



Central Division
Paris Seat

ORDER

of the Court of First Instance of the Unified Patent Court
Central division (Paris seat)
issued on 8 January 2024
concerning the Generic Application No. App_590707/2023
lodged in the Revocation Action No. ACT_555899/2023
UPC_CFI_263/2023

HEADNOTES: request for stay of the proceeding

KEYWORDS: parallel EPO proceedings; rapid decision

REFERENCE CODE ECLI:

APPLICANT:

Carrier Corporation - 13995 Pasteur Blvd. - FL 33418 - Palm Beach Gardens - US
Represented by Gregory Lees, Dehns

RESPONDENT:

BITZER Electronics A/S - Kærvej 77 - 6400 - Sønderborg - DK
represented by Tilman Pfrang, Meissner Bolte

PATENT AT ISSUE:

European patent n° EP 3 414 708

PANEL:

Presiding judge	François Thomas
Judge-rapporteur	Paolo Catalozzi
Technically qualified judge	Ulrike Keltsch

DECIDING JUDGE:

This order has been issued by the panel.

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 29 June 2023 BITZER Electronics A/S has brought an action against Carrier Corporation before this Seat of the Unified Patent Court, registered as No. ACT_555899/2023 UPC_CFI_263/2023, asking for the revocation of the patent at issue to the extent of claim 1.
2. On 20 November 2023 Carrier Corporation has lodged a statement of defence, as well as an application to amend the patent, registered as No. App_588353/2023.
3. On 1 December 2023 the defendant in the revocation action has lodged a Generic Application, pursuant to Rule 295 (1) (a) of the Rules of Procedure ('RoP') and Article 33 (10) of the Unified Patent Court Agreement ('UPCA'), registered as No. App_590707/2023, asking for the stay of the proceeding pending an opposition proceedings before the European Patent Office.
4. On 15 December 2023 the claimant in the revocation action has submitted its comments to the request for stay of the proceedings, asking for the rejection of the request.

GROUND FOR THE ORDER

5. The request is based on the fact that on 28 June 2023 a notice of opposition to the patent at issue has been filed before the European Patent Office ('EPO') and that a request for accelerated processing of that opposition has been filed by the defendant on 1 November 2023.
6. The applicant has argued that a stay of the current proceedings is appropriate, having regard to the fact that the opposition proceedings subsumes the revocation action, since the patent at issue was validated for France, Germany and United Kingdom and, therefore, has a wider territorial scope than the revocation action and that this action has been filed in respect of the apparatus claim only, whereas the opposition has been filed in respect of the apparatus and the method claims.
7. It has added the parallel proceedings before 'EPO' and the Unified Patent Court may result in a procedural inefficiency, since the grounds for the revocation action are substantially the same as for the opposition proceedings.
8. According to Art. 33 (10) 'UPCA' the Court may stay its proceedings when a rapid decision may be expected from the 'EPO'.

9. This provision has been implemented by Rule 295 (a) 'RoP' which allows the Court to stay the proceedings 'where it is seized of an action relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings) before the European Patent Office or a national authority where a decision in such proceedings may be expected to be given rapidly'.
10. While it is not disputed that an opposition to the patent at issue has been lodged before the 'EPO', the Respondent has argued that a rapid decision in such proceedings is not expected.
11. The Rules of Procedures do not give any guidance in order to establish when a decision is to be considered as 'rapid' for the present purposes.
12. It seems appropriate that the Court, requested to stay the proceedings, shall weight up the opposing interests of the parties and, in particular, the interest in having a decision by the Unified Patent Court in an appropriate time and the interest in avoiding costs for parallel proceedings.
13. In doing so, the Court shall take into account the expected date of the decision before the 'EPO' (as well as before any national authority) and consider whether an order of stay the proceedings until that date would cause an unjustifiable harm to the right to access to justice of the claimant who has lodged its claim before the Unified Patent Court or not.
14. In carrying out the assessment on the existence of an unjustifiable harm that would derive from the order of stay the proceedings, the Court has to take into consideration also the expected date of its judgement.
15. Indeed, while it seems convenient to order the stay of the proceedings where the proceedings before 'EPO' or any national authority is near to the end and the proceedings before the Unified Patent Court has just begun, the opposite must be said where these factual circumstances are not existing.
16. According to this panel, the mentioned criterion represents a proper implementation of the discretionary power assigned to the Court, as it appears to be respectful of the principles of proportionality, flexibility, fairness and equity (see, Preamble 2 and 4 of the RoP).
17. It must be added that the fact the 'EPO' opposition has a wider territorial scope and – allegedly – a wider substantive scope than the current proceedings shall not be taken into consideration for the present purposes, because it could lead to a disproportionate limitation of the right to access to justice of the claimant, where compared to the interest of avoiding the inefficiency deriving from parallel proceedings.
18. In the case at hand, there is not a concrete proof of the date in which the 'EPO' decision on the opposition will be issued.
19. The applicant has observed that, in the experience of its representatives, the 'EPO' decision has to be expected in 9-10 months, but this argument is not supported by any evidence.
20. The absence of a concrete expectation for a 'EPO' decision in the near future, evaluated together with the expected date of the current proceedings, that can be estimated in approximately one year since the lodging of the claim, as provided for by Preamble 7 'RoP', leads this panel to the conclusion that the requirement of the 'rapid decision' of the 'EPO' proceedings is not fulfilled.

21. It follows that, given the factual circumstances at hand, the request submitted by the applicant, defendant in the revocation action, has to be rejected.
22. Since a consistent interpretation of the requirement for allowing the request for stay of the proceedings and of term 'rapid decision' mentioned in Article 33 (10) 'UPCA' is needed, it is appropriate to grant leave to appeal to this order.

ORDER

For these grounds the Court:

- rejects the application;
- leave to appeal is granted.

Issued on 8 January 2024.

The Presiding judge

François Thomas

The Judge-rapporteur

Paolo Catalozzi

The technical qualified judge

Ulrike Keltsch

REVIEW

Leave to appeal is granted.