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DOI: 10.17803/2713-0533.2025.4.34.882-907

Towards the Uniformity and Consistency in Jurisprudence on the European and Eurasian Patents

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Abstract: The paper analyzes dispute-resolution practice for European patents and evaluates mechanisms to ensure its uniformity, with emphasis on the functioning of the European Union. The European patent dispute system is complex and involves multiple adjudicative bodies — national courts of contracting states to the European Patent Convention, the European Patent Office's Boards of Appeal, the Unified Patent Court, and the Court of Justice of the EU — which creates a need for tools to harmonize case law and consolidate European patent law. Using comparative legal analysis and statistical data on Eurasian patent disputes, the study assesses the applicability of European harmonization mechanisms to the Eurasian patent system and concludes that establishing a specialized supranational court for Eurasian patents would currently be premature. The analysis draws on foreign and Russian scholarly literature, national court practice across Europe, and decisions of the Court of Justice of the European Union (CJEU), the European Patent Organization (EPO) and the Court of Intellectual Property Rights.

Keywords: Unified Patent Court; European Patent Court; disputes on European patents; disputes on Eurasian patents; European patent; Eurasian patent

Cite as: Kasyanov, R.A. and Yazberdiev, I.M., (2025). Towards the Uniformity and Consistency in Jurisprudence on the European and Eurasian Patents. *Kutafin Law Review*, 12(4), pp. 882–907, doi: 10.17803/2713-0533.2025.4.34.882-907

Contents

I. Introduction

The European Patent Convention of 1973 (hereinafter referred to as the EPC, Munich Convention) was adopted as one of the first steps towards the harmonization of European patent law. The EPC stipulates rules for granting a European patent, which is effective in one or more contracting states. Once granted the European patent becomes a subject of national regulation of each designated EPC member state. In other words, the European patent does not have a unitary character in the EPC countries and represents a set of patents with a legal force equivalent to national patents (the so-called "classical" European patent). Thought the preamble to the EPC indicates the desire of its member states to define certain standard rules governing European patents so granted, which, however, may signal on the limited potential of the Munich Convention in terms of harmonizing European patent law. At the same time, the EPC serves as a basis for further steps towards the harmonization of European patent law. The EPC sets forth that any group of its member states are free to conclude an international agreement according to which such a European patent has a unitary character in the territory of these countries. With the adoption of Regulation (EU) No. 1257/2012

of the European Parliament and of the Council of 17 December 2012 on enhanced cooperation in the field of unitary patent protection (hereinafter referred to as Regulation (EU) No. 1257/2012), a European patent may, at the request of its holder, acquire a unitary effect. Such a patent is called a European patent with unitary effect, or, as it is commonly abbreviated, a unitary patent (hereinafter in the paper such a patent will be referred to as a unitary European patent).[1]

Dispute resolution on European patents is complicated by the number of jurisdictional bodies whose competence includes the consideration of such cases: national courts of the member state to the EPC, appeal bodies of the European Patent Office (EPO), the Unified Patent Court (UPC), the Court of Justice of the EU (CJEU). The same European patent may be the subject of parallel judicial and quasi-judicial proceedings, which may lead to legal uncertainty. Thus, the national court of the EPC countries have repeatedly come to different and contradictory decisions when considering disputes over the same European patent (see, for example, *Novartis and Gibavision v. Johnson & Johnson*, *Document Security System v. European Central Bank*, *Pozzoli v. BDMO SA*, *Conor v. Angiotech*, *Apple v. Samsung*, etc.) (Khuchua, 2019, pp. 262–263). However, this can be explained by the lack of a single legal regulation of the validity of issued European patents and the existing differences in the procedural rules for considering patent disputes.

This paper examines mechanisms developed to harmonize and unify the approaches to resolve disputes concerning European patents.

II. Protocol on Interpretation: Challenges of Harmonization of the National Judge's Approaches to Patent Claim Interpretation

The Protocol on the Interpretation of Art. 69 EPC (hereinafter referred to as the "Protocol") was adopted to supplement the Munich Convention and provides guidance on the use of the European patent application materials on the basis of which the scope of protection

[1] Hereinafter in the article, a term "European patent" will be referred both to the classical European patent and the unitary patent (the European patent with unitary effect), unless the context indicates otherwise.

conferred by a European patent is determined. According to the Protocol, the scope of protection should be determined in an approach that ensures "fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties." Since the outcome of a patent dispute depends largely on the determination of the scope of protection, the "golden mean" principle enshrined in the Protocol was intended to serve as an effective means of ensuring uniform practice in the examination and resolution of disputes on European patents by national courts. Nevertheless, this measure did not preclude national courts from rendering inconsistent decisions on the same European patent in proceedings between the same parties.

The original version of the Protocol included only one article that prescribed national judges to follow a "middle ground" between the strict (literal) and liberal (broad) approaches when determining the scope of protection afforded by a European patent. In the first case, the wording used in the claims is limited to its literal meaning. This approach provides a reasonable degree of certainty for third parties, but on the other hand, there remains a risk of unfairness to the patent owner if what he believes he is claiming is excluded by the use of the wording in the claims in its strict, narrow meaning. In the second case, the wording in the claims is used only as a guide to determine the "inventive concept" protected by the patent. This approach guarantees a sufficient level of protection for the patent owner but leaves third parties uncertain as to the extent of the legal protection of the patented invention (England, 2016, p. 689). By thus conferring upon courts broad discretion in interpreting Art. 69 EPC and in determining the extent of legal protection, the Protocol has been described as a "masterpiece of ambiguity" (Baillie, 1976, p. 153).

