

UJUB

Opt-out Day

Grand auditorium du Medef - 55, avenue Bosquet, Paris 7^e

Monday 6 June 2016

14.00-16.00 Mock trial on the opt-out

Cast and crew:

Presiding judge - judge-rapporteur
Registrar

The generic manufacturer Generoso's patent attorney
The generic manufacturer Generoso's attorney-at-law
The originator Haussmann La Riche's patent attorney
The originator Haussmann La Riche's attorney-at-law
Script doctor and coordinator

Marie Courboulay (FR)
Sarah Boucris (FR)
Guillaume de la Bigne (FR)
Wouter Pors (NL)
Kevin Cordina (UK)
Emmanuel Gougé (FR)
Pierre Véron (FR)

Caveat

This mock trial is protected under the copyright laws of the United States and other countries throughout the world (including Ruritania). Any unauthorized exhibition, distribution, or copying of this mock trial or any part thereof may result in civil liability and criminal prosecution. The story, all names, characters, and incidents portrayed in this production are fictitious. No identification with actual persons, places, buildings, and products is intended or should be inferred.

The mock trial is based on the 18th draft of Rules of procedure of the Unified Patent Court (19 October 2015) and on the UPC Case Management System as tested in the first months of 2016. It cannot be used as a model for filing actual opt-outs. Please check carefully the final Rules of procedure and the final UPC Case Management System when the Court comes in operation before making any actual opt-out.

No animals were harmed in the making of this mock trial.

Storyboard

The pharmaceutical company Haussmann La Riche is the holder of a key patent relating to the treatment of corns (an ingrowing callus often on the foot; FR: *cor au pied*) by applying *"A composition for use with an electronic treatment device, which composition comprises a peptide of up to 100 amino acids, the peptide having a repeating amino acid sequence – MASE-(n) where n is at least 3"*

[NB: the patent received upon filing a main classification as an electronic device for performing operations (B) and a secondary classification for human necessities (A), but the main claim was dropped during the prosecution and the claim eventually granted is for a composition. This situation is governed by Rule 17(3)c (*"the action involves a single patent having more than one classification"*).

The medicine carrying out this patent has provided Haussmann La Riche with the greatest part of its income in 2016.

This patent was filed at the end of 1997 by the Ruritanian company Haussmann La Riche founded in 1850, whose registered office was in Bach Strasse, Strelsau (Ruritania¹); this charming Central Europe country is not a member of the European Patent Organization or a member of the European Union).

¹ <https://en.wikipedia.org/wiki/Ruritania>

As it taught a disruptive technology (no relevant prior art cited), the patent was granted very quickly in 1999; no opposition was filed.

In 2000, for non-disclosed reasons, Haussmann La Riche provided Haussmann La Moche², also a Ruritanian company, whose registered office was in Beethoven Strasse, Strelsau, with all its assets; after this contribution, Haussmann La Riche was dissolved and liquidated (therefore, it has ceased to exist since 2000, under Ruritanian law, very similar, in this respect, to French law, French Professor Dinbater having drafted the Ruritanian civil, commercial, civil code and labour codes).

Shortly after the transfer, in 2001, following the advice from Haussmann La Riche's spin doctors, Haussmann La Moche changed its name to Haussmann La Riche; however, its registered office did not change (Beethoven Strasse, Strelsau).

Haussmann La Riche had the transfer operation and its change of name duly registered, notably in the UK, French, German and Dutch registers (needless to say that registering the transfer with the European Patent Register was impossible as this Register accepts only filings until the grant of the patent or until the end of the opposition period).

Therefore, two companies with the same name (Haussmann La Riche) existed: a first one, Haussmann La Riche I, from 1850 to 2001, domiciled at Bach Strasse, Strelsau; a second one, Haussmann La Riche II, from 2001 to date, domiciled at Beethoven Strasse, Strelsau.

In 2012, within the framework of an agreement for the creation of a patent pool, Haussmann La Riche assigned the co-ownership (50%) of the patent to another Ruritanian company known as Nivartos, with its registered office at Mozart Strasse, Strelsau.

This patent will expire at the end of 2017 and Haussmann La Riche fears the arrival of many generics to the market in early 2017, the generic drug manufacturers relying on the slow procedure to secure their position on the market before a court decision is issued.

Haussmann La Riche, in order not to put all its eggs in one basket (to avoid the potential revocation of its patent by a single decision) decided to opt out its patent under Article 83 of the UPC Agreement ("*to opt out from the exclusive competence of the court*", « *décider de déroger à la compétence exclusive de la Juridiction* »).

The opt-out was made online before the expiry of the sunrise period, on 31 December 2016, just before midnight, by Barbie (Fräulein Barbie Roberts), the secretary to the patent department manager at Haussmann La Riche, Dr Schweitzer, European patent attorney (Dr Schweitzer, although a scrupulous German and European patent attorney, heading the IP department of Haussmann La Riche based in Munich, had forgotten this patent in the list of the company's other patents for which he had registered an opt-out during the sunrise period; but unfortunately, his observant secretary realised it at the last minute); she left her fiancé Ken Carson during the New Year's Eve dinner to fill in the online form as follows, to designate the patent proprietor:

Details required by Rule 5.3	
Proprietors/Applicants pursuant to Rule 8.5.	Haussmann La Riche Bach Strasse, RT Strelsau
SPCs	
Holders of any granted SPC, if different from the proprietors listed above	

² In French slang, "*moche*" means "*nasty*".

Barbie filled in the form as follows to designate the applicant for the opt-out:

Opt-out Applicant Data	
Data available in precompiled fields is retrieved from user profile and company data	
Applicant is a company/firm? *	<input type="button" value="No"/>
First Name *	<input type="text" value="Barbie"/>
Last Name *	<input type="text" value="ROBERTS"/>
Contact e-mail *	<input type="text" value="barbie.roberts@hausmann-la-riche.com"/>

On 2 January 2017, after a very romantic New Year's Eve with Ken, Barbie realised — alas in part only — her mistake and lodged a "*correction*" with the Registry, pursuant to Rule 8(6), last sentence, to add "*Nivartos, Mozart Strasse, RT Streslau*" as the co-owner of the patent.

In 2017, to "clear the way", the Italian generic drug manufacturer Generoso initiated an action for revocation of the patent before the UPC central division; as the patent received upon filing a main classification as an electronic device (H), the registrar assigned the case to the Paris seat of the central division.

Hausmann La Riche challenges the competence of the UPC, since it considers that it had correctly taken the necessary steps to "*opt out from the exclusive competence of the Court*".

Generoso argues that the UPC is competent because the opt-out had been incorrectly made for three reasons:

- ▶ mainly because the opt-out was made in the name of "*Hausmann La Riche I, Bach Strasse, Strelsau*", a corporate entity which has no longer a legal existence;
- ▶ and also because the opt-out was not made in the name of Nivartos, although this company is the co-owner of the patent;
- ▶ in the alternative, because Fraülein Barbie Roberts had no capacity to register the opt-out (Dr Schweitzer alone had the authorisation to do so on behalf of the proprietors, in his capacity as head of the patent department and European patent attorney).

On the contrary, Hausmann La Riche argues that the application to opt-out had been correctly made:

- ▶ since mention of the company's address is not required by Rule 5 as an element of identification, indicating an erroneous address for a company correctly named is of no consequence;
- ▶ since the omission of Nivartos as co-owner of the patent in the opt-out was corrected before any litigation through the correction filed by Fraülein Barbie Roberts, there is no problem of validity of the opt-out;
- ▶ Barbie did have the capacity to apply for an opt-out, for Rule 5 does not restrict the standing to apply for an opt-out to certain persons.

The question whether the UPC has jurisdiction must be presented as a Preliminary objection (Rule 19 of the Rules of Procedure, to which Rule 48 *in fine* refers) within one month of the lodging of the Statement of claim.

This question falls within the competence of the judge-rapporteur (Rule 20); for this matter, the appointed judge-rapporteur is the presiding judge. The question of the validity of the opt-out will thus be decided by the judge-rapporteur (therefore by a single judge), except if the judge-rapporteur decided to refer the matter to the panel under Rule 102.

Schedule of the mock trial proceedings

15 March 2017	<i>Filing of the Claimant's Statement for revocation with the Registrar by Generoso representatives Wouter Pors + Guillaume de la Bigne</i>
7 April 2017	<i>Service of the Statement for revocation to the patent holders</i>
6 May 2017	<i>Respondent's Preliminary objection by Haussmann La Riche and Nivartos' representatives Emmanuel Gougé + Kevin Cordina (within one month of service of the Statement for revocation to the patent holder)</i>
20 May 2017	<i>Claimant's written comments on the Preliminary objection by Generoso representatives Wouter Pors + Guillaume de la Bigne (within 14 days of service of notification of Preliminary objection)</i>
27 May 2017	<i>Reply on Written Comments on Preliminary objection by Haussmann La Riche's representatives Emmanuel Gougé + Kevin Cordina</i>
3 June 2017	<i>Claimant's Rebuttal on Reply on Written Comments on Preliminary objection by Generoso representatives Wouter Pors + Guillaume de la Bigne</i>
6 June 2017	<i>Notional date of the mock trial</i>

Documents of the mock trial proceedings

Written pleadings

2017-03-15_Claimant_Statement_for_revocation.pdf
 2017-04-07_Service_on_Haussmann.pdf
 2017-04-07_Service_on_Nivartos.pdf
 2017-05-06_Respondent_Preliminary_objection.pdf
 2017-05-20_Claimant_Written_comments_on_preliminary_objection.docx
 2017-05-27_Respondent_Reply_on_Claimant_Written_comments_on_Prelim_Objection.pdf
 2017-06-03_Claimant_Rebuttal_on_Respondent_Reply_on_Claimant_Written_comments_on_Prelim_Objection.pdf

Exhibits

Claimant Generoso Exhibits

Claimant_Generoso_Exhibit_1_EP_0_813_496_B1.pdf
 Claimant_Generoso_Exhibit_2_Carson_Declaration.pdf
 Claimant_Generoso_Exhibit_3_1997_Short_publication.pdf
 Claimant_Generoso_Exhibit_4_E-mail_2012-12-22_from_Condek_to_Roberts.pdf

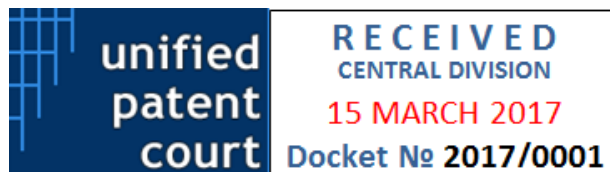
Respondents Haussmann La Riche and Nivartos Exhibits

Respondents_HLR_Nivartos_Exhibit_01_1.pdf
 Respondents_HLR_Nivartos_Exhibit_01_2_bis.pdf
 Respondents_HLR_Nivartos_Exhibit_01_3_ter.pdf
 Respondents_HLR_Nivartos_Exhibit_01_4_quater.pdf
 Respondents_HLR_Nivartos_Exhibit_02.pdf
 Respondents_HLR_Nivartos_Exhibit_03.pdf
 Respondents_HLR_Nivartos_Exhibit_04.pdf
 Respondents_HLR_Nivartos_Exhibit_05.pdf

Docket №

UNIFIED PATENT COURT

CENTRAL DIVISION (PARIS SECTION)



STATEMENT

FOR REVOCATION OF EUROPEAN PATENT № 0 813 496 B1

Filed on 15 March 2017

ON BEHALF OF

Generoso, a company governed by Italian law,
with its registered office located in Strada dell'Orto 2016, Milano, Italy

"The Claimant"

represented by

Mr Wouter Pors,
attorney-at-law, Bird & Bird
Zuid-Hollandplein 22, 2596 AW The Hague, The Netherlands
PO Box 30311, 2500 GH The Hague, The Netherlands
wouter.pors@twobirds.com

Guillaume de La Bigne
European Patent Attorney (representative of record for the purpose of service)
LLR
11 boulevard de Sébastopol, 75008 Paris, France
labigne@llr.fr

AGAINST

Haussman la Riche, a company governed by Ruritanian law, with its
registered office located in Beethoven Strasse 1770, Strelsau, Ruritania

Nivartos, a company governed by Ruritanian law, with its
registered office located in Mozart Strasse 1756, Strelsau, Ruritania

"The Defendants"

RELEVANT PROVISIONS OF THE UPC AGREEMENT AND EUROPEAN PATENT CONVENTION

Article 65 (Decision on the validity of a patent) of the UPC Agreement states that:

(1) The Court shall decide on the validity of a patent on the basis of an action for revocation or a counterclaim for revocation.

(2) The Court may revoke a patent, either entirely or partly, only on the grounds referred to in Articles 138(1) and 139(2) of the EPC [European Patent Convention].

Article 138(1)a) EPC states that :

*Subject to Article 139, a European patent may be revoked with effect for a Contracting State only on the grounds that the subject-matter of the European patent is not patentable under Articles **52 to 57**;*

Further, article 54(1) and (2) EPC states that :

*(1) An invention shall be considered to be **new** if it does not form part of the state of the art.*

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

COMPETENCE OF THE CENTRAL DIVISION OF THE UPC

According to article 33(4) UPC, an action referred to in article 32(1)(d) UPC (actions for revocation of patents and for declaration of invalidity of supplementary protection certificates) shall be brought before the **central division**.

The Claimant brings therefore before the central division of the UPC an action for revocation of the European patent № 0 813 496 (Generoso Exhibit 1).

AN INEFFECTIVE ATTEMPT TO LODGE AN APPLICATION TO OPT OUT

The Claimant is aware that the patent proprietors made a desperate last minute attempt to exclude the validity of the weak European patent № 0 813 496 from the jurisdiction of the highly-competent Unified Patent Court which will no doubt revoke it as soon as it reads it and the relevant prior art.

