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BEYOND THE PTAB: CAN UPC REVOCATION CREATE LEVERAGE IN U.S. PATENT DISPUTES?

As IPR institution becomes less predictable, multinational defendants should consider whether a corresponding European patent offers another path to challenge the patent owner's global enforcement position.

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THE PTAB BOTTLENECK

For more than a decade, a company sued on or threatened by a U.S. patent could treat inter partes review as a central defensive option. Recently that assumption has become less reliable. Official USPTO data through July 31, 2026, show an FY2026 year-to-date institution rate of 39% by petition, down from 68% in FY2024. The underlying split is substantial: 58% of petitions receiving a Director-level discretionary determination were denied, while 76% of matters reaching merits or other statutory review were granted.

Under the current process, the parties brief discretionary considerations separately from the merits and other statutory considerations. Effective October 20, 2025, the Director determines whether to institute after reviewing discretionary considerations, the merits, and non-discretionary considerations in consultation with at least three PTAB judges; the Director may refer the institution decision to one or more Board members where appropriate. If review is instituted, the proceeding is referred to the PTAB to conduct the trial. This process makes the Director the institution gatekeeper, with the consequence that the question becomes not only whether the invalidity case is strong, but whether it will be heard. [1]

The Office's March 2025 process separates discretionary briefing from the merits, and later guidance added considerations such as domestic manufacturing, U.S. investment, and small-business status. An April 2026 ex parte reexamination procedure also permits patent-owner input before the substantial-new-question determination, and a July 2026 proposed rule would require third-party requesters to identify all real parties

[1] U.S. Patent & Trademark Office, https://www.uspto.gov/sites/default/files/documents/Trial_Stats_June_2026.pdf *Trial Statistics—July 2026*; *Interim Processes for PTAB Workload Management* (Mar. 26, 2025); *Director Institution of AIA Trial Proceedings* (Oct. 17, 2025).

in interest. Those developments do not establish a comparable collapse in reexamination orders, but they reinforce the need to evaluate alternative forums early. [2]

A DIFFERENT PATENT, BUT A REAL SECOND FRONT

One possible response is a standalone revocation action before the Unified Patent Court against a European patent corresponding to the asserted U.S. patent. The strategy begins with four questions: Is there a granted European family member? Is it within UPC jurisdiction and not validly opted out? Is the proposed claimant "concerned by" the patent under Article 47(6)? And, most importantly, do the European and U.S. claims actually correspond?

As for standing, the claimant-status threshold for a third-party revocation action was further defined in *LS9 GmbH v. Bellissa HAAS GmbH*, where the Milan Central Division held at first instance that legal persons generally satisfy it even without activity in the relevant industry, suggesting—subject to further appellate development—that a corporate challenger need not show existing European sales or a specific infringement threat. The decision is in German because central-division proceedings use the patent's language of grant; footnote 3 links the decision and a detailed English summary. [3]

The UPC can revoke a patent throughout the participating states in which it has effect, and revocation operates retroactively. It may consider EPC grounds—including lack of novelty or inventive step, insufficiency, added matter, and certain entitlement or post-amendment scope defects—that are broader than an IPR's Sections 102 and 103 grounds based on patents and printed publications. A UPC revocation action has no PTAB-style policy-based institution gate, no Section 315(b) one-year service bar, and does not itself trigger Section 315(e) IPR estoppel. [4]

A UPC judgment, however, cannot revoke the U.S. patent, bind a U.S. district court, the ITC, the PTAB, or the USPTO, or automatically produce issue preclusion in the United States.

U.S. LEVERAGE THROUGH UPC

The leverage is economic, evidentiary, and strategic. A successful revocation may remove a commercially important part of the owner's international portfolio, weaken a worldwide royalty demand, and generate a reasoned technical record involving the same specification, inventive concept, prior art, experts, and party positions. The independently usable prior art and factual material may support U.S. discovery, cross-examination, claim construction, district-court invalidity defenses, or an ex parte reexamination request.

Federal Circuit precedent permits foreign-prosecution statements to constrain U.S. claim scope in limited circumstances, but it does not recognize automatic "foreign file-wrapper estoppel." *Caterpillar* and

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[2] U.S. Patent & Trademark Office, *Interim Processes for PTAB Workload Management* (Mar. 26, 2025); *Additional Discretionary Institution Facts* (Mar. 11, 2026); *Pre-Order Procedure Regarding Substantial New Question Determinations in Ex Parte Reexamination Proceedings* (Apr. 1, 2026); *Proposed Real-Party-in-Interest Identification Rule for Ex Parte Reexamination* (July 22, 2026).

[3] Agreement on a Unified Patent Court arts. 47(6), 34, 49(6), and 65; *LS9 GmbH v. Bellissa HAAS GmbH, UPC_CFI_860/2025* (Milan Central Division Aug. 19, 2026) (German-language decision); UPC Law, English-language summary.

[4] 35 U.S.C. §§ 311(b), 315(b), (e), and 316(e).

