingly. Not every theoretically possible extension may be worthwhile. In many cases, a targeted infringement action directed against the headquarters may be enough to bring a multinational company group to the negotiating table.

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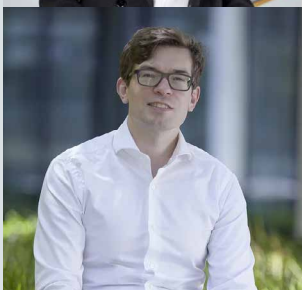

[73] LG München I. (2025). Endurteil v. 25 September 2025 – 7 O 16055/24. In Bürgerservice BAYERN.RECHT, available at: https://www.gesetze-bayern.de/Content/Document/Y-300-Z-GRURRS-B-2025-N-29197.

[74] LG München I, case numbers 21 O 13056/25 and 21 O 13057/25.

[75] US District Court for the Western District of Texas, Order of 13 February 2026, 6:25-cv-00581.

UPC Substantive Law - Comparisons With the EPO and National Courts

This article is a continuation of a series in the *Hoffmann Eitle Quarterly*, in which we compare substantive law at the UPC with that of the EPO and national courts. More details can be found in the News section of the Hoffmann Eitle website, which is regularly updated.

No hindsight allowed: the UPC rejects inventive step attacks that are based on fragmented analyses

UPC Order UPC 337/2025 issued by the Munich Central Division provides important clarification on the methodology for assessing inventive step.

Specifically, the Court emphasised that a prior art document must be assessed as a whole. In doing so, it cautioned against selecting a specific embodiment or example from within a broader disclosure as the starting point for the analysis, unless the prior art itself provides a reason or pointer for doing so. In the absence of such a pointer, isolating a particular embodiment or example bears the risk that such a selection itself already involves hindsight, as the selection may already be influenced by knowledge of the invention. The Court thus underscored that the skilled person would not arbitrarily focus on a specific example, but would instead derive their starting point from the overall technical teaching of the document.
Thus, while EPO practice often starts with a specific embodiment from within the closest prior art based on the criterion of "most features in common", the UPC decision highlights that such a selection must itself be free from hindsight.

The Court furthermore held that it is not permissible to artificially split the claimed subject-matter into individual features and assess their obviousness in isolation. The skilled person interprets individual claim features in light of the claim as a whole and in view of their technical function within the overall teaching (the inventive concept). In the present case, the Court concluded that the skilled person, reading the claim as a whole in the context of the description, using its common general knowledge, would understand that the claim features are interdependent. Against this background, the inventive step assessment must consider whether the skilled person would have been led to the claimed combination as a whole, rather than treating the features as independent building blocks that can be evaluated separately.

The Court thus rejects a fragmented, feature-by-feature analysis, if the claim features are interdependent even without synergy. By contrast, the EPO often requires the presence of a synergistic effect to support an inventive step based on a combination of features (CLB I.D.9.3.2).

Overall, the UPC Order appears more patentee-friendly than the general approach taken at the EPO on these points.

The UPC aligns with the EPO on added matter

The EPO is notorious for adopting a strict approach to the assessment of added matter. Early decisions from the UPC have indicated that the UPC might be more lenient in its approach. For example, in Abbott v. Sibio, the UPC Court of Appeal (CoA) considered whether the omission of an elastomeric 'sealing member' from an on-body sensor device adds matter. In particular, the CoA asked whether the skilled person would consider the sealing member to be "necessary for achieving the overall aim and effect of the invention", suggesting that the UPC may place more focus on the function and purpose of the original disclosure than might be expected from the EPO. However, in Abbott v. Sibio there was no parallel EPO decision for direct comparison.

In Guardant Health v. Sophia Genetics, the UPC Local Division in Paris considered whether the combination of features recited in the granted claims of EP 3 591 073 B1 (EP'073) added matter, with the features arising from a numbered embodiment in the description and several elements disclosed in different passages of the description, alongside alternatives to the claimed features. In particular, the UPC considered whether the claimed combination of features was directly and unambiguously disclosed in the original disclosure or whether the application was "used as some kind of reservoir from which scattered fragments can be combined". This terminology is familiar from EPO case law, perhaps indicating the UPC's desire to align with the EPO for assessing added matter. The UPC concluded that Guardant Health "does not provide any arguments to convince the Court that, among all the elements mentioned in the PCT application, the person skilled in the art would have been prompted to choose from among the alternatives proposed, those leading to the invention disclosed in EP'073."