However, this attempt is unsuccessful as the so called “opt-out” is invalid: see Mr Ken Carson ‘s Statement (Generoso Exhibit 2): “*She left me on a New Year’s Eve for filing a fake opt-out. I must admit, I didn’t know what to say. I’m left alone*” .

Further, online inspection (on 1st January 2017) on the register evidences that :

- most importantly, the opt-out was made in the name of "Hausmann La Riche, Bach Strasse, Strelsau", a corporate entity which no longer has a legal existence;
- secondly, the name of Nivartos was lacking in the opt-out request, even though this company is the co-owner of the patent;
- thirdly, Ms Barbie Roberts had no capacity to register an opt-out.

LACK OF NOVELTY OF CLAIM 1 OF EUROPEAN PATENT № 0 813 496

Claim 1 of European patent № 0 813 496 B1 recites *a composition for use with an electronic treatment device, which composition comprises a peptide of up to 100 amino acids, the peptide having a repeating amino acid sequence – MASE-(n) where n is at least 3.*

The subject matter of Claim 1 is not new over the article of “The Italian Journal of Skin Treatment” (Generoso Exhibit 3 : O. Maserati’s short publication).

Indeed, this document was published on Thursday 27 March 1997 before the date of filing of the patent 1st of April 1997.

O. Maserati discloses a composition for use with an electronic device (*water bath treatment electronic device (PEDILUVE 5000® Pediluve Electrique SA, Louvier, France)*), which composition comprises a peptide of up to 100 amino acids (*10% dilution of the mutated Maseratin*), the peptide having a repeating amino acid sequence – MASE-(n) where n is at least 3 (*see figure 1 of the short publication*).

Thus, the single claim of European patent № 0 813 496 is not patentable as anticipated by O. Maserati’s short publication.

The Claimant paid the fee for the revocation action through the UPC management case system.

SUMMARY

The Claimant

- claims with respect to all designated Contracting States, a revocation of European patent № 0 813 496
- requests a copy of the decision to be sent to the national patent office of any Contracting Member State concerned.

LIST OF EXHIBITS

- Generoso Exhibit 1 : European patent № 0 813 496 B1
- Generoso Exhibit 2 : Mr Ken Carson 's Statement
- Generoso Exhibit 3 : O. Maserati short publication

REQUEST FOR SERVICE ABROAD OF JUDICIAL OR EXTRAJUDICIAL DOCUMENTS

DEMANDE
AUX FINS DE SIGNIFICATION OU DE NOTIFICATION A L'ETRANGER
D'UN ACTE JUDICIAIRE OU EXTRAJUDICIAIRE

Convention on the service abroad of judicial and extrajudicial documents in civil or commercial matters, signed at The Hague, November 15, 1965.

Convention relative à la signification et à la notification à l'étranger des actes judiciaires ou extrajudiciaires en matière civile ou commerciale, signée à La Haye, le 15 Novembre 1965.

Identity and address of the applicant <i>Identité et adresse du requérant</i>
Unified Patent Court Central Division, Paris Seat, Registry 10 Boulevard du Palais 75001 Paris France

Address of receiving authority <i>Adresse de l'autorité destinataire</i>
Ministry of Justice, Department for Service of Judicial Documents, Paul van Beukering Boulevard 1 1000 AAX Strelsau Ruritania

The undersigned applicant has the honour to transmit - in duplicate - the documents listed below and, in conformity with article 5 of the above-mentioned Convention, requests prompt service of one copy thereof on the addressee, i.e.,
(identity and address)

Le requérant soussigné a l'honneur de faire parvenir-en double exemplaire- à l'autorité destinataire les documents ci-dessous énumérés. en la priant conformément à l'article 5 de la Convention précitée, d'en faire remettre sans délai un exemplaire au destinataire, savoir:
(identité et adresse)

Hausmann la Riche, Beethoven Strasse 1770, Strelsau. Ruritania

☒ (a) in accordance with the provisions or sub-paragraph (a) of the first paragraph of article 5 of the Convention.*
a) selon les formes légales (article 5 alinea premier, lettre a).

☐ (b) in accordance with the following particular method (sub-paragraph (b) of the first paragraph of article 5)*:
b) selon la forme particulière suivante (article 5, alinea premier, lettre b) :

☒ (c) by delivery to the addressee, if he accepts it voluntarily (second paragraph of article 5)*:
c) le cas échéant, par remise simple (article 5, alinea 2).

The authority is requested to return or to have returned to the applicant a copy of the documents- and of the annexes-with a certificate• a provided on the reverse side.

Cette autorité est priée de renvoyer ou de faire renvoyer au requérant un exemplaire de l'acte -et de ses annexes- avec l'attestation figurant au dos

List of documents
Énumération des pièces

Statement for Revocation of European
Patent No. 0 813 496 B1, filed by Generoso

Done at Paris _____, le 17 mars 2017,
Fait à _____ le _____

Signature and/or stamp
Signature et/ou cachet



Liberté • Égalité • Fraternité
RÉPUBLIQUE FRANÇAISE

CERTIFICATE
ATTESTATION

The undersigned authority has the honour to certify, in conformity with article 6 of the Convention, *L'autorité soussignée a l'honneur d'attester conformément à l'article 6 de ladite Convention.*

1) that the document has been served *

1. que la demande a été exécutée

7 April 2017

-the (date) -le (date)

-at (place, street, number) -a (localité, rue numéro) Beethoven Strasse 1770, Strelsau, Ruritania

--in one of the following methods authorized by article 5

--sous une des formes suivantes prévues à l'article 5

☒ **(a) in accordance with the provisions of sub-paragraph (a) of the first paragraph of article 5 of the Convention*.**

a) selon les formes légales (article 5, alinea premier, lettre a)

☐ **(b) in accordance with the following particular method:**

b) selon la forme particulière suivante:

☐ **(c) by delivery to the addressee, who accepted it voluntarily.***

c) par remise simple

The documents referred to in the request have been delivered

to: Les documents mentionnés dans la demande ont été remis a

-(identity and description of person)

-identité et qualité de la personne)

Mr. Jon Reelax

-relationship to the addressee family, business or other

-liens de parenté de subordination ou autre, avec le destinataire de l'acte

General Director of Haussmann la Riche

2) that the document has not been served, by reason of the following facts*:

2. que la demande n'a pas été exécutée, en raison des faits suivants:

In conformity with the second paragraph of article 12 of the Convention, the applicant is requested to pay or reimburse the expenses detailed in The attached statement*

Conformément à l'article 12, alinea 2, de ladite Convention, le requérant est prié de payer ou de rembourser les frais dont le détail figure au mémoire ci-joint.

Annexes

Annexes

Documents returned:

pièces renvoyées

Statement for Revocation of European

Patent No. 0 813 496 B1, filed by Generoso, as served

In appropriate cases, documents establishing the service:

Le cas échéant, les documents justificatifs de l'exécution:

Done at Strelsau, the 7-4-2017,

Fait à

le

Signature and/or stamp.

Signature et/ou cachet.



SUMMARY OF THE DOCUMENT TO BE SERVED
ELEMENTS ESSENTIELS DE L'ACTE

Convention on the service abroad of judicial and extrajudicial documents In civil or commercial matters, signed at The Hague, November 15, 1965.

Convention relative à la signification et à la notification à l'étranger des actes judiciaires et extrajudiciaires en matière civile ou commerciale, signée à La Haye, le 15 Novembre 1965.

(article 5, fourth paragraph)
(article 5. alinea 4)

Name and address of the requesting authority:

Nom et adresse de l'autorité requérante:

Unified Patent Court, Central Division, Paris Seat, Registry, 10 Boulevard du Palais, 75001 Paris, France

Particulars of the parties: Claimant: Generoso, Strada dell'Orto 2016, Milano, Italy

Identité des parties:

Defendant: Nivartos, Mozart Strasse 1756, Strelsau. Ruritania

JUDICIAL DOCUMENT
ACTE JUDICIAIRE

Nature and purpose of the document:

Nature et objet de l'acte-

— Statement for Revocation of European Patent No. 0 813 496 B1, aimed at the revocation of the patent

Nature and purpose of the proceedings and, where appropriate, the amount in dispute: *Nature et objet de l'instance le cas échéant le montant du litige:*

Revocation of a European patent, no monetary claim filed

Date and place for entering appearance-

Date et lieu de la comparution:

6 May 2017, UPC Paris Central Division, 10 Boulevard du Palais, 75001 Paris, France

Court which has given judgment:**

Jurisdiction qui a rendu la décision:

N/A

Date of judgment:**

Date de la décision:

N/A

Time limits stated in the document:**

Indication des délais figurant dans l'acte:

Preliminary objections can be filed ultimately 6 May 2017

EXTRAJUDICIAL DOCUMENT
ACTE EXTRAJUDICIAIRE

Nature and purpose of the document:

Nature et objet l'acte:

Time limits stated in the document:**

Indication des délais figurant dans l'acte:

REQUEST FOR SERVICE ABROAD OF JUDICIAL OR EXTRAJUDICIAL DOCUMENTS

DEMANDE
AUX FINS DE SIGNIFICATION OU DE NOTIFICATION A L'ETRANGER
D'UN ACTE JUDICIAIRE OU EXTRAJUDICIAIRE

Convention on the service abroad of judicial and extrajudicial documents in civil or commercial matters, signed at The Hague, November 15, 1965.

Convention relative à la signification et à la notification à l'étranger des actes judiciaires ou extrajudiciaires en matière civile ou commerciale, signée à La Haye, le 15 Novembre 1965.

Identity and address of the applicant <i>Identité et adresse du requérant</i>
Unified Patent Court Central Division, Paris Seat, Registry 10 Boulevard du Palais 75001 Paris France

Address of receiving authority <i>Adresse de l'autorité destinataire</i>
Ministry of Justice, Department for Service of Judicial Documents, Paul van Beukering Boulevard 1 1000 AAX Strelsau Ruritania

**The undersigned applicant has the honour to transmit - in duplicate - the documents listed below and, in conformity with article 5 of the above-mentioned Convention, requests prompt service of one copy thereof on the addressee, i.e.,
(identity and address)**

*Le requérant soussigné a l'honneur de faire parvenir-en double exemplaire- à l'autorité destinataire les documents ci-dessous énumérés. en la priant conformément à l'article 5 de la Convention précitée, d'en faire remettre sans délai un exemplaire au destinataire, savoir:
(identité et adresse)*

Nivartos, Mozart Strasse 1756, Strelsau. Ruritania

☒ (a) in accordance with the provisions or sub-paragraph (a) of the first paragraph of article 5 of the Convention.*
a) selon les formes légales (article 5 alinea premier, lettre a).

☐ (b) in accordance with the following particular method (sub-paragraph (b) of the first paragraph of article 5)*:
b) selon la forme particulière suivante (article 5, alinea premier, lettre b) :

☒ (c) by delivery to the addressee, if he accepts it voluntarily (second paragraph of article 5)*:
c) le cas échéant, par remise simple (article 5, alinea 2).

The authority is requested to return or to have returned to the applicant a copy of the documents- and of the annexes-with a certificate• a provided on the reverse side.

Cette autorité est priée de renvoyer ou de faire renvoyer au requérant un exemplaire de l'acte -et de ses annexes- avec l'attestation figurant au dos

List of documents
Énumération des pièces

Statement for Revocation of European
Patent No. 0 813 496 B1, filed by Generoso

Done at Paris _____, le 17 mars 2017,
Fait à _____ le _____

Signature and/or stamp
Signature et/ou cachet



Liberté • Égalité • Fraternité
RÉPUBLIQUE FRANÇAISE

CERTIFICATE
ATTESTATION

The undersigned authority has the honour to certify, in conformity with article 6 of the Convention, L'autorité soussignée a l'honneur d'attester conformément à l'article 6 de ladite Convention.

1) that the document has been served *

1. que la demande a été exécutée

7 April 2017

-the (date) -le (date)

-at (place, street, number) -a (localité, rue numéro) - Mozart Strasse 1756, Strelsau, Ruritania

--in one of the following methods authorized by article 5

--sous une des formes suivantes prévues à l'article 5

☒ **(a) in accordance with the provisions of sub-paragraph (a) of the first paragraph of article 5 of the Convention*.**

a) selon les formes légales (article 5, alinea premier, lettre a)

☐ **(b) in accordance with the following particular method:**

b) selon la forme particulière suivante:

☐ **(c) by delivery to the addressee, who accepted it voluntarily.***

c) par remise simple

The documents referred to in the request have been delivered

to: Les documents mentionnés dans la demande ont été remis a

-(identity and description of person)

-identité et qualité de la personne

Mr. Jonas Clever

-relationship to the addressee family, business or other

-liens de parenté de subordination ou autre, avec le destinataire de l'acte

General Director of Nivartos

2) that the document has not been served, by reason of the following facts*:

2. que la demande n'a pas été exécutée, en raison des faits suivants:

In conformity with the second paragraph of article 12 of the Convention, the applicant is requested to pay or reimburse the expenses detailed in The attached statement*

Conformément à l'article 12, alinea 2, de ladite Convention, le requérant est prié de payer ou de rembourser les frais dont le détail figure au mémoire ci-joint.

Annexes

Annexes

Documents returned:

pièces renvoyées

Statement for Revocation of European

Patent No. 0 813 496 B1, filed by Generoso, as served

In appropriate cases, documents establishing the service:

Le cas échéant, les documents justificatifs de l'exécution:

Done at **Strelsau**, the **7-4-2017**,

Fait à

le

Signature and/or stamp.

Signature et/ou cachet.



SUMMARY OF THE DOCUMENT TO BE SERVED
ELEMENTS ESSENTIELS DE L'ACTE

Convention on the service abroad of judicial and extrajudicial documents In civil or commercial matters, signed at The Hague, November 15, 1965.

Convention relative à la signification et à la notification à l'étranger des actes judiciaires et extrajudiciaires en matière civile ou commerciale, signée à La Haye, le 15 Novembre 1965.

