



Hamburg - local division

UPC_CFI_22/2023
Order
of the Court of First Instance of the Unified Patent Court,
issued on 20 December 2024

Guiding principles:

According to Rule 30.2 RoP, further applications to amend the patent are only admitted with the permission of the court. Admission is ruled out if there are approximately three months between the alleged reason for the amendment and the filing of the application. The point of view of the patent proprietor is not relevant when assessing the question of a possible delay in the proceedings.

Keywords:

Further application for amendment of the patent; Rule 30.2 RoP; delay

PARTIES TO THE DISPUTE

- 1) **10x Genomics, Inc.** Represented by Prof. Dr Tilmann Müller-Stoy
(applicant for 1)) - 6230 Stoneridge Mall
Road, 94588-3260 Pleasanton, CA, USA
- 2) **President and Fellows of Harvard College,** Represented by Prof. Dr Tilmann Müller-Stoy
(applicant for 2)) - Richard A. and Susan F. Smith
Campus Centre, Suite 727E, 1350 Massachusetts
Avenue, Cambridge, Massachusetts 02138, USA
- 3) **Vizgen, Inc,** Represented by Jérôme Kommer
(defendant) - 61 Moulton Street, 02138
Cambridge, USA

PATENT IN SUIT:

Patent number	Owner
EP4108782	President and Fellows of Harvard College

COMPOSITION OF THE PANEL:

Presiding judge	
and rapporteur	Sabine Klepsch
legally qualified judge	Dr Stefan Schilling
legally qualified judge	Margot Kokke
technically qualified judge	Dr Arwed Burrichter

The Order was issued by the full Court. LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT OF THE PROCEEDINGS:

Patent infringement

Here: Application under Rule 333.1 RoP for review of the Rapporteur's Order of 8 November 2024 (ORD_60341/2024) (hereinafter: Order) APPLICATIONS

OF THE PARTIES:

By document dated 26 November 2024, the plaintiff re 2) applied for an order:

- A. The procedural order (ORD_60341/2024) of the Judge-Rapporteur of 8 November 2024 in proceedings UPC_CFI_22/2023, ACT_460565/2023 will be reviewed by the panel.
- B. The third application for amendment of the patent dated 25 October 2024, filed in workflow 58507/2024, is allowed.
- Ba. In the alternative: Auxiliary requests 1 and 2, with the third application for amendment of the patent dated 25 October 2024 in workflow 58507/2024, are admitted into the proceedings.
- Bb. Further in the alternative: The appeal is allowed.

The defendant claims:

Dismiss applications B to Bb. of the applicant re 2).

FACTS OF THE CASE:

In a document dated 25 October 2024, the second plaintiff filed a third application to amend the patent in suit. The background is explained: Plaintiff 2) filed an application to amend the patent ("1AÄP") within the time limit pursuant to Rule 29.a RoP on 14 March 2024 and submitted auxiliary requests 1-30 (AR1 to AR30; Annexes BP 27- AR1-AR30). Against the background of the parallel opposition proceedings pending before the European Patent Office ("EPO"), the applicant 2) filed a second application for amendment of the patent (Rule 30.2 RoP) on 25 July 2024, with which a further 23 auxiliary requests were submitted ("2AÄP"). The preliminary opinion of the Opposition Division of the EPO was issued on 2 August 2024. In view of this, the applicant re 2) now filed the third application for amendment of the patent (Rule 30.2 RoP), with which, in addition to the 53 already known, a further 2 auxiliary requests were submitted.

Based on the auxiliary requests relating to the patent in suit, the applicants would submit alternative requests for relief. These were submitted as an application pursuant to Rule 9 RoP with the number 58510/2024 for the main proceedings (ACT_460565/2023).

The defendant submitted a statement on the admissibility of the application to amend the patent in suit in a document dated 4 November 2024 in the aforementioned workflow 58510/2024. It is of the opinion that a corresponding amendment could have been made at an earlier date. The preliminary view of the Opposition Division does not require any correspondingly amended auxiliary requests.

By Order of 8 November 2024 - ORD_60341/2024 - the rapporteur rejected the third application to amend the patent in suit.

