



Central Division (Section Munich)

UPC_CFI_1/2023 Order rejecting a Preliminary Objection of the Court of First Instance of the Unified Patent Court delivered on 24/08/2023

APPLICANT/S

- 1) **Amgen, Inc.** Represented by Michael Eder
Amgen Center Drive, CA 91320-1799,
Thousand Oaks, US

RESPONDENT/S

- 1) **Sanofi-Aventis Deutschland GmbH** Represented by Daniel Wise
Brüningstrasse 50, 65926 Frankfurt, DE
- 2) **Sanofi-Aventis Groupe** Represented by Daniel Wise
82 Avenue Raspail, 94250 Gentilly, FR
- 3) **Sanofi Winthrop Industrie S.A.** Represented by Daniel Wise
82 Avenue Raspail, 94250 Gentilly, FR

RELEVANT PROCEEDING PARTIES

- 1) **Sanofi-Aventis Deutschland GmbH** Represented by Daniel Wise
(Claimant)
Brüningstrasse 50 - 65926 Frankfurt, DE
- 2) **Sanofi-Aventis Groupe** Represented by Daniel Wise
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82 Avenue Raspail, 94250 Gentilly, FR
- 3) **Sanofi Winthrop Industrie S.A.** Represented by Daniel Wise
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- 4) **Amgen, Inc.** Represented by Michael Eder
(Defendant)
One Amgen Center Drive, CA 91320-1799,
Thousand Oaks - US

Applicant (Defendant in the main proceedings) is also represented by: H. Ulrich Dörries, J. Heselberger and A. Berger.

Respondents (Claimants in the main proceedings) are also represented by: A. Michel-de Cazotte, N. Hölder, M. Gruber and M. Pfeifer.

PATENT AT ISSUE

| Patent no. | Proprietor/s |
|------------|--------------|
|------------|--------------|

| | |
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| EP3666797 | Amgen, Inc. |
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PANEL/DIVISION

Panel 1 of the Central Division (Section Munich).

DECIDING JUDGE

This Order is an order of the Judge-rapporteur András Kupecz ('JR').

LANGUAGE OF PROCEEDINGS: English

SUBJECT-MATTER OF THE PROCEEDINGS

Preliminary objection in revocation action. Rule 48, 19.1(b) Rules of Procedure of the Unified Patent Court ('RoP').

1 STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES

The Requesting party in the Preliminary objection proceedings, Defendant in the main proceedings (herein referred to as 'Defendant'), is requesting that:

- the Preliminary objection be allowed (Rule 21.1 RoP).
- the revocation action be rejected as inadmissible.
- the claimants shall pay the defendant's costs.

The Respondents in the Preliminary objection, Claimants in the main proceedings (herein referred to as 'Claimants'), are requesting that:

- the Preliminary objection be rejected.
- the request on costs associated to the PO is rejected (which should in any case be dealt with as part of the final costs order of the revocation action).

2. BACKGROUND OF THE CASE AND SUMMARY OF THE FACTS

- 2.1 Claimants in the revocation action with number ACT_459505/2023 UPC_CFI_1/2023 have brought a revocation action against European patent¹ 3 666 797 B1 ('the Patent') in the Central Division (Section Munich) of the Unified Patent Court (hereinafter referred to as 'CD Munich', 'UPC', and 'main proceedings', respectively). In the main proceedings, Claimants request the Court to revoke the Patent in the Contracting Member States where it has such jurisdiction according to Article 32(1)(d) of the Agreement on a Unified Patent Court ('UPCA').
- 2.2 The Statement of revocation was lodged in hard-copy at the Registry in Luxembourg on June 1, 2023 at 11.26 in the morning. The Statement of revocation was (deemed to be) served on Defendant on 29 June 2023 (see Order number 536514 in Application 528654/2023).
- 2.3 Defendant has brought an infringement action to the Munich Local Division of the UPC ('Munich LD') against the Claimants in the present revocation action, also relating to the Patent (ACT_459916/2023).
- 2.4 The Statement of claim in the infringement action was lodged in hard-copy at the sub-registry at the Munich LD on June 1, 2023 at 11.45 in the morning.
- 2.5 On 20 July 2023, the Defendant uploaded a Preliminary Objection ('PO') within the meaning of Rule 48 in connection with Rule 19.1(b) of the RoP onto the Case Management System ('CMS') in the workflow "defence".
- 2.6 Defendant was informed by the Registry that the uploaded document was not the Defence to revocation and that preliminary objections need to be filed in a separate proceeding in the CMS.
- 2.7 Defendant subsequently lodged the PO, including exhibits, via the CMS using the designated workflow on 25 July 2023.
- 2.8 Claimants were notified of the PO on 25 July 2023 via the CMS.
- 2.9 Claimants submitted written comments, including exhibits, to the PO on 8 August 2023 ('CC').
- 2.10 An oral hearing (by video conference) was scheduled by the Court to give the parties the opportunity to be heard (Rule 20, 48, 264 RoP).
- 2.11 In advance of the oral hearing, Defendants submitted a Reply to Claimants' Defence to Preliminary Objection (on 15 August 2023) and Claimants filed a Rejoinder in Preliminary Objection (on 16 August 2023).
- 2.12 The hearing took place by video conference on 17 August 2023. At the hearing, parties presented their arguments and addressed questions from the JR. At the end of the hearing, the JR indicated that the decision or order would be delivered today.

