



Action n°: UPC 526/2024  
ACT\_51533/2024  
Revocation action

**Order**  
**of the Court of First Instance of the Unified Patent Court**  
**Central Division (Section Munich)**  
**issued on 18 April 2025**

CLAIMANT

**Kunststoff KG Nehl & Co.**, Stresemannstraße 30-34 - 32257 - Bünde - DE.

represented by: Hannes Jacobsen, CBH Rechtsanwälte, Ismaningerstr. 65a - 81675 – München - DE.

DEFENDANT

**Häfele SE & Co. KG**, Adolf-Häfele-Straße 1 - 72202 - Nagold - DE.

represented by: Ulrich Blumenröder, Grünecker Patent- und Rechtsanwälte PartG mbB, Leopoldstr. 4 - 80802 - München - DE.

PATENT AT ISSUE

European patent EP 3 767 151.

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. Case Management Order.

## FACTS AND REQUESTS

The Claimant has brought a revocation action before the Unified Patent Court ('UPC'), the Central Division, section Munich, in relation to European patent EP 3 767 151 ('the Patent').

The Claimant argues that:

- a) the subject-matter of all claims of the Patent is not patentable, in particular is not new or does not involve an inventive step (Art. 65 (2) UPCA, Art. 138 (1), 100 a) EPC),
- b) The Patent does not disclose the invention clearly and completely enough to enable a person skilled in the art to carry it out (Art. 65 (2) UPCA, Art. 138 (1), 100 b) EPC),
- c) The subject-matter of the Patent extends beyond the content of the application as originally filed and, since the Patent is based on a European divisional application, beyond the content of the earlier application EP 3 055 603 as originally filed (Art. 65 (2) UPCA, Art. 138 (1), 100(c) EPC),

and on these grounds requests that the Central Division in accordance with Art. 65 (2) UPCA:

1. revokes European Patent EP 3 767 151 B1 entirely.
2. The Defendant shall bear the legal costs incurred by the Claimant.

The Defendant in its defence requests that:

1. The claim for revocation is dismissed.
2. The plaintiff bears the costs and expenses of the proceedings.

In an auxiliary way, the Defendant requests:

1. As auxiliary requests 1 to 40 to maintain the patent in amended form on the basis of the claim sets attached as Exhibit I (first auxiliary request to 40th auxiliary request)
2. As auxiliary requests 41 to 80 to maintain the patent in amended form on the basis of the apparatus claims only contained in the claim sets attached as Exhibit I for the first auxiliary request to the 40th auxiliary request.

In defence to the application to amend the patent, the Claimant submits that the application to amend the patent is inadmissible and unfounded on various grounds and maintains that the Patent should be revoked in full.

The written pleadings in accordance with Rule 43 RoP have been exchanged, the Rejoinder to the reply to the defence to the application to amend ('RA') was the last pleading, submitted by the Claimant on 17 April 2025.

## ORDER

In preparation for the further course of this action, having responsibility for the management of this case, to that end making use of his case management powers as laid down in Chapter 8 of the Rules of Procedure ('RoP'), after having consulted with the other members of the panel, the judge-rapporteur gives the following directions.

### *Value of the case and costs*

The Claimant has assessed the value of the proceedings at EUR 500.000. The Defendant has not contested the value of the proceedings as assessed by the Claimant. As the value of the proceedings in a (stand-alone) revocation action is only relevant for the determination of the ceiling of recoverable costs, the Claimant's (uncontested) valuation appears acceptable. In accordance with the table of ceilings for reimbursable costs depending on the value in dispute as published by the Administrative Committee (24 April 2023 as D-AC/10/24042023\_D), the ceiling corresponding to a value of EUR 500.000 would be set at EUR 56.000.

Parties may submit, in advance of the decision at the oral hearing, by way of Rule 9 RoP application, a preliminary estimate of the legal costs that they will seek to recover, until **21 May 2025**.