(article 5, fourth paragraph)
(article 5. alinea 4)

Name and address of the requesting authority:

Nom et adresse de l'autorité requérante:

Unified Patent Court, Central Division, Paris Seat, Registry, 10 Boulevard du Palais, 75001 Paris, France

Particulars of the parties: Claimant: Generoso, Strada dell'Orto 2016, Milano, Italy

Identité des parties:

Defendant: Nivartos, Mozart Strasse 1756, Strelsau. Ruritania

JUDICIAL DOCUMENT
ACTE JUDICIAIRE

Nature and purpose of the document:

Nature et objet de l'acte-

Statement for Revocation of European Patent No. 0 813 496 B1, aimed at the revocation of the patent

Nature and purpose of the proceedings and, where appropriate, the amount in dispute: *Nature et objet de l'instance le cas échéant le montant du litige:*

Revocation of a European patent, no monetary claim filed

Date and place for entering appearance-

Date et lieu de la comparution:

6 May 2017, UPC Paris Central Division, 10 Boulevard du Palais, 75001 Paris, France

Court which has given judgment:**

Jurisdiction qui a rendu la décision:

N/A

Date of judgment:**

Date de la décision:

N/A

Time limits stated in the document:**

Indication des délais figurant dans l'acte:

Preliminary objections can be filed ultimately 6 May 2017

EXTRAJUDICIAL DOCUMENT
ACTE EXTRAJUDICIAIRE

Nature and purpose of the document:

Nature et objet l'acte:

Time limits stated in the document:**

Indication des délais figurant dans l'acte:

PRELIMINARY OBJECTION

Filed on 5 May 2017

BETWEEN

HAUSSMANN LA RICHE

a company governed by Ruritanian law, having its registered office at Beethoven Strasse, 1770 Strelsau Ruritania, represented by Mr Jon Reelax, acting in his capacity as General Director.

AND

NIVARTOS

a company governed by Ruritanian law, having its registered office at Mozart Strasse, 1756 Strelsau, Ruritania, represented by Mr Jonas Clever, acting in his capacity as General Director.

Claimants to the preliminary objection / Defendants to the revocation action

Represented by

Emmanuel Gougé
Attorney-at-law, Pinsent Masons LLP
emmanuel.gouge@pinsentmasons.com
who is authorized to accept service in relation to these proceedings;

Kevin Cordina
European Patent Attorney, Olswang LLP
kevin.cordina@olswang.com

Vs.

GENEROSO

a company governed by Italian law, having its registered office at Strada dell'Orto, 2016 Milano, Italy, represented by Ms Donatella Tutti.

Defendant to the preliminary objection / Claimant to the revocation action

Represented by

Wouter Pors
Attorney-at-law, Bird & Bird
wouter.pors@twobirds.com
who is authorized to accept service in relation to these proceedings;

Guillaume de la Bigne
European patent attorney, LLR
labigne@llr.fr

By this Preliminary objection, the Defendants seek to declare the Unified Patent Court (hereinafter "UPC") incompetent to hear the revocation action brought by the Claimant against their European patent No. 0 813 496 B1 (hereinafter EP 496), basing its argumentation on the prior opt-out of said patent, lodged according to Rule 5 of the Rules of Procedure of the Unified Patent Court (hereinafter the "Rules").

Background to the proceedings

1. The well-known Ruritanian pharmaceutical company Haussmann La Riche (hereinafter "Haussmann La Riche I") was founded in 1850 in Strelsau, Ruritania. In 1997, it filed a European patent application covering a new apparatus for the treatment of corns and a new composition for use in that device. The European patent was granted in 1999 under No. 0 813 496 B1.
2. In 2000, it transferred all its assets (including its patents) to one of its wholly owned subsidiary, Haussmann La Moche, also incorporated in Strelsau. Following said transfer, Haussmann La Riche I was dissolved and liquidated. One year later, the company Haussmann La Moche changed its name to Haussmann La Riche (hereinafter "Haussmann La Riche II"). The change of name has been duly registered in the relevant national patent registers (UK, French, German and Dutch).
3. In 2012, Haussmann La Riche II assigned the co-ownership (50%) of its European patent No. 0 813 496 B1 to the Ruritanian company Nivartos. As the transfer of ownership took place after the grant of the patent (and after the opposition period had expired), Nivartos is not mentioned as co-owner in the European patent register. However, said transfer has been duly registered in the national registers.
4. As part of their patent pool strategy, the two patent co-owners Haussmann La Riche II and Nivartos decided, during the sunrise period¹, to opt out from the exclusive competence of the UPC. Nivartos confirmed its willingness to do so by a letter of consent sent to Haussmann La Riche on 7 December 2016 (**Exhibit 1**).
5. Thus, Ms Barbie Roberts, personal secretary to Dr Schweitzer (head of the IP department and European patent attorney), lodged under his instructions, an online application to opt out tEP 496. It should be noted that online application forms to opt-out are partly automatically filled in with information from the European Patent Office database, notably with regards to the name of the proprietor. As mentioned above, the assignment of ownership to Nivartos occurred years after the grant of the European patent and for this reason the name of Nivartos is not recorded in the European Patent Register. Therefore it did not automatically appear on the online form. The very conscientious Ms Barbie Roberts noticed it and completed the form application by adding the name of Nivartos on 2 January 2017 to correct the error.
6. Notwithstanding the decision of the patent proprietors to opt-out from the exclusive competence of the UPC, the Claimant, the Italian generic drugs manufacturer Generoso, decided to lodge an action for revocation of the patent before the Central Division of the Unified Patent Court against Haussmann La Riche II and Nivartos on 15 March 2017. Haussmann La Riche II and Nivartos received said statement for revocation on 7 April 2017.
7. The court assigned the case to the Paris seat.

¹ A period which enables European patent owners to lodge opt-out applications before the entry into force of the Unified Patent Court Agreement – hereinafter "the Agreement". This early lodging has been made possible thanks to the Protocol to the Agreement which allows some parts of the Agreement to come into effect before the Agreement itself has done so, namely Article 10 concerning the establishment of the Registry, which is the one who shall register the opt-out applications.

PRELIMINARY REMARKS: JURISDICTION AND COMPETENCE OF THE JUDGE-RAPPORTEUR

8. According to Rule 19.1 (a):

*"Within one month of service of the Statement of claim, the defendant may lodge a Preliminary objection concerning: the jurisdiction and competence of the Court, **including any objection that an opt-out pursuant to Rule 5 applies to the patent that is the subject of the proceedings**".*

- 8.1 And, according to Rule 20.1:

*"As soon as practicable after the expiry of the period referred to in Rule 19.5, **the judge-rapporteur shall decide the Preliminary objection.**"*

- 8.2 Pursuant to the combination of Rule 19.1(a) and 20.1, it is clear that the judge-rapporteur has jurisdiction and competence to decide upon the validity of the opt-out.

9. We also would like to state that, in view of the low level of complexity of this matter, the judge-rapporteur has no need in this case to refer to the panel for decision.

INCOMPETENCE OF THE UNIFIED PATENT COURT AS A RESULT OF A PRIOR OPT-OUT

Legal framework:

10. According to Article 83(3) of the Agreement:

*"**Unless an action has already been brought before the Court, a proprietor** of or an applicant for a European patent granted or applied for prior to the end of the transitional period under paragraph 1 and, where applicable, paragraph 5, as well as a holder of a supplementary protection certificate issued for a product protected by a European patent, **shall have the possibility to opt out from the exclusive competence of the Court.** To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period. **The opt-out shall take effect upon its entry into the register.**"*

- 10.1 However, Rule 5.13 lays down an exception to this Article concerning the date upon which the opt-out shall take effect in the case where this has been made during the sunrise period:

*"Applications accepted by the Registry before the entry into force of the Agreement shall be treated as entered on the register **on the date of entry into force of the Agreement.**"*

- 10.2 Furthermore, Rule 5.6 enables the opt-out applicant to complete or correct his initial application if some of the *"requirements [to validly lodge an opt-out] are missing or incorrectly recorded"*. In such a case, the amended opt-out shall not be effective upon its entry into the register, nor on the date of entry into force of the Agreement (where the opt-out has been filed during the sunrise period), but *"from the date of correction"*.

11. The requirements needed for an opt-out application to be valid, as mentioned in Rule 5.6, are laid down in Rule 5.3 as follows:

"(a) the name of the proprietor or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and all relevant postal and, where applicable, electronic addresses;

(b) where such proprietor, applicant or holder have appointed a representative, the name and postal address and electronic address for service of the representative;

(c) details of the patent and/or application including the number (...)."

12. It will be argued below, that (A) the opt-out has been validly lodged by the two patent co-owners, and meets the requirements laid down in Rule 5.3, and that (B) Ms Barbie Roberts had capacity to lodge the application to opt-out on the behalf of Haussmann La Riche II.

A) Opt-out application validly lodged by the two patent co-owners

13. According to Rule 5.1 (a):

"Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out."

In the present case, the contested patent is owned in co-ownership by Haussmann La Riche II and Nivartos. It will be shown below that both proprietors have validly lodge the application to opt out.

a) Opt-out application validly lodged by Haussmann La Riche

14. The legal existence of Haussmann La Riche is no in doubt (**Exhibit 2**). Besides, because of Haussmann La Riche's long history (Haussmann La Riche I - from 1850 to 2001 - and Haussmann La Riche II – from 2001) Haussmann La Riche (I and II) have become one of the oldest and most well-known companies of the city of Strelsau. Haussmann La Riche II is, more broadly, renowned across Europe in the pharmaceutical industry. Because of its sustained business success since 1850 (starting with Haussmann La Riche I until today with Haussmann La Riche II) everyone in Strelsau (and in particular the competitors) knows Haussmann La Riche and would have no problem to localise it (**Exhibit 3**).
15. As mentioned above, the requirements to be met for an opt-out application to be validly lodged, provided in Rule 5.3 (a), include *"all relevant postal and, where applicable, electronic addresses"*.
- 15.1 The purpose of this Rule is **a practical one** to enable the Registry and third parties to reach the applicant.
- 15.2 Because of Haussmann La Riche's reputation, no one will need to rely on the address to help with its identity verification. Furthermore, Ms Barbie Roberts, who has been an employee at Haussmann La Riche I and II since 1995, put her professional email address < barbie.roberts@haussmann-la-riche.com > when filing the application, which enables the Registry and third parties to reach Haussmann La Riche II electronically.
16. Finally, taking into account the general principles of law recalled in paragraph 6 of the Agreement's Preamble:
- "Considering that the Unified Patent Court should be devised to ensure expeditious and high quality decisions, [it shall strike] a fair balance between the interests of right holders and other parties and [take] into account the **need for proportionality and flexibility**;"*
- 16.1 in paragraphs 2 and 4 of the Preamble of the Rules of Procedure:
- "2. The Rules shall be applied in accordance with Articles 41(3), 42 and 52(1) of the Agreement **on the basis of the principles of proportionality, flexibility, fairness and equity**;"*
- "4. **Flexibility shall be ensured by applying all procedural rules in a flexible and balanced manner** with the required level of discretion for the judges to organise the proceedings in the most efficient and cost effective manner;"*
- 16.2 and in Article 42 of the Agreement:
- "(1) The Court shall deal with litigation in ways which are proportionate to the importance and complexity thereof."*

(2) The Court shall ensure that the rules, procedures and remedies provided for in this Agreement and in the Statute are used in a fair and equitable manner and do not distort competition.";

- 16.3 it should be reminded that the provisions of the Agreement and the Rules shall be interpreted in a flexible and proportionate manner, always bearing in mind the facts. In the present case, to have recorded Bach Strasse instead of Beethoven Strasse is of no consequence and does not prevent the Registry, nor any third party, from identifying who Haussmann La Riche is and from corresponding with the company.
17. For the reasons stated above, the fact that the address recorded in the application form is not the actual address of Haussmann La Riche's registered office is an immaterial misstatement and does not invalidate the opt-out application.

Therefore, Haussmann La Riche II did validly lodge the application to opt-out.

b) Opt-out application validly completed with the name of the patent co-owner, Nivartos

18. As mentioned above, because of the automatic filling of the online application with the information populating the European Patent Office database, the name of Nivartos did not appear as co-owner of the contested patent when Ms Barbie Roberts lodged the opt-out application.
- 18.1 However, Rule 5.6 *in fine* enables the applicant to modify his application after it has been lodged:
- "If the requirements are missing or incorrectly recorded, a correction may be lodged with the Registry. The date of entry of the correction shall be noted in the register".*
- 18.2 This is exactly what Ms Roberts did as soon as she realised that the name of Nivartos was missing. She added Nivartos on 2 January 2017, i.e. 2 days after the lodging, as follows: "*Nivartos, Mozart Strasse, RT Streslau*" (**Exhibit 4**).
- 18.3 As mentioned above, Nivartos confirmed its willingness for the opt-out by a letter of consent sent to Haussmann La Riche II on 7 December 2016 (**abovementioned Exhibit 1**).
19. In conclusion, both co-owners of the patent did validly lodge the application to opt-out.

B) Ms Barbie had capacity to validly lodge the opt-out application

20. Pursuant to Rule 5.1:
- "The proprietor of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application with the Registry".*
- 20.1 And pursuant to Rule 5.4:
- "Rule 8 [requiring representatives in certain situations] shall not apply to Applications to opt out made pursuant to this Rule 5. Where a representative is appointed, such a representative may include professional representatives and legal practitioners as defined in Article 134 EPC in addition to those referred to in Article 48 of the Agreement."*
- 20.2 According to these Rules, the person who shall lodge the application to opt out is the proprietor of or the applicant for a European patent, and said proprietor or applicant may or may not appoint a representative to opt-out on his behalf.
21. The Rules however, do not specify who, in the case where the proprietor is a legal person and did not appoint any representative, shall lodge the application on his behalf. In such a case, and

according to these Rules, the standing to apply for an opt-out is not restricted to certain persons. Therefore it must be interpreted as enabling any authorized person to lodge an opt-out application.

