



Lokalkammer München
UPC_CFI_298/2023

Revised Order
in the proceedings before the
Court of First Instance of the Unified Patent Court
delivered on 13/01/2025

CLAIMANTS

- 1. 10x Genomics, Inc.**
- 2. President and Fellows of Harvard College (“Claimant 2”)**

represented by: Tobias Wuttke

DEFENDANTS

- 1. NanoString Technologies Inc.**
- 2. NanoString Technologies Germany GmbH**
- 3. NanoString Technologies Netherlands B.V.**

represented by: Oliver Jan Jüngst

Summary of facts

On August 19th 2024 Claimant 2) filed **55 auxiliary requests** within the application to amend the patent at issue. In this application Claimant 2) asks for allowance to limit the number of auxiliary requests *at a later stage*, if the panel considers it absolutely necessary to limit the number of auxiliary requests.

In the parallel opposition proceedings before the EPO the oral proceedings are scheduled already for March 18-20, 2025. The parties have agreed that the proceedings are stayed until the decision of the Opposition Division of the EPO.

Defendants requested to

I. ex parte – suspend Defendant’s deadline for the “Defence to the Application to amend the Patent” pending the Court’s final order on the requests II-V below;

II. dismiss the application to amend the Patent in its entirety as inadmissible;

alternatively,

III. that Patentee is ordered to reduce the number of auxiliary requests to a reasonable number, (“revised application to amend the Patent”) whereby

a. the allowable quantity is determined by the Court

b. each auxiliary request on file in the UPC case is on file in the EPO opposition of the Patent and/or dependent on an auxiliary request on file in the EPO opposition of the Patent;

c. the Defendants’ 2-month period to file a response to the revised application to amend the Patent begins once Defendants have been served with said revised application to amend the Patent;

in the further alternative,

IV. to determine the deadline for the submission of Defendants’ defence to the application to amend the Patent at two months after the first instance decision of the EPO in the parallel opposition proceedings and the filing of reasonable auxiliary requests by Patentee in the UPC workflow;

in the furthest alternative,

- V. to set a harmonized deadline for the three submission of Defendants' (1) rejoinder to the reply to the statement of defence, (2) reply to the defence to the counterclaim and
 - (3) defence to the application to amend the Patent at two months after
 - (a) the first instance decision of the EPO in the parallel opposition proceedings and
 - (b) the filing of reasonable auxiliary requests by Patentee in the UPC workflow for the application to amend the Patent.

Claimant 2) requested to reject defendants requests. With orders dated October 14th 2024 (ORD_51811/2024; ORD_51812/2024; ORD_51813/2024) the judge-rapporteur decided as follows:

- 1. The proceedings CC_592964/2023, CC_593069/2023, CC_593060/2023 and the corresponding applications to amend the patent are stayed as of today.
- 2. The stay shall end at the date of the decision of the Opposition Division of the EPO concerning the patent at issue.
- 3. Claimant 2) is ordered to reduce the number of auxiliary requests to a one-digit number. Deadline: 20 days after the decision of the Opposition Division of the EPO.
- 4. The Defendants' 2-month period to file a response to the revised application to amend the Patent begins once Defendants have been served with said revised application to amend the Patent.

In his reasoning the judge-rapporteur in accordance with Rule 30.1 (c) considered it necessary to limit the number of auxiliary requests to a one-digit number.

In view of section 3 of this order **Claimant 2)** with application dated October 29th 2024 made the following **requests**:

- A. The orders ORD_51811/2024; ORD_51812/2024; ORD_51813/2024 of the judge-rapporteur in the proceedings UPC_CFI_298/2023 of October 14,

2024 is reviewed by the panel in so far as it concerns the reduction of the number of auxiliary requests (no. 3 of the order).

- B. The auxiliary requests filed with the application to amend the patent on August 19, 2024 by Claimant 2) in the corresponding workflows 45714/2024, 45719/2024, 45724/2024 are allowed into the proceedings.
- Ba. In the alternative, the auxiliary requests filed with the application to amend the patent on August 19, 2024 by Claimant 2) in the corresponding workflows 45714/2024, 45719/2024, 45724/2024 are allowed into the proceedings to the extent that they are subject to the parallel proceedings before the European Patent Office at the time of the decision of the Opposition Division.
- Bb. In the further alternative, leave to appeal be granted.

Claimant 2) is of the opinion that the reasonable number of auxiliary requests cannot be determined in an abstract, general way. Rather the assessment must take into account the specific circumstances of the case at hand. In the view of Claimant 2) the number of auxiliary requests in this specific case is reasonable due to the fact that Claimant 2) in the revocation proceedings is confronted with a total 42 validity attacks. In view of this the number of individual amendments would be manageable. For reasons of fairness and flexibility Claimant 2) must be allowed to make the auxiliary requests in their entirety from the EPO proceedings or from other parallel proceedings the subject matter of the present proceedings. Otherwise, Claimant 2) might be prevented from defending at all in the present counterclaim for revocation the patent in suit in a version examined by the EPO in the opposition proceedings and considered to be valid. Since in the UPCA and the RoP the relevance of opposition proceedings before the EPO for the course of proceedings before the UPC is recognized, it would be absurd to suspend proceedings before the UPC with regard to parallel opposition proceedings or even to consider a suspension if an auxiliary request which is the

subject of discussion before the EPO could no longer be introduced into the UPC proceedings due to the independence of the respective proceedings.

Defendants request as follows:

- I. Dismiss the request for review in each case App_58910/2024; APP_58913/2024; APP_58916/2024

and

therewith to confirm item No. 3 of the respective orders (ORD_51811/2024; ORD_51812/2024; ORD_51813/2024) dated October 14, 2023, issued by the Judge Rapporteur.