Parties are, notwithstanding the above, encouraged to find agreement on the amount of costs that is deemed reasonable and proportionate and/or on how to allocate costs depending on the outcome of the case. The Court will, in principle, respect an agreement between the parties in this respect.

A final decision will, if necessary, be taken by the panel after hearing the parties at the oral hearing.

### *Auxiliary requests*

The Defendant has filed proposed amendments by way of 40 sets of claims ('auxiliary requests') – in two alternative forms, so 80 in total – in the context of a (conditional) application to amend the patent. Pursuant to Rule 50.2 RoP in connection with Rule 30.1 and 30.2 RoP, conditional proposals to amend the patent must be reasonable in number given the circumstances of the case. Claimant is of the opinion that the auxiliary requests relied upon by the Defendant are of an unreasonably high number and therefore do not satisfy these requirements.

In order to determine whether the number of proposals conditionally submitted is reasonable, the Court must weigh all the relevant circumstances of the case and the interests of the parties.

In the present case, the proposals made by the Defendant (40 auxiliary requests, times 2) are not deemed reasonable in number given the circumstances of this case. The arguments provided by the Defendant explaining the high number of requests are not convincing. The fact that there are multiple proceedings ongoing in relation to the Patent, as well as other patents in the same family, and that different deciding bodies may arrive at different outcomes on substantive issues is not decisive for the number of auxiliary requests that is considered reasonable in the present revocation action, where the panel, independently of the outcome of and decisions in other proceedings, has to decide on the basis of the facts and arguments brought forward by the parties in these proceedings. In addition, in the meantime, these other proceedings have developed

further so that the Defendant should be in a better position to identify which of the auxiliary requests are relevant (which was also suggested by the Defendant in its Reply to the defence to the application to amend). In any event, the Court cannot see how the multitude of proceedings justifies 40 (times 2) auxiliary requests. The large number of features of the claims of the Patent, which was drafted and prosecuted to grant by the Defendant itself, is – without further explanation, which is lacking – also not a justification of the number of auxiliary requests currently relied on, especially taking into account the (limited) complexity of the technology involved. The number of prior art documents and individual validity attacks is also not so numerous as to warrant 40 (times 2) auxiliary requests.

Furthermore, the Defendant has, in response to the Claimant's objections that the auxiliary requests are not convergent, rightfully replied that there is no general rule requiring "convergence" of auxiliary requests in UPC proceedings. However, this does not mean that the way the requests are presented and structured is not relevant for determining what a reasonable number of requests is and/or for the way these proceedings are conducted. The Court agrees with the Claimant that there is no clear structure or hierarchy in the auxiliary requests comprising different combinations of features Aux1-Aux18, as presented by the Defendant. This makes it unduly difficult for the Claimant and the Court to prepare the case for the oral hearing.

In conclusion, the number of proposed amendments is not considered reasonable given the circumstances of this case. The number of auxiliary requests and the way in which these are presented makes it unreasonably difficult for the Claimant to focus its arguments against the auxiliary requests and for the Court to prepare the oral hearing.

Although the RoP are clear in that the proposed amendments must be reasonable, the sanction in case this requirement is not met, is not made explicit. In the view of the Court, it would be unreasonable and too far-reaching – also in view of Article 65(3) UPCA – to reject the application to amend altogether (cf. CD Paris seat, decision of 5 November 2024, case CFI 309 /2023, *NJOY/Juul Labs*, par. 9.4). Instead, the Court intends to deal with the auxiliary requests, in the event that these would become relevant, in the order they have been submitted until a reasonable number has been reached. In view of the circumstances of this case, which include the number of validity attacks on the patent, the technology involved and which – for the benefit of the Defendant – still gives room to take into account the developments in related proceedings, a number of auxiliary requests of up to 10 will in all likelihood still be considered as reasonable by the Court.

