

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 11 April 2025
Amendment of claim (R. 263 RoP)
Addition of a defendant (R. 305 RoP)

HEADNOTE:

1. When applying R. 263 and R. 305 RoP, the Court of First instance has discretion. The scope for review on appeal is consequently limited. The appellant is required to establish that the Local Division went beyond the boundaries of its discretion and could not reasonably have reached the decisions in the impugned orders.
2. R. 263 RoP requires that the application shall explain why a requested change or amendment of case was not included in the original pleading. This means that the reasoning must be included in the application. It does not prohibit that the precise wording of the requested amendment is set out in one or more annexes, such as amended Statements of claim with and without tracked changes.
3. When dealing with a request to add a person as a party under R. 305 RoP, when considering the interests of the parties and procedural efficiency, among the circumstances that the Court may take into account are: whether the claimant was or should have been aware of the alleged infringing acts of such a person at an earlier stage, the involvement of the other parties with that person's allegedly infringing acts, the effect on the other parties if the party is added as a party and the stage of the proceedings. The level of the duty of presentation and proof of such circumstances is lower when dealing with a request under R. 305 RoP than when dealing with the case on the merits. The weighing of the evidence provided, the weighing of the relevant circumstances and of the interests of the parties and procedural efficiency is at the discretion of the Court.

KEYWORDS:

- Amendment of claim (R. 263 RoP); adding a party (R. 305 RoP)

APPELLANTS/ DEFENDANTS IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE:

1. **TGI Sport Suomi Oy (previously Supponor Oy)**, Vaisalantie 6, 02130 Espoo, Finland;
2. **TGI Sport Virtual Limited (previously Supponor Limited)**, Office 415 26-28 Hammersmith Grove, London W6 7BA, United Kingdom;
3. **Supponor SASU**, 291 Rue Albert Caquot, CS 40095, Sophia-Antipolis, 06560 Valbonne, France;
4. **TGI Sport Italia S.r.l. (previously Supponor Italia S.r.l.)**, Via Castiglioni, 1, Busto Arsizio, VA 21052, Italy;
5. **Supponor España SL**, Off 662, Gran Via Business Center SL, Gran Via de les Corts Catalanes 630, Barcelona 08007, Spain;

hereinafter jointly referred to as TGI;

all represented by: Dr. Henrik Lehment, attorney at law, Hogan Lovells , Düsseldorf, Germany and other representatives from that firm as well as from Gleiss Lutz, Düsseldorf, Germany; and Hannes Snellman Attorneys, Helsinki, Finland

RESPONDENT/CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE

AIM Sport Development AG, Schwanenplatz 4, 6004 Luzern, Switzerland;

hereinafter referred to as AIM;

represented by: Johanna Flythström, attorney at law, Roschier Attorneys, Helsinki, Finland; and other representatives from that firm as well as from Powell Gilbert (Europe), Dublin, Ireland; and Noerr, München, Germany.

LANGUAGE OF PROCEEDINGS

English

PANEL AND DECIDING JUDGES

Panel 2:

Rian Kalden, presiding judge and judge-rapporteur

Ingeborg Simonsson, legally qualified judge

Patricia Rombach, legally qualified judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

Helsinki Local Division, ORD_6926/2025 of 11 February 2025 and ORD_8222/2025 of 19 February 2025

Reference numbers of the Court of First Instance:

ACT_545571/2023, UPC_CFI_214/2023 (infringement action), App_1205/2025, App_2558/2025,

App_3474/2025, App_7964/2025

ORAL HEARING

The parties agreed that the Court of Appeal may decide on the basis of the written submissions only.

FACTS OF THE CASE

- 1 In an Infringement action lodged by AIM before the Helsinki Local Division, TGI filed a Preliminary objection, arguing that the UPC did not have jurisdiction to hear the case. By decision of 20 October 2023, the Local Division allowed the Preliminary objection and dismissed the Infringement action lodged by AIM.
- 2 By decision issued on 12 November 2024 (APL_596007/2023, UPC_CoA_489/2023), the Court of Appeal set aside this decision of the Local Division and referred the action back to the Helsinki Local Division.
- 3 After hearing the parties, the Local Division ordered that AIM would be allowed to file a R. 263 RoP application for leave to change claim or amend case by 8 January 2025 (ORD_61534/2024).
- 4 The Local Division also ordered that, as TGI had not yet filed a Statement of defence, TGI shall have three months (based on R. 23 RoP) to lodge their Statement of defence after the content of the Statement of claim would have been determined in the order on the R. 263 RoP application.