This remark is not unfounded. The fact is that within the framework of national jurisdictions, the formation of the practice of considering disputes on European patents was determined by the established features in the approaches to the construction of the formula of an invention and its interpretation in order to determine the scope of legal protection provided. Accordingly, EPC contracting states adopt divergent positions with respect to the doctrine of equivalents. For example, the English legal order's adherence to a literal approach to defining the scope of

protection generally precludes recourse to the doctrine of equivalents, whereas that doctrine is applied, in varying forms, in the German, French and Dutch legal systems. In other words, if the doctrine of equivalents is recognized, holders of European patents can count on a more liberal approach in the process of protecting their own patent rights, relying on a broader interpretation of the claims and, as a result, broader legal protection. If the doctrine of equivalents is denied, the legal protection provided by the patent is considered narrower, which, in turn, provides some certainty to third parties regarding the scope of legal protection of the patented invention.

Thus, in the absence of uniform and explicit rules for determining the scope of legal protection of a patented invention (and this issue is one of the basic ones in the process of resolving a patent dispute), the courts of European countries are forced to be guided by approaches that either had already been established by the time the EPC was adopted, or were still in the process of being developed. For this reason, it seems inevitable that the courts of the EPC countries will issue divergent decisions on a dispute over the infringement or revocation of the same European patent. The most illustrative example is *the Improver case*, where a patent owner sought for an injunction against the use of the patented invention in the competitor's products developed by Remington Corporation. The decisions of the courts of European countries in this case turned out to be contradictory: for example, in Germany, Belgium, Italy and the Netherlands, the courts considered the infringement of the European patent proven, while the courts in England, Austria and France came to the opposite conclusion, rejecting the patent holder's claim (Khuchua, 2019, pp. 261–262).

At the same time, following the Protocol's adoption, a gradual shift has been observed in some national courts of certain European jurisdictions' attitudes toward the doctrine of equivalents and in their approaches to its application. This is especially noticeable in the practice of English courts, whose position changed significantly after amendments were made to the text of the Protocol, effectively recognizing the application of the doctrine of equivalents. Thus, in the further cases the so-called "Protocol questions" were formulated, which constitute a three-step test for the application of purposive interpretation methods (England, 2016,

p. 691). Later, in *the Kirin-Amgen case*,[2] the compliance of the principle of purposive interpretation with the provisions of the Protocol was confirmed, but the court clarified that the Protocol questions should be used solely as a guide for the judge who must answer the key question: "What would a person skilled in the art have understood the patentee to have used the language of the claim to mean."[3] It concluded that the Protocol "shuts the door on any doctrine which extends protection outside the claims."[4] Ultimately, the precedent established in Actavis recognized the applicability of the doctrine of equivalents in English patent law, at least insofar as European patents are concerned.

In German patent law, the recognition of the doctrine of equivalents was established in the *Formstein case*.[5] Suggested In essence, the legal position articulated in that case is that the scope of legal protection extends to equivalent claim features that would have been regarded by a person skilled in the art as obvious substitutes for the claimed features (England, 2016, p. 692). The standard of proof by which such obviousness is established has been developed in subsequent case law, the most notable example being Schneidmesser I.[6] The standard of proof is a three-step test consisting of three consecutive questions accepted to be called Schneidmesser questions ("Schneidmesser questions"). The wording of the Schneidmesser questions is similar to the Protocol questions developed by English judges in the previously mentioned *Catnic and Improver cases* (England, 2016, p. 692). At

[2] United Kingdom House of Lords. Kirin-Amgen Inc. v. Hoechst Marion Roussel Ltd & Ors. [2004] UKHL 46 (21.10.2004). Available at: https://publications.parliament.uk/pa/ld200304/ldjudgmt/jd041021/kirin-1.htm [Accessed 03.01.2025].

[3] United Kingdom House of Lords. Kirin-Amgen Inc. v. Hoechst Marion Roussel Ltd & Ors. [2004] UKHL 46 (21.10.2004), Para. 69.

[4] United Kingdom House of Lords. Kirin-Amgen Inc. v. Hoechst Marion Roussel Ltd & Ors. [2004] UKHL 46 (21.10.2004), Para. 44.

[5] Federal German Court. Case Law Decision of the Bundesgerichtshof (Federal Court of Justice), 10th Civil Senate, of 29 April 1986 (X ZR 28/85). OJ EPO 1987, 551. Available at: https://www.epo.org/xx/legal/official-journal/1987/12/p551/1987-p551.pdf [Accessed 03.01.2025].

[6] Federal German Court. Case Law Decision of the Bundesgerichtshof (Federal Court of Justice), 10th Civil Senate, of 29 April 1986 (X ZR 28/85). OJ EPO 1987, 551. Available at: https://www.epo.org/xx/legal/official-journal/1987/12/p551/1987-p551.pdf [Accessed 03.01.2025].

the same time, according to German jurisprudence, the application of the doctrine of equivalents may be limited if an equivalent element of claims is recognized as unpatentable (*Formstein case*) or is disclosed in the description but not claimed as an independent element of claims (so-called "selection decision principle") (*Occlussion*[7] and *Diglycidyl*[8]).

