



**Local Division Munich
UPC_CFI_501/2023**

Procedural Order
of the Court of First Instance of the Unified Patent Court
Local Division Munich
issued on 20 December 2024

CLAIMANT

Edwards Lifesciences Corporation

1 Edwards Way - 92614 - Irvine – US

represented by: Boris Kreye, Elsa Tzschope, Ioana Hategan (Bird & Bird)

supported by: Bryce Matthewson (Powell Gilbert)
Bernhard Thum, Jonas Weickert (Thum & Partner)

DEFENDANTS

1) Meril Gmbh

Bornheimer Straße 135-137 - 53119 - Bonn – DE

2) Meril Life Sciences Pvt Ltd.

M1-M2, Meril Park, Survey No 135/2/B & 174/2 Muktanand Marg, Chala, Vapi - 396 191
Gujarat - Vapi - IN

3) Meril Italy S.r.l.

Piazza Tre Torri 2 - 20145 - Mailand - IT

represented by: Andreas von Falck, Lukas Wollenschlaeger, Felipe Zilly (Hogan Lovells)

PATENT AT ISSUE

European patent n° 3669828

PANEL/DIVISION

Panel 1 of the Local Division Munich

DECIDING JUDGE/S

This decision has been delivered by the presiding judge Dr. Matthias Zigann acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS

English

SUBJECT-MATTER OF THE PROCEEDINGS

Infringement Action

Generic procedural Applications App_56822/2024 and App_65677/2024 according to Rule 263 RoP

Rule 105.5 RoP after Interim Conference

SUMMARY OF FACTS

The claimant sued the defendants for infringement of EP 3669828. The defendants filed, inter alia, a counterclaim for revocation.

The written procedure was closed on 11 November 2024. An interim conference was held by videoconference on 19 December 2024. At the interim conference, the generic procedural requests App_56822/2024 and App_65677/2024 pursuant to Rule 263 of the Rules of Procedure were also discussed. All issues will be dealt with in one order.

REQUESTS

Claimant requests with brief dated 17 October 2024 (App_56822/2024):

We refer to our requests filed with our Statement of claim on 27 December 2023 and clarify our Requests I. and IV. on an auxiliary basis and on behalf of Claimant, we request leave to change our claim pursuant to R. 263.1 RoP.

In particular, we request that Romania, which joined the Unitary Patent system on 1 September 2024 be included in the list of countries for which Claimant seeks an injunction ("Request I."). In addition, we request that Defendants be ordered to provide relevant purchase documents (e.g. invoices) as proof for the claim for information ("Request IV.)."

Defendants request with brief dated 4 November 2024 (App_56822/2024):

- I. Claimant's (alleged) "clarifications" of Requests I. and IV. as specified in Claimant's Application of 17 October 2024 be rejected;*
- II. Claimants' Application of 17 October 2024 for leave to amend its case pursuant to Rule 263.1 RoP be rejected.*

Defendants request with brief dated 12 December 2024 (App_65677/2024):

On an auxiliary basis and on behalf of Defendants, we request leave to change our claim pursuant to R. 263.1 RoP:

In the name and on behalf of Defendants and Counterclaimants (in the following together referred to as "Defendants"), we request:

1. that the patent in suit (EP 3 669 828 B1) be revoked in its entirety;

in the alternative:

that the patent in suit (EP 3 669 828 B1) be revoked in its entirety for all Contracting Member States in which EP 3 669 828 B1 has effect;

in the alternative:

that the patent in suit (EP 3 669 828 B1) be revoked with effect in the territories of the Contracting Member States for which the European Patent has effect at the time of the decision on the counterclaim for revocation, namely Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, the Netherlands, Portugal, Romania, Slovenia and Sweden;

in the alternative:

that the patent in suit (EP 3 669 828 B1) be revoked with effect in the territories of the Contracting Member States for which the European Patent had effect at the time of the counterclaim for revocation, namely Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, the Netherlands, Portugal, Slovenia and Sweden;

2. that Claimant and Counterclaim Defendant bear the costs of the proceedings.

The claimant agreed to the defendant's request to add Romania to the counterclaim if its own motion to amend was successful.

Claimant requests with brief dated 4 November 2024 (ACT_597277/2023):

1. For the purpose of the oral hearing on 11 February 2025, Claimant wishes that the parties be allowed to use demonstratives, in particular PowerPoint presentations. However, these should be limited to figures and images that were already included in their written submissions. Claimant submits that the use of such PowerPoint presentation would be helpful to present its case to the Court.

