IP High Court International Center – Advisory Board Selections:
2025 International IP Landmark Cases 8

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IP High Court
International IP Law Research Center

A. U.S. Cases by Judge Admond E. Chang

1. Amgen Inc. v. Sanofi, 598 U.S. 594 (2023)

a) Summary of Decision

Global pharmaceutical giant Amgen obtained patents that claimed antibodies (which are comprised of amino acids) that helped reduce patients' levels of LDL cholesterol. The antibodies worked by binding themselves to a particular protein that naturally occurs in the human body; the protein makes it more difficult for the body to extract LDL cholesterol from the bloodstream. But Amgen did *not* claim any particular antibody described by any *particular* amino-acid sequence. Instead, Amgen claimed "the entire genus" of antibodies that would bind to the protein and block the protein from being an obstacle to LDL cholesterol extraction.

In prosecuting the patent, Amgen identified the amino-acid sequences of 26 antibodies, but otherwise then only described two research methods to make antibodies beyond the 26. Amgen then sued Sanofi for patent infringement. Ultimately, the district court held, and the Federal Circuit affirmed, that Amgen had failed to satisfy the enablement requirement, 35 U.S.C. § 112(a). Section 112(a) requires that the specification sufficiently describe the invention "as to enable any person skilled in the art . . . to make and use" the invention.

b) Significance

The Supreme Court agreed, holding that Amgen had not enable the class of all antibodies, which Amgen had tried to define by *function*. This case is an important application of the principle that the more an inventor claims, the "more it must enable." 598 U.S. at 613. Also, given the incentive of inventors to obtain a patent that is not limited to a specific invention, but instead describes the invention by referring to a broad *function*, the *Amgen* case is important because it rejects the notion that merely describing "painstaking experimentation" and "random trial-and-error" discovery, 598 U.S. at 614, is sufficient. This enforcement of the enablement requirement applies outside of

pharmaceuticals, as shown by the other examples that the Supreme Court cited in *Amgen*. 598 U.S. at 606–610 (invalidating certain claims for telegraph, light bulb, and glue).

2. Thaler v. Vidal, 43 F.4th 1207 (Fed. Cir. 2022)

a) Summary of Decision

A purported inventor, Stephen Thaler, applied for patents for a collection of source code that he acknowledged was generated entirely by artificial intelligence. Instead of listing a person's name as the inventor, Thaler wrote on the patent applications that the invention was "generated by artificial intelligence."

b) Significance

The Federal Circuit affirmed the PTO's and the district court's decisions rejecting the application for failure to list a human person as an inventor. The Patent Act specifically defines "inventor" as "the *individual* or, if a joint invention, the *individuals* collectively who invented or discovered" the invention. 35 U.S.C. § 100(f) (emphases added). Although the Patent Act does not go further in defining the term "individual," the Federal Circuit reasoned that the plain meaning of the word (according to dictionaries) is confined to a natural person. And the Supreme Court has interpreted other federal statutes that use the term "individual" as referring to human beings. Given the prominence of generative AI in many industries, and the advancement of AI in generating results in a way that scientists admit they *cannot fully explain*, this decision is significant because human inventors must at least contribute to the invention.

The prior PTO Director interpreted *Thaler* to permit a patent application based on AI contribution so long as there was at least one human person who made a "significant contribution" to the invention. The PTO adopted that standard from the already-existing standard used to evaluate whether a person was a joint inventor, as governed by the factors in *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).

But recently (on November 28 of this year), the new PTO Director rescinded the prior Guidance and instead emphasized that the PTO presumes that the inventors named on the application are the actual inventors. The new Guidance explains that AI systems are analogous to other tools, like laboratory equipment and software. So long as a human person "conceived" of the invention, that is, formed in his or her mind the "definite and permanent idea of the complete and operative invention," then that is sufficient, even if AI assisted in creating the invention. 90 Fed. Reg. 54636 (quoting *Burroughs Wellcome Co. v. Barr Labs.*, Inc., 40 F.3d 1223, 1228 (Fed. Cir. 1994)).