III. Judicial Cooperation as a way to Harmonize the Practice on Disputes over the European Patents

Judicial cooperation between national courts is perhaps an unobvious but, as it turns out, quite successful and probably a promising and effective way to harmonize the practice of European patent litigation and, as a consequence, European patent law itself (Walsh, 2019, p. 423). Judicial cooperation may be exercised through studying foreign case law while considering pending patent disputes by national judges or in informal meetings and internships of patent judges.

In adjudicating patent disputes, British judges have repeatedly relied on decisions of their foreign counterparts. For example, in the *Grimme case*[9] a decision of a foreign superior court had precedential value among EPC member states when that dispute involved a point of patent law of general importance ("where a point of patent law of general importance"). According to the UK Court of Appeal, it is possible to depart from the reasoning of a foreign judgment if there is a firm conviction that the foreign court's findings are erroneous. It is interesting to note that the *Grimme* judgement emphasizes the importance of applying the same rules wherever possible, given the

[7] Federal German Court. Bundesgerichtshof, Urteil 10.05.2011. X ZR 16/09. (In Germ.). Available at: http://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&nr=56437&pos=0&anz=1 [Accessed 03.01.2025].

[8] Federal German Court. Bundesgerichtshof. Urteil. 13.09.2011, X ZR 69/10. (In Germ.). Available at: https://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&az=X%20ZR%2069/10&nr=58039 [Accessed 03.01.2025].

[9] United Kingdom Court of Appeal (Civil Division). Grimme Maschinenfabrik GmbH & Co KG v. Derek Scott (t/a Scotts Potato Machinery). 2010. WCA Civ 1110. Available at: https://www.bailii.org/ew/cases/EWCA/Civ/2010/1110.html [Accessed 03.01.2025].

absence of a common patent court for the EPC countries, and notes the success of national judges in ensuring some degree of uniformity by referring to foreign court decisions. The Grimme case is also notable for the fact that the English judges engaged in consultations with their German and Dutch counterparts, inquiring whether they had encountered analogous cases concerning the matter at issue.

Later, in *Schütz*[10] the UK Supreme Court took into account the judgement of the German courts, since Germany is also a party to the EPC. In the course of the case, it was observed that due to the different approaches to many patent law issues, it was not possible to achieve complete consistency in the national courts, which, however, is not excluded in the future. Therefore, according to the English judges, "it is sensible for national courts at least to learn from each other and to seek to move towards, rather than away from, each other's approaches." As *the Warner-Lambert case*[11] shows, foreign judgements have prompted English judges to re-examine their own findings with respect to the same European patent. Nevertheless, while acknowledging the undesirable circumstance of divergent decisions concerning the same European patent, the judge maintained his position, which was noted to be less favorable to the patent and apparently at variance with the views of his foreign counterparts.

French judges also occasionally refer to the judgments of their foreign counterparts, for example in cases such as *Milan v. AstraZeneca*, *Warner-Lamber v. Sandoz*, *MVF v. Intelligent Insect Control*, *Lilly v. Sanofi-Aventis*, *Akzo v. Nobel* (Walsh, 2019). However,, French court decisions are characterized by their brevity, which makes it difficult to assess how much weight French judges ultimately attach to foreign judgements (Walsh, 2019, p. 428).

Regular informal meetings of judges from EPC member states, held in various formats, play a significant role in the harmonization

[10] United Kingdom Supreme Court. Schütz Ltd. v. Werit Ltd. Case No: A3/2009/2582. [2013] UKSC 16. Available at: https://www.bailii.org/uk/cases/UKSC/2013/16.html [Accessed 03.01.2025].

[11] United Kingdom Supreme Court. Warner Lambert Company LLC v. Generics (UK) Ltd t/a Mylan and another [2018] UKSC 56. Available at: https://www.bailii.org/uk/cases/UKSC/2018/56.html [Accessed 03.01.2025].

of practices in patent dispute resolution and in the development of European patent law more broadly. First, the harmonization of European patent litigation practice is facilitated by the appointment of so-called "external members" to the Enlarged Board of Appeal from among the national judges (Art. 11(5) EPC, Rule 12d(2) of the EPC Implementing Regulations). At the same time, external members are entitled to continue to perform their employment and official duties at the national level, i.e., to continue to be national judges.

Secondly, particular emphasis should be placed on the European Patent Judges' Symposium and the European Forum of Judges. The European Forum of Judges is convened biennially, while the Symposium is held on an annual basis. The European Patent Judges' Symposium dates back to 1982 and it is held every two years. During the meetings, representatives of national courts, the Court of Justice of the EU and the Enlarged Board of Appeal exchange experiences, ideas and opinions on points of debate in European patent law, including through case studies. According to the data published on the website of the European Patent Organization, the Symposium of European Patent Judges was last held in 2015. In contrast to the Symposium, the European Judges' Forum continues to bring together leading experts annually to discuss key developments in patent law and practice.

Thirdly, the EPO organizes regular internships for national judges. These internships provide national judges with the opportunity to become more familiar with the EPO's practice, which can then be applied in specific cases at the national level.

