



Central Division (Section Munich)

UPC_CFI_80/2023
Rule 105.5 RoP Order
of the Court of First Instance of the Unified Patent Court
delivered on 18/03/2024

CLAIMANT

- 1) **ASTELLAS INSTITUTE FOR REGENERATIVE MEDICINE** Represented by Mark
9 Technology Drive - MA 01581 - Westborough Didmon of Potter Clarkson
- US

DEFENDANTS

- 1) **Healios K.K** Represented by James Nicholls and
7-1, Yuraku-cho 1-chome Chiyoda-ku - 100- Pamela Tuxworth of JA Kemp
0006 - Tokyo - JP
- 2) **Osaka University** Represented by James Nicholls and
1-1 Yamadaoka Suita-shi - 565-0871 - Osaka - Pamela Tuxworth of JA Kemp
JP

PATENT AT ISSUE

Patent no.

Proprietor/s

EP3056564

Healios K.K, Osaka University

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 PROCEEDINGS:

English.

SUBJECT-MATTER OF THE PROCEEDINGS

Revocation action. Order following interim conference (Rule 105.5 RoP).

BACKGROUND AND FACTS

With reference to the Court's Rule 28 RoP order dated 25 October 2023 and the invitation to the interim conference dated 22 February 2024, an interim conference was held on 13 March 2024 by video conference (Rule 105.1 RoP). At the interim conference, the parties appeared before the judge-rapporteur.

On behalf of the Claimant, other than by the representative mentioned above, the interim conference was attended by

- Oliver Laing, Potter Clarkson
- Nick McDonald, Potter Clarkson
- Georgia Carr, Potter Clarkson
- Helen Bartlett, Potter Clarkson
- ..., Senior Director (IP Innovations) at Astellas Institute for Regenerative Medicine
- ..., Senior Director (Intellectual Property) at Astellas Pharma Europe B.V
- ..., Senior Director (IP Litigation) at Astellas Pharma Europe B.V
- ..., the Claimant's technical expert

On behalf of the Defendant, other than by the representatives mentioned above, the interim conference was attended by:

- Dr Kapil Tuladhar, Representative before the Unified Patent Court
- Mr Takayuki Imazato, Japanese Patent Attorney and European Patent Attorney

- Mr John Hornby, English and Welsh Solicitor
- ... (General Manager, Legal Department, Healios K.K.)
- ... (Inventor of the Patent)
- ... (Assistant at Healios K.K. with respect to experiments)
- ... (Intellectual property consultant)

Ulrike Voß (presiding judge) and Paolo Gerli (technically qualified judge), members of the panel, were present as observers.

The interim conference was audio recorded and the participants were informed accordingly (Rule 106 RoP).

The judge-rapporteur discussed several issues with the parties in preparation for the oral hearing. The decisions taken at the interim conference are as set out below.

DECISIONS TAKEN AT THE INTERIM CONFERENCE

Requests

The parties confirmed that they maintained their requests as brought forward during the written procedure.

EPO Proceedings

The parties informed the judge-rapporteur about the outcome of the EPO opposition. The judge-rapporteur informed the parties that he would contact the opposition division to ask when the written decision would become available.

The Defendants, after being asked by the judge-rapporteur, indicated that they did not wish the proceedings to be stayed pending the outcome of the EPO proceedings. The oral hearing in this case will go ahead as planned unless the Court informs the parties otherwise.

Admissibility of the second declaration of ... (D21)

The parties discussed the admissibility of the second declaration of ... (D21). The parties and the judge-rapporteur agreed that D21 was admitted into the proceedings on the condition that the Defendant has until **11 April 2024** to file a succinct reply to the submission and the declaration, possibly including a short reply expert report, of which the length should be similar to Claimant's submissions and which should be strictly in reply to points raised in D21 and the Claimant's submission.

Value of the dispute

After discussion with the parties, the value of the dispute proceedings for the purpose of applying the scale of ceilings for recoverable costs (Rule 104(j) in connection with Rule 152.3 RoP) was set at 4,000,000 EUR (four million euros).

In relation to costs, the Administrative Committee ('AC') has published a table of ceilings for reimbursable costs depending on the value in dispute (24 April 2023 as D-AC/10/24042023_D).

According to this table, the ceiling corresponding to a value of EUR 4,000,000 EUR would be set at EUR 400,000 (four hundred thousand euro).

The judge-rapporteur pointed out to the parties the table as drawn up by the AC relates to a ceiling for recoverable costs, i.e. the maximum amount of costs recoverable. In accordance with article 69 UPCA, reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity requires otherwise (up to a ceiling set in accordance with the Rules of Procedure, see above).

In order for the parties and the Court to assess whether costs incurred are indeed reasonable and proportionate and whether or not equity requires otherwise, the Court and parties must have access to information showing at least a detailed description of the number of hours spent working on this particular case, by whom, what for and at what rate. The same applies to any expenses incurred.

To this end, the Court will allow the filing of additional exhibits relating to costs until two weeks prior to the hearing (**11 June 2024**) for all costs incurred until that date. This submission may be updated by a further submission to be lodged at the latest **noon CET** on the day before the hearing (**24 June 2024**). The last submission may include an estimate of costs incurred for the hearing itself.

The judge-rapporteur informed the parties that the Court will, in principle, respect an agreement between the parties on the amount of costs that is deemed reasonable and proportionate.

Confirmation oral hearing date

The date for the oral hearing, already communicated to the parties in the Rule 28 RoP order, is confirmed for:

26 June 2024, 09.30 CET,

Cincinnatistraße 64, 81549 Munich, Germany

The hearing room will be announced in the summons to the oral hearing (Rule 108 RoP).

The judge-rapporteur explained to the parties that it is the Court's firm intention to conclude the hearing in one day. 25 June is reserved for the hearing in case 75/2023. The third day (27 June 2024, reserved as per the Rule 28 RoP Order) is in principle only reserved for unforeseen events, like technical difficulties.

ORDER

Having heard the parties at the interim conference, in accordance with the above, the Court orders as follows:

1. Document D21 is admitted into the proceedings. Defendant is given the opportunity until 11 April 2024 to file a succinct reply to the submission and the declaration, possibly including a short reply expert report, of which the length should be similar to Claimant's submissions and which should be strictly in reply to points raised in D21 and the Claimant's submission.

2. The value of the proceedings for the purpose of applying the scale of ceilings for recoverable costs is set at 4,000,000 EUR (four million euros).
3. Parties are allowed to file additional exhibits relating to costs until 11 June 2024 for all costs incurred until that date. This submission may be updated by a further submission to be lodged at the latest noon CET on 24 June 2024.
4. The date and time for the oral hearing is confirmed for 26 June 2024, 09.30 CET.

INFORMATION FOR THE PARTIES

The Defendant is instructed to file its reply in the workflow of the present order by using the opportunity to comply with the order. Further submissions on costs may be submitted by way of a separate Rule 9 generic application workflow.

18 March 2024
KUPECZ
Judge-rapporteur

ORDER DETAILS

Order no. 598256 in ACTION NUMBER: ACT_465342/2023
UPC number: UPC_CFI_80/2023
Action type: Revocation Action

REVIEW:

Pursuant to Rule 333 RoP, the above 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.