- 21.1 As head of the IP department, Dr Schweitzer filed several opt-out applications for the company during the sunrise period. However, he forgot to file one: EP 496. Ms Barbie Roberts, his personal assistant who is very reliable and conscientious, and who was instructed by Dr Schweitzer to follow up the proceedings regarding these opt-outs (**Exhibit 5**) realised that Dr Schweitzer missed one. She therefore came back to work during her holidays and lodged the opt-out application for him.
- 21.2 By filling the online application form, she had to fill in two categories of fields: the "Details required by Rule 5.3" (details needed in order to lodge a valid opt-out) and the "Opt-out Applicant data". The second category is to be filled in in order to enable the Registry and third parties to communicate with the applicant. At this stage, Ms Roberts mistakenly ticked "No" instead of "Yes" by answering the question "Applicant is a company/firm?". However, this misstatement is of no consequence since she also put as contact e-mail, her professional e-mail at Haussmann La Riche <Barbie.roberts@Haussmann-la-riche.com>, which enables the Registry and third parties to reach Haussmann La Riche, but also clearly shows that she acted in the name of the company.

Opt-out Applicant Data

Data available in precompiled fields is retrieved from user profile and company data

Applicant is a company/firm? *	No ▼
First Name *	Barbie
Last Name *	Roberts
Contact e-mail *	barbie.roberts@haussmann-la-riche.com

Screenshot of the amended online application form

- 21.3 Ms Roberts, as an employee of Haussmann La Riche II and having been instructed by Dr Schweitzer (head of the IP department) had capacity to lodge the application to opt out patent EP 496 on the company's behalf. Furthermore, the fact that she ticked the answer "NO" to the question "Applicant is a company/firm?" is of no consequence on the validity of the opt-out.
22. In summary, Haussmann La Riche II and Nivartos' opt-out has been validly lodged and became effective on 2 January 2017, i.e. more than two months before Generoso brought its action before the Court.

SUMMARY

Having regard to Rules 19.1 (a) and 20.1 of the Rules of Procedure, Haussmann La Riche II and Nivartos request that the judge-rapporteur:

As a main claim,

Pursuant to Article 83(3) of the Agreement, Rule 5 of the Rules of Procedure, the Preamble of the Agreement, the Preamble of the Rules of Procedure, and Article 42 of the Agreement:

- Hold that the Unified Patent Court is incompetent to hear this case.
- Hold that the address is not a validity requirement of the opt-out application.
- Hold that there is no restriction to certain persons for applying to an opt-out.

In any case,

- Order Generoso to pay the costs of the procedure borne by Haussmann La Riche II pursuant to Article 69 of the Agreement.

* * *

LIST OF EXHIBITS

- 1.** HLR/N Exhibit 1: Nivartos Letter of Consent
- 2.** HLR/N Exhibit 2: Company House Extract
- 3.** HLR/N Exhibit 3: Sponsor of the Ruritanian Football team (Football World's cup 2010)
- 4.** HLR/N Exhibit 4: Screenshot of the amended application dated 2 January 2017
- 5.** HLR/N Exhibit 5: Email of 11 December 2016

Unified Patent Court
Judge-rapporteur

Filed: 20 May 2017

Case nr: 2017/0001

Written comments on
preliminary objectiOns

Generoso, a company governed by Italian law,
with its registered office located in Strada dell'Orto 2016, Milano, Italy,
claimant in the main proceedings,
respondent in the preliminary objections ("**Generoso**"),

represented by:

1. Mr. Wouter Pors,
attorney-at-law, Bird & Bird
Zuid-Hollandplein 22, 2596 AW The Hague, The Netherlands
PO Box 30311, 2500 GH The Hague, The Netherlands
wouter.pors@twobirds.com
2. Guillaume de La Bigne,
European Patent Attorney (representative of record for the purpose of service)
LLR, 11 boulevard de Sébastopol, 75008 Paris, France
labigne@llr.fr

against

1. **Hausman la Riche**, a company governed by Ruritanian law,
with its registered office located in Beethoven Strasse 1770, Strelsau, Ruritania
 2. **Nivartos**, a company governed by Ruritanian law,
with its registered office located in Mozart Strasse 1756, Strelsau, Ruritania
- defendants in the main proceedings,
claimants in the preliminary objections (jointly also: "**Hausmann cs**"),

represented by:

1. Emmanuel Gougé,
attorney-at-law, Pinsent Masons (representative of record for the purpose of service)
Member of the Paris bar, Solicitor (England & Wales),
21-23 rue Balzac, 75008 Paris, France
emmanuel.gouge@pinsentmasons.com
2. Kevin Cordina,
European Patent Attorney, Olswang
kevin.cordina@olswang.com

A. Introduction and principles of UPC law

1. Generoso takes the position that the opt-out of EP 0 831 496 B1 (“EP 496”) by a certain Barbie Roberts is invalid and therefore the Unified Patent Court is competent to hear the revocation claim filed by Generoso. Barbie Roberts is not an owner of EP 496. The company which she initially listed in the opt-out register as owner of EP 496 ceased to exist in 2001. The second owner of the patent was only added later on, so the opt-out application was in any case not filed on behalf of all co-owners of EP 496. Until the present day, at best only one of the co-owners of EP 496 appears in the opt-out register, but only because it was introduced by a third party, Barbie Roberts, who has no rights at all to EP 496. This will be explained in more detail below.
2. As a starting point, it is important to realise that the contracting parties to the Unified Patent Court Agreement (“UPC Agreement”) intended to create a single forum for litigation with regard to both Unitary Patents and traditional European patents, which should have exclusive jurisdiction to decide such cases. In the end, no national court should be left competent to decide cases on the infringement and validity of European patents, in whatever form. This is also clear from the considerations that precede the UPC Agreement.
3. However, as a transitional measure only, it should remain possible to bring actions on infringement and validity of traditional European patents (and not of Unitary Patents) before a national court for a limited period of time. This is clearly the exception to the exclusive jurisdiction of the UPC, and it is also clear that using this exception cannot guarantee the legal certainty mentioned in the “wish” preceding the UPC Agreement. Besides, such exceptions are an obstacle for the free movement of goods within the European Union and therefore are difficult to reconcile with Union law, which under article 20 and 24 UPC Agreement should always take priority. Therefore, it should clearly remain the exception.
4. Such an exception cannot be interpreted broadly, but instead needs to be interpreted strictly. The UPC Administrative Committee has clearly understood this and has therefore set strict requirements for an opt-out application to be valid, as listed in Rule 5 of the Rule of Procedure (RoP). There is no room for broad interpretation of the requirements, which would devalue the creation of a single jurisdiction for the litigation of European patents in the UPC Contracting Member States; any European patent should in principle be within the jurisdiction of the UPC and only left out in exceptional, clear defined situations.

5. Against this background it is clear that Haussmann la Riche (new) and Nivartos have not validly opted out EP 496.

B. Patent co-owner Haussmann la Riche (new) not validly identified

6. Haussmann la Riche (new) claims that it is a well-known pharmaceutical company, founded in 1850. This, however, is not true. The company Haussmann la Riche that was founded in 1850 was liquidated in 2001 and does not exist anymore. It sold its assets, including EP 496, to the company Haussmann la Moche, a different legal entity without the reputation in the life sciences sector that Hausmann la Riche (old) had. It is this legal entity that has owned the patent since 2000. This relatively unknown company Haussmann la Moche then changed its name to Haussmann la Riche, which to the outside world may indeed have created the impression that this legal entity had been active in the life sciences sector since 1850. The fact that a new legal entity can assume a well-known name of another legal entity after an asset deal, is all the more reason why it should be absolutely clear in the name of legal certainty which legal entity actually takes legal action, including filing an opt-out application.
7. The rules are clear: Rule 5(3)(a) RoP provides that the opt-out application must contain:

“the name of the proprietor or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and all relevant postal and, where applicable, electronic addresses”
(underlining added)

8. However, as shown in the following screenshot of the Case management system

Details required by Rule 5.3

Proprietors/Applicants pursuant to Rule 8.5.

SPCs

Holders of any granted SPC, if different from the proprietors listed above

the application does not contain the postal address of the legal entity that currently goes by the name of Hausmann la Riche, but of the liquidated legal entity that used to carry that name. Since the Rules of Procedure do not require submitting the company

registration number of the legal entity that files the request and since the UPC case management system does not even allow for submitting that, the postal address in this case is the only company data to correctly identify the patent co-owner. This is not something that can be ignored and therefore the opt-out application is invalid, meaning that the UPC retains competence to hear the claim for revocation of EP 496, as was the basic intention of the Contracting Member States.

C. No opt-out by both patent co-owners

9. Rule 5(1)(a) RoP clearly provides that if a patent is owned by two proprietors, they both have to lodge the application to opt out. It is not in dispute that this has not happened; the application to opt out was at best only lodged by Hausmann la Riche (new) on 31 December 2016. Again, this is an important issue of legal certainty. Third parties that want to decide whether they can clear the path for their own products by filing a central attack on validity with the UPC need to be able to rely on the opt-out register. This may be a matter of hours or even days, as the whole sector is well aware of the urgency to file opt-outs and revocation actions due to the countless seminars and conferences in which this issue was addressed in recent years.
10. Barbie Roberts tried to change her omission on 2 January 2017, but that could not be taken into account without violation of the required legal certainty. The Rules of Procedure do not provide for an opt-out in stages. If this would be allowed, it would become impossible to set the boundaries to create legal certainty. What if an opt-out for a patent having multiple owners was filed by just one, and then followed by others a week later? Or a month? Or a year? Or even after a revocation action had been commenced? The only just solution is applying a hard and fast deadline, meaning that you only get one shot to do it right.
11. Anyway, Haussmann cs cannot claim that their interests are harmed since they are now subject to the jurisdiction of the UPC. After all, there is no better patent court available in Europe.
12. An application to opt out can only be made once. This is clearly provided in Rule 5(11) RoP. Again, this is perfectly logical given the aim of the UPC Agreement. You cannot opt out, then opt in and then opt out again. You just get one shot. This is a further reason why an incorrect opt-out application cannot be repaired later on. The clear intention of the Contracting Member States was to provide only one option to use the exception to the rule by opting out.

13. Thus, the fact that Nivartos was omitted in the original application cannot be repaired.

D. Patent co-owners not duly represented

14. A further ground is that applications were not filed by the patent owners (Hausmann la Riche and – maybe – Nivartos), but by an unknown individual, Barbie Roberts. Of course, it is unfortunate that the UPC case management system (and also Rule 5(4) RoP) allows access to users who do not qualify as UPC Representatives under article 48 UPC Agreement, but in this case the application was even filed by a person who had no legal authority to represent the patent owners at all.
15. This is a matter that is not covered by the UPC Agreement or the Rules of Procedure, which simply provide that such an application has to be filed by the patent proprietors, but do not deal with the issue of who is permitted to act on behalf of such a proprietor if the proprietor is a legal entity.
16. Under article 24(1)(e) UPC Agreement this is a matter of national law. Under rules of private international law, the question of representation of a legal entity is governed by the national law of the country of incorporation of the legal entity, in this case Ruritanian law. The UPC has not been provided with a legal opinion on the content of Ruritanian corporate law, which of course would be the responsibility of the patent owners, since they now want to rely on the representation by this Barbie Roberts.
17. We have been informed that Ruritanian law might bear some resemblance to French law. It would therefore seem likely that the standard situation would be that such a company can be represented by its management as provided for in the by-laws of the legal entity. In this case, that is Mr. Jon Reelax (see Hausmann cs exhibit 2). However, he did not file the opt-out application.
18. Of course, the management could also issue specific powers of attorney to other officials of the company. For instance, the patent department manager of Hausmann la Riche (new), Dr. Schweitzer, might hold such a power of attorney, although even that has not been submitted by the company. It is however highly unlikely that Barbie Roberts would have such power of attorney under Ruritanian law. EP 496 was not opted-out together with the other traditional European patents owned by Hausmann cs. It is clear that there was no decision to opt-out by Mr. Reelax or Dr. Schweitzer. In fact, we know from the affidavit by Ken Carson, Barbie Robert's former fiancé, that she acted on her own at the very last moment. This is actually confirmed in paragraph 21.1

of Haussmann cs' Preliminary Objections, which states that Dr. Schweitzer forgot to file an opt-out for EP 496. Under Ruritanian corporate law, this is not a duly representation of Haussmann la Riche (new). Finally, Haussmann cs exhibit 5 does not constitute a valid power of attorney to opt out EP 496 under Ruritanian law at all.

19. On top of all of this, Barbie Roberts did not even claim in the UPC case management system that she filed the opt-out on behalf of the patent owners, but on behalf of herself.
20. For Nivartos, we have no information on company representation. Dr. Schweitzer is not employed by Nivartos. Actually, there are serious doubts whether Nivartos is a co-owner of EP 496 at all. Haussmann cs have submitted as their exhibit 1 an affidavit by a Mr. Jonas Clever, who claims that he in person, and therefore not the company Nivartos, owns 50% of EP 496. Mr. Clever seems to have granted a power of attorney to Dr. Schweitzer to act on behalf of Nivartos, but that is futile if Nivartos is not a co-owner of EP 496, and since Mr. Clever has not granted a power of attorney to Dr. Schweitzer to represent him personally. Anyway, there is no trace of a further power of attorney, either on behalf of Nivartos or on behalf of Mr. Clever, to Barbie Roberts. Nivartos or Mr. Clever in person were therefore not duly represented by Barbie Roberts when she filed to opt-out application.