IV. Cooperation between EPO and National Courts to Harmonize the Practice on European Patent Disputes

In addition to judicial mechanisms, a European patent may be challenged in a "quasi-judicial" proceeding. Thus, within nine months following the publication of the decision to grant a European patent, any interested party may lodge an opposition with the European Patent Office against the grant of said patent. Upon examination of the opposition, the European patent may be upheld, revoked or amended; the decision shall have legal effect in the territory of all EPC member

states in respect of which the European patent has been granted. The decision on the opposition may be appealed against. In such a case, the appeal is heard by the Board of Appeal and, if the case has a precedent-setting character, by the Enlarged Board of Appeal.[12]

The harmonization of national court practice with the legal positions established by the European Patent Office in the course of opposition proceedings and appeals concerning European patents constitutes another mechanism for aligning legal approaches in the resolution of European patent disputes. UK judges are considered to be the most active in this regard. Thus, in the *Merrell Dow case*, the UK's duty was for the first time articulated as an obligation to interpret the provisions of national patent law, insofar as possible, in conformity with the interpretation of analogous provisions of the EPC, requiring courts to take into account the decisions of the Boards of Appeal (Walsh, 2019, p. 424). It was recognized that, although such decisions were not legally binding, they should be accepted as persuasive authority. In *Genentech*, the UK Court of Appeal reaffirmed the duty of enforcers to interpret national patent law in the spirit of the Munich Convention, noting that if such an approach resulted in a departure from established practice, it should be regarded as the intention of the judges to comply with the EPC (Walsh, 2019, p. 424).

At the same time, the declared "duty" does not mean that English judges must rely unconditionally on the EPO's practice. In *Biogen*, the UK House of Lords reached different conclusions from those reached by the EPO, while noting that there was no divergence in the practice of the two enforcement bodies (McDonagh, 2017). Further, in the *Human Genome Science* case, recognizing the importance in consistency of approaches, the UK court noted that the national court is not bound by the reasoning of the EPO's decision where, in the opinion of the national court, the EPO makes a decision that is inconsistent with the EPC or its prior practice.[13] As a result, the judges held that the UK courts favor a uniform approach in interpreting the EPC and national patent law

[12] Hereinafter in the text of this article, both the "Boards of Appeal" and the "Enlarged Board of Appeal" will be collectively referred to as "Boards of Appeal" or "EPO" unless the context requires clarification.

[13] United Kingdom Supreme Court. Human Genom Sciences Inc. v. Eli Lilly. 2011. UKSC/2010/0047. Available at: https://supremecourt.uk/uploads/uksc_2010_0047_judgment_1b5c97f73a.pdf [Accessed 03.01.2025].

and in adhering to EPO practice, while preserving a certain room for dialogue that allows lower courts to depart from an EPO decision if, in their view, it is inconsistent with the EPC, prior domestic practice, or is based on a misunderstanding of the parties' arguments.

Germany also recognizes the importance of the EPO's jurisprudence in European patent invalidation cases. For example, in *Zahnkranzfräser*,[14] the German court ruled that although the EPO's decisions in its European patent invalidation proceedings were not legally binding, they constituted expert opinions of considerable weight, which should be taken into account when assessing patentability in national proceedings. This legal position was later confirmed by the German Federal Supreme Court in *Walzenformgebungsmaschine*,[15] where it was held that although the Federal Patent Court was not bound by EPO decisions inconsistent with national jurisprudence, it seemed appropriate to adopt a decision in the interest of the uniform application of European patent law.

It should be noted that not only do national courts take into account the decisions of the European Patent Office, but, conversely, the EPO periodically examines and takes an interest in the interpretative practices of the European Patent Convention as developed by national courts and national patent offices. Thus, the decision in *Case G5/83* indicates the obligation of the EPO and its appeal panels to take into account the practice of interpretation of the EPC by national courts and patent offices of the States Parties to this international agreement. At the same time, later in *the G1/13* case, the EPO was recognized as having a decisive role to play in the interpretation of the EPC and in making decisions at last instance on matters relating to the grant of European patents.[16] However, the EPO cannot be relieved by the EPO

[14] Bundesgerichtshof, 5 May 1998 (X ZR 57/96). (In Germ.). Available at: https://www.epo.org/en/legal/official-journal/1999/05/p322.html [Accessed 03.01.2025].

[15] Bundesgerichtshof, 15 April 2010 (Xa ZB 10/09). (In Germ.). Available at: https://www.epo.org/en/legal/official-journal/2010/11/p622.html [Accessed 03.01.2025].

[16] Technical Board of Appeal. Case number T154/04, 15.11.2006. Available at: https://www.epo.org/boards-of-appeal/decisions/pdf/t040154ep1.pdf [Accessed 03.01.2025].

of its assigned duty to act as an independent quasi-judicial body due to harmonization considerations.[17] Therefore, when provisions of national law conflict with the meaning of the EPC, the EPO is limited in relying in its decisions on the practice of national courts and national patent offices.[18]

V. UPC: New Hopes for Effective Harmonization of Patent Litigation Practice in Europe

The Agreement on the Unified Patent Court, also known as the Unified Patent Court Agreement, (hereinafter UPCA) was adopted by a number of EU member states in 2013. The UPCA provides for the establishment of the Unified Patent Court (UPC), a court common to the member states of the UPCA that forms part of their national judicial systems and possesses exclusive jurisdiction over disputes concerning both unitary and "classical" European patents. The UPC consists of a Court of First Instance and a Court of Appeal. The Court of First Instance consists of a central division as well as local and regional divisions. Local divisions are established in the UPCA member states upon request, and regional branches are established for two or more the UPCA member states upon request. There are currently twenty local and regional divisions and one central division based in Paris, with sections in Munich and Milan. The Court of Appeal operates in panels based in Luxembourg. As a rule, cases before the Court of Appeal are heard by panels of five judges.