3. POINTS AT ISSUE

- 3.1 Defendant argues that the CD Munich is not competent to hear this case, since to the best of its knowledge the revocation action was filed after the parallel infringement action ACT_459916/2023 pending at the Munich LD between the same parties relating to the same patent (Article 33.4, s.2 UPCA).

¹ Used in accordance with the definition of Article 2(e) UPCA: a patent granted under the provisions of the EPC, which does not benefit from unitary effect by virtue of Regulation (EU) No 1257/2012.

- 3.2 Defendant furthermore argues that, unless Claimants correct this deficiency in due time, the complaint is to be rejected as inadmissible (R. 19.5 s.5 RoP e contrario) and that Claimants shall bear defendant’s costs according to Article 69.1 UPCA.
- 3.3 Defendant also refers to the information available (last accessed by it on July 19, 2023) in the proceeding search function of the CMS in relation to the Patent, which shows that the “date of lodging” of the infringement action was before that of the revocation action:

| Number ↕ | Proceeding | Court Division | Internal Reference | Patent no. | Date of lodging |
|-----------------|---------------------|----------------|--------------------|------------|------------------------|
| ACT_459505/2023 | Revocation Action | Munich central | | EP3666797 | 01/06/23 19:32:16 CEST |
| ACT_459916/2023 | Infringement Action | Munich local | | EP3666797 | 01/06/23 13:33:02 CEST |

- 3.4 Finally, Defendant contends that according to Claimants’ own submissions, they did not file the revocation action at the CD Munich but at the UPC Registry seated at the Court of Appeal in Luxembourg, referring to Rule 3.2 of the rules governing the Registry of the Unified Patent Court (‘Registry Rules’).²
- 3.5 Claimants argue that when they lodged the revocation action, the Defendant’s infringement action had not yet been brought so the central division is (exclusively) competent.
- 3.6 According to Claimants, Article 33.4, second sentence, UPCA cannot be interpreted in a way that would make the admissibility of the revocation action dependent on factors that are not apparent to the claimant.
- 3.7 Claimants also refer to the CMS, pointing out the “date of receipt” recorded there:

Official Case Dates

| | |
|-------------------------------------|------------------------|
| Date of receipt / effective lodging | 02/06/23 18:59:56 CEST |
|-------------------------------------|------------------------|

Alerts

- 🔔 Multiple proceedings on patent EP3666797
- 🔔 Document lodged in hard-copy form pursuant to RoP4.2.

Screenshot of “date of receipt” attributed to the Revocation Action

Official Case Dates

| | |
|-------------------------------------|------------------------|
| Date of receipt / effective lodging | 26/06/23 09:35:40 CEST |
|-------------------------------------|------------------------|


Alerts


- 🔔 Multiple proceedings on patent EP3666797

Screenshot of “date of receipt” attributed to the Infringement Action

² Dated 6 April 2023, available online via https://www.unified-patentcourt.org/sites/default/files/upc_documents/rules-of-registry_16052023.pdf.