Tanabe held that relevant foreign representations may be considered; *Tanabe* used them in assessing the range of equivalents while expressly declining to characterize the result as estoppel. *Gillette* and *Apple* relied on clear EPO or Japanese statements to support claim construction where corresponding claims closely aligned and the statements were not foreign-law-specific. *TI Group*, *Pfizer*, and *AIA Engineering*, however, caution that differences in foreign law, procedure, or claim language may make such statements inappropriate or unpersuasive. Thus, a clear foreign interpretation may function like prosecution disclaimer—or narrow the range of equivalents—but is not automatically binding. Research through August 25, 2026 uncovered no reported U.S. merits decision treating a UPC validity judgment as dispositive of U.S. patent validity. [5]

Accordingly, materially overlapping claims may create portfolio and settlement leverage. Merely related family members, however, may have little legitimate evidentiary relevance in the United States.

THE STRATEGY IS ALREADY EMERGING

This is not purely theoretical. A November 2025 Berkeley Center for Law & Technology in-house panel identified "preemptive revocation" as part of UPC defensive planning, while a companion panel compared invalidity forum selection at the UPC, EPO, and PTAB against the sharp decline in IPR institution. [6]

To this end, any company with European patent exposure to an aggressive competitor should consider filing a UPC protective letter proactively, before a PI application is served. This approach is essential for ensuring the court will hear the defendant before granting ex-parte preliminary injunctive relief.

Furthermore, a defendant can effectively bifurcate UPC proceedings by routing a standalone revocation action through a wholly owned subsidiary to a UPC Division designated based on the technology. Accordingly, the Paris Central Division handles human necessities including SPCs extension patents, operations/transport, textiles/paper , fixed constructions, physics, and electricity. Munich Central Division handles mechanical engineering, lighting, heating, weapons, and explosives, plus chemistry and metallurgy without SPCs. Milan Central Division handles human necessities without SPC. This strategy was employed in the *Edwards Lifesciences* litigation, where a subsidiary of the defendant Meril Life brought a parallel revocation proceeding in Paris, while the patent was involved in an infringement in another UPC forum. The UPC applies no real-parties-in-interest doctrine equivalent to the US PTAB.

The closest documented analogue is the NJOY–JUUL/VMR campaign. In September 2023, NJOY Netherlands filed nine standalone revocation actions in the Paris Central Division against European vaporizer patents owned by JUUL Labs and VMR Products while the same corporate groups were litigating in the United States before the ITC, the U.S. District Court for the District of Delaware, and the PTAB. The U.S.

[5] See *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983); *Tanabe Seiyaku Co. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726, 733 (Fed. Cir. 1997); *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1374 (Fed. Cir. 2005); *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1312–13 (Fed. Cir. 2014); but see *TI Group Automotive Systems (N. Am.), Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1136 (Fed. Cir. 2004); *Pfizer Inc. v. Ranbaxy Laboratories Ltd.*, 457 F.3d 1284, 1290 (Fed. Cir. 2006); *AIA Engineering Ltd. v. Magotteaux International S/A*, 657 F.3d 1264, 1279 (Fed. Cir. 2011).

[6] Berkeley Center for Law & Technology, *UPC Defensive Strategy From the Inside: Protective Letters, Preemptive Revocation, and Saisie Preparedness*; *Invalidity Challenges at the EPO, UPC, and PTAB: Forum Selection, Inventive Step Divergence, and the Collapse of IPR Institution Rates* (Nov. 20, 2025).

record shows why an independent European merits forum can matter: Altria affiliates sought IPR of patents asserted against NJOY ACE, but four petitions were denied institution, and the sole instituted patent was later upheld, while the ITC entered an exclusion order based on four U.S. patents. The UPC nevertheless adjudicated all nine European challenges on the merits; at first instance, five patents survived and four were revoked, and the Court of Appeal ultimately affirmed full revocation of one European patent. The campaign therefore demonstrates actual use of UPC revocation as a parallel portfolio attack when U.S. post-grant relief was limited. The public record does not establish, however, that the challenged EP and U.S. claims were materially identical or that any UPC ruling controlled the U.S. outcomes. [7]

The NanoString–10x Genomics dispute provides a stronger same-family example because 10x expressly identified six U.S. patents asserted against NanoString' s CosMx platform in Delaware as belonging to the same patent family as EP 2 794 928 and EP 4 108 782. The European patents initially created substantial injunction pressure: a German court enjoined CosMx under EP 2 794 928, and the UPC granted a preliminary injunction under EP 4 108 782. NanoString then attacked the family on several fronts. The UPC Court of Appeal lifted the EP 4 108 782 preliminary injunction because validity was not sufficiently certain; the German Federal Patent Court revoked the German part of EP 2 794 928; and, in October 2024, the UPC Munich Central Division granted NanoString's standalone revocation action against EP 2 794 928. In parallel, the PTAB instituted NanoString's IPR of U.S. Patent No. 11,542,554, one of the six same-family U.S. patents. A worldwide settlement and cross-license in May 2025 ended the pending U.S., German, and UPC disputes. The sequence shows how European revocation can counter multi-country injunction pressure and become part of a global resolution: the record also included favorable rulings for 10x, an EPO decision maintaining EP 4 108 782 in amended form, and Bruker's acquisition of NanoString's business during its restructuring. [8]