Since the UPC became operational on 1 June 2023, it is premature to speak about the influence of the practice of this international specialized judicial body on the harmonization of approaches in the examination of European patent disputes by national courts or EPO's appellate boards. Therefore, for the time being, it cannot even be said that national courts or EPO's appellate boards rely on the case law of the UPC. Moreover,

[17] Technical Board of Appeal. Case number T154/04, 15.11.2006.

[18] Enlarged Board of Appeal. Case number G0001/13, 25.11.2014. Available at: https://www.epo.org/boards-of-appeal/decisions/pdf/g130001ex1.pdf [Accessed 03.01.2025].

that with so many judicial divisions within the UPC, conflicting practice between central, local and regional divisions may be inevitable (Cohen, 2024). Therefore, first, care should be taken to ensure that the UPC does not disintegrate into disparate local court jurisdictions applying different practices in patent disputes (Michele-De Gazotte et al., 2022). This is expected to take years of work by the Court of Appeal (Cohen, 2024) that may decide to transfer a case to the full composition of the UPC if the case is of exceptional importance and the decision may affect the uniformity and consistency of the jurisprudence.

The UPC shall be composed of legally qualified judges and technically qualified judges. To ensure the independence and impartiality of the UPC, judges are prohibited from engaging in any other activity, regardless of whether it generates income, except where otherwise permitted by the Administrative Committee. However, the right of legally qualified judges can combine their duties with judicial functions at the national level, subject to conflict-of-interest rules (Art. 17(3) of the UPCA), is noteworthy. Apparently, this is not an exception but is already an active practice in the work of UPC. Thus, recently appointed new judges of the Unified Patent Court continue to perform their duties in national courts (Klos, 2024). It seems that such overlap could potentially have a positive effect on the harmonization of European patent litigation practice at the national and supranational levels. Conversely, such judges may transfer to the UPC the legal approaches used in patent disputes before national courts.

In addition, in order for national courts to apply the case law of the UPC, special mechanisms are required. Such mechanisms have been discussed earlier in the paper. In Germany, for example, the decision in *Walzenformgebungsmaschine*[19] to review decisions rendered by EPO authorities and by courts of other EPC member states addressing a substantially similar issue and, where appropriate, to provide reasons for reaching a different conclusion. However, in some jurisdictions, e.g., the Netherlands, such mechanisms are not observed in the practice of

[19] Bundesgerichtshof, 15 April 2010 (Xa ZB 10/09). (In Germ.). Available at: https://www.epo.org/en/legal/official-journal/2010/11/p622.html [Accessed 03.01.2025].

national courts even when the case involves the same parties, more or less the same facts and the same European patent (Michele-De Gazotte et al., 2023). It remains to be seen how actively national courts will rely on the case law of the UPC in European patent disputes, but it may be assumed that this will not present a significant challenge for those jurisdictions that are, to a greater or lesser extent, familiar with the doctrine of precedent (e.g., Germany, France).

Even in the UK, which was a signatory to the UPCA but had to withdraw from this international agreement due to Brexit, the case law of the UPC may have relevance (Michele-De Gazotte and Snape, 2023). It has been suggested that Ireland could serve as an alternative to representation of the UK jurisdiction in the UPC. The accession of that country would be reportedly an important development as Ireland would be the first and the only state party to UPCA representing the common law system. UPCA and the Rules of Procedure contain common law principles and procedures with which continental law judges may not be familiar (Whelan et al., 2023, p. 31). In this context, the Irish jurisdiction of the UPC may be of particular interest to those who rely on common law principles and rules (e.g., US companies). In addition, there has been a significant increase in the presence of international pharmaceutical companies in Ireland in recent years. The prospects for informal interaction between the English courts, where the proportion of patent disputes is not likely to decrease, and the judges of the Irish division of the UPC, for whom the decisions of their English colleagues are generally persuasive and authoritative, are therefore interesting (Whelan et al., 2023, pp. 31–33).

Some patent specialists hope that if the UPC can achieve harmonization of the practice of patent litigation between court divisions, such a result will definitely have a positive impact on the practice of national courts, and consequently there will be prospects for uniformity in the practice of European patent litigation at both national and supranational levels (Michele-De Gazotte et al., 2022). Sir Robin Jacob, former UK patent judge, one of the architects of the UPC argued that national courts will listen to the legal positions of the UPC, as the decentralized system of national courts and Board of Appeal deciding patent disputes

with conflicting decisions will not be a thing of the past.[20] It is also important that the UPC, in its turn, is not going to "reinvent the wheel," but, as the President of the UPC Court of Appeal said in one of his interviews, will seek to take into account the case law already established by the national courts and the Board of Appeals.[21]

VI. The Role of the CJEU in Harmonization of Patent Litigation Practice

The CJEU does not examine patent disputes on the merits but gives the so-called preliminary rulings concerning the interpretation of the EU Treaties and legal acts of the EU institutions at the request of national courts (Art. 267 TFEU). The binding nature and legal force of the CJEU's preliminary rulings are determined not by the EU Treaties, but by the established practice of the CJEU itself (Ispolinov, 2016, pp. 72–74). Thus, in its preliminary rulings in the International Chemical Corporation case, the CJEU stated that there are sufficient grounds for any national court — not only the court that submitted the preliminary request — to regard an EU legal act declared invalid in a preliminary ruling as invalid for the purposes of resolving disputes before it.[22] Further, in *Köbler case*,[23] the CJEU held that if a national judgement was made with an apparent refusal to follow the established practice of the CJEU on the matter, this would be considered a sufficiently serious

[20] Unified Patent Court: "Conflicting decisions aren't something of the past." Kluwer Panet Blog. 13.12.202 Available at: https://patentblog.kluweriplaw.com/2023/12/13/unified-patent-court-conflicting-decisions-arent-something-of-the-past/ [Accessed 03.01.2025].