and the submission dates

| Stage | VER | Documents | Subm. Date |
|---|-----|--|---------------------------|
|  Statement for revocation / Declaration of invalidity | 1 | 2023.06.01 - Letter to the UPC - Lodging of Revocation Action - Exhibit - English Letter to Registry - Sanofi v Amgen - Uploading Issues on CMS - signed - Exhibit - English Sanofi v Amgen - Revocation Action - EP 3 666 797 – signed v2 - Pleading - English Formal-checks_Notification-of-positive- outcome - Formal check outcome - English statementOfRevocation - Acknowledgement - English statementOfRevocation - Request to the EPO relating to a pending proceeding for the purposes of RoP295(a) and RoP298. - English | 01/06/23 00:00:00 CEST |

| Stage | VER | Documents | Subm. Date |
|--|-----|--|---------------------------|
|  Statement of claim | 2 | Antwort auf Formal Check - Formal response to the request for amendments - German Verletzungsklage Amgen - Pleading - German Zahlungsbeleg Gerichtskosten - - Other - German Formal-checks_Notification-of-positive- outcome - Formal check outcome - German Receipt - Acknowledgement - German statementOfClaim - Request to the EPO relating to a pending proceeding for the purposes of RoP295(a) and RoP298 - German | 20/06/23 11:15:03 CEST |

- 3.8 In any event, according to the Claimants, the exact local time is not relevant for Article 33.4 UPCA (cf. RoP 17.4) when two actions are brought on the same day; if it were, it would in all cases be impossible for the claimant to know whether an infringement action relating to the same patent and between the same parties had already been brought because it takes at least a couple of hours before an action appears on the register.
- 3.9 Moreover, Claimants state that the revocation action had been lodged in hard-copy form (at 11.26 am CET on 1 June at the Registry in Luxembourg) before any points in time put forward by the Defendant at which it had allegedly filed its infringement action.
- 3.10 Further, Claimants argued that an infringement action can only be commenced by filing a statement of claim that complies with the requirements set out in RoP 13. This was not the case for Defendant's infringement action because several deficiencies had to (or still have to) be corrected by the Defendant.

3.11 Further facts, grounds and arguments as raised by the parties will be addressed in the below where relevant for the outcome of this Preliminary objection.

4. FOUNDATIONS FOR THE ORDER

(International) jurisdiction of the UPC and its competence for the revocation action

4.1 The (international) jurisdiction of the UPC has not been challenged by the parties. The present (main) action is a patent revocation action. In accordance with Article 31 UPCA, the international jurisdiction of this Court shall be established in accordance with Regulation (EU) No 1215/2012.³

4.2 According to Article 24.4 of Regulation (EU) No 1215/2012, 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.

4.3 Article 71b.1 of Regulation (EU) No 1215/2012 adds that a common court shall have jurisdiction where, under this Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument. The UPC is a “common court” within the meaning of Article 71a et seq. of Regulation (EU) No 1215/2012, see Article 71a.2 sub a Regulation (EU) No 1215/2012 and Article 1 UPCA, second part.

4.4 Pursuant to Article 32.1 (d) UPCA, the UPC shall have exclusive competence for actions for revocation of (European) patents. In view of this exclusive competence, and since no opt-out (Article 83.3 UPCA) from the exclusive competence of the Court in relation to the Patent is in effect, the UPC - as a common court of the Member States to the UPCA - has international jurisdiction based on article 24.4 of Regulation (EU) No 1215/2012 and is competent in respect of the present revocation action.

The PO: competence of the CD Munich - Article 33.4 UPCA

Summary

4.5 This PO is about the ‘internal competence’ of the different divisions of the UPC. Defendant argues that the CD Munich is not competent in the present revocation action because an infringement action based on the same patent had already been brought before the Munich LD against the Claimants when the revocation action was brought (with reference to article 33.4 UPCA, second sentence). The Claimants say that they brought their revocation action first and therefore the CD Munich is competent.

4.6 The circumstances of this case are specific in that the Statement of revocation (by Claimants) and Statement of claim (by Defendants) were both filed in hard-copy on the morning of June 1, 2023. On that morning, on the very first day of operation of the UPC, the CMS had ceased to function. Hence, both parties reverted to hard-copy lodging of their statements (Rule 4.2 RoP). Claimants lodged their Statement of revocation at 11.26 in the morning at the Registry in Luxembourg. The Defendants lodged their Statement of revocation at 11.45 in the morning at the sub-registry at the Munich LD.

4.7 Based on these facts, which are not in dispute between the parties, the Court finds that the revocation action was brought before the infringement action was brought and therefore considers

³ Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast), ELI: <http://data.europa.eu/eli/reg/2012/1215/2015-02-26>.

itself competent in respect of the revocation action on the basis of Article 33.4 UPCA. The PO is rejected accordingly. The grounds for coming to this conclusion are given below.

