

***Non-binding Guidance  
for the use of the  
“General Template for Decision – UPC CFI”***

**Decision in an action for infringement  
with counterclaim for revocation**

**DECISION**

**of the Court of First Instance of the Unified Patent Court  
Local division in ... / Regional division in ... / Central division (Paris Seat or Munich Section)  
delivered on ... [dd month in words yyyy]  
concerning ... [EP/UP/SPC/EP application at issue]**

HEADNOTES: ... [required by R. 67 RegR] [to be provided by the judge-rapporteur/single judge]

KEYWORDS: ... [required by R. 67 RegR] [to be provided by the judge-rapporteur/single judge]

REFERENCE CODE ECLI: ... [required by R. 67 RegR] [to be provided by the Deputy-Registrar]

CLAIMANT:

... [name and postal address]

represented by ... [academic title (where applicable), name, national professional title, firm]

assisted by ... [academic title (where applicable), name, national professional title, firm]

DEFENDANT:

... [name and postal address]

represented by ... [academic title (where applicable), name, national professional title, firm]

assisted by ... [academic title (where applicable), name, national professional title, firm]

PATENT AT ISSUE (data to be retrieved in databases of the EPO)

European patent n° ... [hereafter referred to by its last three digits, e.g. EP 789]

[or European patent with unitary effect n° ... [e.g. UP 789]

[or Supplementary protection certificate ... [e.g. SPC 789]

[or European patent application n° ... [e.g. EP application 789]

PANEL/DIVISION

Panel [in divisions having more than one panel number of the panel: ...] of the Local [or: Regional] Division  
in ... [or: of the Central Division (Paris Seat) or: of the Central Division (Munich Section)]

DECIDING JUDGES OR: DECIDING JUDGE [R. 350.1(c) RoP]:

[in case the panel is delivering the Decision]

This decision has been delivered by the presiding judge ..., the legally qualified judge ..., the legally qualified judge ... and the technically qualified judge ...

*[or: ... by the presiding judge..., the legally qualified judge... and the legally qualified judge ...]*

*[in case the single judge is delivering the decision]*

This decision has been delivered by the *single judge* ...

SUMMARY OF FACTS [R. 350.1(f), 4 RoP]

[Free text]

INDICATION OF THE PARTIES' REQUESTS [R. 350.1(e), 4 RoP]

*[For Optional standard text see DECISION (INCLUDING ORDERS)]*

**THE CLAIMANT'S REQUESTS**

The Claimant seeks (e.g)

- Permanent injunction for direct *[or]* indirect infringement [Art. 63(1), 25, 26 UPCA]
- Provision for periodic penalty payment in case of non-compliance with the injunction [Art. 63(2) UPCA, R. 354.3 RoP]
- Order to take corrective measures [Art. 64 UPCA]
- Order to give information [Art. 67 UPCA]
- Order to display and publish the decision [Art. 80 UPCA]
- Enforceability of orders [Art. 82(1) UPCA, R. 118.8, 350.2 RoP]
- Declaration of liability for damages to be determined in separate proceedings [Art. 68 UPCA, R. 118.1 RoP]
- Order of an interim award of damages [Art. 68 UPCA, R. 119 RoP]
- Cost decision in principle [Art. 69 UPCA, R.118.5 RoP]

**THE DEFENDANT'S REQUESTS**

The Defendant seeks (e.g.)

- Dismissal of the Infringement action in full *[or]* in part
- Cost decision in principle [Art. 69 UPCA, R. 118.5 RoP]

**THE DEFENDANT'S<sup>1</sup> REQUESTS WHEN COUNTERCLAIM FOR REVOCATION IS FILED**

- Revocation of the EP 789 / UP 789 / SCP 789 entirely or partly [Art. 65 UPCA , R. 118.3 RoP]

**THE PATENT PROPRIETOR'S REQUESTS WHEN COUNTERCLAIM FOR REVOCATION IS FILED**

The Patent Proprietor seeks

- Dismissal of the counterclaim entirely or partly
- [As main or as auxilliary request(s):]* Partly Dismissal of the counterclaim *[by defending the patent by amendment with one or more alternative set of claims, see R. 30.1(a) RoP]*

[Free text]

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<sup>1</sup> Defendant is the Defendant of the infringement action who is also Claimant of the counterclaim.

