



Munich Local Chamber
UPC_CFI_114/2024
UPC_CFI_448/2024

Order for proceedings
of the Court of First Instance of the Unified Patent Court Local Chamber
Munich
issued on 2 December 2024

PLAINTIFFS

- 1) Heraeus Electronics GmbH & Co. KG**
- 2) Heraeus Precious Metals GmbH & Co. KG**

represented by: Paul Szynka (CBH)

DEFENDANT

Vibrantz GmbH

represented by: Christian Paul (Jones Day)

PATENT IN DISPUTE

European Patent No. 3 215 288

JUDICIAL PANEL/CHAMBER

Panel 1 of the Munich Local Chamber

PARTICIPATING JUDGES

This order was issued by Presiding Judge Dr Matthias Zigann as rapporteur, legally qualified Judges Brinkman and Pichlmaier, and technically qualified Judge Ashley.

LANGUAGE OF PROCEEDINGS

German

SUBJECT

- Request for review by the panel pursuant to Rule 333 of the Rules of Procedure (APP_55548/2024) concerning the refusal to allow the amendment to the application – extension to include indirect infringement of a procedural right – pursuant to Rule 263 of the Rules of Procedure (App_33728/2024).
- Request for admission of amendment to the application pursuant to Rule 263 of the Rules of Procedure – extension of the application to include claims relating to Romania (App_53768/2024)
- Application for leave to amend the claim pursuant to Rule 263 of the Rules of Procedure – extension of the counterclaim to include Romania (App_54229/2024)
- Application to replace the counter-defendant in the nullity counterclaim proceedings CC_43919/2024 pursuant to Rules 25.1, 42.2, 305.1 (c) VerfO with the plaintiff (App_54645/2024)
- Various motions by the applicant (App_48806/2024).

FACTS

The first plaintiff is suing the defendant for alleged infringement of EP 3 215 288 concerning a metal sintering preparation in Germany, Italy and France (ACT_13227/2024 UPC_CFI_114/2024). The defendants are defending themselves on the basis of, among other things, a prior right of use in the course of trade. In the counterclaim for revocation (CC_43919/2024 UPC_CFI_448/2024) against the second plaintiff as the registered patent holder, it also asserts obvious prior use on the basis of the right of prior use in the course of trade. For the sake of simplicity, the counter-defendant is currently listed as plaintiff 2.

The plaintiffs' request for leave to extend the action pursuant to Rule 263 of the Rules of Procedure to include claims for indirect infringement of claims 5 (DE) and 6 (FR and IT) of 5 June 2024 was rejected by order of the rapporteur dated 25 September 2024 (ORD_36668/2024). The rapporteur stated as grounds that claims for infringement of claims 5 and 6 could already have been asserted in the action. The plaintiffs filed a timely request for review by the panel of judges pursuant to Rule 333 of the Rules of Procedure on 10 October 2024.

With effect from 1 September 2024, the Republic of Romania acceded to the Agreement on a Unified Patent Court.

In an application dated 27 September 2024, the plaintiffs requested that the extension of the action to include claims for patent infringement in Romania be admitted. This includes claims for indirect infringement of process claim 6. The defendant opposed this, but requested a three-month response period in the event of admission. It argued that the right of prior use under Article 28 EPGÜ was governed by national law, in this case Romanian law, and that the defendant needed this period to prepare its defence based, among other things, on this right.

In a motion dated 1 October 2024, the defendant requested that the extension of the counterclaim to Romania be admitted.

The interim hearing is currently scheduled for 3 April 2024, and the oral hearing for 1. July 2024.

On 15 November 2024, the rapporteur submitted the following proposal to the parties:

The opposing party must be granted a legal hearing in accordance with Rule 333.2, third sentence, of the Rules of Procedure.

After consultation with the panel, it should be noted in advance that the respective motions to extend the action due to Romania's accession may have to be granted simply because, in view of their respective actions and motions, both parties agree on the merits (Articles 43 and 76(1) EPGÜ). Insofar as the request to extend the action due to Romania's accession is granted, the indirect infringement of procedural rights is also the subject matter of the dispute.

