



## Mannheim - local division

**UPC\_CFI\_410/2023**  
**procedural order**  
**of the Court of First Instance of the Unified Patent Court, issued**  
**on: *10/07/2024***

SLIDE

- 1) **MED-EL Electromedical devices  
Gesellschaft m.b.H.**  
(plaintiff and counter-defendant) -  
Fürstenweg 77a - 6020 - Innsbruck - AT

COMPLAINT PAGE

- 1) **Advanced Bionics AG**  
(defendant) - Laubisrütistrasse 28 - 8712  
- Stäfa - CH
- 2) **Advanced Bionics GmbH**  
(defendant and counterclaimant) - Max-  
Eyth Strasse 20 - 70736 - Fellbach-  
Oeffingen - DE
- 3) **Advanced Bionics Sarl**  
(defendant and counterclaimant) - 9 rue  
Maryse Bastié, CS 90606 - 69675 - Bron  
Cedex - FR

## PATENT IN DISPUTE

<i>Patent no.</i>	<i>Owner</i>
<b>EP4074373</b>	MED-EL Elektromedizinische Geräte Gesellschaft m.b.H.

## DECIDING JUDGES

Presiding judge	<b>Peter Tochtermann</b>
judge-rapporteur	<b>Holger Kircher</b>
Legally qualified	<b>Andras Kupecz</b>
Judge	

## PROPERTY

With the present infringement action (ACT\_585052/2023), which was received by the Mannheim local division on 7 November 2023, the plaintiff is claiming infringement of EP 4 074 373 (hereinafter: the patent in suit) against the defendants. In a document dated 22 March 2024, the defendants replied to the infringement action. In addition, the defendants 2 and 3 challenged the patent-in-suit by way of a revocation counterclaim (CC\_15513/2024). In documents dated 24 May 2024, the plaintiff replied to the revocation counterclaim of defendants 2 and 3 and, in the alternative, requested that the patent in suit be amended.

Even before the pendency of the present infringement action - namely on 27 September 2023 - the defendant 1 filed an action for revocation concerning the patent in suit with the Central Chamber in Paris, which was served on the plaintiff on 16 October 2023 (ACT\_576555/2023, UPC\_CFI\_338/2023; hereinafter: central revocation action). The central action for annulment essentially contains the same attacks against the patent as the present action for annulment. The only difference between the two actions is that the nullity counterclaim here additionally asserts the ground for nullity of insufficient disclosure.

In the proceedings before the central chamber, the written procedure was concluded by Order dated 15 May 2024. The oral hearing before the central chamber is scheduled for 29/10/2024. An interim hearing is scheduled to take place on 15 July 2024.

In the present proceedings, the parties were granted a hearing on a possible referral of the action for annulment and the application for amendment by Order of 13 June 2024. Defendants 2 and 3 have objected to the referral in their statement of

24.6.2024 was opposed. In its statement, also submitted on 24 June 2024, the plaintiff did not raise any objections to a referral.

#### JUSTIFICATION OF THE ORDER

##### I.

The presently ordered referral of the revocation counterclaim of the defendants 2 and 3 has its basis in Art. 33 para. 3 lit. b UPCA.

Pursuant to Art. 33(3) UPCA, the local division has various options for further proceedings after an action for revocation has been filed. Which option the local division ultimately chooses is at its own discretion. In principle, the present Board is of the opinion that it is generally appropriate for the local division to also hear and decide on the revocation counterclaim pursuant to Art. 33(3)(a) UPCA. It is thus in agreement with all the Orders of other Boards cited by the defendants 2 and 3 in their statement of 24 June 2024 (page 5 et seq.).

However, the present case has the special feature that almost all of the attacks against the patent in suit contained in the revocation counterclaim have already been asserted in the previously filed central revocation action. In this particular case constellation, the Board exceptionally exercises the discretion granted to it by referring the nullity counterclaim to the central division. The decisive factor for the Chamber is, in particular, the aspect of efficiency in the conduct of the proceedings, which, according to Section 4 of the preamble to the RoP, always carries particular weight when exercising its discretion. In the present case, the aspect of efficiency requires the central division to also decide on the nullity counterclaim, as it is (at least largely) familiar with the subject matter of the nullity counterclaim due to the significantly more advanced central nullity action. In contrast, having two different panels dealing with the same subject matter would be contrary to the principle of procedural economy and would therefore be inefficient.

The objections raised by defendants 2 and 3 against the referral are not valid.