E. Conclusion on opt-out

21. Thus, the attempt to opt out EP 496 has been made on behalf of a company that no longer exists (Hausmann la Riche (old)) and on behalf of a company that is not a co-owner of EP 496 (Nivartos) by a person who is not authorized to represent any relevant company and without lodging the application on behalf of both patent co-owners.
22. Therefore, whoever currently owns EP 496, they are subject to the jurisdiction of the UPC, which is the main rule anyway, the basic intention of the Contracting Member States and the best court in Europe to defend your patent in.
23. Haussmann cs have argued that they are quite well-known, so it really wouldn't matter whether the opt-out was done correctly by a person authorized to do so. This of course cannot set aside the need for legal certainty.
24. The instruction to apply procedural rules with proportionality, flexibility, fairness and equity also does not change this, as it is clearly proportionate, fair and equitable to

have patent revocation actions handled by the UPC. Flexibility can be applied where needed, but especially with regard to opt-out not to the detriment of legal certainty.

F. Generoso's claim for revocation is valid

25. Of course, the claim for revocation as filed by Generoso is perfectly valid, as Generoso could rely on the information contained in the national patent registers in the United Kingdom, Germany, France and The Netherlands. Besides, the defendants have appeared to defend their case, which means that the UPC has jurisdiction under article 26 in combination with 71(b)(2) Brussels I Regulation, since both Haussmann la Riche and Nivartos have made an appearance in court without contesting jurisdiction on other grounds than article 83 UPC Agreement.

G. Final conclusion

26. The final conclusion therefore is that the preliminary objections as submitted by Haussmann la Riche and Nivartos should be rejected, the UPC has to assume jurisdiction to hear the revocation action with regard to EP 496 against these two defendants and Haussmann la Riche and Nivartos should be ordered to remunerate all costs incurred by Generoso in relation to these preliminary objections. Generoso will submit a specification of these costs during the main proceedings and hereby requests a cost order under Rule 150(2), to be taken in the decision on the merits.

Wouter Pors
Guillaume de la Bigne
UPC Representatives

REPLY ON WRITTEN COMMENTS ON THE PRELIMINARY OBJECTION

Filed on 26 May 2017

BETWEEN

HAUSSMANN LA RICHE

a company governed by Ruritanian law, having its registered office at Beethoven Strasse, 1770 Strelsau Ruritania, represented by Mr Jon Reelax, acting in his capacity as General Director.

AND

NIVARTOS

a company governed by Ruritanian law, having its registered office at Mozart Strasse, 1756 Strelsau, Ruritania, represented by Mr Jonas Clever, acting in her capacity as General Director.

Claimants in the preliminary objection / Defendants in the main proceedings

Represented by

Emmanuel Gougé
Attorney-at-law, Pinsent Masons LLP
emmanuel.gouge@pinsentmasons.com
who is authorized to accept service in relation to these proceedings;

Kevin Cordina
European Patent Attorney, Olswang LLP
kevin.cordina@olswang.com

Vs.

GENEROSO

a company governed by Italian law, having its registered office at Strada dell'Orto, 2016 Milano, Italy, represented by Ms Donatella Tutti.

Defendant in the preliminary objection / Claimant in the main proceedings

Represented by

Wouter Pors
Attorney-at-law, Bird & Bird
wouter.pors@twobirds.com
who is authorized to accept service in relation to these proceedings;

Guillaume de la Bigne
European patent attorney, LLR
labigne@llr.fr

1. By this reply on written comments on the preliminary objection dated of 6 May 2017, the Defendants seek to declare the Unified Patent Court (hereinafter "UPC") incompetent to hear the revocation action brought by the Claimant against their European patent No. 0 813 496 B1 (hereinafter "EP 496"), basing their argumentation on the prior opt-out of said patent, lodged according to Rule 5 of the Rules of Procedure of the Unified Patent Court (hereinafter the "Rules").

As it will be demonstrated below, the Claimant tries to mislead the Court with wrong statements which cannot go unanswered.

- 1.1 According to Rule 36:

Without prejudice to the powers of the judge-rapporteur pursuant to Rule 110.1, on a reasoned request by a party lodged before the date on which the judge-rapporteur intends to close the written procedure [Rule 35(a)], the judge-rapporteur may allow the exchange of further written pleadings, within a period to be specified. Where the exchange of further written pleadings is allowed, the written procedure shall be deemed closed upon expiry of the specified period.

It is requested that the Defendants are permitted to make the following submissions on the claimant's comments on the Defendant's Preliminary Objections. The Comments make misleading statements that mischaracterise the Defendant's position and if not addressed in writing will lead to unnecessary and lengthy discussion at the Oral Hearing. In order to address the misleading comments it is also necessary to file additional exhibits, as filed herewith. The Court is thus requested to grant permission under Rule 36 for these additional, and final, written submissions to be entered into the case.

- 1.2 The Submissions are also necessary to ensure compliance with **Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms** which sets out the principle of a right to a fair trial. This principle ensures adversarial proceedings, meaning that both parties must be heard, which should allow the defendant to respond to all the claims stated against him.

In the present case, the Defendants should be able to reply to the Comments on the preliminary objection submitted by the Claimant, since he did submit new arguments, and it turns out that some of them are specious.

- 1.3 Furthermore, according to **Rule 20.1** related to the preliminary objection, "*the judge-rapporteur shall give the parties an opportunity to be heard*". The following reply is made for the purpose of such a hearing.

I. THE AIM OF OPTING OUT

2. The Defendants agree with the Claimant when he says that the possibility of opting out a European patent from the exclusive competence of the UPC is only a transitional measure, and should remain the exception. However, since the implementation of the UPC system leads to major changes (it enables for example a central attack against a European patent, as it is the case here), a transitional period allowing the patentees to opt out is necessary, and such wish of the patentees should be respected.
- 2.1 This being said, the Defendants also agree with the Claimant when he argues that the requirements to validly lodge an opt-out application should not be interpreted broadly. However, a strict interpretation should not be made at the expense of the general principles of law regarding the need for proportionality, flexibility, fairness and equity¹.
- 2.2 In the present case, there is no doubt that Haussmann La Riche and Nivartos agreed to opt out from the exclusive competence of the UPC the patent they own in co-ownership since 2012. Therefore, it would appear disproportionate, inflexible, unfair and inequitable (it should be reminded

¹ These general principles are recalled in paragraph 6 of the Agreement's preamble, paragraphs 2 and 4 of the Preamble of the Rules of Procedure, and Article 42 of the Agreement.

that Generoso is a generic drugs manufacturer and therefore a competitor of the Defendants) to impose to Haussmann La Riche and Nivartos the competence of the UPC (and thus, the huge consequences it involves) because of an immaterial misstatement (wrong address) which is of no consequence in order to identify and to reach the applicant.

II. VALID IDENTIFICATION OF HAUSSMANN LA RICHE

3. The current legal existence of Haussmann La Riche is not in doubt (**Exhibit 2**). Besides, in light of Haussmann La Riche's long history (Haussmann La Riche I - from 1850 to 2001 - and Haussmann La Riche II – from 2001) Haussmann La Riche (I and II), have become one of the oldest and most well-known companies of the city of Strelsau. Haussmann La Riche II is, more broadly, renowned across Europe in the pharmaceutical industry. Because of its sustained business success since 1850 (starting with Haussmann La Riche I until today with Haussmann La Riche II) everyone in Strelsau (and in particular the competitors) knows Haussmann La Riche II and would have no problem to localise it (**Exhibit 3**).
- 3.1 Contrary to what the Claimant states in its written comments, Haussmann La Riche II never argued that it was the same entity as Haussmann La Riche I. Nevertheless, the Court shall be reminded that Haussmann La Moche (before becoming Haussmann La Riche II) was a wholly owned subsidiary of Haussmann La Riche I, which had full legal control on it. *De facto*, Haussmann La Moche benefited from Haussmann La Riche I sustained success. Furthermore, by acquiring all its assets in late 2000, Haussmann La Moche absorbed its parent company. Indeed, said transfer of assets – called in Ruritanian law a "universal transfer of assets"² – cannot be assimilated to a simple sale of assets from a company to another, but should rather be considered as a substitution of the acquiring company in all property, rights and obligations of the absorbed company. This absorption of Haussmann La Riche I (including its human asset) allowed Haussmann La Moche (who became Haussmann La Riche II only months after the absorption) to maintain the success and reputation of the initial and well-known Haussmann La Riche company founded in 1850.
4. With regard to the immaterial error concerning Haussmann La Riche's address, it should not invalidate its opt-out application. Indeed, the requirement provided in Rule 5.3 (a) ("*all relevant postal and, where applicable, electronic addresses*") is met.
- 4.1 According to the Claimant, "*the postal address in this case is the only company data to correctly identify the patent co-owner*". However, this statement is untrue. Firstly, the name of Haussmann La Riche appears clearly on the application (and said company cannot be confused with Haussmann La Riche I, since the latter was dissolved and liquidated in 2000). Secondly, according to the abovementioned provision, an electronic address may as well be used to identify the applicant. In the present case, Ms Barbie Roberts, who has been an employee at Haussmann La Riche since 1995 (at Haussmann La Riche I from 1995 until 2000, and after that at Haussmann La Riche II from 2000 until now), put her professional electronic address < barbie.roberts@haussmann-la-riche.com > when filing the application. This enables the Registry and third parties to identify Haussmann La Riche as the applicant.
- 4.2 Lastly, the purpose of this Rule is more a **practical one**; *i.e.* to enable the Registry and third parties to reach the applicant. Thanks to the electronic address said purpose is achieved.
- 4.3 The mistake in the address has had no consequences on the ability of the Claimant to contact and serve proceedings on the Defendants. As can be seen from the "Request For Service Abroad" provided by the Claimant, they were able to identify the correct address of Haussmann La Riche II and arrange service. The incorrect address on the opt-out did not affect their ability in any way to identify the correct address for service. The incorrect address therefore has not had any practical consequences on proceedings and does not invalidate the opt-out application.

III. OPT-OUT APPLICATION VALIDLY COMPLETED WITH THE NAME OF THE PATENT CO-OWNER, NIVARTOS

5. According to Rule 5.1 (a):

² See Article L 236-3 of the French Commercial Code which is very similar to the Ruritanian Commercial Code.

"Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out."

5.1 In the present case, the contested patent is owned in co-ownership by Haussmann La Riche II and Nivartos. Contrary to what the Claimant argues, it is obvious that Nivartos is the co-proprietor of EP 496, rather than Nivartos' General Director, Mr Jonas Clever (for a correction of the clerical error in Letter of consent of 7 December 2016: **Exhibit 1 bis**). Therefore, Nivartos shall lodge the opt-out application together with Haussmann La Riche.

5.2 However, as already mentioned in the preliminary objection, the online application is partly automatically filled in with the information in the European Patent Office database (which can be outdated), and therefore the name of Nivartos did not appear as co-owner of the contested patent when Ms Barbie Roberts lodged the opt-out application. However this has been corrected by Ms. Roberts.

5.3 In order to challenge Nivartos' valid application, Generoso denies the possibility for opt-out applicants to rectify an incorrect or incomplete application, arguing that this would create legal uncertainty. However such possibility is clearly provided in Rule 5.6 and cannot possibly be denied. Rule 5.6 *in fine* provides that:

"If the requirements are missing or incorrectly recorded, a correction may be lodged with the Registry. The date of entry of the correction shall be noted in the register".

5.4 This is exactly what Ms Roberts did as soon as she realised that the name of Nivartos was missing. She added Nivartos on 2 January 2017, i.e. 2 days after the lodging, as follows: "*Nivartos, Mozart Strasse, RT Streslau*" (**Exhibit 4**).

5.5 Moreover, such a correction does not create legal uncertainty since, when an applicant amends its application on the basis of Rule 5.6, the opt-out application only becomes effective "*from the date of correction*" (Rule 5.6). This means that before that date (which, as suggested by Generoso could indeed occur "*a week later, or a month, or a year*" since the contracting Member States did not set any deadline to amend the application), a statement for revocation of the incorrectly opted-out patent can and should be brought before the UPC. Thus, third parties are able to rely on the opt-out register, and the legal certainty is maintained.

6. Finally, the Claimant based all its argumentation, regarding the alleged impossibility to modify an application to opt out, on Rule 5.11, which makes no sense. Indeed, said Rule provides that:

"A patent or application the subject of an Application to withdraw which has been entered on the register may not thereafter be the subject of a further Application to opt out."

6.1 This rule means that an application to opt out can only be made once and withdrawn once. This scenario has however nothing to do with the present case. Haussmann La Riche and Nivartos' opt-out application has never been withdrawn; it has only been completed by correction after filing, which, as demonstrated above, is totally admissible.

7. In conclusion, both co-owners of the patent, Haussman La Riche II and Nivartos, did validly lodge the application to opt-out, more than two months before Generoso filed its statement for revocation.

IV. MS BARBIE ROBERTS HAD CAPACITY TO VALIDLY LODGE THE OPT-OUT APPLICATION

8. Pursuant to Rule 5.1:

"The proprietor of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application with the Registry".