Contrary to Abbott v. Sibio, there are parallel EPO opposition proceedings for EP'073, and this proved to be a relevant factor in the UPC's decision. Specifically, the UPC referred to the EPO Board of Appeal (BoA) Preliminary Opinion issued in the opposition proceedings for EP'073, in which the BoA stated that it was minded to revoke EP'073 for added matter. One of the UPC's criticisms was that the Patentee had not addressed the negative position in the Preliminary Opinion. This is interesting from a procedural perspective, as the Preliminary Opinion was admitted as evidence only after the oral hearing at the UPC took place, and so Guardant Health would have had limited opportunity (if any) to address the Preliminary Opinion. It is also interesting that the UPC gave such weight to the Preliminary Opinion given that it is simply a preliminary indication of the BoA's position, rather than a final decision.

This decision indicates the UPC's desire to align its approach for the assessment of added matter with the EPO. In the EPO BoA hearing that was held after this decision issued, EP'073 was indeed revoked under added matter. It will be interesting to see if the UPC CoA will follow suit.

Infringement of medical device claims: the standard use threshold

In the infringement action Emboline v AorticLab, the Munich Local Division had to decide whether the defendant's medical device infringed a claim directed to an "embolic protection device that can be deployed in a patient's blood vessel to protect the downstream organs from potential emboli" (r. 18). A central dispute was whether the accused product included "graspable structures into which a hook can engage as specified in the patent claim" (r. 51), i.e., structures that would enable removal of the device from the blood vessel (r. 24).

The Court found that the attacked embodiment was "objectively neither intended nor suitable for removal from the blood vessel by means of a hook using the section referred to by the claimant as 'V-shaped'" (r. 52). Instead, it was "normally removed from the blood vessel by pulling it out using the rod to which it is firmly attached" (r. 53).

The Court acknowledged the general principle that infringement is not excluded merely because a device is typically operated in a non-infringing way, even if the manufacturer specifies a different use, "as long as the use of the patented teaching remains possible" (r. 55). For medical devices, however, the Court added an important qualification: an unconventional, claim-compliant use is relevant only if it aligns with professional practice and recognised rules of medical science. In particular, the standard use in medicine requires that the procedure be performed "professionally, carefully and in accordance with current medical standards" (r. 56).

Here, using a hook to retrieve the device did "not constitute proper, professional and intended use", even if technically possible, because it would damage the device and it was at most possible in the context of "unconventional methods in an emergency", which "cannot play a role in the assessment of patent infringement" (r. 57). Accordingly, the Court concluded that the accused device did not infringe the patent.

The decision does not make clear whether, when assessing validity, this feature would also be construed as limited to being suitable for use only under standard medical practice. It will be interesting to see whether the UPC case law further develops in this direction: EPO case law does not expressly include this principle.

As an aside, the case also nicely illustrates a significant downside of making the revocation counterclaim dependent on a finding of infringement: if the counterclaimant establishes non-infringement they must then bear the costs for the revocation counterclaim.[76]

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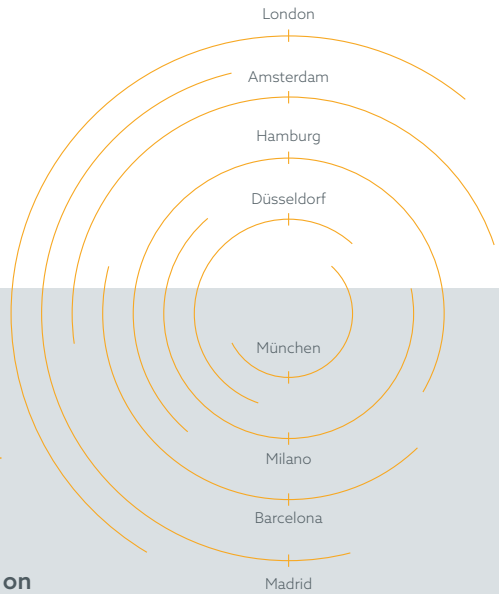
[76] Juliet Redhouse and Marianna Galliani also contributed to this article.



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