Article 33.4 UPCA

4.8 Article 33 UPCA governs the competence of the divisions of the Court of First Instance of the UPC. In other words, Article 33 UPCA relates to the ‘internal competence’ of the UPC.

4.9 For revocation actions, paragraph 4 of Article 33 UPCA, first sentence, gives the main rule according to which the central division is exclusively competent for such actions:

“Actions referred to in Article 32(1)(b) and (d) [actions for declarations of noninfringement and revocation actions, respectively, JR] shall be brought before the central division. [underline JR]”

4.10 The second sentence of Article 33.4 UPCA formulates an exception to the main rule for the situation in which an infringement action between the same parties relating to the same patent has been brought in a local or regional division:

“If, however, an action for infringement as referred to in Article 32(1)(a) between the same parties relating to the same patent has been brought before a local or a regional division, these actions may only be brought before the same local or regional division. [underline JR]”

4.11 There is no dispute between the parties that the two actions to which the PO pertains are between the same parties and relate to the same patent.

4.12 Therefore, the main legal issue that needs to be addressed is when an action can be considered to “have been brought” before a local or regional division in the meaning of Article 33.4 UPCA, second sentence.

4.13 Parties have different views as to this issue. Defendant is of the view that the actual date and time of filing an action should be decisive. Claimants, on the other hand, are of the view that the exact local time is not relevant for Article 33.4 UPCA, particularly not where two actions are brought on the same day. Rather an action has to appear on the register in order to be considered to have been brought, according to Claimants.

4.14 In interpreting Article 33.4 UPCA, the Court will focus on the ordinary meaning of the terms in their context and in the light of the object and purpose of the UPCA.⁴

4.15 In the Preamble, the UPCA (inter alia) sets out that the Contracting Member States:

“[Wish] to improve the enforcement of patents and the defence against unfounded claims and patents which should be revoked and to enhance legal certainty by setting up a Unified Patent Court for litigation relating to the infringement and validity of patents;”

and

“[Consider] that the Unified Patent Court should be devised to ensure expeditious and high quality decisions, striking a fair balance between the interests of right holders and other parties and taking into account the need for proportionality and flexibility;”

(underline JR)

⁴ Cf. Article 31.1 Vienna Convention on the Law of Treaties (1969).

4.16 In Article 33, the UPCA provides rules determining the internal competence of the various divisions of the UPC. It is apparent from the wording of Article 33 UPCA, in the context of the UPCA as a whole and in light of its object and purpose, that these rules, including Article 33.4, are drafted so as to promote the concentration of proceedings between the same parties on the same patent in one division, see for example Article 33.2, first section:

“If an action referred to in Article 32(1)(a), (c), (f), (g) or (h) is pending before a division of the Court of First Instance, any action referred to in Article 32(1)(a), (c), (f), (g) or (h) between the same parties on the same patent may not be brought before any other division.”

4.17 In general, having proceedings between the same parties relating to the same patent pending before different divisions of the same court would indeed be inefficient and could lead to conflicting decisions within the UPC which is obviously undesirable.

4.18 For revocation proceedings, Article 33.4 UPCA, second sentence, provides for a ‘shift’ in competence from the central division to a local or regional division if infringement proceedings have been brought in that local or regional division. This shift in competence reflects the desire to concentrate proceedings between the same parties in relation to the same patent.⁵

4.19 The rules determining the (internal) competence of the UPC must, on the other hand, be clear and predictable. This is particularly important for legal certainty, but also contributes to expeditious proceedings and the balance sought between the interests of patentees and other parties in line with the objectives of the UPCA. Moreover, it should be reasonably possible for parties to predict, in advance, which division of the UPC is competent. An arbitrary assignment of an action to a division (panel and/or judge) after bringing the action is to be ruled out. The competence of the divisions of the UPC must accordingly be based on the law and on objective criteria.

4.20 This also implies that parties and the Court must be able to assess this competence based on objectively verifiable facts. This is particularly important for the JR who, faced with an objection ex Rule 19.1(b) RoP, has to be able to investigate the competence of its division within the (limited in time and scope) realm of a preliminary objection.⁶ The JR must be able to carry out this determination in a predictable way, without having to assess the merits of the case brought in its division or any other division.⁷

The meaning of “has been brought” in Article 33.4 UPCA

4.21 The term having “brought” (German: “erhoben”, French: “engagée”) an action is not separately defined in the UPCA or the RoP.