B. Unifiied Patent Court (UPC) Cases by Judge Anna-Lena KLEIN

1. *BSH Hausgeräte v Electrolux*, CJEU, 25 February 2025, C-339/22 (International jurisdiction in patent infringement proceedings)

a) Main Points of the Ruling

- A claimant may bring a patent infringement case before the Courts of the member state where the defendant is seated (forum rei, Art. 4 Brussels Ia regulation), also with regard to the infringements of foreign patents, regardless of where the infringement occurred. These Courts' jurisdiction will prevail even if the defendant lodges an invalidity defense against the patent in suit.
- The result of this decision has been described as a "one stop shop" for world-wide litigation[1].
- In the wake of the CJEU's decision, there have been numerous decisions from the UPC and national Courts dealing with so called long arm jurisdictions and the effects of the CJEU's decision (see below).
- Potential for wider effects:
  - ✓ The LD Mannheim has held that the CJEU's reasoning also applies where a Court has jurisdiction based on Art. 7 (forum loci delicti commissi).
  - ✓ The Regional Court Munich I accepted jurisdiction in a PI concerning more than 20 countries.
  - ✓ The Regional Court Munich I has received patent infringement claims concerning US patents.

b) Judicial Background of the Case

Under the Brussels I bis regulation, persons domiciled in a Member State shall, subject to other rules in the regulation, be sued in the courts of that Member State, Art. 4.

One of the rules diverting from that "forum rei" is Art. 24 of the regulation. Under Article 24 of the Brussels I bis Regulation, which is part of Section 6 of Chapter II, headed 'Exclusive jurisdiction', the regulation provides in summary that in proceedings concerned with the validity of the patent, the Courts of the Member State for who the EP was granted shall have exclusive jurisdiction[2].

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1) See, e.g., *Müller-Stoy/ Lepschy*, GRUR Patent 2025, 331, 332, margin 5.

2) "The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties: . . .
(4) in proceedings concerned with the registration or **validity of patents**, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of

c) The Case at Hand

BSH has a European patent, validated in a number of EU countries as well as the UK and Turkey. In 2020, BSH brought an action against Electrolux alleging infringement of all the national parts of that European patent in Sweden.

Electrolux pleaded, inter alia, that the claims relating to infringements of the national parts of the patent other than the Swedish part ('the foreign patents') were inadmissible. Electrolux argued that the foreign patents were invalid and that the Swedish courts did not have jurisdiction to rule on whether they had been infringed, based on Art 24(4) of the Brussels I bis Regulation.

d) CJEU's Decision

The CJEU held that (in relation to EU-countries)

- the exclusive jurisdiction rule laid down in Article 24(4) of the Brussels I bis Regulation **concerns only** the part of the dispute relating to the **validity** of the patent. Accordingly, a court of the Member State in which the defendant is domiciled, which has jurisdiction, under Article 4(1) of the Brussels I bis Regulation, in an action alleging infringement of a patent granted in another Member State, **does not lose that jurisdiction** merely because, as its defence, that defendant challenges the validity of that patent (para 41)
  - ✓ exclusive jurisdiction is the exception
  - ✓ in patent infringement cases, this exclusive jurisdiction would become more or less the rule, if Art. 24 para 4 was understood differently
  - ✓ legal certainty (which is one of the objectives of the Brussels I bis Reg) would be challenged if Court could lose jurisdiction depending on the defence of the defendant
  - ✓ infringement proceedings may be stayed where Court thinks that there is "reasonable, non-negligible possibility of that patent being declared invalid" by the Court concerned with validity issues
  - → (margin 52) "In the light of the findings above, the answer to the first and

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whether the issue is raised by way of an action or as a defence, the courts of the Member State in which the deposit or registration has been applied for, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place. Without prejudice to the jurisdiction of the European Patent Office [(EPO)] under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, **the courts of each Member State shall have exclusive jurisdiction in proceedings concerned with the registration or validity of any European patent granted for that Member State (…)**"

second questions is that Article 24(4) of the Brussels I bis Regulation must be interpreted as meaning that a court of the Member State of domicile of the defendant which is seised, pursuant to Article 4(1) of that regulation, of an action alleging infringement of a patent granted in another Member State, does still have jurisdiction to hear that action where, in the context of that action, that defendant challenges, as its defence, the validity of that patent, whereas the courts of that other Member State have exclusive jurisdiction to rule on that validity."