For reasons of procedural economy and fairness, and in an effort to avoid divergent decisions in a further action yet to be filed for claims of indirect infringement of the procedural claim in Germany, France and Italy, it may then be necessary to revise the order of 25 September 2024.

As a result, each party would prevail with its claims. The amount in dispute in the action and the counterclaim would each have to be increased to €1.25 million. In this respect, the defendant has not presented any better figures for the amendment to the action. The defendant has not presented any figures at all for the amendment to the counterclaim. The defendant should be granted a deadline for its response with regard to Romania. The panel considers a period of two months from the date of admission of the extension to be sufficient.

The panel suggests that the parties agree to this proposed procedure.

The plaintiffs agree with the procedure suggested in this procedural order of 15 November 2024. In addition, they point out that, in its order of 21 September 2024 (UPC CoA 456/2024 APL 44633/2024 – OrthoApnea), the Court of Appeal took a narrow view of an amendment of claim within the meaning of Rule 263 of the Rules of Procedure:

"Not every new argument constitutes an 'amendment of case' requiring a party to apply for leave under R. 263 RoP. An amendment of case occurs when the nature or scope of the dispute changes. For example, in an infringement case, this occurs if the plaintiff invokes a different patent or objects to a different product."

The defendant states that it does not oppose the Chamber's intended handling of the two extensions of the action to Romania. However, it continues to consider the requested three-month response period to be appropriate. This is to ensure adequate preparation of the statement. However, it considers a revision of the decision of 25 September 2024 concerning the extension to the procedural claim to be inadmissible.

Under App_48806/2024, the plaintiffs also filed motions regarding the passive legitimacy of the counterclaim.

In his order of 25 September 2024 in App_48806/2024, the rapporteur ordered:

1. It is clarified that the time limits for responding to the statement of defence and the counterclaim shall not commence until the plaintiffs and their legal representatives have received unredacted versions of the statement of defence and the counterclaim.

2. The defendant may respond to the written statement of 27 August 2024 within 10 days.

In a further order dated 25 September 2024 (ORD_53396/2024 in APP_48805/2024) in the context of an objection by the second plaintiff against the counterclaim, the rapporteur stated that

- R. 25.1 VerFO was to be understood to mean that the counterclaim for annulment could also be directed against the "R. 8.6 holder" (the counter-defendant);
- R. 25.1 VerFO was also to be understood as a reference to R. 42.2 VerFO.

Under App_54645/2024, the plaintiffs then filed a motion under Rule 305.1 (C) VerFO with regard to the counterclaim. The defendant did not comment further on this motion despite having the opportunity to do so.

The rapporteur referred all the applications dealt with here to the panel for a joint decision.

APPLICATIONS BY THE PARTIES

The plaintiffs request in APP_5548/2024:

pursuant to R. 333.1 VerFO, we request that the panel review the order (ORD_36668/2024) of 25 September 2024 to the extent that it rejects the motion under II.2 (indirect infringement of the procedural right) and the consequential claims referring thereto.

With regard to the applicants' requests in App_33728/2024, reference is made to the order of 25 September 2024 (ORD_36668/2024).

The defendant requests in App_54229/2024:

We request, pursuant to R. 263 VerFO, that the extension of the counterclaim for revocation to include the Romanian part of the patent in suit be admitted as follows (changes highlighted):

1. *European patent EP 3 215 288 is declared invalid in the territory of the Federal Republic of Germany (DE), the French Republic (FR), the Italian Republic (IT) and the Republic of Romania (RO).*
2. *The counter-defendant shall bear the costs of the counterclaim.*

The plaintiffs request under App_48806/2024:

1. *We request, pursuant to Rule 9.1 of the Rules of Procedure, that the Court grant the parties a legal hearing on passive legitimacy pursuant to Rule 361 of the Rules of Procedure and suggest that the counterclaim be dismissed as manifestly futile pursuant to R. 361, 363 VerFO as manifestly futile.*