The main reason given was that the application was inadmissible and could not be admitted. This was because the new version of the amendment could have been made at an earlier stage in response to the preliminary opinion of the Opposition Division. In view of the preliminary opinion of the Opposition Division and the possible outcome of the opposition proceedings, the second plaintiff was not left without rights. If the patent-in-suit were to be upheld in a legally binding and restricted manner in other validity proceedings before the conclusion of the present proceedings, this could be taken into account in the present proceedings, just as a legally binding complete cancellation would have to be taken into account, because such a decision would then take effect erga omnes.

The plaintiff re 2) contests this with its application of 26 November 2024 for a review by the panel.

It is of the opinion that the two aspects cited by the rapporteur as grounds would not justify a rejection. The third application for amendment of the patent in suit could not have been filed at an earlier date. The correct standard for assessing the timeliness of the filing of an application to amend the patent pursuant to Rule 30.2 RoP must be whether the patent proprietor could reasonably expect that the filing of the application would not cause a delay in the legal proceedings. In the present case, the second plaintiff could expect that, even if the time limit provided for by the Rules of Procedure for a defence to an action for revocation were fully transferred to the further application for amendment of the patent, the last document on this subject would be available to the local division after four months, i.e. by the end of February 2025 and thus at least several weeks before the oral proceedings. The reference that a legally restricted version of the patent in suit would be taken into account before the UPC Agreement is also not convincing, as it is not clear whether an application to amend the patent in suit will be admitted in the appeal instance.

The defendant, on the other hand, takes the view that the assessment of the timeliness of an application under Rule 30.2 RoP does not depend on the expectations of the patent proprietor. It is not relevant whether the patent proprietor could expect that the filing of the request not cause a delay in the legal dispute. The second plaintiff thus fails to recognise the importance of the front-loaded system in proceedings before the UPC Agreement, in particular with regard to Rule 30 RoP, which provides for a clear rule-exception relationship. According to Rule 30.1 RoP, the patent proprietor's application to amend the patent could be included in the defence to the counterclaim. At this stage of the proceedings, the patent proprietor already knows the essential lines of attack from the counterclaim for revocation, on the basis of which he is authorised to file corresponding amendments. A reaction to all attacks on the legal validity already contained in the revocation counterclaim in the form of an application to amend the patent must therefore in principle already be made with the defence to the revocation counterclaim and cover it comprehensively.

Exceptionally, Rule 30.2 RoP provides for the admission of later applications to amend the patent with the permission of the court. In order for the exception to apply, such later applications must be particularly justified. Whether the patent proprietor subjectively assumed that the proceedings would be delayed or not could not play a role in this respect, even if a

objective potential for delay of such a later application must be included in the assessment. The decisive factor was whether a change had occurred since the action for annulment to which the second plaintiff had to react exceptionally and whether it had done so in good time without delaying the proceedings.

The legal position of the second plaintiff was also sufficiently secured. A limitation of the patent in suit by the EPO had to be taken into account by the Court of Appeal due to the effect of this decision erga omnes, which follows from Art. 105b (3) EPC. Moreover, the legal opinion of the plaintiff re 2) leads to the fact that in parallel validity proceedings, the admission of further auxiliary requests could always be enforced as soon as new auxiliary requests are filed in these other validity proceedings. Thus, the patent proprietor would be able to determine the subject matter of the proceedings before the Unified Patent Court at any time, irrespective of the provisions of the Rules of Procedure and irrespective of the fate of such auxiliary requests in the parallel proceedings, by merely filing even auxiliary requests that may be inadmissible in the parallel proceedings.

In a document dated 26 November 2024, the plaintiff re 2) filed an application for review pursuant to Rule 333.1 RoP (App_62866/2024). The defendant commented on this in a document dated 4 December 2024.

REASONS:

The request for review is admissible but unfounded. The PANEL expressly agrees with the view expressed by the rapporteur that the third application to amend the patent in suit is inadmissible.

1. The application is admissible.

The application of 26 November 2024, after the time limit was retroactively extended by one day because the application was originally filed in English, was filed and the fee paid within the time limit under Rule 333.2 RoP. The defendant had an opportunity to comment under Rule 333.2, which it did. The Rapporteur's Order on the admissibility of an application for amendment of the patent in written procedure is an Order falling within the scope of Rule 333.1 RoP. According to Rule 333.1 PANEL, all case management decisions or orders made by the judge-rapporteur or the presiding judge (English version: "Case management decisions or orders made by the judge-rapporteur or the presiding judge"; French version: "Les décisions ou ordonnances relatives au traitement des affaires rendues par le juge-rapporteur ou le président") are reviewable by the panel upon reasoned application. The Order rejecting the application to amend the patent in accordance with Rule 30 RoP organises the course of the proceedings and is therefore procedural.