- 5 AIM filed a R. 263 RoP application and, as an appendix to the application, an amended Statement of claim, highlighting all the changes made compared to the original one and also a clean amended Statement of claim. In addition, AIM filed a (due to CMS requirements (also separate) submission concerning grounds for the acceptability of adding a new defendant pursuant to R. 305 RoP.
- 6 TGI requested that all of AIM's requests be dismissed as inadmissible and/or unfounded.

The impugned orders

1. In the impugned orders, the Local Division granted the requested leave to change claim and amend case, and also accepted TGI Sport Virtual UK Limited (hereinafter TGI UK, and together with TGI: the defendants) to be added as a defendant to the case, based on alleged infringement of that defendant in the German territory. As a consequence of the allowed amendments, the measures requested by AIM now also (further) cover the German territory as well as the Spanish territory, and are also based on infringement by equivalence and liability of the defendants as an intermediary.
2. The Local Division referred to R. 263 RoP, as interpreted by the Court of Appeal in its decision of 21 November 2024 (UPC_CoA_456/2024, APL_44633/2024), and to R. 305 RoP and, insofar as relevant, gave the following summarised reasons for its orders:
 - a. R. 263 RoP only requires that the amendments are explained in the application; changes may be presented in detail in an appendix to the application.
 - b. TGI UK is alleged to infringe the patent in suit in Germany, jointly with the other defendants, based on the same patent and the same products of TGI. If the adding of a new party would be denied, it would always be possible for the claimant to initiate separate proceedings against TGI UK either in the UPC or other courts. If such a separate case would be initiated before the UPC, joining the cases would be very likely and adding the new party furthers procedural economy. Regardless of where such a case would be filed, the aim to avoid the risk of irreconcilable and inconsistent decisions favours allowing adding a party at this stage.
 - c. The reason for adding Germany follows from the fact that TGI UK is alleged to infringe the patent in suit in Germany, jointly with the other defendants. This assertion is based on a draft agreement which AIM asserts it did not have knowledge of at the time of the lodging of the original Statement of claim or the oral hearing in September 2023.
 - d. Under the specific circumstances of the case, where AIM has requested to amend the Statement of claim at a stage where the case is about to restart basically from the beginning and the defendants are given the full three months (based on R. 23 RoP) to lodge their Statement of defence, the frontloaded nature of the proceedings is protected and the defendants' right to defence is not compromised.
 - e. Even though AIM was aware of (alleged) infringements in Spain, adding the territory of Spain should be accepted. If it would be refused, AIM could initiate new proceedings in the UPC or other courts. The same reasons of avoiding the risk of irreconcilable and inconsistent decisions and procedural economy apply.
 - f. The addition of infringement by equivalence does not fall under the scope of R. 263 RoP.
 - g. AIM Sports' new alternative claim that certain defendants should be considered intermediaries if they are not considered infringers is based on same acts and the same patent and similar considerations apply as with respect to a new claim based on infringement by equivalence.
 - h. Further changes are either allowed because they refer to actions during years 2023-2024 or because they do not fall under R. 263 RoP.

Appeal proceedings

3. TGI appealed the Order.

PARTIES' REQUESTS

4. In summary, TGI requests that the Court of Appeal
 1. set aside the impugned orders of the Court of First Instance in full, or in the alternative: in part;
 2. dismiss the application for leave to change claim and amend the Statement of claim in full, or in the alternative: in part;
 3. if the Court of Appeal would render a cost decision, order that AIM bear the costs of the appeal proceedings.
5. AIM requests that the appeal be dismissed and, in the alternative, that the impugned orders be upheld in part and, in the event the Court of Appeal would issue a cost decision, order that TGI bear the costs of the appeal proceedings.