8.1 And pursuant to Rule 5.4:

*"Rule 8 [requiring representatives in certain situations] shall not apply to Applications to opt out made pursuant to this Rule 5. Where a representative is appointed, such a representative may include professional representatives and legal practitioners as defined in Article 134 EPC in addition to those referred to in Article 48 of the Agreement"*³

- 8.2 According to these Rules, the person who shall lodge the application to opt out is the proprietor of or the applicant for a European patent, and said proprietor or applicant may or may not appoint a representative to opt-out on his behalf.
- 8.3 The Rules however, do not specify who, in the case where the proprietor is a legal person and did not appoint any representative, shall lodge the application on his behalf. In such a case, and according to these Rules, the standing to apply for an opt-out is not restricted to certain persons. Therefore it must be interpreted as enabling any authorized person to lodge an opt-out application.
- 8.4 According to Ruritanian law⁴, the person who can represent Haussmann La Riche II and act on its behalf is its General Director, Mr Jon Reelax. He however may delegate his authority for administrative, technical, financial or accounting acts to an employee of the company. Accordingly, he delegated his authority concerning the patent department to the head of the IP department and also European patent attorney, Dr Schweitzer. Within this delegation of authority, Dr Schweitzer shall perform, on behalf of the company, any needed act related to the life of Haussmann La Riche II's patents (i.e. including opt-out applications) (**Exhibit 1 ter**). He therefore filed several opt-out applications for the company during the sunrise period (**Exhibit 1 quarter**). However, he forgot to file the contested one: EP 496. Ms Barbie Roberts, his personal assistant who is very reliable and conscientious, and who was instructed by Dr Schweitzer to follow up the proceedings regarding these opt-outs (**Exhibit 5**), realised that Dr Schweitzer missed one. She therefore came back to work during her holidays and lodged the opt-out application for him.
9. By filling the online application form, she had to fill in two categories of fields: the "Details required by Rule 5.3" (details needed in order to lodge a valid opt-out application) and the "Opt-out Applicant data". The second category is to be filled in in order to enable the Registry and third parties to communicate with the applicant. At this stage, Ms Roberts mistakenly ticked "No" instead of "Yes" by answering the question "Applicant is a company/firm?". However, this misstatement is of no consequence since she also put as contact e-mail her professional electronic address at Haussmann La Riche <Barbie.roberts@Haussmann-la-riche.com>, which on the one hand enables the Registry and third parties to reach Haussmann La Riche, and on the other hand clearly shows that she acted on behalf of the company, and not on behalf of herself, as argued by the Claimant.
10. Ms Roberts, as an employee of Haussmann La Riche and having been instructed by Dr Schweitzer, had capacity to lodge the application to opt out EP 496 on the company's behalf. Furthermore, the fact that she ticked the answer "NO" to the question "Applicant is a company/firm?" is of no consequence on the validity of the opt-out.

V. THE DEFENDANTS DID NOT DEFEND THEIR CASE ON THE MERITS

11. Finally, the Defendants completely disagree with Claimant's argument which consists in saying that the UPC has jurisdiction under Article 26 in combination with Article 71(b)(2) of Brussels I Regulation, since Haussmann La Riche II and Nivartos have made an appearance in court without contesting jurisdiction on other grounds than Article 83 of the Agreement.
- 11.1 Article 26 of Brussels I Regulation provides that:

"1. Apart from jurisdiction derived from other provisions of this Regulation, a court of a Member State before which a defendant enters an appearance shall have jurisdiction. This rule shall not apply where appearance was entered to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of Article 24." (Underlining added)

³ According to the Claimant, Rule 5.4 is unfortunate since it allows persons who do not qualify as UPC representatives under Article 48 of the Agreement to file opt-out applications. However, this rule is not at all unfortunate. It is only pragmatic to extend the faculty to be a representative within lodging opt-out applications, since this act is purely administrative and does not require a particular litigation skill.

⁴ Which again is very similar to French law.

2. In matters referred to in Sections 3, 4 or 5 where the policyholder, the insured, a beneficiary of the insurance contract, the injured party, the consumer or the employee is the defendant, the court shall, before assuming jurisdiction under paragraph 1, ensure that the defendant is informed of his right to contest the jurisdiction of the court and of the consequences of entering or not entering an appearance."

According to Article 26 (1), the fact that Haussmann La Riche and Nivartos entered an appearance before the UPC is of no consequence with regards to its jurisdiction since they did it only to contest it. There is no need for Haussmann La Riche and Nivartos to contest the UPC's jurisdiction "on other grounds than Article 83 of the Agreement".

- 11.2 Article 71(b)(2) does not exist. Perhaps the Claimant meant Article 71(2)(b). However said provision deals with the recognition and enforcement of judgments given in a Member State by a court in the exercise of jurisdiction provided for in a convention on a particular matter. This, again, has nothing to do with this case.

CONCLUSION

12. To conclude, Haussmann La Riche II and Nivartos' opt-out application has been validly lodged and does not raise any legal certainty issue. Indeed, it has been validly lodged by both patent co-owners (the immaterial error in the address of Haussmann La Riche II is of no consequence, and Nivartos' co-ownership and willingness to opt out the patent has already been demonstrated), and Ms Barbie Roberts, who acted under Dr Schweitzer's instructions, had authority to do so.

Furthermore, opt-out has become effective on 2 January 2017, i.e. more than two months before Generoso brought its action before the Court.

EXISTING EXHIBITS

HLR/N Exhibit 1: Nivartos' Letter of Consent.

HLR/N Exhibit 2: Company House Extract.

HLR/N Exhibit 3: Sponsor of the Ruritanian Football team (Football World's cup 2010).

HLR/N Exhibit 4: Screenshot of the amended application dated 2 January 2017.

HLR/N Exhibit 5: Email of 11 December 2016.

NEW EXHIBITS

HLR/N Exhibit 1 bis: Corrective Declaration of Mr Jonas Clever.

HLR/N Exhibit 1 ter: Delegation of authority to Dr Schweitzer.

HLR/N Exhibit 1 quarter: List of patents to opt out from the exclusive competence of the UPC.

REBUTTAL TO REPLY TO WRITTEN COMMENTS
ON THE PRELIMINARY OBJECTION

Filed on 3 June 2017

ON BEHALF OF

Generoso, a company governed by Italian law,
with its registered office located in Strada dell'Orto 2016, Milano, Italy

“The Claimant” in the main proceedings

“The Defendant” in the preliminary objections

represented by

Wouter Pors

Attorney-at-Law, Bird & Bird

Zuid-Hollandplein 22, 2596 AW The Hague, The Netherlands

PO Box 30311, 2500 GH The Hague, The Netherlands

wouter.pors@twobirds.com

Guillaume de La Bigne

European Patent Attorney (representative of record for the purpose of service)

LLR

11 boulevard de Sébastopol, 75008 Paris, France

labigne@llr.fr

AGAINST

Hausmann la Riche, a company governed by Ruritanian law, with its
registered office located in Beethoven Strasse 1770, Strelsau, Ruritania

Nivartos, a company governed by Ruritanian law, with its
registered office located in Mozart Strasse 1756, Strelsau, Ruritania

“The Defendants” in the main proceedings

“The Claimants” in the preliminary objections

represented by

Emmanuel Gougé

Attorney-at-Law, Pinsent Masons LLP (representative of record for the purpose of service)

emmanuel.gouge@pinsentmasons.com

Kevin Cordina

European Patent Attorney, Olswang LLP

kevin.cordina@olswang.com

In accordance with Rule 36 of the RoP, it is requested that Generoso is permitted to file the following rebuttal arguments to the Claimants' reply to written comments on the preliminary objection. This rebuttal consists of two parts: a response to the reply filed by Defendants and a submission of new facts. Indeed, these additional arguments are based on recent events.

RESPONSE TO THE REPLY TO WRITTEN COMMENTS ON THE PRELIMINARY OBJECTIONS

1. Generoso will only respond to the arguments presented by Haussmann cs as far as these are not covered by Generoso's previous pleadings. However, Generoso does not accept any of Haussmann cs' arguments, except if specifically stated below and does not waive its position in any way. Generoso also retains the right to further elaborate on any and all arguments during the oral hearing.
2. Since Haussmann cs have requested to be allowed to file a reply and in as far as such request is granted, Generoso is then entitled to file a rebuttal; this already follows from the equality of arms principle.
3. Haussmann cs argue that the strict interpretation of the provisions on opt out should be limited by the principles mentioned in recital 6 of the UPC Agreement. However, that recital is aimed at substantive decisions of the UPC, such as on validity and infringement. It cannot be used to limit the UPC's jurisdiction. The fact that a case is heard by the UPC can never be in breach of the principles cited in the recitals to the UPC Agreement. Quite to the contrary, it is in line with those principles.
4. It is not relevant whether everyone in Strelsau knows who Haussmann La Riche is; the revocation of the patent is claimed for the territory of the UPC, of which Ruritania and Strelsau are not a part.
5. Generoso disputes the nature of the transfer of assets claimed in paragraph 3.1 of the reply filed by Haussmann cs. They failed to file any evidence on the content of Ruritanian law. The concept of a legal merger of legal entities (apparently called a universal transfer of assets in France) is known in various UPC Contracting Member States and is quite different from a mere transfer of assets. The UPC cannot be expected to apply Ruritanian law *ex officio* and Generoso cannot be expected to research such law; this is the burden of proof of Haussmann cs, especially since Ruritania is not a Contracting Member State to the UPC Agreement.
6. Especially in this case an electronic address is not sufficient to identify the proper legal entity, whereas the postal address does provide complete clarity.
7. Under UPC law, it is not the responsibility of the Claimant to serve proceedings on the Defendant, as that is the task of the UPC itself. Indeed, the patent proprietor was correctly

identified by Generoso, correctly served by the UPC and did appear in Court. Only the opt-out application was wrong.

8. Nivartos claims that “it is obvious” that Nivartos is co-owner of the patent and not Mr. Clever, but the evidence submitted by Nivartos itself shows the contrary. Nivartos should be kept bound to its own evidence. Nivartos has now filed a “corrective declaration” by Mr. Clever as its **Exhibit 1 bis**, but Generoso disputes that Mr. Nivartos is telling the truth in this declaration. Nivartos has spent a lot of time and energy on contesting the UPC’s competence to hear this case, which they apparently find very important (which makes sense, as their patent is invalid); it is hard to believe that they would make such an error. If they wanted to prove that Nivartos and not Mr. Clever is co-owner of the patent, they should have submitted the obvious evidence, namely the deed of transfer. That evidence would predate the filing of this defense by Generoso, whereas the declaration of Mr. Clever is in response to that defense. That makes it all the more suspicious that no documentation on the actual transfer was submitted.
9. Haussmann cs basically argue in paragraph 8.4 that Barbie Roberts can represent the patent co-owners because “she is very reliable and conscientious”. Again, Haussmann cs have not submitted any legal opinion on Ruritanian law, but it is clear that this is not a legal argument under any national law for attributing the power to represent a legal entity.
10. In paragraph 10 Haussmann cs seem to claim that Barbie Roberts is authorized to represent the company because of the mere fact that she is an employee. This cannot be taken seriously and is in contradiction with Haussmann’s **Exhibit 1 ter**, which clearly shows that a power of attorney is needed to represent the company, even for someone of high ranking within the company, such as Dr. Schweitzer.
11. In response to paragraph 11.2: Generoso relied on Article 71b(2) Brussels I Regulation, see Official Journal of the EU L 163, Volume 57, of 29 May 2014, English edition, page L 163/3.

ADDITIONAL ARGUMENTS EVIDENCING A FRAUDULENT ATTEMPT TO LODGE AN APPLICATION TO OPT OUT

12. Generoso’s management was told at the end of May, by former Nivartos HRD, Mr Alan Condek, who recently (29 May 2017) joined Generoso, that in December 2016, relations between co-owners Haussmann La Riche and Nivartos have deteriorated : Haussmann La Riche was no longer in favour of opting out the European patent № 0 813 496 B1 contrary to Nivartos intention. Thus, Dr Schweitzer decided to postpone any opt out application relating to European patent № 0 813 496 B1.
13. However, at end of December 2016, Ms Roberts was thinking of leaving Haussmann La Riche and moving to Nivartos, as evidenced by the email sent by Alan Condek to Ms Roberts (Generoso Exhibit 4). Thus, it is likely that she fraudulently filed the application to opt out the EP patent, despite Dr Schweitzer’s instructions to postpone it, in order to make good impression on her potential employer.

14. Because a statement for revocation was filed and Ms Roberts finally decided to stay at Haussmann la Riche, Haussmann La Riche is trying in vain to claim that the opt out was validly filed by Ms Roberts.

FINAL CONCLUSION

The final conclusion previously filed is confirmed. Namely, the preliminary objections as submitted by Haussmann La Riche and Nivartos should be rejected.

LIST OF EXHIBITS ALREADY FILED

- Generoso Exhibit 1 : European patent № 0 813 496 B1
- Generoso Exhibit 2 : Mr Ken Carson 's Statement
- Generoso Exhibit 3 : O. Maserati short publication

NEW EXHIBIT

- Generoso Exhibit 4 : email from Alan Condek to Barbie Roberts dated 22/12/2016

(19)



(11)

EP 0 813 496 B1

(12)

EUROPEAN PATENT SPECIFICATION

(45) Date of publication and mention
of the grant of the patent:

01.01.1999

(51) Int Cl.:

B65D83/262 A61K38/00

(21) Application number: 97905020.0

(22) Date of filing: 01.04.1997

Corn treatment and apparatus for dispensing.

(84) Designated Contracting States:

AT BE BG CH CY CZ DE DK EE ES FI FR GB GR
HR HU IE IS IT LI LT LU LV MC MK MT NL NO PL
PT RO SE SI SK TR

(73) Proprietor: Haussmann La Riche
Bach Strasse, Strelsau, Ruritania

EP 2 254 647 B1

Note: Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent, in accordance with the Implementing Regulations. Notice of opposition shall not be deemed to have been filed until the opposition fee has been paid. (Art. 99(1) European Patent Convention).

Corn treatment and apparatus for dispensing

This invention relates to the treatment of corns, and in particular to apparatuses for the treatment of corns and compositions for use in such devices.

Background to the inventions

The treatment of corns in an efficient and effective manner is difficult. It has been the Achilles heel of the medical profession. Practitioners have identified two types of difficulty, both of which are addressed by the inventions disclosed herein.

Firstly, corns typically form on parts of the anatomy to which is difficult to attach treatment devices. The human foot is an irregular shape, placed within a shoe, and flexed and battered continuously during the day. Providing a device which is capable of delivering treatment while allowing users to go about their normal daily life is exceptionally difficult.