4.22 In view of its plain meaning, the context as well as the object and purpose of the UPCA as set out above, “bringing an action” in the view of the Court means the objective act of lodging a Statement of claim by the claimant in case of an infringement action or a Statement of revocation in case of a revocation action.

4.23 Claimants argued that the requirements of Rule 13 RoP first have to be met in order to consider an action as having been brought. Article 33.4 UPCA, however, makes no reference to any further

⁵ The Court notes that a counterclaim for revocation may still be brought before the local division in case a revocation action is already pending at the central division. In such case Article 33.3 UPCA in connection with Rule 75 RoP provides a mechanism with essentially the same aim as Article 33.4 UPCA.

⁶ Which is when this issue will generally need to be dealt with (Rule 19.1(b) in connection with Rule 19.7 RoP). ⁷ According to Rule 20 RoP, the JR has to decide “as soon as practicable” and the period of lodging a defence shall in principle not be affected (Rule 19.5).

formal or substantive requirements other than “bringing” the action, nor does it refer to (appearance on) the register or to the subjective knowledge of a party. Moreover, if the view of Claimants were accepted, an assessment of the respective actions brought in two (or more) divisions of the UPC would be required at a later point in time, i.e. after bringing the action. This would complicate the proceedings and would make the outcome inherently less predictable which is to be avoided (see 4.19 and 4.20 above).

- 4.24 To regard the lodging of a Statement of claim or revocation as bringing an action for the purposes of Article 33.4 UPCA is also consistent with the RoP. Rule 4 RoP refers to “lodging” written pleadings and other documents. According to Rule 261 “All pleadings and documents lodged with pleadings shall bear a time and a date which shall be the time and date of receipt of pleadings at the Registry.” The (signing and) lodging of written pleadings and other documents in (the default) electronic form triggers the “automatic issue of an electronic receipt, which shall indicate the date and local time of receipt” (Rule 4.1 RoP). These provisions ensure that it is easily and objectively verifiable if and when a document, such as a Statement of claim or revocation, has been lodged.

The point in time at which an action “has been brought”

- 4.25 As follows from the above, it should also be clear, predictable and objectively verifiable when an action has been brought to a division. The drafting of Article 33.4 UPCA also presupposes a clear answer to this question of chronology: either the revocation action was brought first in which case the main rule applies, i.e. the central division is competent, or at the time of bringing the revocation action, an infringement action has been brought in a local or regional division, triggering the exception and shifting the competence exclusively to that local or regional division.
- 4.26 The way to unequivocally and objectively determine which action has been brought first in time is by establishing and comparing the exact date and time of lodging of the Statement(s) of claim and the Statement of revocation. Determining the date and time of lodging is a matter of fact which, under normal circumstances, can be done in a straightforward way using commonly accepted units of date (year, month, day) and time (hours, minutes, seconds), also see above, Rule 4.1, 261 RoP referring to the “time and date”.

Further points and arguments brought forward by the parties

- 4.27 The reference of the parties to Rule 17.4 RoP is not considered to be relevant for the present case. This Rule states when an action “shall be regarded as having commenced” before the Court and depends on the date of receipt attributed by the Registry. The latter is done after the lodging of a statement of claim or revocation, with retro-active effect, only once certain (formal) requirements have been complied with (cf. Rule 17.1, 16.2 and 16.3 RoP). In the view of the Court, whether or not an action shall be regarded as having commenced in the sense of Rule 17.4 RoP is therefore a different matter from the objective determination if and when an action “has been brought” as required by Article 33.4 UPCA.
- 4.28 The Claimants argued that considering the exact (local) time on the day of filing would lead to unpredictable, arbitrary results. However, as follows from the foregoing, quite the opposite is the case. The exact date and time of lodging a statement of claim or revocation is a fact that can be objectively verified, typically in a straightforward way using the means foreseen in the RoP.
- 4.29 It is also not apparent why this interpretation of Article 33.4 UPCA would lead to an “arbitrary disadvantage for the revocation claimant” or would be “in stark contrast to the aim of the UPCA to provide efficient and rapid proceedings (also) for revoking invalid patents” (2.14,2.19 CC). A revocation claimant has the full and effective right to pursue its revocation action. The only possible issue for the revocation claimant is that it may not be able to do so in the (central) division

originally indicated but in a local division in case it turns out that infringement proceedings have been brought there first (also see 4.31 with regard to Rule 19.5 RoP).