2. *As a precautionary measure, we raise an objection pursuant to R. 48, 19.1 (b) VerFO, challenging the jurisdiction of the Munich Local Chamber, and request that the counterclaim be dismissed as inadmissible.*

3. *Furthermore, we request and apply for, pursuant to Rule 9.1 of the Rules of Procedure, the issuance of a procedural order clarifying that the time limits attached to the service of the counterclaim by the Rules of Procedure (in particular Rule 29(a) of the Rules of Procedure) shall commence to run concurrently with the*

time limit for responding to the statement of defence, only commence upon service of an unredacted version of the counterclaim together with its annexes

The defendant requests under App_48806/2024:

The counter-defendant's motions pursuant to Rules 9.1, 361, 363, 48, 19.1 of 27 August 2024 are dismissed.

The plaintiffs request under App_54645/2024

that we request, on behalf of the counter-defendant and the plaintiff, that the counter-defendant be replaced by the plaintiff in the nullity counterclaim proceedings CC_43919/2024 pursuant to R. 25.1, 42.2, 305.1 (c) VerfO.

The defendant does not make any application under App_54645/2024.

REASONS

Extension to include action and counterclaim concerning Romania

The two extensions of the action are to be permitted because both parties request that the question of infringement and validity concerning Romania also be heard and decided. In this respect, the defendant has requested permission for an unconditional extension of the counterclaim. The defendant has therefore expressed the wish that the question of the validity of the Romanian part of the European patent should be heard independently of whether the plaintiff's request for permission to extend the action concerning Romania is granted. Both parties are therefore essentially arguing the same thing. Romania is to be subsequently included in the subject matter of the action and the counterclaim. Permission should therefore be granted.

Extension of the action to include a procedural claim

In its order of 21 September 2024 (UPC CoA 456/2024 APL 44633/2024 – OrthoApnea), the Court of Appeal took a narrow view of the existence of an amendment to the claim. Within the meaning of Rule 263 RoP, as it was based on the rapporteur's order:

"Not every new argument constitutes an 'amendment of case' requiring a party to apply for leave under Rule 263 RoP. An amendment of case occurs when the nature or scope of the dispute changes. For example, in an infringement case, this occurs if the plaintiff invokes a different patent or objects to a different product."

Accordingly, the additional reference to the procedural claim does not constitute an amendment of the claim within the meaning of Rule 263 RoP. This is because, following the example of the Court of Appeal, no further patent is being asserted. The allegation of infringement concerning the same product is merely substantiated by a further patent claim. Therefore, only Rule 13 in conjunction with paragraph 7 a.E. of the preamble and Rule 9.2 of the Rules of Procedure need to be examined.

This examination shows that, for the reasons of procedural economy set out above, the subsequent extension of the action to include claims for infringement of the procedural claim is not objectionable. No permission is required. The plaintiffs' application under Rule 263 of the Rules of Procedure of 5 June 2024 is therefore to be rejected in all other respects. The order of the rapporteur of 25 September 2024 (App_33728/2024) is to be set aside.

Correction of the active heading

The counter-defendant in the counterclaim for annulment (plaintiff 2) CC_43919/2024 is to be replaced by the plaintiff (1) in accordance with Rules 25.1, 42.2 and 305.1 (c) of the Rules of Procedure. Since the defendant has not raised any objections to this, reference can be made to the grounds for the application.

The plaintiffs' precautionary objection is therefore unfounded in any case and must be dismissed.

Increase in the amount in dispute

The value in dispute of the action and the counterclaim is increased to €1.25 million in each case. In the absence of any other indications, the Chamber bases its decision on the plaintiff's estimate. The additional court costs are to be paid within 10 working days.

