

GULDE & PARTNER

NEWSLETTER
Patents

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EPO: Claim construction mandatory | UPC: German Courts most attractive | UPC: Legislation extends to UK | GULDE extends Munich team



The EPO's Enlarged Board of Appeal Landmark Decision G1/24 ("Heated Aerosol")

Mandatory claim construction at the EPO – The impact of the decision G1/24

Background of the case

In the past, the EPO only consulted the description if a claim was found to be unclear. In contrast thereto, German Courts and UPC divisions always start their cases on how to construe the claims, i.e. what is meant by the claim and its features.

The referring Decision T 0439/22 of 24 June 2024 is an appeal against a finding of the EPO opposition division rejecting the opposition. The patent in suit concerns an article for a vaping device, which contains an aerosol forming material (tobacco). A key issue in the appeal was whether claim 1 of the patent as granted was novel.

With the interlocutory decision the Technical Board of Appeal referred the following questions of law to the Enlarged Board:

Question 1

Is Article 69(1), second sentence, EPC and Article 1 of the Protocol on the Interpretation of Article 69 EPC to be applied to the interpretation of patent claims when assessing the patentability of an invention under Articles 52 to 57 EPC?

Question 2

May the description and figures be consulted when interpreting the claims to assess patentability and, if so, may this be done generally or only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation?

Question 3

May a definition or similar information on a term used in the claims which is explicitly given in the description be disregarded when interpreting the claims to assess patentability and, if so, under what conditions?

Decision of the Enlarged Board of Appeal

The enlarged Board of Appeal of the EPO decided that the claims are the starting point and the basis for assessing the patentability of an invention under Articles 52 to 57 EPC.

Most importantly, the description and drawings shall always be consulted to interpret the claims when assessing the patentability of an invention under Articles 52 to 57 EPC, and not only if the person skilled in the art finds a claim to be unclear or ambiguous when read in isolation.

This landmark decision is a step towards aligning claim interpretation principles between the EPO and the national courts as well as the UPC.

The Enlarged Board considers that neither Article 69 EPC and Article 1 of the Protocol, nor Article 84 EPC are entirely satisfactory as a basis for claim interpretation when assessing patentability.

Article 69 EPC and the Protocol are arguably only concerned with infringement actions before national courts and the UPC. Such a conclusion can be drawn from the wording of Article 69 EPC and the Protocol, the drafting history of these provisions, and from their position in the EPC, (Article 69 EPC is found in Chapter III, "Effects of the European patent and the European patent application").

The Enlarged Board considers that there is no clear legal basis, in terms of an article of the EPC, for claim interpretation when assessing patentability. Given the above, the strictly formal answer to Question 1 would be "No". The Enlarged Board will, however, give some further guidance on this issue.

The case law, where the description is referred to only in cases of unclarity or ambiguity, is contrary to the wording, and hence the principles, of Article 69 EPC. It is also contrary to the practice of the national courts of the EPC states and to the practice of the UPC.

The Enlarged Board finds it a most unattractive proposition that the EPO deliberately adopt a contrary practice to that of the tribunals that are downstream of its patents. On this point, the Enlarged Board agrees with the harmonisation philosophy behind the EPC.

A further reason for rejecting this line of Board of Appeal case law is a logical one. The finding that the language of a claim is clear and unambiguous is an act of interpretation, not a preliminary stage to such an interpretative act.

Take-aways

Claim construction will become an issue during patent prosecution. Examiners may ask for even more claim amendments due to clarity under Article 84 EPC. EPO examiners are likely to seek enhanced "clarity" of the claims to avoid ambiguities that might complicate the interpretation: "The correct response to any unclarity in a claim is amendment", is stated in the reasons.

However, it is likely that the EPO will not adopt the German Courts far-stretching claim construction approach. In the famous decision "Rotorelemente", the German Federal Court resolved a contradiction between the claims and the entire content of the description and the drawing by exchanging two mixed up terms of claim 1 against each other.

UPC Statistics – Case Numbers up to 31 August 2025

UPC News: German Courts remain the role model for patent infringement actions in Europe – 2/3 of all UPC cases are filed with German UPC Courts

For decades, German courts remained the role model for patent litigation actions in Europe. One reason is the technical expertise the Judges demonstrated in numerous technical fields. Other reasons are the cost-effectiveness and the speed of the proceedings.

