Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Mannheim Local Division
UPC_CFI_745/2024
(CCR: UPC_CFI_200/2025)

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 8 August 2025
concerning EP 4 108 413
concerning App_22065/2025
(R. 263 RoP)
concerning App_28086/2025
(R. 333 RoP)

CLAIMANT:

Sunstar Engineering Europe GmbH, Emil-Fischer-Straße 1 - 86641 - Rain am Lech - DE,

represented by: Holger Stratmann

DEFENDANT:

CeraCon GmbH, Talstraße 2 - 97990 - Weikersheim,

represented by: Matthias Sonntag

DEFENDANT in the counterclaim for revocation proceedings:

Sunstar Engineering Inc., 3-1 Asahi-machi, Takatsuki - 569-1134 - Osaka - JP,

represented by: Holger Stratmann

PATENT AT ISSUE:

European patent EP 4 108 413

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order is issued by the presiding judge Tochtermann, the judge-rapporteur Böttcher, the legally qualified judge Bessaud and the technically qualified judge Gaillarde.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Infringement action – counterclaim for revocation – R. 263 RoP, R. 333 RoP

BRIEF SUMMARY OF THE FACTS:

The Defendant of the infringement proceedings and Claimant of the counterclaim for revocation proceedings ("Claimant CCR") applies for leave to amend its counterclaim for revocation (App_ 22065/2025) by introducing a new novelty attack based on the new prior art document (in terms of Art. 54(3) EPC) Euro-PCT application PCT/JP2019/051559 (published as WO 2021/131055 and EP 3 868 480 A1, "EP'480").

The counterclaim for revocation (CCR) was filed on 6 March 2025, the oral hearing in the infringement proceeding and the counterclaim for revocation proceeding is scheduled for 10 February 2026.

Claimant CCR filed its application in question on 8 May 2025 (with the other party being notified on 9 May 2025). The brief of the application already contains the statements on the alleged lack of novelty of the patent-in-suit over EP'480 for which admission is sought.

On 9 May 2025, the Defendant of the counterclaim for revocation proceedings ("Defendant CCR") filed its defence to the counterclaim together with a conditional application to amend the patent.

The Claimant of the infringement action and the Defendant CCR, which the Claimant of the infringement action is affiliated with (jointly "Defendant CCR's side"), objected to Claimant CCR's application under R. 263 RoP. By order of 6 June 2025, the judge-rapporteur dismissed the application. For further details, reference is made to the parties' briefs and to the order of 6 June 2025.

On 23 June 2025 (Monday), Claimant CCR filed a request for review of the order of 6 June 2025 (App_28086/2025).

Therein, Claimant CCR argues that there is no further room for discretion beyond the aspects addressed in R. 263.2 RoP. Rather, if the grounds for exclusion pursuant to R. 263.2 RoP were not given, leave to amend the case had to be granted. Therefore, contrary to the impugned order, it

could not be left open whether leave to amend the case is excluded pursuant to R. 263.2 RoP in the case at hand.

Furthermore, in Claimant CCR's opinion, the judge-rapporteur exercised his discretion erroneously by considering facts irrelevant to the present case on the one hand and by ignoring the particularities of the present case on the other hand when balancing the parties' interests.

In putting forward a general rule that an application to grant leave to amend a counterclaim for revocation *per se* cannot be based on the fact that a prior art document, which "could" have been discovered before, is discovered only later, the impugned order suffered from an error in the exercise of discretion. Apart from the requirement to take all circumstances of the individual case into account, such rule would be far from reality, given the fact that it is common practice and a necessity to task third party search service providers with a search for prior art, in particular in the light of the short time period for a counterclaim for revocation. Amendments based on newly discovered prior art are the exact reason why R. 263.2 RoP existed in the first place, namely to limit the general admissibility of such amendments (R. 263.1 RoP) in cases where the party acted negligently and/or where the other party would be unreasonably hindered. Not granting leave to amend the counterclaim for revocation by introducing new prior art in a situation where it is clear beyond any doubt that the patent is invalid would create a materially unlawful situation and thus not be in the interest of the UPC (and the general public). Moreover, the impugned order failed to take into account that the newly found prior art document is clearly and objectively *prima facie* highly relevant, being – to a large extent – identical with the patent-in-suit. While the Claimant CCR is of the opinion that the prior art search conducted by a reliable search service provider should have revealed EP'480, it opines that it acted with due diligence by tasking a reliable search provider with the prior art search. Therefore, EP'480 was not revealed only due to circumstances not under Claimant CCR's control. The interests of Defendant CCR's side could be sufficiently taken into account by either extending the time period for the statement of defence to the CCR or even by granting a separate time period to react to EP'480. This would be all the more true as Defendant CCR's side including their representatives were well familiar with EP'480, given the fact that EP'480 is a patent application of Defendant CCR for which the representatives are identical with the representatives in the case at hand. The Defendant CCR's side had no appreciable interest in obtaining an injunction against Claimant CCR on the basis of an invalid patent. Moreover, the principle of procedural economy and efficiency (s. Preamble 4 RoP) militated in favour of granting leave to amend the CCR instead of forcing the parties into further, separate revocation proceedings, in particular when taking into account that the oral hearing in the case at hand is scheduled for 10 February 2026 only, leaving plenty of time for the Defendant CCR's side to adept their defence strategy (especially because such strategy would have had to consider EP'480 from the very beginning).

