

**UPC\_CFI\_740/2024**  
**ACT\_63258/2024**

## **Decision**

**of the Court of First Instance of the Unified Patent Court  
issued on 5 February 2025**

### **Headnotes:**

1. A Preliminary objection can also be raised with regard to a counterclaim for revocation.
2. Art. 33 (2) UPCA must be interpreted in such a way that this provision is not only applicable if an action between the same parties on the same patent is brought before *several different* divisions, but equally if an action between the same parties on the same patent is brought *twice before the same division* (argumentum a fortiori).
3. In the event of a decision of the judge-rapporteur allowing the Preliminary objection concerning a counterclaim for revocation there is no legal basis for a separate decision on the costs relating to this objection.

**Claimants**

Telefonaktienbolaget LM Ericsson  
Ericsson GmbH

represented by: Christof Augenstein  
represented by: Christof Augenstein

**Defendant**

Motorola Mobility LLC

represented by: Klaus Haft

**Language of the proceedings:**

English

**Patent at issue:**

EP 3 780 758

**Panel:**

Panel 1 of the Local Division Munich

**Deciding Judge:**

This order has been issued by the Judge-rapporteur Tobias Pichlmaier

**Points at issue:**

Preliminary objection against counterclaim for revocation

## **Summary of facts and party requests**

On 30 January 2024, Defendant (of the Counterclaim for revocation) filed a first action against Claimants (of the Counterclaim for revocation) for the infringement of the patent in suit under file no. ACT\_5324/2024 (UPC\_CFI\_41/2024; “First Action”). This action is limited to information, accounting, and damages.

On 6 May 2024, Defendant requested leave to amend this first action by adding requests for injunctive relief, recall and destruction.

On 5 June 2024, Claimants filed a Statement of Defence in response to the infringement action under file no. ACT\_5342/2024 (UPC\_CFI\_41/2024) and a first counterclaim for revocation of the patent in suit under file no. CC\_33544/2024, UPC\_CFI\_41/2024 (“First Counterclaim”).

On 12 June 2024, Claimants also filed a notice of opposition against the patent in suit with the European Patent Office.

On 6 August 2024, the Court rejected Defendant’s request for leave to amend its action.

On 16 August 2024, Defendant therefore filed a second action against Claimants for the infringement of the patent in suit under file no ACT\_47298/2024 (UPC\_CFI\_488/2024; “Second Action”) with requests for injunctive relief, recall and destruction.

On 3 December 2024, Claimants filed a second counterclaim for revocation of the patent in suit in the present proceedings under file CC\_63258/2024 (UPC\_CFI\_740/2024; “Second Counterclaim”) which was served on Defendant on 5 December 2024.

Defendant is of the opinion that the Court, in particular the Local Division Munich, does not have jurisdiction for the Second Counterclaim because the same subject matter, i.e. the validity of the patent in suit, is already subject to the prior proceedings between the Claimant and Defendants in the same court (*lis pendens*).

Defendant therefore with his Preliminary objection requests to

1. dismiss Claimants' counterclaim for revocation under file no. CC\_63258/2024, UPC\_CFI\_740/2024 as inadmissible.
2. order Claimants to bear the costs of the counterclaim for revocation.

Claimants request to

1. reject the preliminary objection.
2. order the defendant to bear the costs of the preliminary objection.

Claimants argue that the Agreement on a Unified Patent Court and the Rules of Procedure do not provide for the possibility of a Preliminary objection against a counterclaim for revocation; a Preliminary objection according to Rule 19 RoP in the view of Claimants only addresses infringement actions.

Claimants have stated the following: The use of the terms "Statement of claim" and "defendant" makes it unambiguously clear that the provision only and exclusively applies for the defendant in the infringement action. The section related to the Counterclaim for Revocation (Rules 25-30 RoP) does not contain any referral to Rule 19 RoP.

## Grounds

1. A Preliminary objection can also be raised with regard to a counterclaim for revocation.

Rule 19 RoP (“Preliminary objection”) states that the defendant may lodge a Preliminary objection within one month of service of the Statement of claim. The subject of such an objection is

- (a) the jurisdiction and competence of the Court,
- (b) the competence of the division indicated by the claimant.

Equally, a revocation action can be subject of a Preliminary objection for this reasons (Rule 48 RoP).

The Claimants are right in that Rule 19 RoP addresses infringement actions. However, the section concerning infringement actions also contains the provisions for a counterclaim for revocation. There is no apparent and substantive reason to deny the possibility of a Preliminary objection according to Rule 19 RoP to someone defending against a counterclaim for revocation. The Rules of Procedure in Rule 48 clearly state that also in the case of a counterclaim for revocation a lack of competence for the reasons stated in Rule 19 may exist. On this basis, however, the defendant must be able to assert this lack of competence procedurally in the same way as the defendant of an infringement action. This also follows from the principle of equality of arms, which is a corollary of the very concept of a fair hearing, which implies that each party must be afforded a reasonable opportunity to present his case, including his evidence, under conditions that do not place him at a substantial disadvantage vis-à-vis his opponent (Judgement of the European Court of Justice C-199/11).

2. There is no jurisdiction and competence of the Court of First Instance for a second counterclaim for revocation between the same parties on the same patent, if such an action is already pending before the Court of First Instance.

Art. 33 (2) UPCA must be interpreted in such a way that this provision is not only applicable if an action between the same parties on the same patent is brought before *several different* divisions, but equally if an action between the same parties on the same patent is brought twice before *the same* division (argumentum a fortiori). The

only reasonable explanation for the wording *different divisions* is that the authors of the RoP could imagine that the same action (for example for tactical reasons) might be brought before different divisions of the Court, but not that the same action might be brought twice before the same division. The court may comprise several divisions (Art. 7 UPCA); nevertheless, it is and remains an Unified Court also within the meaning of Article 33 UPCA.

According to Art. 33 (2) UPCA, Rule 19 RoP, the Court of First Instance, and thus also the Local Division Munich does not have competence and jurisdiction for the second counterclaim (CC\_63258/2024, UPC\_CFI\_740/2024), because the same subject matter, i.e. the validity of EP 3 780 758, is already subject to the prior proceedings between the Claimant and Defendants in the same Local Division and thus the same Court (*lis pendens*). Since the local chamber has no competence and jurisdiction with regard to the second Counterclaim for revocation (CC\_63258/2024, UPC\_CFI\_740/2024), this Counterclaim is to be rejected as inadmissible.

3. According to Rule 20.1 (sentence 2) RoP, the decision shall include instructions to the parties and to the Registry concerning the next steps in the proceedings. On this basis, the judge-rapporteur orders that the infringement action will be continued in accordance with the Rules of Procedure, while further submissions regarding the counterclaim for revocation and the Application to amend the patent are not to be filed.
4. In the event of a decision of the judge-rapporteur allowing the Preliminary objection concerning a counterclaim for revocation there is no legal basis for a separate decision on the costs relating to this objection. The costs incurred in connection with the Preliminary objection are subject of a final decision on the costs of the proceedings. However, this proceedings have not yet been concluded, as the infringement action is still pending.

## **Decision**

1. The Preliminary objection is allowed. The counterclaim for revocation (CC\_63258/2024, UPC\_CFI\_740/2024) is rejected as inadmissible.
2. This decision may be appealed pursuant to Rule 220.1(a).

Pichlmaier  
Judge Rapporteur