



ORDER
of the Court of First Instance of the Unified Patent Court
Central Division (Paris Seat)
issued on 24. April 2024

concerning EP 3430921

KEYWORDS: Rule 262 RoP request
REFERENCE CODE ECLI: not provided

APPLICANT

**Nicoventures Trading Limited, Globe House, 1 Water Street, London, WC2R 3LA,
United Kingdom**
represented by **Peter Thorniley**

Parties:

NJOY Netherlands B.V.

Westerdoksdiik 423 1013BX Amsterdam Netherlands
represented by **Henrik Holzapfel** - **Claimant** -

Juul Labs International, Inc.

560 20th Street, Building 104 - California 94107 - San Francisco - US – **represented
by Bernhard Thum** - **Defendant** -

Patent at Issue: EP 3 430 921

Deciding Judge:

This order has been issued by the Judge-rapporteur **Maximilian Haedicke**

Language of Proceedings: English

Subject-Matter of the Proceedings

Request based on Rule 262.1(b) of the Rules of Procedure (RoP)

Summary of Facts

Claimant brought a revocation action against Defendant at the Paris Central Division of the Unified Patent Court (571808/2023 UPC_CFI_316/2023) (“Main Action”), requesting the Court to declare that European Patent No. EP 3 430 921 to be void.

Applicant is a party to EPO opposition proceedings regarding the above-mentioned European patent. The claimant in the Main Action is not.

In relation to this revocation action, the Registry has on 15 November 2023 received a request pursuant to Rule 262.1(b) RoP from the Applicant.

With Order of 11 December 2023 the Court informed Applicant and the parties to the Main Action that in relation to the present Rule 262.1(b) RoP application, before proceeding with the application, the Court intends to wait for the outcome of the appeal proceedings that have been brought at the Court of Appeal against order number 573437/2023 on application number 543819/2023 from the Nordic-Baltic division dated 17 October 2023 (APL_584498/2023).

On 18 December 2023 Claimant submitted that it agrees with the Court’s contemplated course of action to wait for the outcome of the above mentioned appeal proceedings.

On 21 December 2023 Applicant stated that it has no objection to awaiting the referenced decision of the Court of Appeal.

Defendant did not wish to comment on the Order of 11 December 2023.

With decision of 10 April 2024 the Court of Appeal issued a decision giving guidelines for public access to the register (R.262.1(b) RoP). (UPC_CoA_404/2023 APL_584498/2023).

Applicant’s Request

Applicant is requesting certain documents as identified in the CMS. The Applicant also seeks access to any further materials submitted to the UPC but not yet visible through the CMS. As supplementary request, applicant also asks for access to documents which are visible in the CMS but which were generated by the Court.

Statement of the Forms of Order sought by the Parties

Applicant seeks access to all written pleadings and evidence submitted by both parties in the Main Action, especially, but not limited to:

- *Corrected Revocation action against EP 3 430 921 - Formal response to the request for amendments - English*
- *Corrected Statement of claim for revocation of EP 3 430 921 - Formal response to the request for amendments - English*
- *Exhibit MWE 1 - Exhibit - English*
- *Exhibit MWE 10 Cohen - Exhibit - -- Other - Translations available*
- *Exhibit MWE 11 Cohen - Exhibit - English*
- *Exhibit MWE 12 Monsees - Exhibit - English*
- *Exhibit MWE 13 Lee - Exhibit - -- Other - Translations available*
- *Exhibit MWE 14 Thompson - Exhibit - English*
- *Exhibit MWE 15 Abehaseera - Exhibit - English*
- *Exhibit MWE 16 Robinson - Exhibit - English*
- *Exhibit MWE 17 Darth Vapor - Exhibit - English*
- *Exhibit MWE 18 Pan - Exhibit - English*
- *Exhibit MWE 19 Cross - Exhibit - English*
- *Exhibit MWE 2 - Exhibit - English*
- *Exhibit MWE 2a - Exhibit - English*
- *Exhibit MWE 3 - Exhibit - English*
- *Exhibit MWE 4 - Exhibit - English*
- *Exhibit MWE 5 - Exhibit - English*
- *Exhibit MWE 6 - Exhibit - English*
- *Exhibit MWE 7 - Exhibit - English*
- *Exhibit MWE 8 - Exhibit - English*
- *Exhibit MWE 9 - Exhibit - English*
- *Exhibit MWE 9a - Exhibit - English*
- *Exhibit MWE 9b - Exhibit - English*
- *Exhibit MWE 9c - Exhibit - English*
- *Exhibit MWE 9d - Exhibit - English*
- *Revocation Action EP 3 430 921 - Pleading - English*

Applicant also seeks access to any further materials submitted to the UPC but not yet visible through the CMS.

