Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Milan - Central Division –
First Instance - central division

UPC_CFI_380/2024

Procedural Order in a Review proceeding

of the Court of First Instance of the Unified Patent Court

delivered on 24/09/2024.

APPLICANT/S in the REVIEW proceedings

1) **EOFLOW Co., Ltd.** 302Ho, HUMAX VILLAGE, 216 - 13595 - Hwangsaeul-ro, Bundang-gu, Seongnam-si, Gyeonggi-do - KR

Represented by Ronald Mirko Weinert

RESPONDENT/S in the REVIEW proceedings

2) **INSULET Corporation** (Main proceeding party - Applicant) - 100 Nagog Park - MA 01720 - Acton - USA

Represented by Dr. Marc Grunwald

PATENT AT ISSUE

Patent no. EP4201327 – owned by Insulet Corporation

LANGUAGE OF PROCEEDINGS: English

DECIDING JUDGE
Composition of the panel:

- Andrea Postiglione — presiding judge/JR
- Anna- Lena Klein — LQ judge
- Uwe Schwengelbeck — TQ Judge

ORDER

1. By application lodged on 3 July 2024, INSULET CORPORATION Co. Ltd (INSULET in the following), pursuant to Art. 33.2 b) UPCA applied before this Central Division for an *ex parte* preliminary injunction against EOFLOW CO Ltd (EOFLOW in the suite), a company with its registered office in Korea.
2. Applicant is the owner of EP 4201327C0, granted on June 19. 2024 as divisional patent of WO2013149186AI dated March 29. 2013, covering "*fluid delivery device with transcutaneous access tool insertion mechanism and blood glucose monitoring for use therewith*" for monitoring insulin levels in diabetic patients and transcutaneous administering drugs in a manner appropriate to the patient's needs.
3. The applicant submitted that EOFLOW embodiment “GLUCOMEN DAY PUMP” was infringing its patent, both in the main and in the dependent claims.
4. In a preliminary defence, EOFLOW opposed the adversary’s request and filed on 26 August 2024 an application for a connection joinder pursuant to Art. 340 RoP, asking the Court that this case be heard together with a parallel case filed by INSULET, in the meantime, before the UPC MILAN Local Division against the Italian distributor of the embodiment, the company MENARINI s.p.a. (Nr. UPC_CFI_400/24).
5. EOFLOW underlined the need to coordinate his defence with the distributor and the inadequacy of time available for its defence, since the panel had already set an oral hearing at the beginning of September.
6. On 28 August 2024, the judge rapporteur urged INSULET to submit his opinion pursuant to Article 340.1 RoP (INSULET opposed the request) and, after consulting with MILAN LD Presiding Judge, rejected the request with Order dated 4 September 2024 postponing the oral hearing to October 2024 in parallel with the hearing in front of Milan LD.
7. The judge rapporteur considered that the parallel handling of the two cases, alongside with the appointment of two judges in both proceedings, were sufficient measures to prevent the issuance of contradictory decisions. He also considered no longer relevant the question of infringement of the principle of the “statutory judge”, stating that, if rule 340 provides for the possibility of connection joinder between two proceedings, also if they are pending in front of different panels (see 340.1 (a) RoP), the principle of the statutory judge might well be set aside – in specific conditions - by the principles of procedural efficiency and celerity, which are of equal importance.

8. On 6 September 2024 pursuant to Art. 333 RoP, EOFLOW made a request for judicial review of the Order of 4th September 2024 based on two grounds:

   (a) lack of competence of the Presiding Judge to decide about the connection joinder it his capacity as judge rapporteur– RoP 340.1;

   (b) the risk of divergent decisions was not set aside by the appointment of the same two judges to the panels.

9. Parties have been heard also on this review proceedings; INSULET observed that:
   - the counterpart had no detriment in the separate proceedings since the case was pending before the competent court pursuant to Art. 33.2 b) UPCA;
   - A joinder between the two proceedings would result into a breach of art. 33 UPCA in the light of the Statement of the CoA in the Order dated September 5, 2024 in UPC_CoA_106/2024, where the CoA wrote that "*a joinder pursuant to R. 340 RoP cannot result in the referral of an action to another division beyond the possibilities provided for referral of actions in Art. 33 UPCA*";
   - a connection joinder would result also in the violation of the principle of the statutory judge, considering that the UPCA allows the claimant to bring infringement action before different Divisions.
   - Art. 340.1 RoP should rather be interpreted as focusing on the word "agreement", meaning that no consolidation can be reached if there is no agreement among all judges involved in cases.
   - Art. 340 RoP would not explicitly provide for an order issued by a panel as stated in other Rules of procedure.

