



Munich local division
UPC_CFI_114/2024
UPC_CFI_448/2024

procedural order
of the Court of First Instance of the Unified Patent Court local division
Munich
issued on 25 September 2024

PLAINTIFFS

- 1) Heraeus Electronics GmbH & Co. KG**
- 2) Heraeus Precious Metals GmbH & Co. KG**(Defendant) represented

by: Paul Szynka (CBH)

DEFENDANT AND OPPOSING PARTY

Vibrantz GmbH

represented by: Christian Paul (Jones Day)

PATENT IN SUIT

European Patent No. 3 215 288

DECISION-MAKING BODY/CHAMBER

Panel 1 of the Munich local division

PARTICIPATING JUDGES

This Order was issued by presiding judge Dr Matthias Zigann as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS

German

OBJECT

Action for infringement - R 361, 363 RoP

PROPERTY

The defendant filed a counterclaim for revocation of the patent in suit (CC_43919/2024 UPC_CFI_448/2024) against Heraeus Precious Metals GmbH & Co. KG on the grounds that at the time the revocation counterclaim was filed, the latter was entered in the register as the patent proprietor and was therefore to be regarded as the correct defendant in the revocation counterclaim for formal reasons pursuant to Rules 25.1, 42.2 and 8.6 RoP.

For the sake of simplicity, this company is referred to in the headline as plaintiff 2). The action was brought solely by plaintiff 1).

APPLICATIONS BY THE PARTIES

The applicant under 2) applies within an objection workflow:

- 1. Pursuant to R. 9.1 RoP, we request that the court grant the parties a fair hearing on their right to be heard pursuant to R. 361 RoP and suggest that the counterclaim be dismissed as manifestly futile pursuant to R. 361, 363 RoP.*
- 2. As a precautionary measure, we raise an objection pursuant to R. 48, 19.1 (b) RoP, contesting the jurisdiction of the Munich local division and request that the counterclaim be dismissed as inadmissible.*

The defendant claims:

The defendants' applications pursuant to Rules 9.1, 361, 363, 48, 19.1 of 27 August 2024 are dismissed.

PRESENTATION BY THE PARTIES

The plaintiff is of the opinion that the counterclaim should have been directed against the substantive patent proprietor, plaintiff 1). Thus, the counterclaim for revocation is either manifestly futile, i.e. inadmissible, or without legal basis (R 361, 363 RoP). The reference to Rule 42 RoP in Rule 25.1 RoP was not to be understood to mean that the revocation counterclaim could be directed against the patentee who was not substantively entitled but registered. It was undisputed between the parties that only the plaintiff 1) was the substantively authorised patent proprietor.

The defendant is of the opinion that the reference to Rule 42 RoP in Rule 25.1 RoP does indeed permit, if not require, a counterclaim for revocation to be brought against the registered patent proprietor. It is undisputed that applicant 2) is still registered.

REASONS

The applications of the applicant under 2) must be rejected.

According to Rule 25.1 RoP, the action for revocation of a patent must be brought against the proprietor of the patent in accordance with Rule 42 RoP. According to Rule 42 RoP, the action for revocation of a patent shall be directed against the proprietor of the patent. If the

If an action for cancellation is brought against the holder under Rule 8.6 ("the registered holder") but the registered holder is not the holder within the meaning of Rule 8.5(a) or (b) ("Rule 8.5 holder"), each such holder shall, as soon as practicable after service of the action for cancellation, apply to the Court under Rule 305.1(c) for the replacement of the registered holder by the Rule 8.5 holder.

Consequently, the action for revocation may be brought against the Rule 8.6 proprietor, i.e. the registered proprietor, as well as against the Rule 8.5(a) or (b) proprietor, the substantive proprietor. In the event of dissolution, the registered proprietor who is not also the substantive proprietor must file an application under Rule 305.1(c) RoP as soon as possible.

According to this provision, the court can order a person to replace another party on the application of a party.

The purpose of this provision is to release the infringing defendant from examining the substantive entitlement to the patent in suit for the purposes of bringing a revocation counterclaim. Insofar as the counterclaim for cancellation is directed against the registered proprietor, the

A counterclaim for annulment is always filed against the correct counter-defendant. Alternatively, the counterclaim for annulment can also be filed against the materially authorised party.

The requirements for action under Rules 361, 363 RoP are therefore not met.

A decision on costs is currently not necessary because the plaintiff 2) currently remains in the proceedings as the correct defendant. There is currently no application pursuant to Rule 305.1 (C) RoP.

ORDER

The applications of the second applicant are dismissed.

INFORMATION ON A REVIEW BY THE ADJUDICATING BODY

Either party may request that this Order be referred to the adjudicating body in accordance with R. 333 RoP. The Order remains effective until it has been reviewed (R. 102.2 RoP)

ORDER DETAILS

Order No. ORD_53396/2024 in PROCEDURE NUMBER: ACT_13227/2024

UPC number: UPC_CFI_448/2024

Type of case: Action for infringement / action for cancellation

No. of the related proceedings Application No.: 48805/2024

Type of application: Objection

Matthias ZIGANN

Digitally signed by Matthias
ZIGANN
Date: 2024.09.25 17:03:42
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Dr Zigann
Presiding judge and judge-rapporteur