Secondly, corns appear to have a unique biological make up, potentially due to their growth location. This biology is largely resistant to known treatment compositions. This resistance varies greatly and it is often necessary to use trial and error to identify a treatment composition that has some success on a particular corn. This process is time consuming, expensive and delays treatment.

Summary of the invention

The claims below provide a new apparatus for the treatment of corns and a new composition for use in that device.

Detailed Description

Figure 1 shows a device for use in the treatment of corns, particularly in combination with the compositions described herein. The device has a plantar member shaped and configured to lie under a user's sole in use. A toe attachment device is provided for attaching one end of the device to a toe of the user, and a heel attachment device is provided for attaching an opposite end of the device to the heel of the user (of the same foot as the toe).

The plantar member has at least one pocket on the surface which in use faces the user's sole. The pockets are provided to hold a treatment composition, potentially of the type described herein. Each pocket is has an open face such that in use the composition is brought into contact with the user's sole and hence the corn. A plurality of pockets may be provided such that the pocket which overlies the corn can be selected, thus minimising the amount of composition required.

Each pocket comprises an electronic device, including sensors to sense a condition of the region close to the pocket and a dispensing mechanism. The dispensing mechanism is configured to dispense the composition into contact with the patient's skin in response to signals from the sensors.

The plantar member is flexible and relatively soft and is maintained in fixed relationship to the user's sole by the toe and heel attachment devices. The pocket walls are sufficiently rigid that the volume of the pockets is largely maintained when bearing a user's weight. The device does not interfere with the user's daily life and the user can continue as normal even though their corn is receiving continuous treatment.

The composition comprises a peptide of up to 100 amino acids, having a repeating amino acid sequence –MASE- (n) where n is at least 3.

Claims

1. A composition for use with an electronic treatment device, which composition comprises a peptide of up to 100 amino acids, the peptide having a repeating amino acid sequence – MASE- (n) where n is at least 3.

Addendum – Claims as filed

1. An electronic device for attachment to a human foot, the device comprising a toe attachment device, a plantar member, and a heel attachment device, wherein the plantar member has a plurality of pockets for holding a composition, each pocket comprises an electronic mechanism for selectively releasing the composition held in the respective pocket, wherein the selective release is performed in response to signals from sensors in the electronic device.
2. A composition for use with the device of claim 1, which comprises a peptide of up to 100 amino acids, the peptide having a repeating amino acid sequence – MASE-(n) where n is at least 3.

DECLARATION

I, the undersigned Ken Carson, born on April 3, 1961, in El Segundo, California (US), declare on my honor that my romance with Barbie Roberts came to an end last December 31, 2016.

Indeed, Barbie left me on this New Year's Eve for filing a fake opt-out.

She told me she urgently had to leave to opt out a European patent from the exclusive competence of the Unified patent Court. But, in the Italian Dreamhouse where I live, I am the inventor who makes high-end machines and gadgets for Barbie to use (though they usually end up malfunctioning). She had never invented anything and cannot be the proprietor of a patent.

I must admit, I didn't know what to say. I'm left alone.

In the Italian Dreamhouse, on March 4, 2017

Ken Carson

K-Carson

Short publication :**Mutated Maseratin protein, with an amplification of the MASE functional domain, reduces desquamation of hands and feet**

Ottavio Maserati, MD, PhD, PharmD

Podology Unit, Università di Bologna, Via Zamboni, 33, 40126 Bologna, Italia

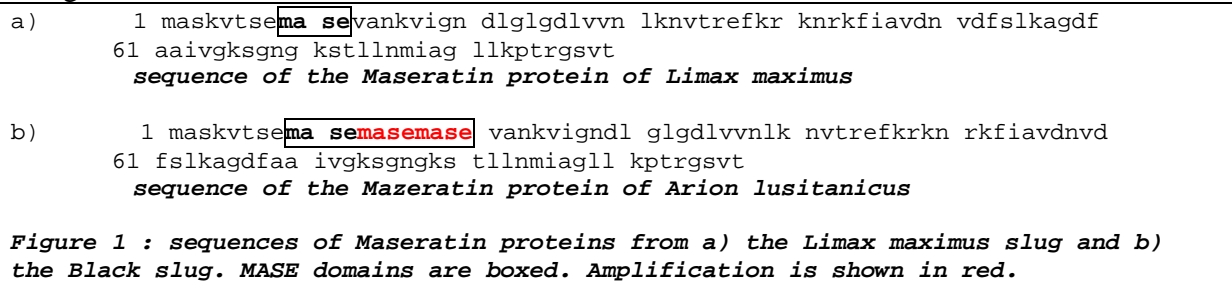
It is known for a long time, from Chinese medicine, that slug can be applied on the human body in order to reduce desquamation.

In 2005, we identified in the slug's slime a very abundant protein, called Maseratin, that is responsible for the reduction of desquamation when applied to hands and feet.

Maseratin, which is a member of the mucoprotein family, is a 90 amino acids long protein having a functional domain (the MASE domain) which interacts with the LEKT1 protein and inhibits the degradation of desmoglein 1, the key protein involved in the maintenance of the integrity of the skin.

We previously observed that *Arion lusitanicus*' slime (the Black slug) is more efficient on desquamation reduction than the slime of other slugs.

After sequencing the complete genome of the Black slug, we identify a genomic amplification of 12 nucleic acids in the *Mase* gene resulting in a triplication of the MASE domain as shown in figure 1.



We therefore extracted and purified by HPLC the mutated Maseratin protein from 1000 Black slugs and 10 micro liters of a 99% purified protein were obtained.

The effect of the purified protein was evaluated on the desquamed feet of 25 adult patients.

A small amount of a 10% dilution of the mutated Maseratin extract was rubbed for 2 minutes on the left heel of each patient, and both feet were placed into a water bath treatment electronic device (PEDILUVE 5000® Pediluve Electrique SA, Louvier, France) containing 2 liters of purified water for 30 min. The treatment consisted of gentle agitation at a temperature of 30°C.

After the treatment the aspect of the treated and non-treated heels were compared and noted on the RICH scale (1 to 10).

The results amazed the research team as a significant modification of the skin surface was observed on the treated heel, after only one treatment. Very significant desquamation reduction was observed after daily application for 5 days in all the patients.

These results are very promising for the skin treatment, and in particular would efficiently and significantly reduce desquamation feet.

Our meeting at the last Expo fair in Strelsau

From : Alan CONDEK <Condek@nivartos.com>

To: Barbie ROBERTS <Barbie.roberts@gmail.com>

Date: 22/12/2016 13:34

Dear Barbie,

Thank you very much for visiting our stand at the last Expo Fair in Strelsau.

I was very interested to discuss the ways in which your skills could help our IP administrative service.

I look forward to receiving your letter and CV confirming your application to our firm.

Kind regards,

Alan

Alan CONDEK

Head of Human Resources
NIVARTOS
Mozart Strasse, 1756 Strelsau
RURITANIA

NIVARTOS

NIVARTOS

LETTER OF CONSENT

NIVARTOS Gmbh
Mozart Strasse
RT Strelsau

Represented by Mr Clever, General Director

Strelsau, 7 December 2016

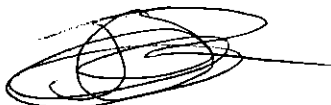
To HAUSSMANN LA RICHE Ltd
Beethoven Strasse
RT Strelsau
Represented by Mr Reelax, General Director

I, Mr Jonas Clever,

HEREBY DECLARE THAT,

- I have 50% of the ownership of European patent n° 0 813 496 B1, pursuant to an assignment dated on 1 July 2012 concluded with Haussman la Riche Ltd company, whose head office is located at Beethoven Strasse, Strelsau.
- I release Dr Schweitzer, Haussmann La Riche's head of the patent department, to act on NIVARTOS' behalf in signing all documents in relation to the European patent n° 0 813 496 B1, and in particular in relation with the opt-out of said patent, according to Article 83 of the Unified Patent Court Agreement and to Rule 5 of the Unified Patent Court Rules of Procedure.

Sincerely,



Signature

NIVARTOS

NIVARTOS

Strelsau, 24 May 2017

I, Mr Jonas Clever, acting in my capacity as General Director of Nivartos, a limited liability company, with a share capital of 1.350.000,00 Ruritanian Marks, recorded in the Commercial Register of Strelsau under No. 283 457 549, having its registered office at Mozart Strasse, 07 0030 Strelsau (Ruritania), have been informed that the letter of consent of 7 December 2016 states that I have 50% of the ownership of European patent n° 0 813 496 B1.

This statement is obviously a clerical error, since the only co-proprietor of abovementioned patent is the company NIVARTOS, pursuant to an assignment dated on 1 July 2012 concluded with Haussman la Riche Ltd Company.

Sincerely,

A handwritten signature in blue ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

DELEGATION OF AUTHORITY

I, Mr Jon Reelax, acting in my capacity as General Director of Haussmann La Riche, public limited company with a share capital of 3.460.000,00 Ruritanian Marks, recorded in the Commercial Register of Strelsau under the No. 123 456 789, having its registered office at Beethoven Strasse, 07 0030 Strelsau (Ruritania),

Hereby authorize,

Dr Schweitzer, manager of Haussmann La Riche's patent department, domiciled at Klenze Strasse 106, Munich, Germany, to perform all acts necessary during the lifetime of the patents of the company.

Made in Strelsau, Ruritania, on 13 January 2006.



European patents of the company which need to be opted out:

- ✓ EP 1 569 895
- ✓ EP 5 965 120
- ✓ EP 4 569 827
- ✓ EP 4 585 888
- ✓ EP 0 813 496 → owned in co-ownership (50%) with Nivartos – OK, they agreed to opt-out.
- ✓ EP 2 369 258
- ✓ EP 1 569 872
- ✓ EP 8 564 123
- ✓ EP 9 456 987
- ✓ EP 2 654 231 → owned in co-ownership (35%) with Koonderel – OK, they agreed to opt-out.
- ✓ EP 9 521 321

INDEPENDENT TRANSLATION

CLERK OFFICE OF STRESLAU COURT OF FIRST INSTANCE
JURIA STRASSE, STRESLAU

COMPANY HOUSE EXTRACT CONSULTATION ON 15.04.2017.

IDENTIFICATION

Company Name: HAUSSMANN LA RICHE,

in replacement of HAUSSMANN LA MOCHE who received from
HAUSSMANN LA RICHE (created in 1850; having its head office address at
Bach Strasse, Streslau, Ruritania) all its assets.

Identification Number: 123 456 789

Administrative Number: 7894 2 3216

Registration Date: February 12th, 2001

INFORMATION CONCERNING THE LEGAL PERSON

Legal form: Limited company

Registered capital: 3.460.000,00 Ruritanian Marks

Head office address: Beethoven Strasse, Streslau, Ruritania

REPRESENTATIVE

General Director: Mr Reelax Jon

Born on September 9th, 1955

Ruritanian nationality

Domiciled in Gobain Strasse, Streslau

INFORMATION CONCERNING THE ACTIVITY

Main activity: pharmaceutical researches

First activity: February 12th, 2001.

Delivered in Strelsau

April 15th, 2017

By the Clerk.

CHEER FOR THE RURITANIANS

Wear
Red & Blue

SHOP NOW





Details required by Rule 5.3

Proprietors/Applicants
pursuant to Rule 8.5.

Hausmann La Riche
Bach Strasse, RT Strelsau AND
Nivartos

SPCs

Holders of any granted
SPC, if different from the
proprietors listed above

Details required by Rule 5.3

Proprietors/Applicants
pursuant to Rule 8.5.

Bach Strasse, RT Strelsau AND
Nivartos
Mozart Strasse, RT Strelsau

SPCs

Holders of any granted
SPC, if different from the
proprietors listed above

From: Georg.Schweitzer@haussmann-la-riche.com
To: Barbie.Roberts@haussmann-la-riche.com
Cc:
Subject: Opt-out proceedings

Sent: 11/12/2016

Barbie,

As you already know, I am in the process of opting out a list of patents of the company.

Could you please follow up the proceedings and keep me updated? (you could maybe do a chart with 2 columns: "opt-out confirmed" and "opt-out to be completed").

If you see something wrong, do not hesitate to modify the application yourself since I showed you yesterday how to proceed.

You will find the list of the opted-out patents in our internal general database in a folder named "opt-out – sunrise period".

Call me if you have questions.

Many thanks,

Georg Schweitzer
Head of Patent Department
European Patent Attorney

HAUSSMANN LA RICHE
D: +0 562 35 F: +0 562 33
georg.schweitzer@haussmann-la-riche.com

OPT-OUT DAY

6 June 2016



U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

1

Incompetence of the Unified Patent Court as a result of a prior Opt-Out

- A. Opt-out application validly lodged by the two patent co-owners
- B. Ms Barbie Roberts had capacity to validly lodge the opt-out application
- C. No fraudulent attempt to lodge an application to opt out
- D. The defendants did not defend their case on the merits



U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

2

A. Opt-out validly lodged by the two patent co- owners



- a) Opt-out application validly lodged by Haussmann La Riche
- b) Opt-out application validly lodged by Nivartos

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

3

a) Opt-out application validly lodged by Haussmann La Riche (1/7)

Rule 5.3 (a):

*"[...] the **name of the proprietor** or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and **all relevant postal and, where applicable, electronic addresses;**"*

The purpose of Rule 5.3 (a) is

- a **practical** one and is **not a condition of validity** to an opt-out.
- enable third parties and the Registry to **identify and reach the applicant** .

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

4

a) Opt-out application validly lodged by Haussmann La Riche (2/7)

Details required by Rule 5.3

Proprietors/Applicants pursuant to Rule 8.5.