ORDER

1. The order of the rapporteur of 25 September 2024 (App_33728/2024) is set aside. The subsequent extension of the action to include claims for infringement of procedural rights is not objected to. In all other respects, the plaintiffs' application under Rule 263 of the Rules of Procedure of 5 June 2024 is dismissed.
2. The plaintiffs' application pursuant to Rule 263 VerfO of 27 September 2024 (App_53768/2024) is granted.
3. The defendant's and counterclaimant's application under Rule 263 of 1 October 2024 (App_54229/2024) is granted.
4. The further written procedure is as follows, uniformly for the action and counterclaim/amendment of the patent:
Plaintiffs 14 January 2025 and 14 April 2025
Defendants 14 March 2025 and 14 May 2025
The plaintiffs may comment on the extension of the counterclaim to Romania in their written statement of 14 January 2025. The defendant may comment on the extension of the action to Romania and the extension of claim 5 in its written statement of 14 March 2025. The plaintiffs may also comment on the extension of the action in their written statement of 14 April 2025.
5. In all other respects, the parties' motions are dismissed.
6. The written proceedings will be closed on 14 May 2025.
7. The date for the interim hearing is postponed to 23 May 2025, 10 a.m., by video conference.
8. The main hearing on 1 July 2025 will remain in person.
9. The amount in dispute in the action and the counterclaim is increased to €1.25 million in each case. The additional court costs are to be paid within 10 working days.
10. The appeal is allowed.

UPC_CFI_114/2024
UPC_CFI_448/2024

INFORMATION ABOUT THE APPEAL IF IT IS AN ORDER PURSUANT TO ART. 73 (2) (B) EPGÜ:

An appeal may be lodged against this order either

- by any party whose claims have been rejected in whole or in part, together with the appeal against the final decision of the Court of First Instance on the substance of the case, or
- after the Court of First Instance has allowed the appeal, within 15 days of service of the relevant decision, by any party whose claims have been rejected in whole or in part (Art. 73(2)(b) EPGÜ, R. 220.2, 224.1 (b) R.

DETAILS OF THE ORDER

Order no. ORD_61305/2024 in ACTION NUMBER: ACT_13227/2024
UPC number: UPC_CFI_114/2024
Action type: Infringement Action
Related proceeding no. Application No.: 55548/2024
Application Type: APPLICATION_ROP_333

Order No. ORD_54024/2024 in PROCEEDINGS NUMBER: ACT_13227/2024
UPC number: UPC_CFI_114/2024
Type of proceeding: Infringement action
No. of the associated proceedings Application No.: 53768/2024
Type of application: Application for leave to amend or extend the claim (Rule 263 of the Rules of Procedure)

Order No. ORD_54346/2024 in PROCEEDINGS NUMBER: ACT_13227/2024
UPC number: UPC_CFI_448/2024
Type of action: Infringement action
No. of the related proceedings Application No.: 54229/2024
Type of application: Application for leave to amend or extend the claim (Rule 263 of the Rules of Procedure)

Order No. ORD_55044/2024 in PROCEEDINGS NUMBER: ACT_13227/2024
UPC number: UPC_CFI_448/2024
Type of action: Infringement action
No. of the related proceedings Application No.: 54645/2024
Type of application: Application for change of party

Order No. ORD_53066/2024 in PROCEEDINGS NUMBER: ACT_13227/2024
UPC number: UPC_CFI_448/2024
Type of case: Infringement action
No. of the associated proceedings Application No.: 48806/2024
Type of application: Submission for procedural application

Signed in Munich on 2 December 2024

<p>Dr Zigann Presiding Judge and Rapporteur</p>	<p>Matthias ZIGANN  Digitally signed by Matthias ZIGANN Date: 2 December 2024 14:16:29 +01'00'</p>
<p>Brinkman Legally qualified judge</p>	<p>Edger Frank BRINKMAN  Digitally signed by Edger Frank BRINKMAN Date: 3 December 2024, 16:03:05 -03'00'</p>
<p>Pichlmaier Legally qualified judge</p>	<p>TobiasGünther Pichlmaier  Digitally signed by Tobias Günther Pichlmaier Date: 02/12/2024 14:30:18 +01'00'</p>
<p>Ashley Technically qualified judge</p>	<p>GrahamWilliam Ashley  Digitally signed by Graham William Ashley Date: 3 December 2024, 08:25:26 +01'00'</p>