2. Claimant refers to its application of 17 October 2024 filed in workflow App_56822/2024, in which it clarified its Requests I. and IV. as submitted with its Statement of claim on 27 December 2023. In this submission, Claimant explained why it is entitled to seek, inter alia, injunctive relief from Defendants with respect to the territory of Romania (Request I.). Furthermore, Claimant clarified that the information Defendants have to provide under Request IV. shall be accompanied by copies of the relevant purchase documents such as invoices or – if not available – shipping documents.

3. On an auxiliary basis, if the Court considers the new Requests I. and IV. to be a change of claim requiring leave from the Court, Claimant submitted that the conditions set out in R. 263 RoP are fulfilled. For the avoidance of repetition, we refer to our submission of 17 October 2024 and maintain our requests. Claimant reserves the right to comment on Defendants' response hereto, which is due on 4 November 2024, at the interim conference if the Court does not rule on this matter beforehand.

4. To further support its case, Claimant submitted a written statement of Prof. Lutter (Exhibit K 62) pursuant to Art. 53(1)(e)UPCA, R. 181.1 RoP. If the Court deems it necessary and decisive for the outcome of the present proceedings, Claimant requests that Prof. Lutter be

summoned as witness to the oral hearing pursuant to R. 181, 177.1(a) RoP (Request IV. in the Reply of 1 July 2024).

Defendants request with brief dated 4 November 2024 (ACT_597277/2023):

I. the Defendants be allowed to use PowerPoint slides during the oral hearing on 11 February 2025 to present their case;

II. a court expert (Rule 170.1, .2 lit. e), Rule 185 RoP) be appointed and it be ordered that an expert opinion is provided on the facts to be proven;

III. the court expert be summoned to the oral hearing, the court expert be heard at the oral hearing, and the parties be allowed to question him.

GROUNDS FOR THE ORDER

All these points have been discussed with all the panel members. In view of the holiday season, the decision will be taken by the judge-rapporteur alone.

I. Joining Romania to the infringement action and the counterclaim

The infringement action of 27 December 2023 was worded as follows

... within the area of application of the Unified Patent Court Agreement at the time of the oral hearing - except in Malta -, in Belgium, Bulgaria, Denmark, Germany, Estonia, Finland, France, Italy, Latvia, Lithuania, Luxembourg, the Netherlands, Austria, Portugal, Sweden and Slovenia, to offer, put into circulation, use, introduce or possess for the abovementioned purposes.

The counterclaim for revocation, dated 26 April 2024, is worded as follows

... that the patent in suit (EP 3 669 828 B1) be revoked in its entirety.

Neither the statement of claim nor the counterclaim mention Romania. It is therefore unclear whether Romania, which acceded on 1 September 2024, was included in the infringement action or the counterclaim. It cannot be assumed that the defendants wanted to add Romania at the time of filing the counterclaim, as this would have been inadmissible.

As both parties now wish to add Romania to the proceedings, leave to amend the respective claims is to be granted (LD Munich order 02.12.2024 UPC-CFI_114/2024 and 448/2024).

II. Leave to amend infringement action as to the information to be provided by defendants

Plaintiff applied for leave to amend the following:

... whereby the list with the data has to be additionally transmitted electronically in a form that can be evaluated by means of EDP (e.g. Excel table), and copies of the relevant purchase documents (namely invoices, alternatively delivery bills) are to be submitted by Defendants as proof of the information, whereby confidential details outside the subject of the disclosure information may be redacted.

According to the CoA, not every new argument constitutes an "amendment of a case" requiring a party to apply for leave under Rule 263 of the Rules of Procedure. An amendment of a case occurs when the nature or scope of the dispute changes. For example, in an infringement case, this occurs when the claimant relies on a different patent or objects to a different product. If a new argument is not an amendment of the case for which judicial leave is required under R. 263 RoP, there are still restrictions on raising new arguments. R. 13 RoP requires that the statement of claim contains the reasons why the facts relied upon constitute an infringement of the patent claims, including arguments of law. This provision must be interpreted in the light of the last sentence of recital 7 of the preamble to the Rules of Procedure, which requires the parties to present their case as early as possible in the proceedings (CoA order of 21.11.2024 UPC_CoA_456/2024 APL_44633/2024).

As the amendments only concern details of the way in which the information is to be provided by the defendants, the request falls under Rule 13 of the Rules of Procedure. Unlike the situation in the previous case, the amendment was filed well in advance of the hearing date and the defendants had sufficient time to comment on it. Leave should therefore be granted. This decision leaves open the question of whether or not the information sought is owed. This will be determined by the Court at a later date.

