



Local Division Munich
UPC_CFI_846/2024

Order
of the Court of First Instance of the Unified Patent Court
issued on 17 April 2025

CLAIMANT IN THE MAIN PROCEEDINGS:

Promosome LLC, 48 Gurley Road, 06902 Stamford, Connecticut, US,

represented by: Georg A. Rauh of Vossius & Partner Patentanwälte Rechtsanwälte mbB,
Siebertstr. 3, 81675 München, DE.

DEFENDANTS IN THE MAIN PROCEEDINGS:

1. **BioNTech SE**, An der Goldgrube 12, 55131 Mainz, Germany,
2. **BioNTech Manufacturing GmbH**, An der Goldgrube 12, 55131 Mainz, Germany,
3. **BioNTech Manufacturing Marburg GmbH**, Emil-von-Bering-Straße 76, 35041 Marburg, Germany,
4. **BioNTech Innovative Manufacturing Services GmbH**, Vollmersbachstraße 66, 55743 Idar-Oberstein, Germany,
5. **BioNTech Europe GmbH**, An der Goldgrube 12, c/o BioNTech SE, 55131 Mainz, Germany,
represented by: Christine Kanz of HOYNG ROKH MONEGIER, Steinstrasse 20 - 40212 –
Düsseldorf, DE. (for Defendants 1-5).
6. **Pfizer Manufacturing Belgium NV**, Rijksweg 12, 2870 Puurs-Sint-Amands, Belgium,
7. **Pfizer SAS**, 23-25 Avenue du Docteur Lannelongue, 75014 Paris, France,
8. **Pfizer AB**, Solnavägen 3h, 11363 Stockholm, Sweden,
9. **Pfizer, Inc.**, 66 Hudson Boulevard East, 10001-2192, New York, USA.

represented by: Tobias J. Hessel of Clifford Chance Partnerschaft mbB
Königsallee 59 - 40215 – Düsseldorf, DE (for Defendants 6-9)

Defendants 1-9 are collectively referred to as “the Defendants”.

PATENT AT ISSUE:

European patent EP 2 401 365.

PANEL/DIVISION:

Panel 2 of the Local Division Munich.

DECIDING JUDGE:

This order has been issued by András Kupecz as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS:

English.

SUBJECT OF THE PROCEEDINGS:

Patent infringement action – Preliminary objection (Rule 20.2 RoP).

SUMMARY OF FACTS AND REQUESTS

Claimant has brought an infringement action before the Unified Patent Court (‘UPC’), relying on Art. 3(c) and Art. 32(1)(a) of the Agreement on a Unified Patent Court (‘UPCA’) before the Local Division Munich (‘LD Munich’).

The infringement action is directed against several variants of the Comirnaty® COVID-19 vaccines developed and marketed collaboratively by the Defendants:

- Comirnaty® Original, attacked embodiment 2a
- Comirnaty® Original/Omicron BA.1, attacked embodiment 2b
- Comirnaty® Original/Omicron BA.4-5, attacked embodiment 2c
- Comirnaty® Omicron XBB.1.5, attacked embodiment 2d
- Comirnaty® JN.1, attacked embodiment 2e

On 7 March 2025 the Defendants raised Preliminary objections concerning the jurisdiction of the Court according to Rule 19.1(a) of the Rules of Procedure of the UPC (‘RoP’) (App_ 11293/2025 on behalf of Defendants 1-5 and App_11261/2025 on behalf of Defendants 6-9, with identical substance, herein jointly referred to as ‘the PO’).

The Defendants do not object to the jurisdiction of the UPC in relation to Comirnaty® variants sold on or after 1 June 2023, i.e. attacked embodiments 2a and 2c – 2e, as the UPCA has established the jurisdiction of the UPC for claims arising on and after 1 June 2023. However, the Defendants raise a preliminary objection against the jurisdiction of the Court to consider the Statement of claim insofar as it seeks relief for Comirnaty® Original/Omicron BA.1 (attacked embodiment 2b) which according to the Defendants has been produced and sold *only before* 1 June 2023, i.e. where the alleged infringing acts have concluded before establishment of the UPC. Assuming jurisdiction for such concluded act

would be contrary to the principle of international law that treaties have no retrospective effect as set out in Art. 28 of the Vienna Convention on the Law of Treaties ('VCLT').

Art. 28 of VCLT stipulates that (emphasis by the Defendants):

"Unless a different intention appears from the treaty or is otherwise established, its provisions do not bind a party in relation to any act or fact which took place or any situation which ceased to exist before the date of the entry into force of the treaty with respect to that party."

According to Defendants, not only is the UPC silent on retroactivity, i.e. it does not expressly provide for it, but it also contains no provisions which would allow such an interpretation.