PARTIES' SUBMISSIONS

6. TGI submits in summary and insofar as relevant:
 - a. AIM's requests are inadmissible because they don't refer to specific amendments, but refer to a new version of the Statement of claim with changes, submitted as annexes (one with tracked changes and one clean version). This is contrary to the principle underlying Art. 76 UPCA. A request that exclusively sets out the applicant's scope of requests in annexes is detrimental to procedural efficiency and legal certainty.
 - b. The application is inadmissible because it lacks a properly substantiated explanation why all the requested changes or amendments were not already included in the original pleading. This applies in particular to the amendments requested by AIM with respect to adding TGI UK as a defendant and the extension of the territorial scope of its request to Germany.
 - c. AIM must have been aware of the involvement of TGI UK in the allegedly infringing acts before the original Statement of claim was filed. AIM failed to provide evidence when it became aware of its involvement.
 - d. When deciding on the request to add TGI UK as a new party under R. 305 RoP, procedural efficiency and the interests of the parties were not properly considered, in view of the advanced stage of the proceedings. There is no re-start of the proceedings, in view of the decision of the Court of Appeal on the Preliminary objection, to which the Local Division and parties are bound (R. 243.2 RoP).
 - e. The order does not determine the extent to which TGI UK is bound to the current proceedings, which is mandatory under R. 306.2 RoP. This violates the procedural rights of TGI and of TGI UK, who was not heard in the previous appeal proceedings on the preliminary objection.
 - f. Allowing the German territory to be covered in these proceedings would increase a risk of irreconcilable and inconsistent decisions in view of the decision of the Munich Higher Regional Court in parallel national proceedings. A potential risk of irreconcilable decisions should not have played a role to the detriment of TGI, as AIM created this risk by initiating UPC and national proceedings in parallel.
 - g. It is uncontested that the Spanish territory could have been added much earlier. As R. 263.2(a) is not fulfilled, leave to extend the claims to this territory shall not be granted. There is no exception as regards the applicability of R. 263.2 (a) RoP in case of a referral back to the Court of First Instance.

- h. The CJEU decision in *BSH vs. Electrolux* does not provide a basis for late-filed amendments of a case. Adding Spain may lead to a decision to stay and thus would prolong the proceedings.
 - i. Allowing AIM to file an amended Statement of claim after they have seen the arguments brought forward in the Statement of defence of TGI in the preliminary measures case (that was originally lodged by AIM in parallel to the proceedings on the merits) would give AIM an unwarranted advantage.
7. AIM, in summary and in essence submits:
- a. R. 263.1 RoP only requires that an applicant explain why such change or amendment was not included in the original pleading. It does not prohibit that the actual changes or amendments are contained in an exhibit. Neither does it create an undue burden if not all changes would be accepted.
 - b. TGI UK did not appeal the impugned orders. TGI does not have a legal interest in the appeal as their case is not adversely affected by the addition of a new defendant.
 - c. It was efficient to add TGI UK as a defendant, because otherwise a new case against TGI UK would need to be filed, which case would either need to be joined with this case or would create a risk of irreconcilable decisions.
 - d. It is clear from the Statement of claim to what extent TGI UK will be bound and may be held liable.
 - e. The acts of infringement of TGI UK took place in Germany, which serves as the justification for the additional claims for the German territory.
 - f. AIM was not aware of the involvement of TGI UK pursuant to the draft agreement for the offering and providing services to FC Bayern München AG; TGI does not deny that TGI UK was in fact involved in supplying systems accused of infringement to FC Bayern München and was aware of it, but failed to disclose this after AIM had mentioned the TGI Group's supply of services to FC Bayern München in general terms in its written submissions ahead of the oral hearing in September 2023.
 - g. No *lis pendens* issue between the German national proceedings and these UPC proceedings is created by adding TGI UK as a defendant. TGI UK is not a party to the German national proceedings.
 - h. A permanent injunction for the territory of Spain had initially not been considered in view of established case law since *GAT v LuK* (C-4/03), but were added as a result of the two opinions of AG Emiliou of 22 February 2024 and 5 September 2024 in *BSH v Electrolux* (C-339/22), later followed by the CJEU in its decision of 26 February 2025, under which the UPC's jurisdiction in relation to infringement is no longer blocked if an invalidity defence is raised.
 - i. The equivalence claim and asserted liability as intermediaries are outside the scope of R. 263 RoP and based on facts that occurred after the original Statement of claim.
 - j. Rule 263.2 RoP expressly requires that all circumstances be considered. The fact that the amended Statement of claim serves as a new start for the proceedings and the new approach to Art. 24(4) Br. Ia Regulation are such circumstances.
 - k. It is in accordance with the front loaded nature of UPC proceedings that AIM added relevant facts when it became aware of them, to enable the Court to address all of the relevant facts and allegations in one proceeding, instead of engaging in separate proceedings for closely connected and inter-related cases.
 - l. TGI is not unreasonably hindered in the conduct of their action since they are given the full three months for their defence foreseen in R. 23 RoP.

GROUNDS:

8. The appeal is admissible but unsuccessful.

Admissibility

9. TGI's appeal is admissible. It cannot be accepted, as AIM submits, that TGI is not adversely affected by the addition of TGI UK as a defendant. The requested joint liability of all defendants makes TGI also accountable for the infringing acts committed by TGI UK.