The CJEU held that (in relation to third countries)

- Article 24(4) of the Brussels I bis Regulation does not apply to a court of a third State and, consequently, does not confer any jurisdiction, whether exclusive or otherwise, on such a court as regards the assessment of the validity of a patent granted or validated in that State
- A Court of a Member State may not rule on (part) invalidity of a patent validated in a third state (principle of non-interference). But if the issue of the validity of a patent granted or validated in a third State is raised as a defence, it does not lose jurisdiction, because the decision of that court sought in that regard is not such as to affect the existence or content of that patent in that third State, or to cause its national register to be amended. The court's decision has only inter partes effect.
    → (margin 76) "It follows from all the findings above that the answer to the third question is that Article 24(4) of the Brussels I bis Regulation must be interpreted as not applying to a court of a third State and, consequently, as not conferring any jurisdiction, whether exclusive or otherwise, on such a court as regards the assessment of the validity of a patent granted or validated by that State. If a court of a Member State is seized, on the basis of Article 4(1) of that regulation, of an action alleging infringement of a patent granted or validated in a third State in which the question of the validity of that patent is raised, as a defence, that court has jurisdiction, pursuant to Article 4(1), to rule on that defence, its decision in that regard not being such as to affect the existence or content of that patent in that third State or to cause the national register of that State to be amended."

e) Effects of the Decision in National/ UPC Proceedings

The decision enables proceedings relating to infringements in other countries. While "cross border injunctions" were possible before the CJEU's decision, there was a risk that a Court could come to the conclusion it had "lost" its jurisdiction, if the defendant raised validity issues. The CJEU has now clarified the provision of Art. 24(4) of the

Brussels I bis Regulation.

In the wake of the CJEU's decision, several divisions of the UPC have dealt with questions relating to cross border injunctions, see e.g.

- LD Mannheim (UPC CFI 359/2023, decision of 18 July 2025, para 35 et sequi) accepted jurisdiction for the infringement of the UK part of an EP. The LD Mannheim also clarified (para 40, referring to the CJEU's decision), that the UPC has no jurisdiction to revoke the national part of a European bundle patent for states other than UPCA contracting member states.
- LD Milan accepted jurisdiction where a defendant had its domicile in Italy and the Court was asked to rule on an infringement of the Spanish portion of an EP in Spain (Preliminary Objection, UPC CFI 792/2024, 15 April 2025, para. 13).
- LD Paris accepted jurisdiction where a defendant had its domicile in France and the Court was asked to rule on an infringement of the Spanish, Suisse and British part of an EP (Preliminary Objection, UPC CFI 702/2024, 21 March 2025, para 19 et sequi).
- LD Mannheim, in a decision of 2 October 2025, (UPC_CFI_162/2024), specified that the principles established in CJEU BSH shall also be valid if the jurisdiction of the UPC is not based on Art. 4 of Brussels I bis regulation, but on Art. 7 (lex loci delicti commissi).
- Already before the announcement of the CJEU's decision, the LD Duesseldorf allowed a so-called long arm jurisdiction (UPC_CFI_355/2023, decision of 28 January 2025, para. 65 et sequi), accepting jurisdiction where the defendant was domiciled in Germany for the UK part of a bundle patent (the UK patent's invalidity was not raised as a defence in these proceedings).
- The LD Hamburg (UPC CFI 387/2025, decision of 14 August 2025, para 46) has held, that "it is already established case law of the Court of First instance that the UPC has international jurisdiction also with respect of the infringement of national parts of an European patent outside of the UPCA countries and even outside of the European Union (...). This is in line with the ECJ's ruling in "BSH Hausgeräte", according to which the court of the Member state of the European Union in which the defendant is domiciled has jurisdiction under Article 4 (1) BR to rule on an action for infringement of a patent granted in another Member state and does even not lose that jurisdiction solely on the ground that the defendant contests the validity of that patent by way of a defense (...)."