Applicant requests the following, court-generated documents:

- *Formal-checks Notification-of-positive-outcome - Formal check outcome - English*
- *Acknowledgement-of-lodging - Acknowledgement – English*
- *EPO-Request-for-case-pending - Request to the EPO relating to a pending proceeding for the purposes of RoP295(a) and RoP298. – English*

In support of these requests (“Main Request”), the Applicant states that

- European Patent EP3430921 is subject to Opposition proceedings at the European Patent Office (EPO). The arguments and evidence presented at the UPC may influence the outcome of proceedings at the EPO.

- Applicant has a justification to understand how the claimant's case, and any defendant response, affects their position in the parallel proceedings at the EPO relating to the same patent. For example, any new evidence brought by the claimant may be admissible in the EPO proceedings, while the positions of the defendant in relation to claim interpretation and/or the extent or prior art disclosure may impact on the understanding the issues under consideration at the EPO.
- As yet, no first instance decision has been reached by the EPO in the pending Opposition Proceeding. It appears therefore that the Main Action has the potential to affect not just the outcome but the scheduling of the Opposition proceedings to which the applicant is a party.
- It would be iniquitous to the principles of natural justice, and to the harmonisation and effectiveness of the European patent system as a whole, to deny parties in EPO Opposition proceedings access to relevant material in parallel UPC revocation actions absent a compelling reason.
- The same reasoning should apply to future documents.

Supplementary Request

As supplementary request, applicant also asks for access to documents which are visible in the CMS but which were generated by the Court. Applicant claims that Rule 262.1(b) also refers to written pleadings and evidence "lodged at the Court" and not only to those "lodged by the court".

Applicant states that

- there is no justification in the Rules of Procedure that Court-generated documents which fall short of the Decisions and Orders of Rule 262.1(a) UPC Rules of Procedure should be restricted in principle from wider circulation. Rather it appears that the provisions of Rules 262.1(a) and 262.1(b) UPC Rules of Procedure were intended to cover the documents of the register exhaustively.
- Applicant claims that either the phrase "lodged at the Court" should be taken to include documents generated by the Court itself, or the Court should use its discretion to make such documents available via a procedure analogous to Rule 262.1(b).

Defendant's Arguments

The defendant objects to the application, primarily based on the following arguments:

- The Supplementary Request solely relates to documents "generated" by the Court. Such documents are addressed by Rule 262.1(a). Both documents lodged at the Court and produced by the Court are addressed in Rule 262.1. Since only the decisions and orders were included in Rule 262.1 (a), there was a clear intention not to give access to the public in regard to other documents generated by the Court.

- The main request is to be rejected since the Applicant fails to provide a reasoned request. Rule 262.1 (b) only relates to written pleadings and evidence that were lodged and recorded and thus not to pleadings and evidence which might be lodged and recorded in the future.
- The Applicant wishes to get access to information which the Applicant already possesses. The patent, the prosecution history and the prior art are known to the Applicant and the Applicant can learn such information from other sources than the pleadings and evidence filed in this case.

Claimant's Arguments

The claimant objects to the Application as far as it concerns future materials that are not on file and not even known yet. Future materials should not be made public "by default". This would be excessively broad and contradicts the wording of Rule 262.1(b). This view is backed by the legislative history of Rule 262.1 RoP.

Grounds for the Order

According to Rule 262.1 (b) RoP,

written pleadings and evidence lodged at the Court and recorded by the Registry shall be available to the public upon reasoned request to the Registry; the decision is taken by the judge-rapporteur after consulting the parties.

The interests of a member of the public of getting access to the written pleadings and evidence as vested in Rule 262.1 (b) RoP must be weighed against the interests mentioned in Art 45 UPCA.

Article 45 UPCA provides as follows:

The proceedings shall be open to the public unless the Court decides to make them confidential, to the extent necessary, in the interest of one of the parties or other affected persons, or in the general interest of justice or public order.

The interaction between these two provisions requires (1) a reasoned request and (2) a balancing of interests.

Reasoned Request

Claimant has submitted a reasoned request.

According to the Court of Appeal in the above-mentioned decision (UPC_CoA_404/2023 APL_584498/2023), a 'reasoned request' in R.262.1(b) RoP

means a request that not only states which written pleadings and evidence the applicant wishes to obtain, but also specifies the purpose of the request and explains why access to the specified documents is necessary for that purpose, thus providing

all the information that is necessary for the judge-rapporteur to make the required balance of interests mentioned in Art. 45 UPCA. (mn. 44)

These requirements are met by Applicant's request. Applicant has stated that it is a party to Opposition proceedings at the European Patent Office with regard to EP3430921. It is evident that arguments and evidence presented at the UPC may influence the outcome of proceedings at the EPO. This is especially the case because as yet, no first instance decision has been reached by the EPO in the pending Opposition Proceeding. The revocation proceedings before the UPC may affect not just the outcome but the scheduling of the Opposition proceedings to which the Applicant is a party.

Balancing of Interests

In UPC_CoA_404/2023 APL_584498/2023 the Court of Appeal has stated that a member of the public who has an interest that written pleadings and evidence are made available usually arises after a decision was rendered (mn 47).