[21] No such thing as a "wait and see" approach, warns UPC's top judge as sunrise period begins. / IAM Media. 01.03.2023. Available at: https://www.iam-media.com/article/no-such-thing-wait-and-see-approach-warns-upcs-top-judge-sunrise-period-begins [Accessed 03.01.2025].

[22] European Court of Justice. Case C-66/80, International Chemical Corporation v. Amministazionne delle Finanze dello Stato. 1981, ECR 1191. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A61919808oCJ0066 [Accessed 03.01.2025].

[23] European Court of Justice. Case C-224/01, Gerhard Köbler v. Austria. 2003, ECR I-10239. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62001CJ0224 [Accessed 03.01.2025].

violation. In other words, the preliminary ruling of the CJEU is that it is binding for all national courts of the EU countries. In subsequent cases examined by the CJEU (see e.g., *Traghetti*,[24] *Ferreira*[25]) the binding nature of its preliminary ruling has only been reinforced (Demark, 2020, pp. 358–365).

Interestingly that none of the EU legal acts applicable in the field of European patent law contains norms defining the criteria of patentability, signs of infringement and grounds for invalidity of a European patent, i.e., the basis of substantive patent law. These issues are regulated by international treaties (EPC, UPCA) or national legislation of the EU countries, and, accordingly, they cannot be referred to the CJEU for their interpretation. It is noteworthy that rules of such content are absent even in Regulation (EU) No. 1257/2012, as a result of which this legal act is often described as an "empty shell."[26] On the contrary, the rules defining the elements of direct and indirect infringement and cases excluded from patent protection have been transferred from the original version of this legal act to the text of the UPCA (Wadlow, 2013, pp. 207–208). This solution was proposed by the UK and was justified by the desire to limit the jurisdiction of the CJEU, as its judges were considered to lack the necessary expertise in the field of patent disputes, and the procedure to give a preliminary ruling takes a long time and leads to additional costs.[27]

It seems that one of the reasons for this skeptical attitude towards the CJEU was its jurisprudence on the interpretation of the

[24] European Court of Justice. Case C-173/03, Traghetti del Mediterraneo SpA [2006] ECR, p.I-5177. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62003CJ0173 [Accessed 03.01.2025].

[25] Court of Justice of the European Union. Case C-160/14, João Filipe Ferreira da Silva e Brito and Others v. Estado português. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62014CA0160 [Accessed 03.01.2025].

[26] *See*: Unitary Patent system is an arbitrary and ailing hybrid monster mix. // Kluwer Patent blogger. 09.12.2021. Available at: https://patentblog.kluweriplaw.com/2021/12/09/unitary-patent-system-is-an-arbitrary-and-ailing-hybrid-monster-mix/ [Accessed 03.01.2025].

[27] House of Commons European Scrutiny Committee-Sixty-Fifth Report of Session 2010-12, The Unified Patent Court: Help or Hindrance? Pp. 15–19. Available at: https://publications.parliament.uk/pa/cm201012/cmselect/cmeuleg/1799/1799.pdf, https://doi.org/10.1093/jiplp/jps230 [Accessed 03.01.2025].

Regulation (EC) No. 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificates for medicinal products (SPC Regulation).[28] The need for supplementary protection certificates (SPCs), which extend the term of patent protection for up to five years, arises from the fact that the grant of marketing authorization for medicinal products requires clinical trials and other lengthy studies. The SPC Regulation appeared to be difficult for national courts to apply, which has led to a steady stream of applications to the CJEU requesting interpretation of this legal act. In turn, the provision of Art. 3(a) of the SPC Regulation, which requires that an SPC be granted only for a product protected by the basic patent, has proved to be the most difficult for the CJEU to interpret. Despite the repeated interpretation of this provision by the CJEU, the questions of what kind of subject matter is to be protected and what criteria should be used to determine whether a product is protected by a basic patent remain controversial and open (Cambrook and Millson, 2020).

In the Brüstle case[29] the CJEU interpreted certain rules of European Parliament and of Council Directive No. 98/44 dated 6 July 1998 on the legal protection of biotechnological inventions (Biotechnology Directive). The CJEU defined the concept of human embryo broadly and classified stem cell inventions applicable not only for industrial and commercial purposes but also for research purposes as unpatentable. By doing so CJEU significantly expanded the scope of application of the exceptions to patentability under Biotechnology Directive. The CJEU's findings raised serious concerns and effectively left biotechnological research developments without the right to patent protection undermining the prospects for new stem cell-based therapies (Vrtovec and Scott, 2011, pp. 502–503). However, the CJEU later clarified its conclusions regarding patentability of stem cell inventions in *the International*

[28] Regulation (EC) No. 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products (Codified version) (Text with EEA relevance) OJ L 152, 16.06.2009, pp. 1–10. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32009R0469 [Accessed 03.01.2025].

[29] European Court of Justice. Case C-34/10, Oliver Brüstle v. Greenpeace eV. ECR I-09821. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62010CJ0034 [Accessed 03.01.2025].