It was interesting to see whether this excellency and attractiveness of the German Courts would last under the new regime of the UPC where different courts all over the member states are available.

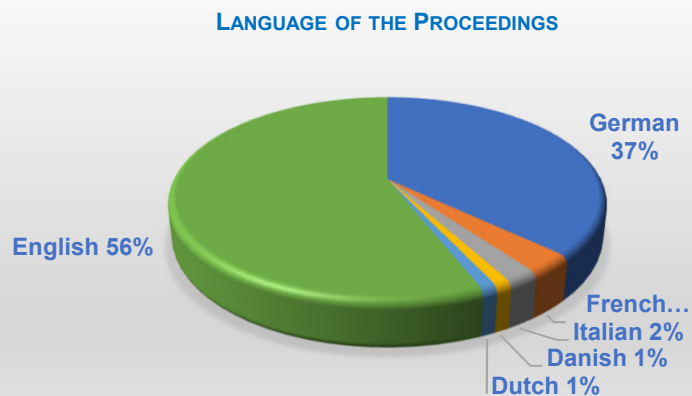
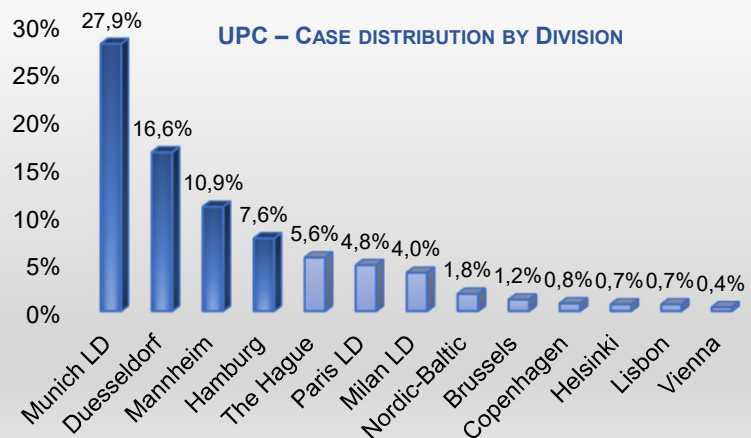
Partners of GULDE & PARTNER recently attended a panel discussion at the AIPPI conference in Yokohama, Japan, which focused on recent UPC developments and statistics.

During the panel discussion, new numbers regarding the case distribution over the different local UPC divisions were presented. The data were collected from the start of the UPC until 31 August 2025.

As clearly visible in the chart on the top right, 2/3 of the cases allocated with the local division are filed with German UPC courts.

Thus, even under the UPC, the German UPC courts remain the predominant legal institution that patent owners from all over the world rely upon. Since the German UPC courts changed its language regime to also hear cases in English, the predominant language changed from German to English.

GULDE & PARTNER is actively participating at the UPC and we look forward to represent your case.



UCP Decisions “Fujifilm Corporation vs. Kodak GmbH”

UPC Jurisdiction extends to UK - The UPC and cross-border litigation

Background of the cases

In different disputes between FujiFilm and Kodak over printing plates, the German UPC Courts Mannheim and Düsseldorf claimed jurisdiction over the UK part of the patents. Two rulings issued in early April for the UPC territory now extend to the UK.

FujiFilm sued Kodak at the Düsseldorf local division of the UPC for infringement of their EP bundle patent EP 3 594 009 B1 granted in 2021 on offset-printing-plate technology. The patent was in force in DE and UK but had lapsed in other designated states before the UPC came into force. FujiFilm pleaded for 10 million EUR in damages and for destruction of all products infringing the patent. The defendant Kodak filed a counterclaim for revocation for the German part of the patent and questioned the UPC's jurisdiction over the UK part of the patent.

Further, FujiFilm sued Kodak at the Mannheim local division of the UPC over EP 35 11 174 and EP 34 76 616. These protect methods for manufacturing planographic and lithographic printing plates.

As the patents are also valid in the UK, the Japanese patent holder FujiFilm requested the court to order the German subsidiaries of the US competitor to refrain from making or marketing their products not only in Germany but also the UK. However, Kodak challenged the UPC's jurisdiction regarding the UK.