III. Clarification of the order in which the Court should consider the auxiliary requests in the context of the application to amend the patent in suit

The Court requests clarification as to the order in which the Court should consider the auxiliary requests in the context of the application to amend the patent in suit. In this respect, the court notes that the only permissible condition for triggering an auxiliary request is that the court finds, for whatever reason, that the main request or the previous auxiliary request should be rejected.

The situation might be different here:

According to the courts preliminary understanding Edwards made two lines of requests, one is ARs 1, 2, 3, 4, ...9, 3', 4' ... 9', 3'' ...9'' and the other is AR 1, 2, 3, 3', 3'', 4, 4', 4'' and so on. A first bifurcation point is at AR 3, and then it meanders along. If, for example, AR 3 is not admissible but both 3' and 4 are admissible it is unclear what AR to pick. The proceedings are subject to party disposition, and the court is not allowed to make a choice on behalf of the patentee.

IV. No party experts to be heard, no court experts to be hired

The Court finds that there is no need to invite the parties' experts to the oral hearing or to appoint a Court Expert on any issue but reserves the right to do so in the future.

ORDER

1. The Claimant's Rule 263 request to add Romania to the infringement action and to specify the information to be provided by the Defendants is granted.
2. Defendant's Rule 263 request to add Romania to the counterclaims is granted.
3. The value of the infringement action and the counterclaim is set at €8 million each. The value of the dispute is set at €16 million.
4. The parties are summoned to the hearing on 11 February 2025, 9.00 a.m., Denisstr. 3 in Munich, room 212 and overflow room 220b.
5. The Parties may use PowerPoint slides to present their case at the Oral Hearing on 11 February 2025. The content of the slides is limited to the content previously submitted to the Court via the CMS. The relevant PowerPoint slides shall be made available to the Court and to the other Party by e-mail no later than 8:00 a.m. on the day of the hearing.
6. The Parties are invited to file by 30 January 2025:
 - a. Cost estimates or information on cost arrangements.
 - b. Physical objects or drawings to further illustrate the technical arguments, in particular the way parts of the leaflets are folded according to the patented invention, the attacked embodiments and the prior art cited in the counterclaim.
 - c. A list of participants in the oral hearing and any requests for a hybrid hearing.
7. The Claimant is invited to submit by 30 January 2025 a clarification of the order in which the Court should consider the auxiliary requests in the context of the application to amend the patent in suit.
8. The parties are invited to inspect any physical objects submitted to the Court by prior arrangement with the Sub-Registry.
9. All other requests of the parties are rejected.

INFORMATION ABOUT REVIEW BY PANEL

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)

INFORMATION ABOUT ORAL HEARING HELD IN COURT

The oral hearing shall be open to the public unless the Court decides to make it, to the extent necessary, confidential in the interests of one or both parties or third parties or in the general interest of justice or public order (R. 115 RoP).

INFORMATION ABOUT AUDIO RECORDING

The oral hearing shall be audio recorded. The recording shall be made available at the premises of the Court to the parties or their representatives after the oral hearing (R. 115 RoP).

INFORMATION ABOUT ABSENCE OR DELAY OF A REPRESENTATIVE

A decision by default may be given, upon request, against a party that was duly summoned but fails to appear at the oral hearing (R. 355.1 (b) RoP).

INFORMATION ABOUT DECISION BY DEFAULT

Should a party fail to comply with the present Order within the time period specified, a decision by default may be given in accordance with R. 355 RoP (R. 103.1, last subparagraph and .2 RoP).

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DETAILS OF THE ORDER

Order no. ORD_598551/2023 in ACTION NUMBER: ACT_597277/2023

UPC number: UPC_CFI_501/2023

Action type: Infringement Action

Order no. ORD_67489/2024 in ACTION NUMBER: ACT_597277/2023

Action type: Infringement Action

Order no. ORD_65874/2024 in ACTION NUMBER: ACT_597277/2023

Action type: Infringement Action

Related proceeding no. Application No.: 65677/2024

Application Type: Generic procedural Application

Order no. ORD_58462/2024 in ACTION NUMBER: ACT_597277/2023

UPC number: UPC_CFI_501/2023

Action type: Infringement Action

Related proceeding no. Application No.: 56822/2024

Application Type: Generic procedural Application

Dr. Zigann
Presiding Judge