



EPG – Court of Appeal
UPC_CoA_297/2024
APL_32012/2024
App_52471/2024

ORDER

of the Court of Appeal of the United Patent Court

issued on 9 October 2024

concerning request for dismissal of grounds for appeal and request to submit new evidence

APPELLANTS (AND DEFENDANT IN THE MAIN PROCEEDINGS BEFORE THE CFI)

1. **SharkNinja Europe Limited**, Leeds, United Kingdom
2. **SharkNinja Germany GmbH**, Frankfurt am Main, Germany

1-2 represented by Attorney-at-law Wolrad Prinz zu Waldeck und Pyrmont, Advocate/Solicitor Dr. Christopher Stothers, Attorney-at-law Kilian Seidel and Attorney-at-law Caroline Horstmann (Freshfields Bruckhaus Deringer)

RESPONDENT (AND CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE CFI)

Dyson Technology Limited, Malmesbury, Wiltshire, United Kingdom

represented by Attorney-at-law Dr. Constanze Krenz and Attorneys-at-law David Kleß and Dr. Joshua Fiedler (DLA Piper, Munich, Germany)

PATENT AT ISSUE

EP 2 043 492

LANGUAGE OF PROCEEDINGS

German

PANEL AND DECIDING JUDGES:

Second Panel:

Rian Kalden, Presiding judge and legally qualified judge
Ingeborg Simonsson, legally qualified judge and judge-rapporteur
Patricia Rombach, legally qualified judge
Graham Ashley, technically qualified judge
Max Tilmann, technically qualified judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- Date: 21 May 2024, Local Division Munich
- Action number attributed by the Court of First Instance: UPC_CFI_443/2023; ACT_589207/2023

POINTS AT ISSUE

- Request that several grounds of appeal be disregarded by the Court of Appeal (R.226RoP, R.222.1RoP).
- Request to submit new evidence (R.222.2 RoP)

PARTIES' REQUESTS

Grounds of appeal not stated in the Statement of grounds of appeal

1. At the interim conference on 16 September 2024, Dyson requested that the following grounds of appeal, constituting validity attacks, should be disregarded by the Court of Appeal:
 - a) Lack of inventive step in relation to Gimelli 1962 (FBD 8) in combination with US 048 (FBD 14)
 - b) Lack of inventive step in relation to GB 572 (FBD 9) in conjunction with common general knowledge
 - c) Lack of inventive step in relation to FR 452/D2 (FBD 11) in conjunction with common general knowledge
 - d) Lack of inventive step in relation to Pifco Vacette (FBD 24) in conjunction with common general knowledge
 - e) Lack of novelty in relation to JP 573 (FBD 10)
2. According to Dyson, the said grounds of appeal were not stated by SharkNinja in the Statement of grounds of appeal and must be considered as no longer maintained.
3. SharkNinja contested the request and submitted that those grounds of appeal were present in the Statement of grounds of appeal, as follows:
 - a) In paragraph 5 of the Grounds of appeal SharkNinja states that all submissions from the pleadings submitted at first instance are maintained in full. As regards the combination of Gimelli (FBD 8) and US 048 (FBD 14), SharkNinja's reasons are set out in paragraph 157 et seq. read together with paragraphs 138 et seq., 119 et seq and 112 et seq. of the Statement of defence.
 - b) – d) Furthermore, in paragraph 155 et seq., under the heading "Alternatives to Gimelli" SharkNinja argues that the Local Division hardly dealt with GB 572 (FBD 9), FR 452/D2 (FBD 11) and Pifco Vacette (FBD 24) as alternative prior art.
 - e) The lack of novelty ground based on JP 573 (FBD 10) was addressed explicitly in paragraphs 158–161 of the Statement of grounds of appeal.

Grounds of appeal; dismissal by the Local Division of the lack of novelty ground

4. In addition, Dyson put forward that the lack of novelty ground in relation to JP 573 had been dismissed implicitly by Munich Local Division, and should, for this reason alone, not be tried on appeal. The implicit dismissal could be seen in the impugned order as follows:
 - The Local Division emphasised that the objection that JP 573 was detrimental to novelty had been raised for the first time at the oral hearing, as follows:

"Dem Einwand der Neuheitsschädlichkeit der FDB 10, der erstmals in der Verhandlung erhoben wurde, ist entgegenzuhalten, dass im Betrieb - wie behauptet - die Klappe (28) eine ähnliche Luftverwirbelung wie in den angegriffenen Handstaubsauger entstehen lassen würde, nicht bewiesen wurde. Die FDB 10 offenbart daher nicht alle Merkmale, insbesondere nicht jene von

1.3. und 1.5.4 des Streitpatents. Selbst wenn dem so wäre, würden die Ausführungen zur Anlage FBD 8 ihre Gültigkeit behalten. In Anbetracht der geringen Relevanz der Anlage FBD 10 erübrigt sich eine weitere Stellungnahme des Gerichts bezüglich deren potentiell verspäteten Einreichung.“