Stem Cell case[30] by limiting its previously proposed broad definition of a human embryo (Minssen and Nordberg, 2015). In the light of this new preliminary ruling, some argued that the CJEU's findings in *the Brüstle case* were based on "poor technical advice" (Brack, 2016), which probably led to the disputed conclusions.

VII. Dispute Resolution Concerning Eurasian Patents: Implementing European Experience

Disputes concerning Eurasian patents granted under the Eurasian Patent Convention (EAPC) possess certain specific features. First, the structure of the Eurasian Patent Organization (EAPOrg) lacks a body competent in examination of revocation proceedings. A Eurasian patent can be challenged by filing an opposition with the Eurasian Patent Office (EAPO) under the administrative revocation procedure. Such an opposition may be filed within three years of the grant of a Eurasian patent. An *ad hoc* panel composed of three EAPO examiners is constituted to consider an opposition filed against the grant of a Eurasian patent. The decision made regarding the opposition can be appealed by filing an appeal to the President of the EAPO, who appoints a new panel. A Eurasian patent annulled under the administrative revocation procedure shall be deemed not to be in force in all EAPC countries from the date of filing of the Eurasian patent application.

Secondly, a Eurasian patent may be revoked before national courts or national patent offices during its term. In all EAPC member states except Kazakhstan, a revocation action is subject to mandatory pre-trial examination by the national patent office, whose decision is effective within the territory of the respective state and may be appealed in court. In the event of simultaneous contestation of a Eurasian patent at both the national and supranational (EAPO) levels, a decision to invalidate the patent may be rendered by a judicial or other competent authority of an EAPC member state only after the administrative annulment procedure

[30] European Court of Justice. Case C-364/13. International Stem Cell Corp. v. Comptroller General of Patents, Designs and Trade Marks. 2014. Available at: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62013CJ0364 [Accessed 03.01.2025].

has been completed. Infringement cases are heard by courts of different levels whose judgements are effective only in those countries where they were made. No conflicting judgements over the same Eurasian patents were found in the EAPC countries, although some scholars argue that different national courts have come to inconsistent decisions regarding infringement of the same Eurasian patents (Krupko, 2018, p. 206).

According to the EAPOrg, since 2010, only 40 oppositions against the grant of a Eurasian patent have been filed with EAPO. At the national level, since 2018 approximately 70 oppositions and revocation actions against Eurasian patents have been filed in the EAPC member states, with the overwhelming majority of such cases registered in Russia,[31] followed by Belarus and Kazakhstan; in the other jurisdictions no such cases have been recorded.[32] The Russian jurisdiction seems to be a preferable forum for disputes over the Eurasian patents because of functioning of the Intellectual Property Court (IP Court) there; no patent courts were established in other EAPC countries. The total number of infringement cases is unknown and appears not to be amenable to reliable quantification.

At present, the IP Court is confronted with gaps in Eurasian patent regulation and is seeking ways to discern the actual intent of the EAPC signatories and to ascertain how specific EAPC provisions are interpreted, understood, and applied in those jurisdictions (*Tofacitinib case*[33] and *Tadalafil case*[34]). Meanwhile, the IP Court preferred to cooperate in these cases with the Ministry of Foreign Affairs of the Russian Federation (Russian MFA). It is likely that, due to the small number of disputes over Eurasian patents in certain EAPC countries such as Kazakhstan and Belarus, or their complete absence in some

[31] *See* more details in the EAPO webinar "Dispute Resolution Practice. Eurasian integration in the field of intellectual property." E.N. Makhankova, A.V. Gutman. Available at: https://www.eapo.org/wp-content/uploads/2024/01/praktika-rassmotreniya-sporov-evrazijskaya-integracziya.pdf [Accessed 03.01.2025].

[32] See more details: Report on the research work "Development of the draft strategy of the Eurasian strategy of intellectual property development until 2035." RGAIS. 2023. P. 46.

[33] Ruling of the Presidium of the Intellectual Property Rights Court of 22.11.2021 in case No. SIP-1030/2020. Available at: https://kad.arbitr.ru/.

[34] Resolution of the Presidium of the Court of Intellectual Property Rights of 08.07.2020 in case No. SIP-664/2018. Available at: https://kad.arbitr.ru/.

jurisdictions[35] the IP Court was unable to identify relevant cases considered by national courts or other competent authorities of the EAPC member states. For this reason, the IP Court resorted to an unconventional approach to ascertain how the EAPC is interpreted, understood, and applied in other jurisdictions. Indeed, there are not any obstacles for the IP Court to support its judgements by reference to foreign case law if the relevant foreign judgements can be easily found. In *the Jakvinus case*[36] and *Sofosbuvir case*[37] the IP Court cited judgements of the national courts of the European countries and the CJEU to argue its findings and conclusions (and there was no need to engage any competent authority to study foreign judgements).

Thus, we can highlight three features of the disputes concerning the Eurasian patent in context of their developments towards uniformity and consistency. Firstly, the IP Court demonstrates its openness to judicial cooperation and dialogue with national judges or other competent national authorities of the EAPC countries. Sometimes the national bodies of certain EAPC countries appear to be not cooperative (e.g., in the above-mentioned *Tofacitinib case* only three of the EAPC countries were cooperative). Secondly, In the Eurasian region, mechanisms for judicial cooperation between national courts in disputes concerning Eurasian patents have not been developed, due to their absence and the relatively low number of such cases in jurisdictions outside the Russian Federation. Thirdly, decisions of the EAPO's *ad hoc* panels are not considered as persuasive authority at the national level.