10. Since several issues have been raised, the panel will proceed in logical order.

11. As to the procedural aspect (the decision taken by the judge rapporteur/presiding judge), the issue appears to be surpassed by the referral of the review to the panel (except for what will be observed at the end of this order).

12. On the merits, INSULET initiated a patent infringement proceeding against a company based outside the perimeter of the contracting member states; the proceeding was filed before a Central Division in accordance with Art. 33.1 b) - third paragraph - of the UPCA; he then brought an infringement action before the Local Division Milan under Art. 33.1(b) - first paragraph - UPCA against the Italian distributor of the allegedly infringing embodiment and, by doing so, it exercised a power conferred by the UPC Agreement.

13. Undoubtedly related proceedings consolidation brings to an effective management of cases and promotes consistency of decisions, even though even in consolidated cases the respective claims and defences of the parties remain separated and are bundled together only for the purpose of the hearing or of the evidence collected. It is highly doubtful, however, that a consolidation at this stage of the proceedings would correspond to the principle of proportionality that inspires the UPC Rules of procedure.
14. The UPC Agreement provides for a mandatory consolidation only in cases where the same actions (relating to the same patent) involving the same parties are brought before different divisions (*i.e. see art 33.4 and art. 33.2 paragraphs 1 and 3 UPCA)*; in all other cases, it leaves the courts free to join proceedings at the outcome of a broadly discretionary appreciation, and under condition that the disputes concern the same patent and the proper administration of justice is respected.
15. In so doing, the courts exercise a procedural power that is also expressed for the division or consolidation of cases pending before the same court in Art. 302 RoP and which only serves the interests of justice. That power must be exercised in accordance with the principles of flexibility and proportionality, i.e. in view of the practical result which the party aims to.
16. This is because such orders only correspond to a need for "effective case management" and do not affect the guarantees of a fair trial. Proof of this is the fact that consolidation can also take place *ex officio*.
17. In this very case, the applicant requested the joinder of the two proceedings based on two assumptions (both taken into account by the JR): that a narrower time limit for defence had been given in this proceeding (than in the parallel case) and on the basis of the harm deriving from divergent decisions.
18. As to the harm deriving from divergent decisions, stressing once again that this risk is minimal due to the presence of the same two judges in the two panels before respectively the LD and the CD Milan, this Court observes that the outcome of a proceedings is always matter-of-factly closely linked to the proof which is presented before the Courts.
19. The appellant portrays the divergent outcome of the judgments as fatally linked to different panel composition. On the contrary, the consistency of a complete legal system, such as that of the UPC, is measured precisely by its ability to avoid such risks

even by means of different tools such as the presence of the same judges in the different panels.

20. The risk of inconsistency cannot be eliminated. In a preliminary Injunction case, similarly as in a proceedings on the merit, the outcome is always bound to the proof, or more precisely, to the "*degree of certainty*" (RoP 211.2) of the evidence presented by the applicant as well as to an assessment of the "*potential harm for either of the parties resulting from the granting or the refusal of the injunction*" (RoP 211.3), which may be different, being different the two parties involved in the proceedings and the evidence lodged; on the other hand, it must be also necessarily considered that an unconditional use of the joinder of cases could also be misused to make up for omissions in one of the proceedings.
21. Furthermore, the applicant has linked the request for joinder to the impossibility of coordinating his defence strategy with that of MENARINI (points 40 ff. of the request), a matter which the Judge-Rapporteur remedied by ordering the case to be heard in parallel with the case pending before the Local Division Milan.
22. Additionally, it seems there is no such thing in the preliminary proceedings as a *res judicata*, considered that preliminary orders may always be revoked at a later stage (RoP 213) with an order that also gives full compensation for any injury caused by those measures.
23. In conclusion, outside the perimeter of the mandatory consolidation of cases as governed by Article 33 UPCA, there is no room for the party to obtain a joinder, even throughout the intervention of third parties in the parallel proceedings, if the court does not consider it appropriate or has adopted other solutions.
24. If, on the other hand, and more likely, the issue on which diverging decisions are feared is that on patent validity/invalidity, also in this case there is no risk of irreparably inconsistent/harmful decisions; here again, it should be recalled what was stated above about the *interim* nature of these decisions.
25. Before both divisions, in fact, the applicant applied for a preliminary injunction on the basis of patent infringement, whereas the respondent objected patent invalidity.
26. Neither judgment in both proceedings can end – obviously - with a declaration of patent validity but only with a provisional statement subject to further examination on the merits (RoP 198.1).