5. SharkNinja contested this as well, arguing that there was no dismissal of this ground by the Local Division.

New evidence

6. At the interim conference on 16 September 2024, the judge-rapporteur raised the question whether the piece of written evidence called FBD 27, submitted by SharkNinja together with the Statement of grounds of appeal on 28 June 2024, was filed too late. FBD 27 is a submission by Dyson in US proceedings.
7. SharkNinja explained at the interim conference that FBD 27 was available to it only on 12 March 2024, ten days before the oral hearing in the Local Division and after the written stage of the proceedings was concluded. SharkNinja argues that it follows from FBD 27 that Dyson holds the opinion that it is obvious for a person skilled in the art to install a cyclone separator device in a Hoover.
8. After the interim conference, on 18 September 2024, SharkNinja submitted new evidence to the Court of Appeal (App_52471/2024) in the form of a written pleading from proceedings in the USA (FBD 28). SharkNinja argues that the evidence could only be introduced in the appeal proceedings because it is a pleading that Dyson, together with other companies of the Dyson Group, only filed on 15 August 2024 in proceedings before the US International Trade Commission. According to SharkNinja, they only became aware of the pleading a month before lodging it with the Court of Appeal. SharkNinja contends that the pleading is relevant because it confirms the expert understanding already presented at first instance that the use and interchangeability of cyclone separators was part of the general technical knowledge.
9. Having been provided with the opportunity to be heard about FBD 28, Dyson argues that this evidence is inadmissible as it is not relevant, and, irrespective of this, it is not clear why SharkNinja could not have introduced the submission into the proceedings at an earlier stage. The pleading FBD 28 relates to four patents, whereby only one has a priority comparable to that of the patent-in-suit. The other patents are ten years younger and say nothing about the question of obviousness at the priority date of the patent in suit. In addition, the only patent with comparable priority relates to a floor Hoover and not a handheld Hoover.

REASONS

Grounds of appeal

10. The Statement of grounds of appeal shall contain an indication of which parts of the decision or order are contested, the reasons for setting aside the contested decision or order and an indication of the facts and evidence on which the appeal is based in accordance with R.222.1 and 2 RoP (R.226 RoP).
11. Requests, facts, evidence and arguments submitted in the Statement of appeal and the Statement of grounds of appeal constitute, on the appellant's side, the subject-matter of the proceedings before the

Court of Appeal (R.222.1 RoP). The Court of Appeal shall consult the file of the proceedings before the Court of First Instance.

12. The level of detail required to meet this standard must be assessed on a case-by-case basis depending on, among other things, how detailed the impugned order is in the contested parts.
13. In this case, the Court of Appeal finds that what has been stated by SharkNinja in the Statement of grounds for appeal suffices in relation to R.226 RoP.
14. The impugned order is very brief in the parts where the Local Division discussed inventive step in relation to FBD 9, FBD 10, FBD 11 and FBD 24. In the Statement of grounds of appeal, SharkNinja has raised criticism against this part of the impugned order and provided reasons why the findings of the Local Division in this part contradicts the findings in other parts of the order (namely the parts dealing with claim construction and infringement). This is enough to meet the criteria of R.226 RoP read together with R.222.1 RoP insofar as the grounds b)-d) are concerned.
15. As regards ground a), it is covered by SharkNinja's general statement in the Statement of grounds of appeal that all submissions from the pleadings submitted at first instance are maintained in full. This however is not enough as such. The submissions from the pleadings submitted at first instance are documents that predate the contested decision and hence as such cannot be seen as reasons for setting aside the contested decision or order or an indication of the facts and evidence on which the appeal is based. The same is true for a mere reference to them in the Statement of grounds of appeal. However, from paragraphs 91 to 101 of the Statement of grounds of appeal it becomes apparent that SharkNinja argues that they have suffered a violation of their right to be heard, as they have not been able to present their complete case as regards their view of the validity of the patent in suit in the hearing held before the Local Division. According to SharkNinja the arguments they presented with the Rejoinder to the Reply were not late filed and could not be dismissed as late filed, as indicated by the Local Division at the hearing before it. From this, in conjunction with SharkNinja's initial statement that all submissions from the pleadings submitted at first instance are maintained in full, it is clear that SharkNinja also want to include in the appeal their arguments from the Rejoinder to the Reply that they were not able to present at the hearing before the Local Division. This includes ground a) that is detailed in the Rejoinder to the Reply in paragraphs 119 to 121.
16. SharkNinja has sufficiently explained in the Statement of grounds of appeal why, in their view, the impugned order is erroneous with regard to the objection of novelty (JP 573).
17. As regards the ground that the invention was not novel, this has been tried in substance by the Local Division (see the citation in para 4 above).
18. Dyson's request that the grounds of appeal enumerated in paragraph 1.a) – e) above shall be disregarded, must by consequence be rejected.

New evidence

19. According to R. 222.2 VerfO, requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal. When exercising discretion, the Court shall in particular take into account: (a) whether a party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First Instance; (b) the relevance of the new submissions for the decision on the appeal; and (c) the position of the other party regarding the lodging of the new submissions.
20. SharkNinja has not convincingly argued why the submissions from US proceedings are relevant for the adjudication of this case. As regards FBD 27, it can be added that it was not submitted in the proceedings before the Local Division but was submitted to the Court of Appeal over three months after SharkNinja obtained it. Similarly, FBD 28 was submitted about a month after SharkNinja obtained it.
21. For the reasons set out, the Court of Appeal exercises its discretion to disregard FBD 27 and FBD 28.

ORDER

1. The Court of Appeal rejects Dyson's request that several grounds of appeal (see para 1 above) shall be disregarded.
2. The Court of Appeal disregards the evidence FBD 27 and FBD 28.

Issued on 9 Oktober 2024

Rian Kalden, Presiding judge and legally qualified judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Graham Ashley, technically qualified judge

Max Tilmann, technically qualified judge