Claimant CCR points out that the requirement of R. 263.2 RoP were met. There were no legal basis for attributing any potential culpability of the third party professional search service provider to Claimant CCR. Contrary to the Defendant CCR's argument, Sec. 278 or Sec. 831 German Civil Code were not applicable.

Defendant CCR's side argues that Claimant CCR failed to demonstrate and prove that the grounds for exclusion under R. 263.2 RoP are not fulfilled. Claimant CCR did not provide a reasonable explanation as to why EP'480 – applying reasonable diligence – could not have been included in the initial CCR, in particular why the commissioned search service provider failed to find EP'480 (R. 263.2(a) RoP). If Claimant CCR itself had conducted the original search and failed to find the document, the introduction of EP'480 would be excluded. The same had to apply if Claimant CCR has outsourced the initial search to an agency that did not carry it out diligently. Given that the

written proceedings are almost concluded, permitting EP'480 to the proceedings at this stage would unreasonably hinder Defendant in the conduct of its action (R. 263.2(b) RoP). The need to give Defendant CCR at least two months to respond to EP'480 would lead to a postponement of the oral hearing. Apart from that, there were no discretionary errors by the JR. Contrary to Claimant CCR, EP'480 were not clearly and objectively, prima facie highly relevant. First, the claims of the patent-in-suit relate to method steps, whereas EP'480 were limited to an apparatus structure only. Second, when handling a patent application, the EPO usually checked the applicant's prior filings including prior art documents within the meaning of Art. 54(3) EPC and cited them if considered relevant. This was clearly not the case in the present case as it was and is immediately apparent that the inventive method steps according to features 3.2.1 and 3.2.2 of claim 1 are not clear and unambiguously derivable from EP'480. In Defendant's side's opinion, this finding is also supported by the fact that the external search provider allegedly commissioned by Claimant CCR – using the search string that produces EP'480 according to Claimant CCR – did not include EP'480 in its search report.

Claimant CCR requests:

1) Order no. ORD_22156/2025 is set aside.

2) Counterclaim Claimant is granted leave to amend its case to the effect that Counterclaim Claimant is allowed to base its Counterclaim for revocation on an additional ground of invalidity, namely on lack of novelty of the patent-in-suit over Euro-PCT application PCT/JP2019/051559, published as WO 2021/131055 and EP 3 868 480 A1.

Defendant CCR and Claimant in the infringement action request:

1. To maintain the Judge Rapporteur's Procedural Order (ORD_22156/2025) of 6 June 2025 concerning App_22065/2025.

2. To dismiss CeraCon's Application to Review an Order (App_28086/2025) dated 23 June 2025.

As an auxiliary request:

The Court grants Sunstar Engineering Inc. a term of 2 months, starting one day after the Court has granted CeraCon's application to review an order and the request to grant leave to amend the case by adding EP 3 868 480 A1 to the proceedings, to respond to the extension of the Revocation Counterclaim.

For further details, reference is made to the parties' briefs.

REASONS FOR THE ORDER:

The admissible request for review is unfounded. The panel confirms the order of the judge-rapporteur on the basis of the same considerations. Moreover, the grounds for exclusion under R. 263.2 RoP do apply.

1. The impugned order is not based on any incorrect legal standards.

First, contrary to Claimant CCR, R. 263 RoP grants the court discretion (cf. Court of Appeal, order of 11 April 2025, UPC_CoA_169/2025, paras. 10 et seq. – TGI Sport Suomi Oy et al vs. AIM Sport

Development AG). As the impugned order correctly states, R. 263 RoP is not subject to different principles when the amendment of a counterclaim for revocation is concerned. Rather, the same principles apply as those generally set out in R. 263 RoP.

In consequence, contrary to Claimant CCR, the absence of a situation in which it is excluded to grant leave to amend the case or claim under R. 263.2 RoP does not mean that leave has to be granted without further weighing of interests and without discretion. Rather, as always in similar situations, the interests of the parties involved and the public interest in the administration of justice as provided by the UPCA and the Rules of Procedure, particularly the public interest in efficient proceedings in accordance with the regime of time periods set out in the Rules of Procedure, have to be balanced, taking all circumstances of the individual case into account. In this context, R. 263.2 RoP only sets out a particular situation where, despite all further circumstances, the grant of a leave to amend the case or claim is excluded. Similarly, R. 263.3 RoP sets out a situation where, despite all further circumstances, leave shall always be granted.