- 4.30 The argument that the central division is especially created for (inter alia) revocation actions, as brought forward by Claimants, does not change this. Also in other situations than Article 33.4, second sentence, local and regional divisions can be competent for revocation actions, in particular when these are lodged by way of counterclaim (Article 33.3 UPCA).⁷
- 4.31 The Court also does not see an “unreasonable risk” for a revocation claimant (2.15 CC). The RoP provide for a clear and efficient solution for the situation in which an ‘unknowing’ revocation claimant later, in the context of a preliminary objection, becomes aware that an infringement action has been brought in a local division before it filed the revocation action. Rule 19.5 RoP provides that a deficiency in the division originally indicated by the claimant may be corrected (voluntarily) by the claimant who may indicate another division, which is competent. In such case the judge-rapporteur shall refer the action to the division indicated by the claimant.
- 4.32 The statement by the Claimant that this interpretation of Article 33.4 UPCA would result in a “race to file first in situations where a controversial patent is granted” which would be “to the detriment of the quality of the submissions” (2.21 CC) is not supported by facts and is also not self-evident to the Court. Revocation actions may be brought to the UPC at any time. It is only a question at which division within the UPC this has to be done, with the aforementioned possibility of correcting this after bringing the action to – what later, if and when an objection is made, turns out to be – the wrong division.

EU Regulation 1215/2012

- 4.33 Finally, even though EU Regulation 1215/2012 does not apply to the question of internal competence of the different UPC divisions, the Court finds further support for its interpretation of Article 33.4 UPCA in Article 32.1(a) of EU Regulation 1215/2012. According to that provision, for the purposes of assessing *lis pendens*, a court shall be deemed to be seised “at the time when the document instituting the proceedings or an equivalent document is lodged with the court”.
- 4.34 Where possible, a uniform and consistent interpretation of the UPCA with EU law is deemed to be desirable, even if Article 33.4 UPCA relates only to ‘internal’ UPC competence.

Interim conclusion on the interpretation of Article 33.4 UPCA

- 4.35 By way of interim conclusion, Article 33.4 UPCA is interpreted such that in order to assess whether an (infringement) action has been brought before a local or regional division, the central division needs to establish if a Statement of claim to bring an infringement action has been lodged at a local or regional division and, if so, at what date and time this was done.

Hard copy lodging because the CMS ceased to function (4.2 RoP)

- 4.36 There is no dispute between the parties as to the fact that at the time of bringing the respective actions, on the morning of June 1, 2023, it was not possible to lodge any documents electronically because the CMS had ceased to function. Therefore Rule 4.2 RoP applies in this case.
- 4.37 In its PO, the Defendant challenged the date and time of lodging the Statement of revocation

⁷ If the local division decides to proceed with the counterclaim, a technically qualified judge is to be allocated (Article 33.3(a) UPCA). Also see footnote 5.

“pleading ignorance”. In the course of the proceedings, however, it accepted that the Claimant’s Statement of revocation was lodged at 11.26 in the morning on June 1. The debate between the parties ultimately focussed on whether the statement of revocation was lodged at the proper place.

4.38 Defendants argue that the Claimants should have lodged the revocation action in hard-copy at the (sub-registry of) the CD Munich and not at the Registry in Luxembourg. According to Defendants, in the situation of Rule 4.2 RoP, the lodging must occur at the court that has competence over the action in the respective case, whether it is the Registry (in case of an appeal) or a competent subregistry (for first instance cases). As the Court of Appeal is not the competent division for this case, the action should not have been lodged at ‘its’ Registry. At best, according to Defendants, only the time of arrival at the CD Munich could be relevant. Claimants disagree arguing that they properly lodged their action at the Registry of the UPC in Luxembourg.

4.39 The Court does not follow Defendant’s interpretation of Rule 4.2 RoP.

4.40 Rule 4.2 RoP reads:

“Where it is not possible to lodge a document electronically for the reason that the electronic case management system of the Court has ceased to function a party may lodge a document in hard-copy form at the Registry or a sub-registry. An electronic copy of the document shall be lodged as soon as practicable thereafter.” (bold and underline JR)

4.41 First of all, based on a plain reading of Rule 4.2, this Rule is drafted in the alternative (“or”) to give a party the choice to – in the exceptional case that it is impossible to lodge a document electronically because the CMS has ceased to function – either file: i) at “the Registry” or ii) at “a sub-registry”.