The CJEU's decision has also been the basis for developments at national level:

- The Regional Court Munich I accepted jurisdiction in a PI concerning more than 20 countries (see https://ipfray.com/munich-i-regional-courts-stunning-pi-for-20-countries-based-on-bsh-doctrine-of-eq

uivalents-difficult-to-enforce-formulation-patent/).

- BMW is being sued in three patent infringement suits at the Regional Court Munich I, two of which are based on US patents (NPE asserts US patents against BMW in Munich - JUVE Patent).

2. Local Division Mannheim, 30 September 2025, UPC_CFI_936/2025 (AILI (Anti Interim License Injunction) in the context of FRAND rate setting)[3)]

a) Main Points of the Decision

On 30 September, the Local Division Mannheim issued (ex parte) a so-called **AILI (Anti Interim License Injunction)**, a preliminary order prohibiting the defendant from initiating/ pursuing an anti-suit injunction and/ or from applying for any other equivalent judicial or administrative measure, (...). Inter alia, this **prohibition includes not to apply** to the UK High Court for a preliminary order requiring the applicants to **grant** the respondents an **interim license** to the applicants' patents, and not to apply to the UK High Court for a preliminary order declaring that the applicants would be in breach of RAND obligations if they did not grant the respondents an interim license to the applicants' patents on the terms determined by the UK High Court.

b) Backgrounds of the Proceedings

In August 2025, the defendant initiated rate-setting proceedings in the UK. Included are negative declaratory actions with regard to infringement, essentiality and validity of four UK parts of EP bundle patents. Additionally, the defendant initiated 18 actions for declaration of non-essentiality in Brazil. Inter alia, the defendant announced an application for an adjustable license for the entire portfolio until the conclusion of the rate setting proceedings.

c) The LD's Decision

Based on Art. 62 et sequi, UPCA, Art. 47 EU Charter and Art. 6 ECHR, the LD grants the requested AILI. The LD decides that there is a serious threat of infringement of the applicant's patent rights. The LD is of the opinion that the issuance of a declaratory judgment in the UK would effectively result in a party submitting to the UK Courts for the global determination of a FRAND rate. According to the LD's order, in recent disputes, UK Courts have tried to persuade the parties of SEP proceedings to conclude an "interim licence". The LD assumes, based on a number of recent UK decisions, that

3) order published here:
<https://ipfray.com/follow-up-translations-and-redacted-versions-of-upc-and-german-anti-interim-license-injunctions-in-interdigital-v-amazon-further-thoughts/>.

the purpose of this is to deter the SEP proprietor from initiating or continuing any other parallel pending litigation that also concerns SEPs. The LD states that, against this background, the UK jurisprudence of interim licenses can de facto act as a prohibition on litigation before the UPC. The LD stresses the importance of EU antitrust law, and the necessity of an EU Court (like the UPC) being able to review FRAND rates, especially with regard to interim licenses, which are determined without specific examination.

The LD underlines the defensive nature of the AILI, intended to protect the UPC proceedings. There is, in the LD's view, no interference with a foreign courts' jurisdiction.

d) Effects of the Decision

Interim License procedures are seen by some to have the same effects as anti suit injunctions (although this is disputed by others). As the procedures relating to anti suit injunctions, anti anti suit injunctions and anti suit injunctions some years ago,the AILI proceedings play a role in international FRAND disputes. While German national Courts have been reluctant to set FRAND rates in proceedings, UK Courts have set FRAND rates. In this context, it might be interesting to note that the LD Paris has received a request to set a FRAND rate see here:(https://www.juve-patent.com/cases/sep-holders-force-upc-into-frand-dance-with-uk-courts/).

The LD Mannheim's AILI case is ongoing. Upon appeal by defendant, the LD Mannheim held a hearing in the case on 14 November 2025. A decision has not yet been published.

The Regional Court Munich I has issued a parallel AILI (see here: https://ipfray.com/follow-up-translations-and-redacted-versions-of-upc-and-german-anti-interim-license-injunctions-in-interdigital-v-amazon-further-thoughts/).