The Court of Appeal further stated that

(...) a member of the public may also have a more specific interest in the written pleadings and evidence of a particular case, where he has a direct interest in the subject-matter of the proceedings, such as the validity of a patent that he is also concerned with as a competitor or licensee, or where a party in that case is accused of infringing a patent by a product which is the same or similar to a product (to be) brought on the market by such member of the public. When a member of the public has such a direct legitimate interest in the subject-matter of certain proceedings, this interest does not only arise after the proceedings have come to an end but may very well be immediately present (mn 53).

Special Interest due to Applicant's Involvement in Opposition Proceedings

In weighing the direct interest of Applicant against the general interest of integrity of proceedings, the balance is in favour of granting access to the written pleadings and evidence of such proceedings to Applicant. He is involved in opposition proceedings which give him a direct interest in the UPC proceedings concerning the validity of the patent.

Immediate Access

Applicant requests and is awarded immediate access. The Court grants immediate access and does not require Applicant to wait until the proceedings are terminated. Applicant has a plausible interest in gaining access to the written pleadings and evidence immediately moment of the issuance of this order. He intends to consider the arguments raised in the ongoing EPO opposition proceedings in comparison with the arguments raised in the Main Action. Parallel opposition proceedings at the EPO operate under a time regime. Applicant's interest in the proceedings hence is also

specific as regards timing. While the interest of the general public usually arises after a decision was rendered (mn 47 of the above cited CoA decision), the Applicant's interest is more specific in that it is present already immediately. Were the access to the file granted only after the decision, the claimant might not be able to use this information in the EPO proceedings due to timing issues.

Balancing of Interests especially in Revocation Actions

The Court notes that Applicant's requests for access to the documents relate to the Main Action as a revocation action. Generally, a revocation action concerns public interest to a higher degree than infringement proceedings. The invalidation of a patent that does not meet the statutory requirements for protection and therefore constitutes an objectively unjustified impediment to competition is in the public interest. The interest of the general public in the destruction of patents that have been wrongly granted allows for the conclusion that arguments exchanged during the revocation proceedings including the discussion of prior art should also be accessible for the public. Applicant's interest to gain access to the requested documents in order to use them in the EPO opposition proceedings is in line with the general interest of justice (Art. 45 UPCA).

Public Files in EPO Proceedings

Further, the EPO files relating to opposition proceedings and also files concerning proceedings before the EPO Boards of Appeal are public. At least in this case, it seems reasonable if the accessibility of documents concerning parallel proceedings before the EPO and before the UPC would be treated similarly. Parallel arguments will most likely be discussed in both proceedings. If there are discrepancies, it is in the public interest that these discrepancies should be considered.

No Confidentiality Requirement

The Court does not see any need for imposing restrictions on granting access to the requested documents. Therefore, the Court does not issue a confidentiality order and also does not order that Applicant is required to keep the written pleadings and evidence he was given access to confidential as long as the proceedings have not come to an end. The parties did not request such order. Further, arguments exchanged in revocation proceedings may serve the public interest according to which unjustified patents should be revoked.

No Access to court-generated Documents

There is no legal basis in the Rules of Procedure stipulating that court-generated documents which cannot be considered to be decisions and orders, written pleadings or evidence should be made public. Both documents submitted to and produced by the Court are addressed in Rule 262.1. From the fact that only the decisions and orders

were included in Rule 262.1 (a), it can be inferred that there was an intention not to give access to the public in regard to other documents generated by the Court. T

No Access to future Documents

The Court does also not see any legal basis for granting access to future documents. Moreover, as the future documents are yet unknown, a balancing of interest as required by R.262.1(b) RoP and Art. 45 UPCA would not be possible and the protection of personal data could not be guaranteed.

No Access to yet invisible Documents

The Court does not see any legal foundation for granting access to documents which are not yet published in the CMS. Additionally, such requests would impose heavy burdens on the registry as the documents would have to be forwarded immediately upon their arrival at the court. It seems reasonable and can be expected from Applicant to wait until the documents have been posted in the CMS.

Order

For these grounds the court orders:

- Applicant is granted access to all written pleadings and evidence submitted by both parties as currently contained in the CMS in action UPC_CFI_316/2023;
- Applicant's request to be granted access to court-generated documents is rejected.
- Applicant's request to be granted access to future materials is rejected;
- Applicant's request to be granted access to any further materials submitted to the UPC but not yet visible through the CMS is rejected;

Issued at 24 April 2024

The Judge-rapporteur
Maximilian Haedicke

Information about appeal:

The present order may be appealed by any party which has been unsuccessful, in whole or in part, in its submissions at the Court of Appeal with the leave of the Court

of First Instance within 15 days of service of the Court of First Instance's decision to that effect (Art. 73(2)(b) UPCA, R. 220.2, 224.1(b) RoP)

ORDER DETAILS

Order no. ORD_587436/2023 in ACTION NUMBER: ACT_571808/2023

UPC number: UPC_CFI_316/2023

Action type: Revocation Action

Related proceeding no. Application No.: 587265/2023

Application Type: APPLICATION_ROP262_1_b