In view of the above considerations, in order to streamline the proceedings and to facilitate preparations for the oral hearing, the Defendant is hereby given the opportunity to limit and/or re-order its proposed amendments, which will ensure that the fall-back positions considered most relevant by the Defendant will be given due consideration by the Court. The Defendant may do so until **7 May 2025** by responding to this order. The Court notes that the Defendant's submission is to be strictly limited to narrowing down the number of auxiliary requests and/or re-ordering the auxiliary requests. As the Claimant has already had the opportunity to set out its full case against all of the auxiliary requests originally filed in the context of the exchange of pleadings in the application to amend, the Claimant is not procedurally harmed by proceeding in this way nor is it necessary to hear the Claimant on this issue at this stage. For the sake of completeness, the Court notes that the further objections made by the Claimant to the (admissibility and allowability of the) auxiliary requests will, in the event these were to become relevant, be decided on after hearing the parties at the oral hearing.

### *New inventive step attack on the basis of Document D16*

In the Reply to the defence to revocation, the Claimant has raised an additional inventive step attack based on prior art document D16 (Exhibit CBH16). Document D16 was already introduced with the Statement for revocation. The Defendant objects to this attack as being late-filed and requests that the arguments are disregarded in accordance with Rule 9.2 RoP.

Leaving aside the question of whether raising a new validity attack against the Patent in the Reply to the defence to revocation based on a document that was already submitted with the Statement for revocation is to be considered as an amendment of the Claimant's case in the sense of Rule 263 RoP (which can certainly be defended, cf. CD Paris in its decision dated 18 December 2024 in case UPC\_CFI\_454/2023, *Tandem Diabetes/Roche Diabetes*, par. 21 et seq.), in any event, in order to be allowable under the front-loaded regime of UPC proceedings, wherein parties have to set out their full case as early as possible in the proceedings (e.g. point 7 Preamble RoP), an explanation is required why the additional attack could not have reasonably been included in the Statement for revocation (cf. LD Paris in its decision dated 11 December 2024 in case UPC\_CFI\_395/2023, *DexCom/Abbott*, par. 68).

Contrary to the Claimant's position, the brief and generic statement in the Statement of revocation as to the "relevance" of D16 with reference to certain paragraphs and Figures of D16 is not an argument or invalidity attack. Further, the fact that the attack was „announced" in the submission dated 14 October 2024 in the parallel UPC (PI) proceedings (which submission is not part of the present proceedings), and thus was already known by the Defendant, does not justify introducing the attack in these proceedings as late as in the Reply dated 17 February 2025, thereby leaving the Defendant only one pleading for its defence to the new attack. To the contrary, it follows that apparently the Claimant had developed the arguments already in October 2024 and then waited 4 months before introducing them into these proceedings. No reasons have been presented or are apparent explaining why the new arguments were not and could not reasonably have been introduced in the Statement of revocation, let alone that justify waiting this long. Therefore, the Court is of the provisional opinion that the additional inventive step attack based on D16 could have and should have been introduced earlier. By introducing the attack this late in the proceedings, the Claimant moreover unreasonably hinders the Defendant's defence possibilities and the Court's preparations. The fact that the Defendant has responded to D16 in its Rejoinder to the reply to the defence to revocation ('R') does not change this.

As a consequence, the parties should expect that the new inventive step arguments based on D16, raised for the first time in the Reply to the defence to revocation, will be disregarded by the Court – regardless of whether Rule 263 or Rule 9.2 RoP applies.