4.42 Defendant further explained during the oral hearing that it essentially sees the Registry in Luxembourg, apart from serving as the Registry for the Court of Appeal, as acting merely as a “roof entity” for the various sub-registries. This view is, according to the Court, too restricted and does not align with Rule 4.2 RoP and the UPCA as a whole.

4.43 In accordance with Article 10.1 UPCA: “A Registry shall be set up at the seat of the Court of Appeal” and Article 10.2: “Sub-registries shall be set up at all divisions of the Court of First Instance.” (underline JR). Where Rule 4.2 refers to “the Registry” (as an alternative for a subregistry), in the context of the UPCA, this means the Registry which is set up (and physically located) at the seat of the Court of Appeal, i.e. in Luxembourg. The Registry in Luxembourg is indeed the Registry of the Court (cf. Article 6 UPCA, “The Court shall comprise ... a Registry”). Even though the Registry also serves the Court of Appeal, it is not (only) the Registry of the Court of Appeal. The fact that sub-registries are set-up at the various divisions of the UPC is a matter of practical organisation. This does not imply that the Registry does not have its general functions within the Court of First Instance.

4.44 Furthermore, this interpretation is confirmed when looking at the history of Rule 4.2. The wording “at the Registry or a sub-registry” was added in the 18th draft for the RoP without further explanation. In Rule 4.1 RoP, however, similar wording (“or relevant sub-registry”) had been introduced previously in the 17th draft, with the following explanation: “This change clarifies that documents and pleadings may be lodged not only at the Registry but also at the sub-registry of the division dealing with the case.”⁸ This change and the explanation given confirms that it was not the intention of Rule 4.1 to make the Registry or a sub-registry a mutually exclusive place for lodging documents, to the contrary. This rationale applies equally (if not more) to lodging of hard copies

⁸ https://www.veron.com/wp-content/uploads/2014-10-31_Digest_Legal_Group_17th_Draft_RoP.pdf.

documents under the special circumstances wherein the CMS has ceased to function as governed by Rule 4.2.

- 4.45 This interpretation of Rule 4.2 also complies with and is not in conflict with Article 33.4 UPCA. That provision indeed governs the competence of the divisions of the UPC for revocation actions, but does not specify where and how a statement of revocation must be (practically) lodged, in particular not when lodging in hard-copy in the situation wherein the CMS ceases to function. Such is part of the details of the proceedings before the Court, which are laid down in the RoP (Article 41 UPCA). To allow, under such circumstances, the lodging of hard-copy documents at the Registry is furthermore in-line with the notion of the UPC as ‘one Court’ with ‘one Registry’ (and under normal circumstances ‘one CMS’), as discussed above in the light of Article 6 and 10 UPCA.
- 4.46 To put it differently, the Registry, being the Registry of the Court, including therefore being the Registry of the CD Munich, functions as a ‘receiving mailbox’ for the entire UPC, especially under the circumstances of Rule 4.2 RoP. The Registry also has many other tasks for the entire UPC, such as “keeping the register” and “publishing the decisions of the Court”, just to name a few (cf. Article 23.2 Statute of the UPC, ‘Statute’). Specifically for revocation actions, Rule 44 RoP states that a Statement of revocation is to be lodged “at the Registry”, further emphasising the role of the Registry. The ‘Court-wide’ role of the Registry is further embodied in that acts of “the Registry” may generally be performed by a member of staff of the Registry or sub-registry of the relevant division and vice versa (Rule 3 RoP).
- 4.47 In summary, under the circumstances that the CMS has ceased to function, Rule 4.2 RoP is interpreted by the Court such that a Statement of revocation may be lodged (as one of the options) at the Registry seated in Luxembourg. Accordingly, the Statement of revocation in this case was lodged at the right place, i.e. at the Registry in Luxembourg. As a consequence, the Court finds that the revocation action has been brought on June 1, 2023, at 11.26 in the morning.