Legal framework, discretion of the Court

10. The Local Division has set out the legal framework for requests under R. 263 and R. 305 RoP in par. 34 – 38 of the impugned order of 11 February 2025, with which the Court of Appeal agrees. There is no need to repeat that here.
11. When applying R. 263 and R. 305 RoP, the Court of First instance has discretion. The scope for review on appeal is consequently limited. The Court of Appeal is of the opinion that TGI failed to establish that the Local Division went beyond the boundaries of its discretion and could not reasonably have reached the decisions in the impugned orders.

Reasoning in R. 263 RoP application

12. R. 263 RoP requires that the application shall explain why a requested change or amendment of case was not included in the original pleading. This means that the *reasoning* must be included in the application. It does not prohibit that the precise wording of the requested amendment is set out in one or more annexes, such as amended Statements of claim with and without tracked changes. The Court of Appeal fails to see why this would be unclear or unduly burdensome. To the contrary, it makes clear beyond any doubt how the requested changes are formulated in the amended Statement of claim. This furthers legal certainty, and it is also efficient should the request be allowed, as no further drafting of a Statement of claim incorporating the allowed amendments is required and the clean amended draft can be served immediately as the final Statement, which was indeed done in the present proceedings. If the request would be allowed only in part, the Local Division can easily and without undue burden deal with this by striking out the refused amendments and approving the remainder.
13. TGI's argument that the addition of the Germany territory was not explained in the application was rightly rejected by the Local Division, by considering that this was sufficiently explained by AIM when stating that the new defendant's actions occurred in Germany. TGI has rightly not argued that it had not understood this when reading the application.

The addition of TGI UK as a new defendant

14. When dealing with a request to add a person as a party under R. 305 RoP, when considering the interests of the parties and procedural efficiency, among the circumstances that the Court may take into account are: whether the claimant was or should have been aware of the alleged infringing acts of such a person at an earlier stage, the involvement of the other parties with that person's allegedly infringing acts, the effect on the other parties if the party is added as a party and the stage of the proceedings. The level of the duty of presentation and proof of such circumstances is lower when dealing with a request under R. 305 RoP than when dealing with the case on the merits. The weighing of the evidence provided, the weighing of the relevant circumstances and of the interests of the parties and procedural efficiency is at the discretion of the Court.
15. The Local Division took into account the evidence presented by the parties and rightly considered the relevant circumstances that TGI UK is a company belonging to the same group as TGI, that the alleged infringements by TGI UK were allegedly performed jointly with TGI, based on the same patent, the same products and the same facts that were already presented by AIM prior to the oral hearing in September 2023, and that TGI was well aware of the allegedly infringing acts of TGI UK.

The Local Division also considered the possibility that if the request would be denied, AIM would lodge separate proceedings against TGI UK, with the result that there would be a risk of irreconcilable and inconsistent decisions and – if lodged before the UPC – the issue of joining the cases based on R. 340 RoP would emerge.

16. Considering the above, the Court of Appeal is of the opinion that the Local Division properly balanced the interests of all parties and procedural efficiency. TGI failed to convincingly substantiate that by allowing the addition of TGI UK the Local Division went beyond the boundaries of its discretion.
17. As also considered (in par. 19) below, the stage of the present proceedings cannot be considered to be 'advanced' and certainly not so advanced that this in itself should have tipped the balance in favour of rejecting the request to add TGI UK as a party.
18. The Local Division rightly took into account a potential risk of irreconcilable decisions if the request would be rejected, and AIM had to initiate separate proceedings against TGI UK. The already pending national proceedings between AIM and other TGI entities before a national court in Germany, which AIM asserts were already pending before it became aware of the involvement of TGI UK, does not alter that. It does not take away the risk of yet further parallel proceedings and ensuing consequences.

The extent to which TGI Sport Virtual UK Limited is bound to the current proceedings

19. At the time the impugned orders were issued, the current proceedings did not consist of more than the original Statement of claim and the Preliminary objection, which was allowed by the Local Division, but on appeal rejected by the Court of Appeal and the case referred back to the Local Division. The Local Division was right in considering that when TGI UK was added as a party, with the leave to change the Statement of claim was granted at the same time, and by allowing the defendants the full three months period foreseen in R. 23 RoP for lodging their Statement of defence, the case in essence restarted. As such, there was nothing to consider in order to determine the extent to which TGI UK was bound by the proceedings as then constituted. The fact that, once the case was referred back to the Local Division, the *Court* is bound by the decision of the Court of Appeal does not make that any different.
20. In any event, it cannot be seen that the procedural rights of TGI have been violated in this respect at all.

