



## **UPC\_CFI-484/2023**

**Order of the Court of First Instance of the Unified Patent Court  
Central Division (Paris Seat)  
lodged in the revocation action No. ACT\_595045/2023  
delivered on 2. July 2024**

### Plaintiff:

**Nokia Technology GmbH**, represented by its Managing Directors Marc Malten and Kristina Marie Vainio, Carl-Theodor-Strasse 6, 40213 Düsseldorf, Germany, marc.malten@nokia.com  
- Plaintiff –

Representative: Rechtsanwalt Boris Kreye, Bird & Bird LLP, Maximiliansplatz 22, 80333 Munich, Germany

### Defendant:

**Mala Technologies Ltd.**, represented by its Managing Director, Izhak Tamir, 41 Yosef Tzvi Street, 52312 Ramat Gan, Israel, izhak.tamir@malatechnology.com  
- Defendant –

Representative: Rechtsanwalt Dr. Thomas Lynker, TALIENS Partnerschaft von Rechtsanwälten mbB, Amalienstrasse 67, 80799 Munich, Germany, thomas.lynker@taliens.com

and

German and European Patent Attorney Dr. Thomas Kurig, Becker Kurig & Partner Patentanwälte

PATENT AT ISSUE:

EP 2 044 709 B1

PANEL:

Panel 1 of the Central Division - Paris Seat

DECIDING JUDGE:

This order has been issued by the Judge-rapporteur **Maximilian Haedicke**

LANGUAGE OF PROCEEDINGS:

English

SUBJECT-MATTER OF THE PROCEEDINGS

Revocation action. Preliminary Objection. Hearing Invitation

BACKGROUND

1. On 21. December 2023 Plaintiff has brought a revocation action against the patent at issue (EP 2 044 709 B1) before this Seat of the Unified Patent Court, registered as number ACT\_ 595045/2023 UPC\_CFI\_ 484/2023. Service on Defendant has been effected on 17. January 2024.
2. On 17 March 2024 Defendant filed an Application to amend the patent within the Defence to revocation (p. 29 et seq., mn. 138 et seq.).
3. Defendant started the workflow for the Application to amend the patent on 13 May 2024 (No. App\_26882/2024).
4. Plaintiff requests to reject Defendant's Application to amend as inadmissible, and to revoke the patent is suit in its entirety in the form of auxiliary requests 1 to 7. Plaintiff argues that Defendant's Application to amend is inadmissible because Defendant failed to initiate the correct workflow in the CMS in a timely manner. Defendant should have started the separate "Application to amend" workflow within the CMS and file its auxiliary requests therein at the same time as it lodged its Defence to revocation (see R. 30.1 RoP). Initiating a separate workflow is essential because R. 55 RoP, in conjunction with R. 32 RoP, establishes a different procedural timetable than the main proceedings. If an application to amend the patent is filed in violation of R. 4.1, sentence 2 RoP, the legal consequence is that the application to amend must be rejected as inadmissible (see MLD UPC CFI 15/2023, Order of 29/09/2023, p.9).

5. Defendant requests to reject Plaintiff's request. Defendant argues that Auxiliary requests 1-7 were effectively introduced into the proceedings on 17 March 2024, along with the filing of the Defence to revocation, and thus not filed too late but filed within the deadline to file a defence. It does not follow from the Rules of Procedure that the Application to amend the patent in response to a revocation action is to be regarded as something separate from the Defence to revocation. And it does not follow from the Rules of Procedure that an Application to amend the patent is only admissible if filed in a separate workflow of the CMS.

## GROUNDS FOR THE ORDER

6. Plaintiff's request to reject Defendant's Application to amend as inadmissible is denied. The Application to amend has been filed within the 2-month time limit of R 49 (1), (2) RoP.
7. By filing the Application to amend in the same submission as the Statement of Defense, Defendant filed this request on 23 May 2024 and hence in a timely manner.
8. It does not unambiguously follow from the Rules of Procedure that the Application to amend the patent in response to a revocation action has to be filed in a separate workflow.
9. Article 29 (a) RoP states:

*"Within two months of service of a Statement of defence which includes a Counterclaim for revocation..."*

The verb "include" may be interpreted to indicate that neither separate written pleadings nor the use of a separate workflow for the Application to amend the patent is required.

10. However, Article 4 (1) RoP provides that

*1. Written pleadings and other documents shall be signed and lodged at the Registry or relevant subregistry in electronic form. Parties shall make use of the official forms available online. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt."*

This provision indicates that whenever a specific workflow is provided, this workflow is to be used. Hence, Article 4 (1) RoP stipulates an obligation to use the workflows provided by the CMS. However, this provision cannot justify Plaintiff's request to set aside the Application to amend the patent.

11. The Rules of Procedure have to be interpreted with reference to the principles of fairness and proportionality (Preamble No. 2 RoP). As stated in ORD\_19619/2024 ACT\_580198/2023, UPC\_CFI\_367/2023, it is not readily apparent to the CMS user

that the CMS requires an independent reaction to the Application to amend a patent by opening a separate workflow. Ambiguities arising from the CMS, particularly shortly after the launch of the UPC, should not be to the detriment of the parties and should not render a submission inadmissible (see also Ordonnance ORD\_25657/2024 ACT\_578871/2023 UPC\_CFI\_360/2023).

12. The Order ORD\_576853/2023 UPC\_CFI\_15/2023 of the Munich Local Division which has been mentioned by Plaintiff states correctly that the parties are obliged under rule 4.1 RoP to use the correct workflow. The Order does not consider the submission to be inadmissible because the wrong workflow was used. The order left open whether in the future submissions filed in the wrong workflow may be inadmissible. This issue doesn't have to be decided in this order. At least for now the use of the wrong workflow does not render a submission inadmissible.
13. However, the parties are strongly encouraged to use the correct workflows in the future, as this makes the case management system more transparent and more accessible.
14. The arguments underlying the Application to amend were brought to the attention of the court and Plaintiff within the 2-month time limit of R 49 (1), (2) RoP. No disadvantage arose for Plaintiff because Defendant failed to open a separate workflow.
15. Whether the patent in suit can be maintained as requested in any of the auxiliary requests 1, 2, 3, 4, 5, 6, or 7 (R. 32.1(b) RoP) will be decided in due course after the oral hearing.

## ORDER

16. Plaintiff's request to reject Defendant's Application to amend as inadmissible is rejected.
17. Whether the patent in suit can be maintained as requested in any of the auxiliary requests 1, 2, 3, 4, 5, 6, or 7 (R. 32.1(b) RoP) will be decided in due course after the oral hearing.

The Judge-rapporteur

Maximilian Haedicke

REVIEW:

Pursuant to Rule 333 RoP, the Order shall be reviewed by the panel on a reasoned application by a party. An application for the review of this Order shall be lodged within 15 days of service of this Order.

ORDER DETAILS

Order no. ORD\_33370/2024 in ACTION NUMBER: ACT\_595045/2023

UPC number: UPC\_CFI\_484/2023

Action type: Revocation Action

Related proceeding no. Application No.: 29031/2024

Application Type: Generic procedural Application