The Registry Rules

- 4.48 The Defendant furthermore relied on the Registry Rules, in particular Rule 3, section 2: “Paper documents and physical evidence may be submitted in person during opening hours of the competent division of the Court of First Instance or of the Court of Appeal.” (emphasis by Defendant in PO, p. 4 top). According to Defendant these Rules confirm that the Claimants should have filed at the competent division of the Court of first Instance, i.e. at the sub-registry of the CD Munich.
- 4.49 The Court does not interpret Rule 3 of the Registry Rules as instructing a party where to lodge a hard-copy document when the CMS has ceased to function. This rule rather makes clear that there are certain opening hours and that documents may be submitted during these hours. The reference to “competent division” is interpreted as pertaining to the ‘normal’ situation in which a competent division has been established and not to the initial lodging of a case with the court, let alone in the (exceptional) situation when the CMS has ceased to function. In fact, Rule 61 of the Registry Rules, which does refer to Rule 4.2 RoP, provides instructions to “the Deputy-Registrar” what to do in case of receiving hard-copy lodging of documents. The Deputy-Registrar in accordance with the Statute (Article 25) and Rule 1(g) of the Registry Rules, is the Deputy Registrar of the Court so this confirms that hard-copy lodging may be done with ‘the Registry’ organisation as a whole.
- 4.50 Nevertheless, even if the Court would have found that there was a conflict between the Registry Rules and the RoP, especially 4.2 RoP, the outcome would not have been different. First of all, the Registry Rules have been adopted by the Presidium on the basis of the UPCA and the Statute to govern the Registrar’s service (Article 10.4 UPCA), to govern the Registry including the subregistries (Article 15.3(e) Statute) and to provide rules for keeping the register of the Court (Article 24.1 Statute). Accordingly, these rules are primarily directed at the Registry and not at

parties seeking to bring a case before the Court. The details of how proceedings are to be conducted before the Court are laid down in the RoP (Article 41.1 UPCA). For this reason, the Registry Rules are not intended to and cannot overrule the RoP, particularly not where it concerns procedural acts performed by a party.

- 4.51 The RoP have furthermore been adopted by the Administrative Committee on the basis of the procedure prescribed by Article 41 UPCA and as such a priori cannot be superseded by the Registry Rules that have been adopted by the Presidium to give effect to the above-mentioned provisions.

Fair and equitable

- 4.52 Finally, the Court finds that the interpretation and application of Article 4.2 RoP as given above is fair and equitable. It would not be reasonable that a party, due to events over which it has no control whatsoever, i.e. when the CMS ceases to function, finds itself potentially from one moment to another in a worse position over another party, merely based on its geographical location at that particular point in time. This would introduce a degree of unpredictability and arbitrariness that is deemed to be unfair and not equitable by this Court.

Conclusion

- 4.53 Based on the above, it is concluded that at the point in time the Claimants brought their revocation action by lodging the Statement of Revocation in hard-copy at the Registry in Luxembourg at 11.26 in the morning of June 1, 2023, no infringement action between the same parties relating to the same patent had been brought to a local division. The infringement action at the Munich LD was brought by Defendants at a later point in time, at 11.45 in the morning of June 1, 2023.
- 4.54 As a consequence, on the basis of Article 33.4 UPCA, first sentence, the Central Division (Section Munich) is competent in respect of the present revocation action. The PO lodged by the Defendant (including the request to reject the revocation action as inadmissible) is therefore rejected.
- 4.55 In view of the rejection of Defendant's PO based on the above reasons, the Court sees no ground for allowing Defendant's request that claimants shall pay the Defendant's costs. This request shall therefore also be rejected.
- 4.56 Because of the fundamental nature of the legal questions raised in this case and to promote a consistent application of the RoP (cf. Preamble RoP, point 8), leave to appeal is hereby granted by the Court of its own motion.

ORDER

For these grounds, having heard the parties on all aspects of relevance for the following order, the Judge-rapporteur:

- rejects the Preliminary Objection
- rejects the request to reject the revocation action as inadmissible
- rejects the request that Claimants shall pay the Defendant's costs
- orders that any remaining issues are to be dealt with in the main proceedings (Rule 20.2)
- grants leave to appeal this Order

INSTRUCTIONS TO THE PARTIES AND TO THE REGISTRY

The next step in the proceedings shall be the lodging of a Defence to revocation by Defendant (Rule 49 RoP), the time period for which has been extended by two weeks (as per the order with number ORD_562856/2023).

INFORMATION ABOUT APPEAL

Leave to appeal is granted. The present Order may be appealed within 15 days of service of this Order which shall be regarded as the Court's decision to that effect (Art. 73(2)(b)(ii) UPCA, R. 21.1 2nd sentence and 220.2, 224.1(b) RoP).

ORDER DETAILS

Order no. 560432 in ACTION NUMBER: ACT_459505/2023

UPC number: UPC_CFI_1/2023

Action type: Revocation Action

Related proceeding no. Application No.: 554674/2023

Application Type: Preliminary objection

Issued on 24 August 2023

KUPECZ

Judge-rapporteur