The amendment could not have been made at an earlier stage

21. In the opinion of the Court of Appeal, the Local Division also could rightly conclude that the requirements of R. 263.2(a) RoP, that the allowed amendments could not have been made with reasonable diligence at an earlier stage, was complied with.

Germany

22. As for Germany, this decision could reasonably be reached based on the arguments, circumstances and evidence before the Local Division as mentioned in par. 15 above.

Spain

23. Where Spain is concerned, even though it was not impossible, under the established case law following the CJEU decision in *GAT v Luk (C-4/03)* it could not have been expected from AIM to include this non-UPC territory in the original Statement of claim in the proceedings on the merits. It is fair to consider that AIM could not have done so with reasonable diligence at that stage. It is equally fair to consider that the anticipated change of this case law in view of the opinions of AG Emiliou, published

after the original Statement of claim, was a relevant circumstance that justified adding the Spanish territory to the requested measures.

24. The possibility that also under the new case law of the CJEU adding the territory of Spain might lead to a decision to stay and possibly (but not necessarily – as the case could be continued with respect to the other territories involved) lead to a delay of the proceedings, must be balanced against the risk that AIM would start separate proceedings in relation to the Spanish territory and the ensuing potential risk of irreconcilable decisions. The Local Division has discretion to balance these risks and TGI has not convincingly substantiated that and why the Local Division could not reasonably have come to its decision.

Other

25. TGI did not bring forward sufficiently substantiated specific objections against the further amendments that were based on the addition of TGI UK as a party and on the extension of territorial scope to German and Spain as well as some other amendments based on the passage of time of over a year since the oral hearing in September 2023. Insofar as TGI objects to those amendments on the same grounds as brought forward in relation to the amendments mentioned above, these objections must be rejected for the same reasons.

The amendments regarding infringement by equivalence and as intermediaries

26. The Local Division rightly considered that, in view of the Court of Appeal order of 21 November 2024 in UPC_CoA_456/2024, APL_44633/2024, not all new arguments have to be regarded as a change of claim as meant in R. 263 RoP, in particular when the claims are still based on the same acts and the same patent. In view thereof, TGI failed to substantiate why the Local Division was wrong when deciding that the claimant should be allowed to also argue – based on the same patent and the same alleged infringing products and acts – infringement by equivalence as well as the alternative liability of TGI and TGI UK as intermediaries in case they are held not to infringe.
27. Even if R. 263 RoP were to apply to these amendments, the requirements thereof would be met. The equivalence arguments were added in view of the claim construction by the German national court on the same patent in parallel proceedings against other TGI entities in its decision that was rendered after the oral hearing in September 2023. The intermediary arguments were added in view of the new group structure of the TGI companies that also occurred thereafter. TGI has not convincingly substantiated that either of these events should have been reasonably anticipated at the time of lodging of the original Statement of claim.

No unreasonable hinderance of the defendants in their conduct of their action

28. The Local Division rightly considered that due to the fact that the Statement of claim was amended before the Statement of defence was lodged at the initial start of the case in 2023 and the defendants were given the full three months (based on R. 23 RoP) to lodge their Statement of defence, the case basically restarted from the beginning and there was no hindrance of the defendants in the conduct of their action.
29. The Court of Appeal fails to see why allowing the requested amendments would be contrary to the front loaded nature of the proceedings, as TGI submitted. Quite to the contrary, it is consistent with the front loaded nature of the proceedings that the amended Statement of claim stage already takes into account the facts and arguments known to AIM at this restarted phase of the proceedings. In addition, it serves procedural efficiency since it prevents that separate proceedings need to be initiated with all associated disadvantages.

30. It is also under the present circumstances not to the disadvantage of the defendants to allow these amendments, even considering that a Statement of defence was already lodged by TGI in the (now withdrawn) preliminary injunction proceedings that AIM originally lodged in parallel to the proceedings on the merits. Allowing AIM to anticipate on the arguments brought forward in that Statement in the proceedings on the merits allows that the case can be argued in the full two rounds of written documents. The Court of Appeal fails to see how that could be to the disadvantage of the defendants, as TGI submits.

Costs

31. This order does not conclude the action. The Local Division shall decide which party shall bear the costs of the proceedings, including these appeal proceedings.

ORDER:

The appeal is dismissed.

This order was issued on 11 April 2025

Rian Kalden, presiding judge and judge-rapporteur

Ingeborg Simonsson, legally qualified judge

Patricia Rombach, legally qualified judge