For these reasons, the Defendants request the Court to dismiss the infringement action insofar as it relates to Comirnaty® variants sold only before 1 June 2023.

The Claimant submitted in its comments to the PO that the existence of different infringing products directly obtained by applying the very same infringing method does not change the continuous nature of the infringing use of the patented method nor the products directly obtained from its application. Independently of this, Defendants merely claim – without any substantiation or evidence and contested by Claimant with lack of knowledge – that attacked embodiment 2b has not been produced and sold on or after 1 June 2023. However, Defendants do not claim that other infringing activities regarding the attacked embodiment 2b, e.g. offering, placing on the market and/or storing, have not taken place since 31 May 2023. Also for this reason, the UPC has jurisdiction in relation to attacked embodiment 2b. Irrespectively, even if it was appropriate to artificially differentiate between different applications of one and the same patent infringing method and thus one could take the position that infringing activity for attacked embodiment 2b may have ceased before 1 June 2023 (which, as mentioned above, is contested with lack of knowledge), it has already been decided on several occasions by the UPC that it has jurisdiction in relation to infringing acts that have been ongoing and/or concluded prior to 1 June 2023.

The Claimant requests to dismiss the PO.

ORDER

The admissible PO is to be dealt with in the main proceeding pursuant to Rule 20.2 RoP.

1.

The PO was duly filed in accordance with Rule 19.1(a), 19.2 and 19.3 RoP, in particular in due time (taking into account the Court's order dated 21 February 2025). Since a preliminary objection may relate to a part of an infringement action only, it is permissible to base it on the grounds of an alleged lack of jurisdiction over acts committed in certain time periods (cf. e.g. LD Mannheim, order of 4 April 2025, UPC_CFI_750/2024, *Fingon/Samsung* para. 1a), LD Munich order of 10 February 2025, UPC_CFI_342/2024, UPC_CFI_483/2024, *Industria Lombarda Materiale Elettrico/PHOENIX CONTACT* para. 26).

2.

On the basis of Art. 32(1)(a) UPCA, in connection with Art. 2(g) and Art. 3(c) UPCA, the UPC has exclusive competence over claims for actual or threatened infringement of a European patent that has not yet lapsed at the time of entry into force of the UPCA. Accordingly, the UPC has (subject

matter) competence in the present case. The Claimant is asserting claims for (alleged) use of a European patent that had not yet expired on 1 June 2023. In his present (non-binding) view, the judge-rapporteur concurs with the reasoning and result of the LD Mannheim and LD Munich (preliminary objection) orders mentioned above, which in turn refer to a wider body of case law of the UPC (see for a most recent overview LD Mannheim in *Fingon/Samsung*, see above, par. 2b), from which it follows that the UPC's (subject matter) competence covers (allegedly) infringing acts committed before the UPCA's entry into force. This competence of the UPC, for actions brought after the entry into force of the UPCA, does not apply with retroactive effect, even if this means that the UPC, as of 1 June 2023, has jurisdiction to decide on matters that occurred in the past.

However, this PO does not have to be conclusively decided at this stage. The Defendants have not challenged the jurisdiction and competence of the UPC in relation to Comirnaty® variants sold on or after 1 June 2023. This means that this action will proceed in any event (also see Rule 19.7 RoP). The judge-rapporteur is aware that an appeal is pending from the LD Munich order in *Industria Lombarda Materiale Elettrico/PHOENIX CONTACT* referred to above and that the Court of Appeal is expected to decide on that appeal soon (see order CoA of 28 March 2025 in UPC_CoA_170/2025, APL_9192/2025 App_14792/2025). Under these circumstances, the judge-rapporteur considers it most efficient to deal with the PO in the main proceedings so that the outcome of said appeal proceedings can be taken into consideration – parties are hereby informed accordingly (Rule 20.2 RoP).

For the further course of these proceedings, the judge-rapporteur would like to note that competence (and jurisdiction) of the UPC and applicable law (i.e. the UPCA and/or national law) are separate issues that are to be assessed separately. To the extent parties deem this distinction relevant, they are invited to comment on the applicable law and the consequences thereof in their regular pleadings that are still to be submitted in these proceedings, starting with the Statement of Defence for the Defendants.

17 April 2025
KUPECZ
Judge-rapporteur

INFORMATION ABOUT PANEL REVIEW

Any party may request that this Order be referred to the panel for a review pursuant to R. 333 RoP. Pending review, the Order shall be effective (R. 102.2 RoP).

DETAILS OF THE ORDER

Order no. ORD_14156/2025 in ACTION NUMBER: ACT_68533/2024 and

Order no. ORD_14155/2025 in ACTION NUMBER: ACT_68533/2024

UPC number: UPC_CFI_846/2024

Action type: Infringement Action

Related proceeding no. Application No.: 11261/2025 and 11293/2025

Application Type: Preliminary objection