



Central Division
Paris Seat

ORDER

of the Court of First Instance of the Unified Patent Court
Central division (Paris seat)
issued on 27 February 2024
concerning the Generic Application No. App_7364/2024
lodged in the revocation action UPC_CFI_255/2023

HEADNOTES: request to further exchange of written pleadings

KEYWORDS: requirements

REFERENCE CODE ECLI:

APPLICANT:

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represented by Emmanuel Larere, Cabinet Gide Loyrette Nouel AARPI

assisted by Raphaëlle Dequiré-Portier, Cabinet Gide Loyrette Nouel AARPI

RESPONDENT:

Edwards Lifesciences Corporation - 1 Edwards Way, Irvine, 92614 California, USA,

represented by Boris Kreye, Bird & Bird LLP

co-represented by Siddharth Kusumakar and Tessa Waldron, Powell Gilbert (Europe) LLP

PATENT AT ISSUE:

European patent n° EP 3646 825

PANEL:

Panel 2 of the Central Division - Paris Seat

DECIDING JUDGE:

This order is issued by the presiding judge and judge-rapporteur Paolo Catalozzi

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 4 August 2023 the applicant lodged a revocation action against patent at issue (EP '825) before this Seat of the Central Division of the Court of First Instance of the Unified Patent Court, registered as No. ACT_551308/2023 UPC_CFI_255/2023.
2. On 16 October 2023, the respondent, defendant in the revocation action, lodged the statement of defence which included a conditional application to amend the patent.
3. On 22 December 2023 the claimant submitted its reply to the defence together with a reply to the application to amend the patent.
4. On 22 January 2024 the defendant lodged its rejoinder to the reply to the defence together with the reply to the defence to the application to amend the patent.
5. On 22 February 2024 the claimant requested to allow the exchange of further written pleadings within a period to be specified, pursuant to Rules 12 (5), 36, 43 (5) and 58 of the Rules of Procedures ('RoP'), setting a one-month deadline expiring on 22 February 2024 for lodging its final revocation submissions and, should the defendant request to be allowed to lodge a further written pleading, setting a one-month deadline expiring on 22 March 2024 for the defendant to lodge its final defence to revocation submissions and in case of denial, granting it the leave to appeal such decision.

FOUNDATIONS FOR THE ORDER

Rule 36 'RoP' and the use of the discretionary powers by the Court.

6. The claimant has based its request on the need to respond to the new defence arguments to the invalidity of EP'825 filed by the defendant on 22 January 2024 in its rejoinder to the reply to the defence together with the reply to the defence to the application to amend the patent.
7. It has pointed out that the defendant's rejoinder relating to the priority issue is grounded on a completely new defence when trying to demonstrate that the subject-matter of claim 1 derives directly and unambiguously from P1 and it has supplemented its defence with new arguments with regard notably to the alleged scope of the patent at issue.

8. The referred Rule 36 'RoP', applicable to the revocation actions by virtue of Rule 58 'RoP', states that 'Without prejudice to the powers of the judge-rapporteur pursuant to Rule 110.1, on a reasoned request by a party lodged before the date on which the judge-rapporteur intends to close the written procedure [Rule 35(a)], the judge-rapporteur may allow the exchange of further written pleadings, within a period to be specified. Where the exchange of further written pleadings is allowed, the written procedure shall be deemed closed upon expiry of the specified period.
9. The provision confers to the judge-rapporteur the discretionary powers to allow further exchange of written pleadings in addition to the ones mentioned in Rule 43 'RoP'.
10. While using these discretionary powers the Unified Patent Court judges have to observe the principles of proportionality, flexibility, fairness and equity, mentioned in the preamble 2 and 4 of the Rules of Procedures (see, UPC CFI 412/2023 CD Paris, order of 9 February 2024).
11. With particular regard to the statutory regime concerning the written procedure, it has to be considered that this regime shall, in principle, ensure that proceedings are carried out in compliance with the principle of due process, allowing the parties to illustrate the facts and the legal arguments on which a claim or a defence is based and to take position on the arguments, in fact and in law, of the opposing party, and, as a result, delimiting the subject-matter of the proceedings.
12. The structure of the written procedure takes also into consideration the aim that proceedings are concluded rapidly (see the Considerations of the Unified Patent Court Agreement) and respectfully, where possible, of the one-year period set by the preamble 7 of the 'RoP' for the infringement and revocation actions.
13. In the current situation, the arguments put forward by the claimant do not appear to justify the use of these discretionary powers and the request of exchange of further written pleadings and to derogate to the general regime provided for the written procedure.
14. Indeed, according to Rule 52 'RoP', the defendant's rejoinder 'shall be limited to a response to the matter raised in the reply'.
15. It follows that where the arguments illustrated in the defendant's rejoinder respect this limit the claimant is not entitled to lodge a further pleading, as no extraordinary circumstance occurred which makes appropriate a written pleading and, anyway, it may react to the last defendant's pleading during the course of the oral hearing.
16. Instead, in case the defendant's rejoinder does not observe this limit, the Court shall consider the relative part of the written pleading as not lodged, so that the claimant has no interest to reply to it.

Request to grant leave to appeal.

17. This judge-rapporteur decides not to grant leave to appeal, because, in the absence of any precedents from the Unified Patent Court on the disputed issue, there is no concrete need for a ruling on the meaning of the relevant rules.

18. Furthermore, he underlines that, having regard to the current stage of the written procedure, substantially at the end, and the holding of the interim conference and the oral hearing in a short while, in case of a possible immediate appeal to this order a decision by the Court of appeal may intervene after that the oral hearing in the current proceedings has taken place and, therefore, would be of no practical use to the parties.

ORDER

For these grounds the judge-rapporteur:

- rejects the requested to allow the exchange of further written pleadings;
- rejects the request to grant the leave to appeal.

Issued on 27 February 2024.

The Judge-rapporteur

Paolo Catalozzi