The defendant has reacted with applications in the UK (see here: https://comparativepatentremedies.blogspot.com/search?updated-max=2025-10-30T08:27:00-07:00&max-results=7). The ensuing UK orders seem to have been the subject of discussion at the oral hearing before the LD Mannheim (see here: https://ipfray.com/unified-patent-court-judges-concerned-over-uk-court-order-threatening-them-with-imprisonment-but-could-it-also-become-risky-for-uk-judges-to-visit-the-eu/).

C. Japan Cases by Former Chief Judge Makiko TAKABE

1. Supreme Court in Japan, 2023(Ju)14, 15 (Mar. 3, 2025) (Comment distribution system case)[4)]

a) Summary of the Decision

The case in which the Court ruled that the act of distributing the computer program in question via the internet from the server located in the United States to the terminals located in Japan that are used by users, in order to provide the video sharing service, constitutes "provision through a telecommunications line" referred to in Article 2, paragraph (3), item (i) of the Patent Act.

b) Significance

If the principle of territoriality were applied strictly, Japanese patent rights would not be effective if part of the work of the patented invention was not carried out within Japanese territory. However, in today's networked society, applying this principle too strictly would result in inadequate protection of patent rights.. This judgment is positioned as one that makes clear that the principle of territoriality should be applied flexibly.

2. Intellectual Property High Court in Japan, 2024(Gyo-Ko)10006 (Jan. 1, 2025) (DABUS Case)[5)]

a) Summary of the Decision

A case in which, with regard to the decision made by the JPO to dismiss an international application which was filed by the Appellant under the Patent Cooperation Treaty and for which the Appellant, in the national procedure for the application, submitted a national document stating "DABUS, the artificial intelligence that autonomously made the present invention" in the column for the name of the inventor as a national document prescribed in Article 184-5, paragraph (1) of the Patent Act, the court dismissed the Appellant's claim to seek rescission of the JPO decision by alleging.

b) Significance

This judgment stated that "inventions" that can be patented under the Patent Act are limited to those inventorned by natural persons, and that under the current Patent Act, AI inventions made autonomously by artificial intelligence (AI) cannot be patented. In this era of rapid development of generative AI, how to handle inventions made autonomously by AI is an important issue that needs to be considered, including

4) See <https://www.courts.go.jp/english/Judgments/search/2070/index.html>.
5) See <https://www.courts.go.jp/ip/eng/assets/ip/eng/chizai_en/chizai_en-pdf-3624.pdf>.

legislation.

D. Korea Cases by Judge Taeksoo JUNG & Hyejin Lee

1. IP High Court of Korea 3rd Division 2023Heo13599 (Jan. 17, 2024) (Tube Alignment Device for Blood Collection Tubes)

a) Category

Registration Invalidation (Patent)

b) Holding

Standard for Inventive Step across Different Fields: The methodology for determining whether the PHOSITA could easily conceive an invention based on a primary prior art from a different technical field, or by combining it with other prior art.

Application to this Case: The court found that Claim 1 of the Subject Invention and Prior Art 5 belong to entirely different technical fields. Furthermore, **Prior Art 5's technical configuration is not general-purpose, nor are the technical objectives of the two inventions close**. Therefore, the PHOSITA would not select Prior Art 5 as a starting point to derive Claim 1.

c) Case Overview & Issues

The plaintiffs argued that the Subject Invention and Prior Art 5 share the same technical field—factory automation equipment—as both relate to alignment devices for supplying cylindrical containers. They further contended that even if the fields differ, Prior Art 5 is relevant to the technical problem of automating the alignment of tube-shaped containers and could be easily adapted; thus, the Subject Invention lacks an inventive step due to Prior Art 5.

d) Summary of Judgment: Dismissal of Claim

1) Legal Principles for Judgment

The "Person having ordinary skills in the art" refers to an average expert with ordinary technical understanding in the relevant field. The primary prior art selected as the closest reference serves as the starting point for such a person's technical creativity.
Therefore, **when judging whether an invention is easily conceivable based on a primary**

prior art from a different technical field, one must examine:

(a) Whether the configuration of the primary prior art is general-purpose for solving the technical problem. (☞ *Requirement of General Applicability*)

(b) Whether the technical objective of the primary prior art is close enough to that of the subject invention to justify transferring the organic combination of its technical elements to the subject invention's field. (☞ ***Requirement of Transposability***)

Crucially, this judgment must not be made based on hindsight with prior knowledge of the subject invention's specifications.