The impugned order is based on these legal standards. The judge-rapporteur did not exercise a discretion not provided for in R. 263 RoP but rather weighed up the interests involved.

2. Contrary to Claimant CCR, the JR did not make mistakes when exercising his discretion, in particular he did not consider irrelevant facts and did not ignore the particularities of the case.

The impugned order rightfully assumes that, on a regular basis, the interest of the claimant of an infringement action and the interest of the defendant of a counterclaim for revocation outweigh the interest of the defendant of the infringement action and claimant of the counterclaim for revocation in a situation where the additional prior art document that is introduced after or only shortly before the submission of the defence to the counterclaim for revocation is easy to be found in an usual (electronic) prior art search when using a proper search string, regardless of whether the failure to include such document in the counterclaim for revocation constitutes negligence. The Rules of Procedure foresee that the claimant of a counterclaim for revocation has to bring forward the grounds for revocation alongside the facts relied on already in the counterclaim for revocation (cf. R. 25.1 (b), (c) RoP). This means that the counterclaim for revocation in particular has to substantiate the attacks on validity and designate all prior art documents the respective claimant wishes to invoke. As the impugned order rightfully points out, the patent owner and the claimant of the infringement action have a considerable interest in developing their further actions based on the content of the counterclaim for revocation. That is the reason why R. 263.2 (b) RoP excludes an amendment if the amendment unreasonably hinders the other party in the conduct of its action. However, even below this threshold of an unreasonable hindrance, these interests must be taken into account in the balancing of interests. Therefore, in a situation as described above, where the prior art document in question can be easily found applying an usual search method, there must be special circumstances that justify granting a leave to amend the case when being weighed up with the interests of the other side.

The impugned order does not suffer from errors in balancing the interests concerned. Claimant CCR merely substitutes its own view on what the outcome of the weighing up should be for that of the impugned order.

3. Apart from that, the panel agrees with the impugned order that the Claimant CCR did not raise any points which could tilt the balance in its favour.

4. However, the foregoing is not decisive, because the amendment is excluded pursuant to R. 263.2(a) RoP. Taking all circumstances into account, the panel is not convinced that there was reasonable diligence on the Claimant CCR's side.

In the case at hand, Claimant CCR was not constrained in finding EP'480 by the three-months period for the counterclaim for revocation, which, by the way, the Rules of Procedures – as a matter of fact – consider to be sufficient on a regular basis. Rather, as already discussed, EP'480 is easy to find. In fact, Claimant CCR did not come across EP'480 conducting a more intensive second search, but, on the basis of its own submission, by chance when conducting a customary search in an unrelated matter.

As already discussed, Claimant CCR itself states that, using the search string that was used for the search report, EP'480 turns up in the search results. As the Defendant CCR's side rightfully points out in its response to the application to amend the case, Claimant CCR does not substantiate why EP'480 did not become part of the search report. Since it must have been found by the search, as Claimant CCR itself points out, EP'480 must have been merely overseen when transferring the search result into the search report or disregarded on purpose because the authors of the search report considered EP'480 to be of no relevance. Against this backdrop, Claimant CCR on which lies the burden of demonstration and prove that there was reasonable diligence involved would have to explain in detail why EP'480 was disregarded or overseen, thereby disclosing the full factual situation so that the court has the full picture and is therefore able to assess the facts beyond doubt. In particular, at the case at hand, it cannot be excluded that the external search service provider deliberately excluded EP'480 on the assumption that it is not relevant. Without further explanation, it cannot be adequately assessed whether Claimant CCR was acting with due diligence when relying on an external search service provider which was properly instructed and sufficiently qualified to assess the relevance of prior art (taking in particular Art. 54 (3) EPC into account) and in accepting the search report as the basis for the counterclaim for revocation without at least quickly counterchecking the prior art documents that were found when using the search string but were deliberately disregarded on the assumption that they were not relevant.

Any unacceptable hardship can be remedied by suspending the infringement proceeding pending a separate revocation action (R. 118.2 (b) RoP) or by rendering a conditional decision on the merits of the infringement action (R. 118.2 (a) RoP), however only after the patent proprietor has had the opportunity to comment on the revocation action in the normal course of the revocation proceeding.

ORDER

The request to review the order dated 6 June 2025 (ORD_22156/2025) is rejected.

ORDER DETAILS

Order no. ORD_32795/2025 in ACTION NUMBER: ACT_63395/2024
UPC number: UPC_CFI_200/2025
Action type: Infringement Action
Related proceeding no. Application No.: 28086/2025
Application Type: APPLICATION_ROP_333

Issued in Mannheim on 8 August 2025

NAMES AND SIGNATURES

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