1. It is true that the plaintiff correctly points out the risk of an inconsistent interpretation if different courts have to decide on the infringement of a patent on the one hand and its legal validity on the other. However, this risk exists in the present case irrespective of whether the revocation counterclaim is referred to the central division or not. This is because the division of jurisdiction in the present case already follows from the fact that defendant 1 first brought the central revocation action before the central division in Paris instead of - like defendants 2 and 3 - attacking the patent in suit within the present infringement proceedings by way of a revocation counterclaim. The defendant side - here defendant 1 - thus itself caused the split of jurisdiction. When filing the central nullity action, it was aware that the plaintiff would not be obliged to do so,

to also bring a subsequent infringement action before the central division (Art. 33 para. 5 sentence 1 UPCA). Rather, it has consciously accepted that the plaintiff may - as ultimately happened - decide to bring the infringement action before the local division. Therefore, even if - as the defendants 2 and 3 demand - their nullity action were not referred to the central division, it could not be avoided that in the present case the infringement and the validity of the patent-in-suit would be decided by different adjudicating bodies due to the central nullity action already filed there in advance by the defendant 1.

2. The fact that this will lead to a change in the language of the proceedings - from German to English - does not speak against the referral of the action for annulment. It is true that a change in the language of the proceedings may well involve considerable translation effort in individual cases, which must in principle be taken into account when exercising the court's discretion. In the present case, however, there is the particularity that the subject matter of the action for annulment is largely identical to the subject matter of the central action for annulment. Therefore, the parties have already submitted documents in English to the central division. Therefore, even if the judge-rapporteur at the central chamber were to request translations of the documents previously exchanged at the chamber here from the parties (R. 39.1 and 2 RoP), this would not involve any significant effort for the parties.

3. Finally, contrary to the opinion of the defendants 2 and 3, the fact that the central nullity proceedings before the central division are already "too far advanced" does not preclude the referral. In particular, it is not true that the referral will "at least cut off the Reply of the counterclaimants". The defendants re 2 and 3 wrongly argue that the central division is obliged to immediately join the referred nullity counterclaim with the central nullity action already pending there. However, the RoP does not provide for such an obligation to (immediately) join the action. Rather, the central division can, for example, join the two proceedings at a later date or refrain from joining them altogether. Even in the latter case, a referral of the action for annulment is freely procedurally economical. In the absence of a (formal) joinder, both proceedings - the already pending central nullity action and the referred nullity counterclaim - are then (formally) conducted separately at the central division. However, as both proceedings essentially concern the same subject matter, this does not lead to any significant additional work for the central chamber.

## II.

In addition to the revocation counterclaim of the defendants 2 and 3, the plaintiff's corresponding application for amendment of the patent in suit (R. 30 RoP) must also be referred to the central division. It is true that the referral of the request for amendment is not expressly regulated in Art. 33 para. 3 lit. a UPCA. However, since the request for amendment is in substance a defence of the patent proprietor against the revocation counterclaim, there can be no doubt that it cannot be referred back to the local division if the revocation counterclaim is referred to the central division.

### III.

Pursuant to R. 37.2 RoP, the Order pursuant to Art. 33(3) UPCA may be issued prior to the conclusion of the written procedure. The Board makes use of this authorisation in the present case.

The early referral ensures that the central chamber has the greatest possible room for manoeuvre in the further procedure with regard to the referred nullity counterclaim. Accordingly, the judge-rapporteur of the central chamber stated at the request of the present judge-rapporteur that, in the event of a referral, the central chamber is interested in this being made as early as possible.

Contrary to the opinion of the defendants 2 and 3, there is no reason to wait and see whether the Court of Appeal - unlike the Chamber here - grants the defendants' application based on R. 340 RoP to refer the entire legal dispute to the Central Chamber. The Order to be made in this respect by the Court of Appeal on the basis of the oral hearing on 17 July 2024 is in no way prejudicial to the Order under Article 33(3) UPCA at issue here. On the contrary: Should the Court of Appeal actually refer the entire legal dispute to the central division in accordance with the defendant's application, the (mere) referral of the nullity counterclaim and the request for amendment ordered here would even partially pre-empt the Order of the Court of Appeal - namely with regard to the nullity counterclaim and the request for amendment.

#### ORDER

1. The action for revocation brought by the defendants 2 and 3 and the applicant's application to amend the patent in suit are referred to the Central Division - Paris.
2. The appeal is not authorised.

ORDER DETAILS

Order No. ORD\_35569/2024 in PROCEDURE NUMBER: ACT\_585052/2023

UPC number: UPC\_CFI\_410/2023

Nature of the action: Action for infringement

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Peter Tochtermann Presiding  
judge

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Holger Kircher judge-  
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