In the alternative,

- II. if the Local Division should decide to alter the orders referred to under time I to

1. dismiss the application to amend the Patent in its entirety as inadmissible, i.e. to find that zero (“0”) auxiliary requests are allowable

in the further alternative

2. order Patentee to reduce the number of auxiliary requests to a reasonable number, (“revised application to amend the Patent”) whereby

- a. the allowable quantity is determined by the Court
- b. each auxiliary request on file in the UPC case is on file in the EPO opposition of the Patent and/or dependent on an auxiliary request on file in the EPO opposition of the Patent.

- III. Dismiss the request for leave to appeal (item Bb. in each of App_58910/2024; APP_58913/2024; APP_58916/2024).

The defendants raise the question why Claimant would have expected to be allowed 55 auxiliary requests in the present case if the EPO already clearly named 53 auxiliary requests “excessive”. In the opinion of the defendants the number of 55 auxiliary

requests contradicts the UPCA and the RoP seeking streamlined and balanced proceedings.

In detail, reference is made to the written submissions of the parties.

Reasons

I. Adjustment of auxiliary requests after the decision of the EPO Opposition Division is rendered

As requested by the parties, the judge-rapporteur ordered to stay the proceedings CC_592964/2023, CC_593069/2023, CC_593060/2023 and the corresponding applications to amend the patent until the date of the decision of the Opposition Division of the EPO concerning the patent at issue. The parties have not raised any objections to this.

Obviously, in view of the state of the proceedings both the judge-rapporteur and the parties consider it appropriate to await the first-instance decision of the Opposition Division of the EPO. In view of the parallel invalidity proceedings before the UPC and the EPO, this is an appropriate course of action.

However, this can only mean that the decision of the Opposition Division of the EPO should not only be taken note of in the present proceedings. Otherwise, the present proceedings could have been continued independently of the outcome of the first-instance proceedings before the EPO. However, if the outcome of the proceedings before the EPO is to be reflected and taken into account in the present proceedings and therefore the present proceedings were ordered to stay, it must be possible for Claimant 2) to adjust his auxiliary requests in the present proceedings according to the decision of the Opposition Division. Claimant 2) therefore correctly pointed out that it would be absurd to stay proceedings before the UPC with regard to parallel EPO opposition proceedings if an auxiliary request which is the subject of discussion before the EPO could no longer be introduced into the UPC-proceedings. The Judge-rapporteur therefore was right to give Claimant 2) the opportunity to adjust his auxiliary requests within 20 days

of the decision of the Opposition Division being rendered and in consideration of that decision.

It remains to be seen whether and how Claimant 2) will adjust its auxiliary requests after the decision of the Opposition Division.

II. Number of auxiliary requests

Insofar as the Judge-rapporteur has ordered to reduce the number of auxiliary requests to a one-digit number, the order must be modified.

1. As correctly stated by the Central Division Paris (UPC_CFI_255/2023, ACT_551308/2023), the reasonable number of auxiliary requests depends in particular on the scope of the counterclaim for revocation. Also if the panel considers the number of 55 auxiliary requests to be exceptionally high, potentially hindering the efficiency of the 'UPC' proceedings and the goal of delivering expeditious decisions, it does not appear that that number is 'unreasonable', considering the extreme complexity of the case (in particular, the number of grounds of invalidity raised), the importance of the patent at issue and the interrelationship with other proceedings, both judicial and administrative.

The principle of fairness (Art. 42 UPCA) and thus the possibility to defend oneself against all attacks brought forward with the counterclaim also applies to the defendant of the counterclaim.

2. At present, it is not possible to foresee upon which requests the Opposition Division will decide. However, the proceedings and the decision of the Opposition Divisions is one of the circumstances that will have to be taken into account under Rule 30.1 (c) RoP with regard to the reasonable number of auxiliary requests.

Therefore, it is not possible at this stage to assess what number of auxiliary requests will ultimately be considered reasonable. This question must remain unanswered for the time being. In view of the numerous attacks brought forward in the counterclaim, a high number of auxiliary requests will

not categorically be considered to be unreasonable in number. Auxiliary requests, which are subject to the parallel proceedings before the European Patent Office at the time of the decision of the Opposition Division will be allowed also within the present proceedings.

However, the number of auxiliary requests to be considered reasonable in number may affect the time limit for replying to the auxiliary requests. In this context, however, it will be necessary to consider the extent to which the parties have already had the opportunity, in the course of the proceedings before the Opposition Division, to respond to the arguments of the other party. In view of this, also a shortening of deadlines has to be considered.

3. In the event that there are any amendments in view of the proceedings and the decision of the Opposition Division, Claimant 2) is asked to submit a uniform (consolidated) version of the auxiliary requests including the grounds. For ease of use, a writ with the function to be able to jump directly from the table of contents to the relevant auxiliary request with a single click would be advantageous.

For these reasons, Panel 1 of the Munich Local Division, composed of the presiding judge Dr. Zigann and the legally qualified judges Kupecz and Pichlmaier modifies section 3 of the order dated October 14th 2024 as follows:

“3. Claimant 2) is ordered to submit his auxiliary requests within 20 days after the decision of the Opposition Division of the EPO.”

Dr. Zigann Presiding Judge	
Pichlmaier Judge-Rapporteur	
Kupecz Legally qualified judge	

INFORMATION ON THE APPEAL

An appeal against the present decision may be lodged with the Court of Appeal within 15 days of service of the Court's decision (Art. 73(1) UPCA, 220 (2) RoP).