27. Nor would a rejection of the Preliminary injunction speak one-way for the invalidity of the patent, and a preliminary invalidity assessment would remain a fact limited to the purpose of the issuance of the PI; likewise, a successful PI – as said - would not shield patent from possible future actions for revocation.
28. To summarize, the concerns raised in the request for consolidations appear to be subsided by the actions already undertaken by the judge rapporteur.
29. A final remark must be made on the procedural violation complained of by the applicant, seeming this occasion opportune to undertake an interpretation of Article 340 RoP, which is, in his wording, somehow unclear.
30. Article 340 RoP must be read from a functional perspective: the request for connection joinder gives rise to an *interim* phase where a necessary dialogue between the two Courts involved in the joining proceedings occurs.
31. Now, the issue raised by the applicant concerns whether the dismissal of such a request could be issued by the judge-rapporteur or should be made by the panel.
32. This Panel is of the opinion that Article 340 RoP provides for a contact between the Courts where only this fact, in case of rejection, should be mentioned in the order, being not necessary that the order explain the merits of the reasons underlying the decision to treat the case separately, bearing in mind (see above) that the procedure pursuant to art. 340 RoP is a sheer procedural one and must be performed also in "*the interests of the proper administration of justice*".
33. Furthermore, the RoPs evidently also seem to aim to avoid opinions, impressions and discussions between judges, even more if of different panels, being manifested and/or finding their way in a parallel proceeding, so as not to impair the impartiality of the Courts and in compliance with the principle of the "integrity of the Courts", which requires that the decision can only take place within the judges designated for that purpose and in the absence of external influence (Art. 344 and ff. RoP).
34. The only task that the RoPs impose on the judge-rapporteur is to inform the parallel panel of a request for consolidation and to examine the chances of success.
35. The flexibility to which the courts are bound does not extend to the issuance of a reasoned rejection order and is limited to "*the required level of discretion for the judges to organise the proceedings in the most efficient and cost-effective manner*" (RoP

preamble point 4) and this reasoning also seems to explain the mention of "panels" in the rule provision 340.

36. If the consolidation is to be upheld, different considerations about the nature of the order could be made.
37. One of proceedings to-be-joined (if not more than one) is, in fact, bound to be heard by new judges, in a new location, and also possibly with new parties involved (since, such in the present case, in parallel proceedings there could also be present other defendants/claimants/applicants).
38. The order of the panel(s), in this case, aims to coordinate the way in which the consolidation process has to be managed, giving guidelines to the Registrar and preserving the activity carried out so far by one or two of the panels.
39. It is, therefore, rational that such a decision cannot be taken by the judge-rapporteur alone because it also affects a different proceeding.
40. A consolidation decision in favour of one of the two (or multiple) panels (Art. 33 UPCA shall be respected) terminates de facto one of the two (or multiple) proceedings, a termination which seems to be feasible only by way of a panel order (see also RoP 361 and 362 in the case of termination of proceedings by way of order, in these cases panel decision are required).
41. This also entails that, if the presiding judges opt consider a joinder feasible, a right to be heard has to be guaranteed in the parallel proceedings as well as in the proceedings in which the joinder is required.
42. To encapsulate, where, such in this case, the order does not affect the two proceedings, and requires a simple consultation, it is opinion of the panel that it might also be rendered by the judge rapporteur; this pursuant to Art. 1.2 Rop which reads: "*Where these Rules provide for the Court to perform any act other than an act exclusively reserved for a panel of the Court, the President of the Court of First Instance or the President of the Court of Appeal, that act may be performed by: (a) the presiding judge or the judge-rapporteur of the panel to which the action has been assigned; (b) a single legally qualified judge where the action has been assigned to a single judge; (c) the standing judge designated pursuant to Rule 345.5*".

ORDER

FOR THESE REASONS

The Judge-Rapporteur's order of 04/09/2024 (App_48857/2024) is approved by the bench.

Appeal is allowed.

In Milan, 24 September 2024

The Presiding Judge – Judge rapporteur

Andrea Postiglione

ANDREA POSTIGLIONE

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The LQJ

Anna-Lena Klein

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The TQJ

Uwe Schwengelbeck

Uwe Schwengelbeck

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ORDER DETAILS

UPC number: UPC_CFI_380/2024

Related proceeding no. Application No.: 50666/2024

Application Type: Review

R 333 INFORMATION CONCERNING APPEAL The present order may be either - appealed against by any party which has been unsuccessful, in whole or in part, in its submissions, together with the appeal against the final decision of the Court of First Instance in the main action, or - after leave to appeal has been granted by the Court of First Instance within 15 days of the date of notification of the relevant decision (Art. 73(2)(b) UPCA, R. 220.2, 224.1(b) Rules of Procedure).