2) Judgment on Inventive Step regarding Prior Art 5

The Subject Invention relates to a method for manufacturing medical blood collection tubes, whereas Prior Art 5 relates to construction sealants; thus, their technical fields are entirely different. Furthermore, even when strictly avoiding hindsight bias, **it is difficult for the PHOSITA to view Prior Art 5 as a valid starting point for the following reasons based on the lack of General Applicability and Transposability**:

(a) Distinct Technical Objectives: Prior Art 5 aims to prevent the deformation of soft (flexible) containers during transport. To achieve this, it employs a delivery box with grid-shaped partitions and sets the depth of the receptacle to be longer than the container itself to prevent breakage.

(b) Lack of General Applicability: The design of a device that pushes and inserts items into a box depends heavily on the item's characteristics and the insertion purpose. Prior Art 5 is a specialized system for improving the transport efficiency of soft tubular members and cannot be considered a general-purpose configuration applicable to inserting any object into a box.

3) Incompatibility with the Subject Invention:

(a) Material: The Subject Invention handles blood collection tubes, which are typically made of glass or hard plastic to maintain shape. The soft, compressible material envisioned in Prior Art 5 is unsuitable for blood tubes.

(b) Process Efficiency: The Subject Invention automates the alignment of tubes into cartridge insertion holes to facilitate subsequent manufacturing steps, e.g., rubber packing and cap assembly. Prior Art 5's approach involves using soft tubes or inserting them deep enough to be fully covered, so it would hinder the efficiency of

these subsequent assembly processes which require the tube opening to be accessible.

e) Reasons for Introducing This Ruling

The principle of no hindsight bias is arguably the core of the non-obviousness determination, and the risk of succumbing to hindsight is particularly high when assessing whether the invention could have been easily made by combining prior art that does not belong to the field of the claimed invention. This risk is further exacerbated when such prior art is used as the primary reference for rejection.

The Korean Supreme Court has already established the legal principle that a prior art reference can be used to negate the non-obviousness of an invention if the technical configuration of the prior art could have been utilized by a PHOSITA without significant difficulty to solve the technical problem facing the invention.

However, using only this standard makes it challenging to determine whether the PHOSITA had a reasonable expectation of success in combining the prior art references. Furthermore, there is a substantial risk that this may lead to an overly broad acceptance of combining prior art based on the product-function perspective, contrary to the legal principle's original intent based on the problem-solving perspective.

This ruling is significant because it introduces **the proximity of technical challenges between the invention and the prior art** as a secondary consideration to mitigate the risk of such hindsight bias.

2. IP High Court of Korea 2nd Division 2024heo14780, 2024heo14803 (Nov. 12, 2025)

a) Summary of the Decision

The central issue in this case is whether an ordinary designer could have easily created the earphone case design from the suitcase design.

In this case, the IP High Court of Korea held that the article need not be identical or similar to the prior design's article. Instead, the Court explained that several factors must be evaluated, including: whether the two articles have identical purpose and function. whether their basic structure and overall form are similar, and whether designers commonly draw inspiration from articles in other fields.

The Court noted that the prior design—often described as the "Rimowa style" which has ribbed surface pattern—had already been widely used for various accessories,

including small cases, protective storage items, and earphone storage cases. Bringing these considerations together, the Court held that the registered design could have been easily created in light of the prior Rimowa design, and therefore the registration must be invalidated.

b) Significance

This case is significant for two main reasons. First, it was the first case in which a foreign party was able to participate remotely in real time in Korea trial. Second, the ruling clarified that, under certain conditions, a prior design from a different article category may be considered when evaluating the creative difficulty of a design.