2. The application is unfounded.

The PANEL maintains the view expressed by the rapporteur that an authorisation out of the question, as the amended version had already been published at an earlier point in time.

reaction to the preliminary opinion of the Opposition Division should have been made. The assessment of the timeliness of an application under Rule 30.2 RoP does not depend on the expectations of the patent proprietor, as the defendant rightly pointed out. It is not decisive whether the patent proprietor could expect that the filing of the request would not cause a delay in the legal proceedings. This is because Rule 30 RoP sets out a clear rule-exception relationship. Thus, according to Rule 30.1 RoP, the patent proprietor's application to amend the patent may be included in the defence to the counterclaim. This is because, at this stage of the proceedings, the patent proprietor is aware of the main defences in the counterclaim for revocation. In this respect, he is already in a position to file corresponding amendments at this stage. A response to all attacks on the legal validity already contained in the revocation counterclaim in the form of an application to amend the patent must therefore generally already be made with the defence to the revocation counterclaim. Only in exceptional cases can a later application to amend the patent be admitted by the court in accordance with Rule 30.2 RoP. This is a strict preclusion provision. The question of whether a new amendment is permitted must take into account whether the new amendment would have been necessary at an earlier point in time in response to the arguments already submitted by the invalidity plaintiff and whether the late request for amendment causes delays in the proceedings. However, the assessment does not depend on the patent proprietor's point of view; rather, the question must be assessed objectively.

On this basis, admission is out of the question. This is because the new version of the amendment could have been made at an earlier stage in response to the preliminary view of the Opposition Division. Irrespective of whether the defendant's view is correct that the plaintiff 2) could have filed the two additional auxiliary requests of the third amendment request with the first amendment request due to the defendant's attacks on the legal validity, it is still not comprehensible for what reason the application was filed at the end of October 2024, although the EPO's preliminary opinion was issued on 2 August 2024.

The appeal must be allowed because the questions concerning the admissibility of subsequent applications to amend the patent under Rule 30.2 RoP have not yet been uniformly decided and are of significance beyond the individual case.

ORDER:

- I. The Rapporteur's Order of 8 November 2024 is confirmed.
- II. The applications B. and Ba. of the applicant re 2) are rejected.
- III. The appeal is authorised.

DETAILS:

Order No. ORD_62955/2024 in ACTION NUMBER: ACT_460565/2023
UPC number: UPC_CFI_22/2023
Action type: Infringement Action
Application No.: 62866/2024
Application Type: APPLICATION_ROP_333

<p>Sabine Klepsch Presiding judge and rapporteur</p>	<p>Digital signed by Sabine Maria Klepsch Date: 2024.12.18 15:56:42 +01'00'</p>
<p>Dr Stefan Schilling legally qualified judge</p>	<p>Stefan Schilling Digitally signed from Stefan Schilling Date: 2024.12.19 11:33:02 +01'00'</p>
<p>Margot Kokke legally qualified judge</p>	<p>Margot Elsa KOKKE Digitally signed by Margot Elsa KOKKE Date: 2024.12.19 09:47:27 +01'00'</p>
<p>Dr Arwed Burrichter technically qualified judge</p>	<p>Arwed Andreas Burrichter Digitally signed by Arwed Andreas Burrichter Date: 2024.12.19 04:50:20 +01'00'</p>

INFORMATION ABOUT THE APPOINTMENT

An appeal against the present Order may be lodged either by any party who has been unsuccessful in whole or in part in its applications, together with the appeal against the final decision of the Court of First Instance on the merits, or - with reference to the consent given for this purpose in these Orders - by any party who has been unsuccessful in whole or in part in its applications, within 15 days of service of the relevant decision (Art. 73(2)(b) UPCA, R. 220.2, 224.1(b) RoP).

Carolin
Bauch
Digitally signed by
Carolin Bauch
Date: 2024.12.19
12:03:08 +01'00'