### *RA*

It appears that the Claimant has used its last written pleading, the RA, to reply to the Defendant's R, see parts I-III up to page 23 of the RA, relating to claim construction, the additional inventive step attack based on D16 and further replies to Defendant's argumentation concerning the Patent as granted. The Claimant's explanation that "*certain aspects of the rejoinder to the reply of the plaintiff and the defendant's main request ... also effects the auxiliary requests the plaintiff's rejoinder to the defendant's reply in that regards*" is *prima facie* not convincing. Of course, the debate about the validity of the patent as granted can be relevant also for the auxiliary requests. However, in accordance with the RoP, the RA should be limited to the matters raised in the

Defendant's Reply to the defence to the application to amend (Rule 32.3 RoP, last sentence, which applies *mutatis mutandis*, see Rule 55 RoP). The purpose of the RA is therefore not to re-open the debate in relation to the patent as granted. The RoP foresee in a limited number of regular pleadings and the proceedings are front-loaded (also see above). A further exchange of pleadings may, to the discretion of the Court, be allowable upon a reasoned request by a party. Such a request has not been made by the Claimant, nor does the Court see any reasons why a further exchange of pleadings would be needed in this case (also see below).

Consequently, the parties should expect that the Court will disregard parts I-III up to page 23 of the RA, where the section "Re VI. Auxiliary Requests" starts.

*No further pleadings, closure of the written procedure and no interim conference (Rules 35, 36 RoP which apply mutatis mutandis, see Rule 58 RoP).*

Apart from the submissions referred to above, the Court does not see a need for any further exchange of pleadings at this stage. Given the elaborate exchange of pleadings to date and the further directions provided by way of this order, the panel also does not see a need to hold an interim conference. Furthermore, the judge-rapporteur intends to close the written procedure on **22 April 2025** and the interim procedure on **12 May 2025**. The parties are hereby informed accordingly.

### *Settlement*

The Court is aware that the parties are engaged in a number of proceedings in different fora. The UPC provisional measures proceedings between the parties at the LD Munich were decided in favour of the Claimant (in those proceedings the Defendant) on the basis of a weighing of interests in its favour. The panel of the LD Munich, however, also expressed the opinion (provisionally, in summary proceedings – this panel will of course make up its own opinion independently) that an infringement of the Patent was more likely than not, but that the validity of the Patent was doubtful (the novelty was found doubtful over D8 and D9, which prior art documents are also part of the present proceedings). In addition, the present UPC revocation action is pending in the first instance and may be followed by an appeal by any party adversely affected. This process will inevitably take time and cause significant costs for the parties. At first glance, and without any prejudice to the outcome of these proceedings whatsoever, it seems to the Court that this case may be suitable for a settlement out of court.

In order to facilitate a potential settlement of the dispute between the parties, the Court offers to keep the date and time scheduled for the interim conference (9 May 2025, 10.00 CET) for an informal discussion with the parties to explore if a settlement is within reach. The parties are requested to inform the judge-rapporteur at the latest on **2 May 2025, 10.00 CET** – by way of one e-mail sent on behalf of both parties to the sub-registry of the Central Division, section Munich (**contact\_munich.ctl@unifiedpatentcourt.org**) – whether there is any merit to having such an informal discussion. This is fully optional. In case the parties wish to make use of this possibility, they should make sure that at least one natural person on behalf each party with authority in relation to settlement matters is present at the conference which will – in principle – be held online. These persons are to be announced in the e-mail sent to the sub-registry.

### *The hearing*

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

**Wednesday 4 June 2025, 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 hearing will in principle be conducted in one day. At the beginning of the hearing, the Presiding judge will give a preliminary introduction to the action which may highlight the issues that the panel considers most relevant. The Presiding Judge may set time limits for the hearing and/or give further instructions.

If parties wish to make use of **visual aids** during the hearing (e.g. presentation slides), these may be sent by email to the sub-Registry (copying the other party) until **Wednesday 28 May 2025, 10.00 CET**. Any such materials may not contain any new facts or arguments and must be strictly based on the pleadings and exhibits already on file and should, where possible, contain references to the pleadings and exhibits.

18 April 2025  
KUPECZ  
Judge-rapporteur

### ORDER DETAILS

Order no. ORD\_18972/2025 in ACTION NUMBER: ACT\_51553/2024  
UPC number: UPC\_CFI\_526/2024  
Action type: Revocation Action