VIII. Conclusion

The European experience illustrates the complexity of achieving harmonization of European patent law through legislative measures. This process typically lasts for a long period of time, necessitates the

[35] Report on the research work "Development of the draft strategy of the Eurasian strategy of intellectual property development until 2035." RGAIS. 2023. P. 46.

[36] Ruling of the Presidium of the Intellectual Property Rights Court of 23.09.2022 in case No. SIP-1027/2020. Available at: https://kad.arbitr.ru/.

[37] Ruling of the Presidium of the Court of Intellectual Property Rights of 04.06.2020 in case SIP-740/2018. Available at: https://kad.arbitr.ru/.

pursuit of compromises, and, due to divergences in the interpretation of European patent law, does not invariably result in the intended outcome. In particular, the Protocol adopted as a supplement to the Munich Convention was intended to ensure a uniform approach by national courts to the interpretation of Art. 69 of the European Patent Convention (EPC), which defines the scope of legal protection. The Protocol sought to establish a balanced position between two divergent interpretative approaches; however, its ambiguous wording ultimately resulted in inconsistent judicial decisions rendered by national courts concerning identical European patents.

The harmonization of European patent law is facilitated by the mechanisms used by national courts to ensure uniformity of practice in European patent litigation. A good example is the consistent development by UK and German judges of uniform legal approaches to the interpretation of Art. 69 of the EPC and the determination of the scope of legal protection. A teleological interpretation of the Munich Convention may serve as a foundation for the application, by national courts of the EPC member states, of mechanisms designed to ensure the uniform adjudication of disputes concerning European patents. As is known, the EPC was adopted as one of the first steps towards the harmonization of European patent law, which, among other things, follows from its content. Subsequently, there were repeated attempts to create a unified EU patent system and a common judicial mechanism for resolving disputes concerning European patents both within the EU and involving non-EU countries, until the UPC became operation since summer 2023.

In the process of adjudicating a European patent dispute, a national court may examine the practice developing within its own jurisdiction and then compare it with the approaches taken by courts in other EPC countries. The national court can then decide for itself whether it should modify the practice within its own country so that it is, for example, in line with the practice of most European countries, or whether it should preserve its distinctiveness. The latter may be necessary when the disputed situation involves, for example, moral values — an area of life in which European countries, even within the EU, may still have significant differences. To this end, national courts, by studying the case

law of foreign courts, retain the freedom to decide differently where there are reasons to do so.

The UPC has two features that should ensure, at least within this judicial body, a uniform practice in European patent litigation. Firstly, the Unified Patent Court comprises of the Court of First Instance, that is decentralized, and the Court of Appeal, that is centralized. The Court of Appeal is a structure intended to promote the uniformity of judicial practice across these divisions. Secondly, the composition of the judiciary, consisting of national judges who continue to exercise their functions within their respective national judicial systems, may potentially contribute to the development of consistent jurisprudence among the national courts of the EPC member states. This shall foster the harmonization of European patent law. The UPC has exclusive jurisdiction over European patent disputes under Art. 32 of UPCA. However, UPCA provides for a seven-year transitional period during which actions in respect of a dispute over a "classical" European patent may be brought before national courts or other competent national authorities (Art. 83 UPCA). In the absence of formal grounds for harmonization of practice between the Unified Patent Court and national courts, it can be assumed that mechanisms for mutual recognition of practice will be developed to ensure uniformity, as is the case between national judicial authorities. While being skeptical of the CJEU's case law concerning patent issues, it is reasonable to expect that the practice of the UPC will have an authoritative value among the national courts of the countries participating in the UPCA.

The significance of the CJEU's jurisprudence in the field of European patent law is ambiguous. It seems that the problem lies in the fact that the preliminary rulings of the CJEU are binding on the national courts of the EU countries and the need for those courts to retain a certain degree of freedom to make a decision that deviates from the established practice, taking into account the specific circumstances of the case.

Number of disputes over the Eurasian patents outside of Russia is small (or in certain EAPC countries are not recorded at all. Therefore, there is no alarm divergences in case law of national courts in EAPC

countries, but it may appear in future when the number of patent litigation cases increases in other EAPC countries.[38]

However, even at present, the improvement of mechanisms employed by national judicial bodies competent to adjudicate disputes concerning Eurasian patents appears to be of considerable significance. EAPO's management is advocating for creation of a supranational patent court for the EAPC countries,[39] but it may be premature now due to a relatively small number of disputes involving Eurasian patents.

The IP Court demonstrates its readiness to judicial cooperation and dialogue with national judges or other competent national authorities of the EAPC countries. Both Tofacitinib and Tadalafil cases illustrated that the IP Court prefers to use the teleological means of interpretation the EAPC and the Patent Regulation in disputes concerning the Eurasian patent. In this light it may be recommendable to establish a supranational institution competent to provide an interpretation of the rules of the EAPC and the Patent Regulation. It is noteworthy that Art. 149a(b) of the EPC allow European countries to create such an institution even though this provision has never been applied. In the EAPC countries the quais-judicial institution may be formed of on ad-hoc basis and comprise of the national patent judges, the renowned patent professional and scholars.

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[39] This has been repeatedly stated by the current EAPO leadership. *See*, for example: https://rapsinews.ru/judicial_news/20230926/309248481.html.

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Received 13.01.2025
Revised 18.02.2025
Accepted 27.02.2025