



Central Division
Paris Seat

ORDER

of the Court of First Instance of the Unified Patent Court

Central division (Paris seat)

issued on 9 February 2024

concerning the Generic procedural application No. App_4285/20234

lodged in the proceedings UPC_CFI_412/2023

HEADNOTES: request for procedural order.

KEYWORDS: statement or defence; time extension.

REFERENCE CODE ECLI:

APPLICANT:

ITCiCo Spain S.L. - C/Pau Piferrer 17 07011, Palma de Mallorca, Spain
represented by Robin Hayes, Whitney Moore LLP

RESPONDENT:

Bayerische Motoren Werke Aktiengesellschaft - Petuelring 130, 80809 München, Germany
represented by Johannes Lang, Bardehle Pagenberg Partnerschaft mbB

PATENT AT ISSUE:

European patent n° EP 2 796 333

PANEL:

Panel 2 of the Central Division - Paris Seat

DECIDING JUDGE:

This order has been issued by the presiding judge and judge-rapporteur Paolo Catalozzi

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 6 November 2023 the respondent has brought a revocation action against the patent at issue before this Seat of the Unified Patent Court, registered as No. ACT_585518/2023 UPC_CFI_412/2023.
2. On 25 January 2024 the applicant, defendant in the revocation action, has lodged a Generic procedural application, registered as No. App_4285/2024, requesting that the Court exercises its case management powers under Rules 9 and/or 334 of the Rules of Procedure ('RoP') to extend the time for delivery of the statement of defence (and the counterclaim, if any) to 29 February 2024.
3. On 2 February 2024 the respondent, asked for its comment by a preliminary order of this judge-rapporteur, has requested to reject the applicant's request for extension of time.

GROUNDINGS FOR THE ORDER

Applicant's allegation.

4. The Applicant has affirmed that a copy of the revocation statement of claim was delivered to its registered office on a date during the last week of November 2023, but that the related exhibits were not delivered with this statement of claim and were accessible only on 2 January 2024.
5. It has added that the delivery of the statement of claim was preceded by two letters from this Seat, both dated 15 November 2023: the first one, enclosing the statement of claim, requested it to provide for an authorised representative in case it wanted to be represented and to accept service of proceedings electronically; the second one, containing the access code to the Case Management System ('CMS'), included the same information concerning representation and the acceptance of service by electronic means.
6. It has believed that those letters were a courtesy informing the defendant that proceedings had been commenced at the Unified Patent Court and that formal service of the statement of claim and the accompanying exhibits would take place via electronic means once access to the 'CMS' had been arranged.
7. It has also pointed out that it received his smart card verification device on 19 December 2023 and tried to log onto the CMS on that date, but was unable to access the case documents and accept service of all the documentation lodged by the claimant despite his best efforts and managed to do it only after the claimant's representatives kindly provided with a download link on 2 January 2024.
8. The applicant has intended to enter a full defence to the current proceedings, but it encountered a significant practical difficulty in meeting the statutory deadline as its long-standing European

Patent Attorney ([REDACTED]) had taken ill during December 2023, so that it was forced to appoint an alternative firm of patent attorneys with expertise in the relevant technology.

9. Finally, it has written to the respondent's representatives informing them that it intended to deliver its defence no later than 29 February 2024, but the received response was that the service had occurred on 25 November 2023 and that accordingly the defence would be due by 25 January 2024.

Rule 9 (3) 'RoP' and the use of the discretionary powers by the Court.