MAIN STEPS IN THE PROCEEDINGS [OPTIONAL]

[Free text]

POINTS AT ISSUE

[Free text]

FOUNDATIONS FOR THE DECISION [R. 350.1(g), 4 RoP]

[Free text]

*Aspects to be possibly taken into account*

*Interpretation of the claims of the patent with regard to validity and infringement, including discussion of person skilled in the art (as far as necessary)*

- *[If counterclaim for revocation was filed:] Are the attacked claims valid?*
  - o *patentability*
    - *novelty*
    - *inventive step*
    - *priority (if in issue)*
    - *industrial application*
  - o *sufficiency*
  - o *added matter*
  - o *extension of protection*
  - o *non-entitlement*
  - o *prior rights (Art. 139(2) EPC)*

*Amendments by auxiliary requests*

- o *[repeat above steps as far as necessary]*
- *Do the Defendant's products infringe the patent?*
  - o *Has the Defendant committed infringing acts?*
  - o *Do these acts fall within the scope of the claims?*
- *Any other issues (e.g. competition defence, FRAND, prior use, exhaustion, compulsory license, etc)*

DECISION INCLUDING ORDERS (OPERATIVE PART) [R. 350.2, 1<sup>ST</sup> SENTENCE RoP]

*Optional standard text (for example)*

- *Permanent injunction for direct infringement [Art. 63(1), 25 UPCA]:*
  - o *The Defendant is ordered to cease and desist from ...*
    - *[in case of a direct infringement of a product patent and to the extent requested by the Claimant and found necessary to prevent an infringement or to prohibit the continuation of the infringement by the Court, Art. 63 (1), 25 (a) UPCA:] making, offering, placing on the market, using or importing or storing for these purposes a ... [wording of the product patent claim(s) that are found to be infringed and, if given, as specified by Claimant's requests and found appropriate by the Court]*

- *[in case of a direct infringement of a process patent and to the extent requested by the Claimant and found necessary to prevent an infringement or to prohibit the continuation of the infringement by the Court, Art. 63 (1), Art. 25 (b) UPCA:] using or offering for use a ... [wording of the process patent claim(s) that are found to be infringed and, if given, as specified by Claimant's requests and found appropriate by the Court]*
  - *[in case of a direct infringement of a process patent from which a product is directly obtained and to the extent requested by the Claimant and found necessary to prevent an infringement or to prohibit the continuation of the infringement by the Court, Art.63 (1), 25 (c) UPCA]: offering, placing on the market, using, or importing or storing for those purposes a ... [product as specified by Claimant's requests and found appropriate by the Court] obtained by a ... [wording of the process claim(s) that are found to be infringed and, if given, as specified by Claimant's requests and found appropriate by the Court]*
- Permanent injunction for indirect infringement [Art. 63(1), 26 UPCA]:
  - *Claimant is ordered to ... [as specified by Claimant's requests and found appropriate by the Court].*
- Order to take corrective measures [Art. 64 UPCA]:
  - The patent or the SPC ... has been infringed by ... *[action of the defendant and product/process found to be patent infringing by the Court].*
  - The defendant is ordered, at his own expense, to
    - recall the products ... *[as specified in the permanent injunction]* from the channels of commerce;
    - deprive the products ... *[as specified in the permanent injunction]* of its infringing property;
    - definitively remove the products ... *[as specified in the permanent injunction]* from the channels of commerce; or
    - to destroy the products *[as specified in the permanent injunction]* and/or the materials and implements ... *[materials and implements principally used in the creation or manufacture of the products as specified in the permanent injunction, to be specified]* [Art. 64(2) (b) to (e) UPCA]  
*[as specified by Claimant's requests and found appropriate by the Court].*
- Order to give information [Art. 67 UPCA]:
  - The Defendant [infringer or a third party pursuant to Art. 67(2) UPCA] is ordered to inform the Claimant of
    - the origin and distribution channels of the infringing products or processes;
    - the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the infringing products; and
    - the identity of any third person involved in the production or distribution of the infringing products or in the use of the infringing process  
*[as specified by Claimant's requests and found appropriate by the Court].*
- Order to display and publish the decision [Art. 80 UPCA]:
  - The Claimant is permitted, at Defendant's expense, to display the decision and publish it in full or in part in the following public media *[journal, etc].*  
*[as specified by Claimant's requests and found appropriate by the Court].*
- Provision for periodic penalty payment in case of non-compliance with any of the abovementioned orders [R. 354(4) RoP]:

- Any failure to comply with the order ... [e.g. to cease and desist] will render the Defendant liable to pay to the Court a penalty of ...
    - up to ... EUR *[or]*
    - up to ... EUR per item *[or]*
    - up to ... EUR per day for each day the Defendant fails to comply with this injunction

*[as found appropriate by the Court; different penalties may apply with regard to different orders].*
  - Enforceability of orders [Art. 82(1) UPCA, R. 118.8, 350.2 RoP]:
    - The order to cease and desist is immediately enforceable.
    - The order is/the orders are enforceable only after the claimant has ...
      - notified the Court which part of the orders he intends to enforce and the notification has been served on the Defendant *[and/or]*
      - a certified translation of the orders in the official language of a Contracting Member State in which the enforcement shall take place has been provided by the claimant and served on the Defendant *[and/or]*
      - a security has been given by the Claimant to the Defendant ... *[as determined by the Court in accordance with R. 352 RoP].*
  - Dismissal of the Infringement action in full [or] in part
    - The action is dismissed.
    - The action is dismissed for the rest.
- Re. damages** (for example)
- Declaration of liability for damages to be determined in separate proceedings [Art. 68 UPCA, R. 118.1 RoP]:
    - Defendant is liable for all damages resulting from the patent infringement ... *[as specified in the permanent injunction].*
  - Order of an interim award of damages [Art. 68 UPCA, R. 119 RoP]:
    - The Defendant is ordered to pay to Claimant as an interim award of damages ... EUR. *[Enforceability of the order see above]*
- Re. validity of the patent or SPC** (for example)
- Revocation of the EP 789 / UP 789 / SCP 789 entirely [Art. 65 UPCA, R. 118.3 RoP]:
    - The European patent ... /European patent with unitary effect ... /Supplementary protection certificate ... is revoked with effect to the territory of ... *[Contracting Member States for which the EP/UP/SPC has effect and as specified by Claimant's requests]*
  - Partial Revocation of the EP 789/UP 789/SPC 789 [Art. 65 UPCA, R. 118.3 RoP] and dismissal of the counterclaim in part:
    - The European patent ... /European patent with unitary effect ... /Supplementary protection certificate ... *[insofar as Defendant<sup>2</sup> seeks its revocation]* is revoked and limited with effect to the territory of ... *[Contracting Member States for which the EP/UP/SPC has effect and as specified by Defendant's requests]* insofar as it extends beyond the following version: ... *[set of claims as submitted by the Patent Proprietor in his (auxiliary) requests for amendment of the patent, see R. 30.1(a) RoP].* For the rest the counterclaim for revocation is dismissed.

<sup>2</sup> Defendant is the Defendant of the infringement action who is also Claimant of the counterclaim.

- Dismissal of the counterclaim for entire revocation:
  - The counterclaim for revocation is dismissed.

**Re. costs** (for example)

- Cost decision in principle [Art. 69 UPCA, R. 118.5 RoP]
  - The Claimant *[or]* Defendant is to bear the legal costs of the proceedings *[or]*
  - The Claimant is to bear ... % of the legal costs of the proceedings and the Defendant ... %.

Done and Delivered on ... [R. 350.1 (b) RoP]

*[note: In case the decision is rendered in writing at the end of the oral hearing, the date of delivery is the day of the oral hearing (even if grounds are issued later on)]*

| <b>NAMES AND SIGNATURES</b>  |   |
|--|---|
| <p><b>Judges</b><br/> <i>[Art. 8 UPCA, Art. 35(5) UPCS]</i><br/>           Presiding judge ...<br/>           Judge-rapporteur ...<br/>           Legally qualified judge ...<br/>           Technically qualified judge ...<br/> <i>[Or: Single judge: ...]</i></p> | <p><b>Deputy-Registrar</b><br/> <i>[Art. 35(5) UPCS]</i><br/><br/>           Deputy-Registrar ...</p> |

**Information about appeal**

An appeal against the present Decision may be lodged at the Court of Appeal, by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of its notification (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

**Information about enforcement** (Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP)

An authentic copy of the enforceable decision or order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.