Decision

In its ruling the Düsseldorf court states regarding EP 009: *“If the defendant is domiciled in a Contracting Member State (here: Germany), the Unified Patent Court has jurisdiction to hear the infringement action in respect of the UK part of the patent in suit. This also applies if the defendant has filed a counterclaim for revocation in respect of the German part of the patent in suit. Even then, as regards the infringement action concerning the United Kingdom, the Unified Patent Court has jurisdiction to hear the case.”* However, the court did not actually decide on the infringement issue regarding the UK. Since the patent was revoked in the UPC territory, the judges reasoned that it is unlikely a British court would uphold the patent if a party were to challenge it in the UK.

The Mannheim local division found EP 174 valid and infringed. Kodak fared better in the parallel proceedings for EP 616. Here, its counterclaim for revocation succeeded. The court revoked EP 616 due to lack of inventive step (case ID: UPC_CFI_359/2023).

The Mannheim local division also ruled that a defendant in a UPC infringement action relating to the UK part of a European bundle patent is allowed to raise an invalidity defence without being obliged to file a national action for revocation in the UK. According to the judges, the UPC will then assess the validity as a mere prerequisite for infringement. The outcome of the infringement action before the UPC has “inter partes” effect only.

Referring to the CJEU decision “BSH Hausgeräte vs. Electrolux”, the UPC concluded that it indeed has jurisdiction to decide upon the infringement of the UK part of a European bundle Patent (legal basis in Article 24(4) of Brussels I Regulation No 1215/2012). The CJEU held that a national court in the defendant's domicile may hear an infringement case of a patent even when that patent is protected in other countries. This also holds to cases where validity proceedings are pending elsewhere. The important point is that the court does not rule on validity with a third party effect, but assesses the validity for infringement purposes only with a binding effect for the parties concerned!

Impact

Following from this decision, with regard to cross-border litigation, the UPC might become even more attractive. The **long arm** of the UPC extends to the UK.

It is important to note that raising invalidity as a defence in an infringement suit does not block the jurisdiction of the defendant's domicile court to decide the case.



New Hire from Page, White & Farrer Germany LLP

PWF partner Olaf Ungerer is joining GULDE & Partner

GULDE & Partner expands its attorney team with two patent experts from Page, White & Farrer (Germany): Olaf Ungerer, who has been working in intellectual property law for more than 30 years and is well known in the market, will move from PWF to GULDE & Partner on January 1st, 2026. Experienced Senior Patent Professional Dr. Jean-Michel Laffargue will follow him. Both are based in Munich.



Olaf Ungerer
German and EP
Patent Attorney

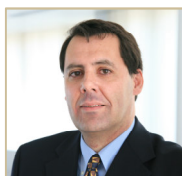
Olaf has been active in intellectual property since 1992, amassing extensive experience in drafting, prosecuting, and defending German, European, and international patent applications across all areas of electrical engineering and physics.

His expertise extends to providing professional opinions on a range of issues, including IP due diligence, freedom to operate (FTO), standard essentiality, infringement opinions, as well as the monetary valuation of patents, trademarks, and domains.

He is also highly skilled in the conduct and procedures of opposition and appeal proceedings before the European Patent Office (EPO) and German authorities, with a particular focus on oral proceedings.

As a member of a working group for patent evaluation at the German standardization institute (DIN), Olaf contributed to the development of the German standard DIN77100 for patent valuation, making him a recognized authority in patent evaluation and portfolio management.

Olaf is an active member of the Patent and Utility Model Working Group of the German Association for the Protection of Intellectual Property and Copyrights (GRUR), which advises the German government on new legislative initiatives. He is also a member of EPLIT.



Dr. Jean-Michel Laffargue
Senior Patent
Professional

Jean-Michel is an IP professional based in Munich since 2004. He previously worked as a research engineer in high-voltage technology at Schneider Electric and holds a Ph.D. with highest honors.

His expertise includes dielectric materials, high-voltage protection, semiconductor devices, telecommunications, mobile communications, medical devices, and more.

Jean-Michel is a native French speaker, fluent in English, proficient in German, and knowledgeable in Dutch.



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At the side of GULDE, the expansion and onboarding as well as the integration of the client base following Olaf and Jean-Michel to GULDE is managed and supervised by Partners Dr. Jan Neigenfink and Nicolas Haße.



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