



Action n°: UPC 252/2023

Revocation action

## Order

of the Court of First Instance of the Unified Patent Court

Central division (Section Munich)

issued on 25 July 2024

concerning EP 2 794 928

### CLAIMANT

- 1) **NanoString Technologies Europe Limited** Represented by Daniela  
Suite 2, First Floor, 10 Temple Back - BS1 6FL - Kinkeldey of Bird & Bird  
Bristol - GB

### DEFENDANT

- 1) **President and Fellows of Harvard College** Represented by Axel Berger of  
17 Quincy Street - 02138 - Cambridge, MA - Bardehle Pagenberg  
US

## PATENT AT ISSUE

*Patent no.*

*Proprietor/s*

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**EP2794928**

President and Fellows of Harvard College

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### PANEL/DIVISION

Panel 1 of the Central Division (Section Munich).

### DECIDING JUDGE

This Order is an order of the Judge-rapporteur András Kupecz.

### LANGUAGE OF THE PROCEEDINGS:

English.

### SUBJECT-MATTER OF THE PROCEEDINGS

Revocation action.

### STATEMENT OF FORMS OF ORDER SOUGHT AND SUMMARY OF THE FACTS

With decision of 7 May 2024, the German Federal Patent Court (“FPC”) revoked the German part of EP 2 794 928 and also found none of the auxiliary requests (“ARs”) 1-9 (corresponding to ARs 1-9 in the present proceedings at the Unified Patent Court (“UPC”)) patentable. At the time of making the application and issuing this order, the FPC had not yet provided the reasons for its decision. In its preliminary opinion of 7 February 2023, the FPC had come to the conclusion that the subject matter of AR 1 was patentable (exhibit D26 in the present proceedings).

It is currently not clear to the Defendant what led the FPC to come to their decision, but Defendant assumes that with regard to AR1, the FPC adopted the reasoning of the Court of Appeal of the UPC (“CoA”) in its decision on divisional patent EP 4 108 782 in preliminary injunction proceedings (UPC\_CoA\_335/2023 dated 26 February 2024, exhibit BP23 in these proceedings). The Defendant argues it was prompted to have certain facts clarified by experts in the field to underline the apparently incorrect understanding of the FPC.

Accordingly, the Defendant, relying on the principles of proportionality, flexibility and fairness, as mentioned in the Rules of Procedure (“RoP”), predictability and in the interest of harmonization as well as transparency and quality, requests the admittance into the proceedings of the submission dated 22 July 2024 as well as two expert reports BP25 and BP26 under Rule 9.1 RoP.

The Claimant opposes the request and requests to dismiss the further written submissions.

### GROUNDS

The Judge-rapporteur, having consulted the Presiding Judge of the panel, dismisses Defendant's request to admit the submission dated 22 July 2024 as well as the two expert reports BP25 and BP26 enclosed with the submission. These further submissions are not admitted into the proceedings.

In proceedings at the UPC, parties shall set out their full case as early as possible. This is also referred to as the "front-loaded character" of UPC proceedings. The front-loaded character of UPC proceedings is aimed at ensuring that proceedings can normally be conducted in a way which allows the oral hearing to be conducted in within one year (point 7 of the Preamble of the RoP, also see CoA order of 28 May 2024 in case 22/2024, at 23).<sup>1</sup> The front-loaded character also serves the principles of fairness and equity by preventing a party (and the Court) from being confronted with and having to react to new evidence and arguments unreasonably late in the proceedings.

The CoA decision on the divisional patent was already issued (including the reasoning) on 26 February 2024 and the FPC took its decision already on 7 May 2024. The Defendant has provided no (satisfactory) explanation why it waited almost five months after the CoA decision and more than two months after the FPC decision to make further written submissions regarding allegedly incorrect facts assumed by the CoA (11 of the request) that it assumes form the basis of the FPC decision and according to the Defendant prompted the submission.

In the present case, the oral hearing is scheduled for 18 September 2024, less than two months from the date of this order. All written pleadings have been exchanged and an interim conference has been held. The summons to oral proceedings is about to be issued. If the further written submissions were allowed, the Claimant, given the nature and complexity of the submissions, in view of the requirements of procedural equality of arms would have to be granted the opportunity to reply to the new submissions in detail including by way of expert evidence. The (international) panel would also have to be able to properly prepare the case. Given the short time still remaining before the hearing, all the more as this is in the middle of the summer holiday period in Europe, this would inevitably lead to a considerable postponement of the hearing.

Also taking into account that the RoP are to be applied and interpreted in accordance with the Claimant's fundamental right to an effective legal remedy and a fair and public hearing within a reasonable time as guaranteed by Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms and, to the extent that European Union Law is concerned, Article 47 of the Charter (see CoA order in case 22/2024 referred to above, at 22 and

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<sup>1</sup> Published on the UPC website.

23), the negative consequences of this delay outweigh the interests of the Defendants in allowing the further submissions.

In coming to its decision to dismiss the application, the Court also takes into account that the reason provided by the Defendant to submit the arguments and evidence is the alleged (yet unknown) misunderstanding of the FPC with which the Defendant disagrees. Whilst the Central Division acknowledges that the interests of harmonising decisions on the validity of a European patent can be promoted by taking into account decisions of other bodies (see CoA order in case 22/2024 referred to above, at 25), it is not the Central Division's role to scrutinise decisions of other courts or of the UPC CoA in proceedings relating to a divisional patent.


#### ORDER

For all of the above reasons, having heard the parties:

- The request to submit further written submissions is denied.
- Any other decision is postponed until the final decision in this case.

Parties are hereby informed that the interim procedure is closed as of today (Rule 110.1 RoP).

András  
Ferenc  
Kupecz



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unterscrieben von  
András Ferenc  
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Datum: 2024.07.25  
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Issued 25 July 2024

KUPECZ

Judge-rapporteur