Gilead provides a concrete clear-the-way example. On June 18, 2025—the date EP 3 854 403 was granted—the U.S. developer of remdesivir filed a standalone UPC revocation action against AMMS's second-medical-use claims covering remdesivir for SARS-CoV-2, rather than waiting for an infringement action. Gilead later filed a parallel EPO opposition, but the UPC reached the first merits result: on May 4, 2026, less than eleven months after grant, the Milan Central Division revoked the patent in full for lack of inventive step. AMMS has appealed, so the first-instance revocation is not final. The case demonstrates rapid, proactive European clearance by a U.S. operating company, not leverage against a corresponding U.S. patent. [9]

[7] See *Vaporizer Battle Comes to End with One Last Win for NJOY at UPC Court of Appeal* (Jan. 7, 2026);; *NJOY v. JUUL Labs—EP 3 498 115* (EPLAW).
[8] See 10x Genomics, *Comments on Second UPC Preliminary Injunction Decision* (Oct. 10, 2023); *NanoString Technologies Europe Ltd. v. President & Fellows of Harvard College*, UPC_CFI_252/2023, decision of Oct. 17, 2024; 10x Genomics, *Form 10-Q for the Quarter Ended March 31, 2025*; 10x Genomics, *Form 8-K (May 12, 2025)*; *EPO Maintains EP7UP 4 108 782 in Slightly Amended Form* (Apr. 1, 2025); Bruker, *Bruker to Acquire the NanoString Business in an Asset Deal* (Apr. 22, 2024).
[9] See *Gilead Sciences, Inc. v. Academy of Military Medical Sciences*, UPC_CFI_552/2025, decision of May 4, 2026; *Costs Decision* (July 10, 2026); *AMMS v. Gilead, UPC_CoA_121/2026 (cost-order appeal)* (Aug. 4, 2026); *EPLAW Analysis*; *Mewburn Ellis, UPC Weekly* (May 2026).

SUBSTANTIAL RISKS AND BENEFITS

The countervailing benefits can be substantial. A UPC revocation action gives the challenger a merits forum without the PTAB's policy-based discretionary institution gate, permits a broader range of EPC revocation grounds, and can centrally eliminate or narrow patent rights across participating European markets. A successful challenge can reduce injunction and royalty exposure, generate a reasoned technical record, and increase leverage in global settlement negotiations. Because the UPC proceeding is not subject to Section 315(b)'s IPR service bar and does not trigger Section 315(e) estoppel, it can add a separate portfolio-level challenge without those IPR-specific statutory constraints.

At the same time, the patent may already be opted out, and alerting the owner before filing may give it time to opt out. The owner may counterattack with a UPC infringement action seeking relief across multiple markets. The unsuccessful party generally faces reasonable and proportionate cost shifting, and security for costs may be ordered. [10]

A validity win may also prove less valuable than expected. The proprietor can seek to preserve amended claims; the result may be a narrower, harder-to-attack patent that still covers the product. Edwards–Meril illustrates how a patent maintained only as amended can later support an infringement injunction. First-instance rulings are not necessarily durable: the UPC Court of Appeal reversed the first-instance revocation in the Amgen–Sanofi PCSK9 dispute, and first-instance DexCom revocations became ineffective after the parties withdrew the revocation claims during appeal as part of a global resolution. [11] [12]

Nor will European and U.S. outcomes necessarily align. Added matter, inventive step, sufficiency, claim interpretation, amendment practice, and evidentiary procedure are not one-for-one equivalents of U.S. written description, obviousness, enablement, or claim construction. EPO opposition may also be the superior vehicle during its nine-month window because it reaches the European patent across all designated EPC states and ordinarily presents less counter-infringement exposure. [13]

A PRACTICAL SCREENING RULE

UPC revocation is not a substitute for IPR. It is best viewed as a selective, portfolio-level second front. It is most promising when the relevant claims closely correspond; the European patent remains within UPC jurisdiction; Europe matters commercially to the owner; the EPC invalidity case is strong; the expected decision can precede a meaningful U.S. litigation or licensing milestone; and the challenger can tolerate fee shifting and a responsive European infringement action.

[10] Agreement on a Unified Patent Court arts. 83, 33, and 69.
[11] See *Edwards Patent Found Valid as Amended by UPC; Meril's Revocation Actions Dismissed*; *Edwards Lifesciences v. Meril—Munich Local Division Infringement Decision* (EPLAW).
[12] See *Amgen v. Sanofi/Regeneron—UPC Court of Appeal* (EPLAW); *DexCom Withdrawal Order*; DexCom, *Form 10-K Settlement Disclosure*.
[13] European Patent Convention art. 99; European Patent Office, *Oppositions*; EPO Guidelines for Examination, *Accelerated Processing of Oppositions* (2026).

As PTAB institution becomes less predictable, counsel evaluating a significant U.S. patent assertion should add a limitation-by-limitation U.S.–EP family review—and a parallel UPC/EPO forum analysis—to the opening defensive checklist.