



The Hague - local division

UPC_CFI_239/2023
PROCEDURAL ORDER
of the Court of First Instance of the Unified Patent Court
delivered on 17 January 2024

Headnote: Defence to Counterclaim not filed together with reply to defence in claim as required by R. 29(a). Deadline to file Defence in the Counterclaim extended (R. 331., 334(a) and 9.3(a) RoP).

Keywords: Procedural order ex officio by JR. Extension of time limit.

CLAIMANTS

- | | | |
|----|--|----------------------------|
| 1) | Plant-e Knowledge B.V.
Renkum – the Netherlands | Represented by Oscar Lamme |
| 2) | Plant-e B.V.
Renkum – the Netherlands | Represented by Oscar Lamme |

DEFENDANT

- | | | |
|----|---|------------------------------|
| 1) | Arkyne Technologies S.L.
Barcelona - ES | Represented by Joran Spauwen |
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PATENT AT ISSUE

Patent no.

Proprietor/s

EP2137782

Plant-e Knowledge B.V.

DECIDING JUDGE

JUDGE RAPporteur ('JR') – MARGOT KOKKE

LANGUAGE OF PROCEEDINGS: English

SUBJECT-MATTER OF THE ORDER AND REASONING

This order concerns the following:

1. Clarification of the time limit for lodging the statement of Defence to the Counterclaim and further written statements
2. Setting a (provisional) date for the interim conference and the oral hearing (with an alternative date)
3. Giving parties the opportunity to comment on the application of article 33(3) UPCA in line with rule 37(2) RoP

1. Clarification of the time limit date for the statement of defence to the Counterclaim

- The time limit for Plant-e Knowledge B.V. to file its Defence to the Counterclaim and any Application to amend the patent is set at **23 January 2024**. The date of filing of this Defence will be considered as the date of filing of the reply in the infringement action as well.

Background

1.1 The defendant (hereinafter Bioo) uploaded its statement of defence in the infringement action (Act_549536) on 9 November 2023. Together with and in the same document as this defence, Bioo filed a counterclaim for revocation (hereinafter: the Counterclaim) pursuant to rule 25.1 RoP. After formal checks, the filing/service of defence was acknowledged in the CMS on 13 November 2023.

1.2 On 14 November 2023 the following message was sent to Bioo:

the CMS requires the Counterclaim also to be filed seperatedly, and a fee needs to be paid (Rule 26 RoP). On the basis of Rule 24 RoP, you have 14 days from this notification to correct the deficiencies [emphasis added, JR]

Subsequently, Bioo uploaded the same combined Defence and Counterclaim in a new workflow in the CMS (CC_588768/2023) with only the patent proprietor, Plant-E Knowledge BV (claimant 1) as defendant.

1.3 On 29 november 2023 Plant-e) received the following message from the UPC:

Please find attached the counterclaim for revocation lodged by the defendant in the main proceeding (case no. 549536/2023). The case no. for the counterclaim for revocation is CC_588768/2023. Attached to this e-mail you will also find the Letter to Accompany Service, which contains further instructions for accessing the case. Please note that the exhibits are uploaded only in case no. 549536/2023. With this e-mail, Plant-e Knowledge B.V. has been served the counterclaim for revocation according to Rule 271.6 (a) Rules of Procedure of the Unified Patent Court. [emphasis added, JR]

1.4 On 12 January 2024 Claimants (hereinafter Plant-e) filed a statement of reply (hereinafter: the Reply) to the defence in the infringement action on 12 January 2024 Regarding the statement of Defence in the counterclaim the following is mentioned in Plant-e's Reply:

*Bioo has included a counterclaim for revocation of the Patent in its Statement of defence ("**Counterclaim**"). As was also noted by the Registry of the Court in its e-mail of 14 November 2023 (**Exhibit EP21**), a counterclaim needs to be filed separately and a court fee needs to be paid. Bioo has only complied with these formalities at a later stage, so the Counterclaim was only served on Plant-e on 29 November 2023 (**Exhibit EP22**). Plant-e will respond to the Counterclaim separately and within the time period as set out*

in the RoP. In this statement of reply Plant-e will therefore not address Bioo's invalidity arguments. For the record, this should not be seen as an acknowledgment in the infringement proceedings that the Patent would be invalid.

reasoning

1.5 The date of filing of the Defence in the Counterclaim is apparently not clear to Plant-e Knowledge B.V. According to rule 29(a) RoP, the claimant must file a Defence to the Counterclaim for revocation and any Application to amend the patent pursuant to rule 30 RoP within two months of service of a Statement of defence containing a Counterclaim for revocation:

Within two months of service of a Statement of defence which includes a Counterclaim for revocation, the claimant shall lodge a Defence to the Counterclaim for revocation together with any Reply to the Statement of defence and any Application to amend the patent pursuant to Rule 30, if applicable. [emphasis added, JR]

1.6 Such Statement of defence was served on claimants on 13 November 2023 (see 1.1 above), hence the Defence to the counterclaim as well as any Application to amend the patent had to be filed before 13 January 2024. Plant-e Knowledge has also been aware of the (wording of) the Counterclaim since 13 November 2023, as the text is combined with the reply. The separate official service of the counterclaim through the CMS is not a relevant start date.

1.7 However, the (current) CMS set-up wherein it is necessary to start a new workflow to upload the defence/counterclaim once more in order to be able to pay the court fee as well as the messages sent to the parties in this regard (as quoted above in 1.2 and 1.3) may have caused confusion. Plant-e Knowledge apparently assumed that the (official) date of the start period for filing the Defence in the Counterclaim, was not 13 November 2023 but 29 November 2023. Working with the new procedural law and the CMS poses considerable challenges for all parties involved. A practicable handling of the challenges that arise is required. The apparent misunderstanding of the relevant deadline by Plant-e Knowledge will in this situation not be held against her; the consequences would be disproportionate. The current order to extend the period for Plant-e Knowledge to file a Defence to the Counterclaim and to 'reunite' the claim and counterclaim workflows is given by the judge-rapporteur ex officio. The concurrence of the filing of submissions in these related proceedings is foreseen in the Rules of Procedure (a.o. rule 29) and is procedurally economical. In addition, the combination of the reply in the claim and the defence in the counterclaim (and further submissions) is necessary as invalidity of the patent is also argued as a defence in de infringement action.

1.8 Taking into account the interests of both parties and the consideration to have speedy proceedings at the UPC with short time limits, the judge-rapporteur herewith extends the time limit for Plant-e Knowledge B.V. to file its Defence to the Counterclaim and any Application to amend the patent to **23 January 2024** (in accordance with rules 331.1, 334(a) and 9.3(a) RoP). The date of filing of this Defence will then be considered as the effective filing date of the reply in the infringement action as well and as the start date for the filing of further submissions. The defendant may then proceed according to rule 29 (d) RoP by lodging a combined reply/rejoinder within two months of the service of the defence in the counterclaim (i.e. the date of the lodging of the Defence set above) and Plant-e knowledge may thereafter proceed according to rule 29(e) RoP.

2. (provisional) date for the interim conference and the oral hearing (with an alternative date)

2.1 As soon as practicable after service of the statement of defence, the JR shall set a date and time for an interim conference (where necessary) and for the oral hearing after consulting the parties (rule 28 RoP). The following dates are proposed.

Interim conference: Wednesday 5 June 2024 (by video conference) (with 10 June as an alternative date) (provisional)

oral hearing: Monday 9 September 2024 in The Hague (with 7 October as an alternative date)

2.2 Parties can notify any *unavailability* to the court within two weeks from the date of this order by sending an email to the following address of the registry of the local division The Hague: contact_the-hague.loc@unifiedpatentcourt.org

3. opportunity to comment on the application of article 33(3) UPCA in line with rule 37(2) RoP

3.1 The parties are given the opportunity to be heard regarding the application of article 33(3) UPCA. Reference is made to rule 37.2 RoP. Comments can be submitted within two weeks of the date of this order in the workflow of this order.

ORDER

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

1. The time limit for Plant-e Knowledge B.V. to file its Defence to the Counterclaim for revocation and any Application to amend the patent is extended to **23 January 2024**.
2. The date of filing of this Defence will be considered as the date of filing of the reply in the infringement action as well and shall be the start date for further submissions (see 1.8 above).
3. Parties can notify the registry in case of unavailability at the proposed hearing dates as mentioned in 2.1 and 2.2 above within two weeks of the date of this order.
4. Parties can submit their position regarding the application of article 33(3) UPCA in reply to this order within two weeks of the date of this order.

DETAILS OF THE ORDER

ORD_2223/2024

UPC case number: UPC_CFI_239/2023

main proceeding CMS nrs: ACT_549536/2023 (claim) (and CC_588768/2023 counterclaim)

Issued on 17 January 2023

Margot Kokke
Judge Rapporteur