10. Pursuant to Rule 9 'RoP', 'on a reasoned request by a party, the Court may: (a) extend, even retrospectively, a time period referred to in these Rules or imposed by the Court; and (b) shorten any such time period' (para 3.), with the exclusion of the time periods referred to in Rules 198 (1), 213 (1) and 224 (1) (para 4.).
11. The provision confers to the Court the discretionary powers to modify, upon a reasoned request of a party, the deadlines set by the statutory rules for performing procedural activities and in exercising these powers the Court has to observe the principles of proportionality, flexibility, fairness and equity, mentioned in the preamble 2 and 4 of the 'RoP' (see UPC CFI 255/2023 CD Paris, order of 10 November 2023, para 11).
12. With particular regard to the request of time extension, the Court has to take into account that the regime of procedural deadlines is aimed to a plurality of purposes.
13. First of all, it ensures that proceedings are concluded rapidly and respectfully, where possible, of the one-year period set by the preamble 7 of the 'RoP' for the infringement and revocation actions.
14. Secondly, it safeguards the principle of fair trial by providing in advance - that is, before the beginning of a proceedings - for the procedural rules which both parties have to comply with and which are regulating the proceedings itself.
15. Thirdly, it protects the principle of impartiality of the judge, which would be affected where the Court altered arbitrarily the statutory deadline in favour of one of the parties.
16. Lastly, it assures the legal certainty that the procedural activity will be performed within a specific period of time and the parties' trust on the relevant provisions being compulsory.
17. On the other side, the protection and the implementation of the right to defence impose to interpret the statutory rules regarding the deadlines in a flexible and equitable way where a party has an objective difficulty to arrange an adequate defence within the time provided for.
18. For all these arguments, this judge-rapporteur agrees with the statement that the power to extend the time limit should only be used with caution and only in justified exceptional cases (see UPC CFI 363/2023 LD Düsseldorf, order of 20 January 2024).
19. It follows that the Court may extend a deadline set by the Rules of Procedures only in case a party alleges and gives evidence that it will not be able or was not able to meet it because of a fact that makes the submission of a document or the arrangement of an adequate content of a pleading in the due time objectively impossible or very difficult.

20. For these purposes, an impossibility or an extreme difficulty to meet the deadline which is attributable to the party requesting the extension of the deadline or its representative does not come into consideration, as it may not be deemed as objective.
21. It may be added that the implementation of the principle of fair trial obliges a party to submit a request for time extension as soon as it appears clear that the meeting of the deadline will not be possible.
22. In the current proceedings, it seems from the documents at hand that the Registry has served the statement of claim by postal services, pursuant to Rule 271 (4) (a) 'RoP' and Article 18 of the Regulation (EU) 2020/1784, at the defendant's registered office. The relative 'Notification of Service' issued by the Registry indicates the date of 25 November 2023 as the date in which the service has been effected.
23. The applicant has complained that the statement of claim which has been served referred to appendices/exhibits which were not enclosed with the correspondence, but under Rule 271 'RoP' a statement of claim, even if it refers to annexes which are not included in the service, can be deemed as validly served on the defendant, provided that the statement of claim without the annexes enables the defendant to assert its rights in legal proceedings before the Court where, as in the present case, this statement of claim states with certainty the subject matter and the cause of action (see UPC CoA 320/2023, order of 13 October 2023).
24. The applicant has affirmed that its authorised representative received his smart card verification device for accessing to the 'CMS' only on 19th December 2023 and he attempted to access the case documents on that date, but he was unable to do so at the time despite his best efforts.
25. This allegation turned out to be lacking of a relevant evidence and, however, it may be noticed that a party's representative waiting for the smart card verification device after the service of the statement of claim (and the reception of the information concerning the lodging of the revocation action) is expected to seek a solution in an appropriate time and act accordingly (for example, by submitting requests to the Court or the Registry)
26. Similarly, the allegation that the defendant's long-standing European Patent Attorney had taken ill during December 2023 and had to take a more extended sick leave than the one originally requested appears to be devoid of sufficient evidence.
27. Moreover, it can be pointed out that applicant's argument that the draft of a proper statement of defence was impossible due to lack of time as all the claimant's documentation was available to the defendant only at a later stage seems to be in contrast with the submission of the current application only on 25 January 2024, that is the last day of the deadline.
28. In any case, submitting the Court a request to extend a time period on the last day of it in a situation in which the reason for that request arose - according to the applicant's allegation - well before may be appreciate as non-complying with the principle of fairness that must guide the procedural activities of the parties.

ORDER

The Judge-rapporteur rejects the request.

Issued on 9 February 2024.

The Judge-rapporteur

Paolo Catalozzi

REVIEW

Pursuant to Rule 333 'RoP', the order shall be reviewed by the panel on a reasoned application by a party. The relative application shall be lodged within 15 days of service of the order.