Haussmann La Riche
Bach Strasse, RT Streisau

SPCs

Holders of any granted SPC, if different from the proprietors listed above

Opt-out Applicant Data

Data available in precompiled fields is retrieved from user profile and company data

Applicant is a company/firm? *

No

First Name *

Barbie

Last Name *

Roberts

Contact e-mail *

barbie.roberts@haussmann-la-riche.com

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

a) Opt-out application validly lodged by Haussmann La Riche (3/7)

The legal existence of Haussmann La Riche is not in doubt
(Exhibit 2 – Company House extract)

INDEPENDENT TRANSLATION

CLERK OFFICE OF STREISLAU COURT OF FIRST INSTANCE
JURA STRASSE, STREISLAU

COMPANY HOUSE EXTRACT
CONSULTATION ON 15.04.2017.

IDENTIFICATION

Company Name: HAUSSMANN LA RICHE,

in replacement of HAUSSMANN LA MOICHE who received from HAUSSMANN LA RICHE (created in 1850, having its head office address at Bach Strasse, Streisau, Ruritania) all its assets.

Identification Number: 123 456 789

Administrative Number: 7894 2 3216

Registration Date: February 12th, 2001

INFORMATION CONCERNING THE LEGAL PERSON

Legal form: Limited company

Registered capital: 3 450 000,00 Ruridassian Marks

Head office address: Beechwood Strasse, Streisau, Ruritania

REPRESENTATIVE

General Director: Mr Rensau Jon

Born on September 9th, 1955

Ruridassian nationality

Domiciled in Gobain Strasse, Streisau

INFORMATION CONCERNING THE ACTIVITY

Main activity: pharmaceutical researches

First activity: February 12th, 2001.

Delivered in Streisau:
April 15th, 2017
By the Clerk.

IDENTIFICATION

Company Name: HAUSSMANN LA RICHE,

in replacement of HAUSSMANN LA MOICHE who received from HAUSSMANN LA RICHE (created in 1850, having its head office address at Bach Strasse, Streisau, Ruritania) all its assets.

Identification Number: 123 456 789

Administrative Number: 7894 2 3216

Registration Date: February 12th, 2001

U.J.U.B.

Kevin CORDINA– Emmanuel GOUGÉ

a) Opt-out application validly lodged by Haussmann La Riche (4/7)

Haussmann La Riche is well-known across Europe
(Exhibit 3 – Sponsor of Ruritania’s football team during the 2010 World Cup)



U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

7

a) Opt-out application validly lodged by Haussmann La Riche (5/7)



Opt-out Applicant Data

Data available in precompiled fields is retrieved from user profile and company data

Applicant is a company/firm? *

First Name *

Last Name *

Contact e-mail *

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

8

a) Opt-out application validly lodged by Haussmann La Riche (6/7)

The mistake in the address has had **no consequences on the ability to contact and serve proceedings on the Defendants**. As can be seen from the "Request For Service Abroad" provided by the Claimant, they were able to identify the correct address of Haussmann La Riche II and arrange service at the proper postal address.

Ministère de la Justice, Direction des Affaires Civiles et du Soutien
Bureau du droit de l'Union, du droit international privé et de l'arbitrage civil (BODIP)

Ministère de la Justice
— KENNEDY FRANKLIN —

**REQUEST
FOR SERVICE ABROAD OF JUDICIAL OR EXTRAJUDICIAL DOCUMENTS**

DEMANDE
AUX FINS DE SIGNIFICATION OU DE NOTIFICATION A L'ETRANGER
D'UN ACTE JUDICIAIRE OU EXTRAJUDICIAIRE

Convention on the service abroad of judicial and extrajudicial documents in civil or commercial matters, signed at The Hague, November 15, 1965.
Convention relative à la signification et à la notification à l'étranger des actes judiciaires ou extrajudiciaires en matière civile ou commerciale, signée à La Haye, le 15 Novembre 1965.

Identity and address of the applicant Identité et adresse du requérant	Address of receiving authority Adresse de l'autorité destinataire
Unifad Patent Court Central Division, Paris Seat, Registry 10 Boulevard du Palais 75001 Paris France	Ministry of Justice, Department for Service of Judicial Documents, Paul van Bovenring Boulevard 1 1000 AAX Brussels Ruritania

The undersigned applicant has the honour to transmit in duplicate the documents listed below and in conformity with article 5 of the above-mentioned Convention, requests prompt service of one copy thereof on the addressee, i.e.,
(identité et adresse)
Le requérant soussigné a l'honneur de faire parvenir en double exemplaire l'ensemble des documents ci-dessous énumérés, en la présente conformément à l'article 5 de la Convention précitée, d'un exemplaire sans retard au destinataire ci-dessous répertorié.
(identité et adresse)

Haussmann La Riche, Beethoven Strasse 1770, Strelsau, Ruritania

Haussmann La Riche,
Beethoven Strasse
1770, Strelsau, Ruritania

a) Opt-out application validly lodged by Haussmann La Riche (7/7)

The Court shall take into account the general principles of law



- ✓ Proportionality
- ✓ Flexibility
- ✓ Fairness
- ✓ Equity

- Paragraph 6 of the UPC Agreement's Preamble ;
- Article 42 of the UPC Agreement ;
- Paragraphs 2 and 4 of the Rules of Procedure's Preamble.

b) Opt-out application validly lodged by Nivartos (3/4)

Rule 5.6 *in fine* enables the applicant to modify his application after it has been lodged, and this is exactly what Ms Barbie Roberts did !

Exhibit 4 – Screenshot of 2 January 2017 of Amended application

Details required by Rule 5.3

Proprietors/Applicants pursuant to Rule 8.5:

SPCs

Holders of any granted SPC, if different from the proprietors listed above:

Details required by Rule 5.3

Proprietors/Applicants pursuant to Rule 8.5:

SPCs

Holders of any granted SPC, if different from the proprietors listed above:



b) Opt-out application validly lodged by Nivartos (4/4)

A correction under Rule 5.6 does not create legal uncertainty since the opt-out application will only become effective « *from the date of correction* ».



B. Ms Barbie Roberts had capacity to validly lodge the opt-out application (1/5)

Relevant rules:

Rule 5.1 : "*The proprietor of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application with the Registry*".

Rule 5.4 : "*Rule 8 [requiring representatives in certain situations] shall not apply to Applications to opt out made pursuant to this Rule 5. Where a representative is appointed, such a representative may include professional representatives and legal practitioners as defined in Article 134 EPC in addition to those referred to in Article 48 of the Agreement.*"

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

15

B. Ms Barbie Roberts had capacity to validly lodge the opt-out application (2/5)

According to these Rules, the person who shall lodge the application to opt out is the proprietor of or the applicant for a European patent, and said proprietor or applicant may or may not appoint a representative to opt-out on his behalf.

However, who shall lodge the application in the case where the proprietor is a legal person and did not appoint any representative ?



U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

16

B. Ms Barbie Roberts had capacity to validly lodge the opt-out application (3/5)

U.J.U.B.

Mr Jon Reelax (General Director of Haussmann La Riche) delegated his authority to Dr Schweitzer (Head of Haussmann La Riche's IP Department) regarding the patents of the company

Exhibit 1 ter – Delegation of authority

HAUSSMANN
LA RICHE

DELEGATION OF AUTHORITY

I, Mr Jon Reelax, acting in my capacity as General Director of Haussmann La Riche, public limited company with a share capital of 3.460.000,00 Ruritarian Marks, recorded in the Commercial Register of Stralsau under the No. 123 456 789, having its registered office at Beethoven Strasse, 07 0030 Stralsau (Ruritarian).

Herby authorize,

Dr Schweitzer, manager of Haussmann La Riche's patent department, domiciled at Klenze Strasse 106, Munich, Germany, to perform all acts necessary during the lifetime of the patents of the company.

Made in Stralsau, Ruritaria, on 13 January 2006.



Kevin CORDINA – Emmanuel GOUGÉ

17

B. Ms Barbie Roberts had capacity to validly lodge the opt-out application (4/5)

U.J.U.B.

Dr Schweitzer had to opt-out a very specific list of European patents of the company

Exhibit 1 quarter

HAUSSMANN LA RICHE

European patents of the company which need to be opted out:

- ✓ EP 1 569 895
- ✓ EP 5 965 120
- ✓ EP 4 569 827
- ✓ EP 4 585 888
- ✓ EP 0 813 496 → owned in co-ownership (50%) with Nivartos – OK, they agreed to opt-out.
- ✓ EP 2 369 258
- ✓ EP 1 569 872
- ✓ EP 8 564 123
- ✓ EP 9 456 987
- ✓ EP 2 654 231 → owned in co-ownership (35%) with Koonderel – OK, they agreed to opt-out.
- ✓ EP 9 521 321

Kevin CORDINA – Emmanuel GOUGÉ

18

B. Ms Barbie Roberts had capacity to validly lodge the opt-out application (5/5)

Dr Schweitzer gave instructions to Ms Barbie Roberts
Exhibit 5 – Email of 11 December 2016

From: Georg.Schweitzer@haussmann-la-riche.com
To: Barbie.Roberts@haussmann-la-riche.com
Cc:
Subject: Opt-out proceedings

Sent: 11/12/2016

Barbie,

As you already know, I am in the process of opting out a list of patents of the company.

Could you please follow up the proceedings and keep me updated? (you could maybe do a chart with 2 columns: "opt-out confirmed" and "opt-out to be completed").

If you see something wrong, do not hesitate to modify the application yourself since I showed you yesterday how to proceed.

You will find the list of the opted-out patents in our internal general database in a folder named "opt-out – sunrise period".

Call me if you have questions.

Many thanks,

Georg Schweitzer
Head of Patent Department
European Patent Attorney

HAUSSMANN LA RICHE
D: +0 562 35 F: +0 562 33
georg.schweitzer@haussmann-la-riche.com

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

19

C. No fraudulent attempt to lodge an application to opt out

1. In a desperate attempt to justify the invalidity of the opt-out application filed by Ms Barbie Robert, Generoso implies that Dr Schweitzer, despite Nivartos' willingness to opt-out the patent, postponed the filing because Haussmann La Riche was no longer in favour of opting out EP 496. Generoso provides however no evidence in support thereto.
2. Generoso suggests, in last a attempt, that Ms Barbie Roberts was considering leaving Haussmann La Riche and joining Nivartos instead, and therefore filed the application to opt out EP 496, despite Dr Schweitzer's instructions to postpone said opt-out, in order to make a good impression on her potential new company. Should we remind the Court that Ms Barbie Roberts has been a loyal employee for Haussmann La Riche since 1995, and that it is still the case today ?

Wouldn't this be considered as



?

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGÉ

20

D. The Defendants did not defend their case on the merits

Hausmann La Riche II and Nivartos have only made an appearance in Court to contest the jurisdiction of the UPC on the ground of Article 83 of the Agreement.

Article 71(b) (2) of Brussel I Regulation:

"Where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, Chapter II shall apply as appropriate regardless of the defendant's domicile."

Article 26(1) of Brussel I Regulation (Chapter II):

"Apart from jurisdiction derived from other provisions of this Regulation, a court of a Member State before which a defendant enters an appearance shall have jurisdiction. This rule shall not apply where appearance was entered to contest the jurisdiction, or where another court has exclusive jurisdiction by virtue of Article 24."

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGE

21

Conclusion

- UPC has no jurisdiction to hear the revocation action with regard to EP 496.
- Pursuant to Article 69 of the Agreement, Generoso should be ordered to remunerate all costs incurred by Hausmann La Riche and Nivartos in relation to this preliminary objection.

U.J.U.B.

Kevin CORDINA – Emmanuel GOUGE

22

OPT-OUT DAY




6 June 2016



U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

1



Claims

1. A composition for use with an electronic treatment device, which composition comprises a peptide of up to 100 amino acids, the peptide having a repeating amino acid sequence – MASE-(n) where n is at least 3.

a) 1 maskvtse~~ma~~ ~~se~~rankvign dglgdlvvn lknvtrefkr knrkfiavdn vdfslkagdf
61 aaivgksng kstllniag llkptrgsvt
sequence of the Maseratin protein of *Limax maximus*

b) 1 maskvtse~~ma~~ ~~semasemase~~ vankvigndl glgdlvnlk nvtrefkrkn rkfiavdnvd
61 felkagdfaa ivgksngks tllnmiagll kptrgsvt
sequence of the Maseratin protein of *Arion lusitanicus*

Figure 1 : sequences of Maseratin proteins from a) the *Limax maximus* slug and b) the *Black slug*. MASE domains are boxed. Amplification is shown in red.

electronic device (PEDILÛVE 5000®Pediluve Electrique SA, Louvier, France)

A statement for revocation of EP o 831 496 was filed on 15 March 2017.

The opt-out of EP o 831 496 B1 (“EP 496”) by Barbie Roberts is invalid.

The Unified Patent Court is competent to hear the revocation claim.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

2

Principles of UPC law



The Unified Patent Court Agreement ("UPC Agreement") intended to create a **single forum** for litigation with regard to both **Unitary Patents** and **traditional European patents**.

The aim of the UPC Agreement is that no national court should be deemed to decide cases on the infringement and validity of European patents.

Paragraph 6 of the preamble of the UPC Agreement is aimed at substantive decisions of the UPC, for example validity and infringement. It cannot be used to limit the UPC's jurisdiction.



CONSIDERING that the Unified Patent Court should be devised to ensure expeditious and high quality decisions, striking a fair balance between the interests of right holders and other parties and taking into account the need for proportionality and flexibility;

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

3

A transitional measure



A transitional measure (for a limited period of time!) allows actions on infringement and validity of **traditional European patents** (and not of Unitary Patents) to be brought before a national court. This is clearly the exception.

Under article 20 and 24 of the UPC Agreement, Union law should always take priority.

ARTICLE 20

Primacy of and respect for Union law



The Court shall apply Union law in its entirety and shall respect its primacy.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

4

Article 24 UPC Agreement

U.J.U.B.

ARTICLE 24

Sources of law

(1) In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:

- (a) Union law, including Regulation (EU) No 1257/2012 and Regulation (EU) No 1260/2012¹;
- (b) this Agreement;
- (c) the EPC;
- (d) other international agreements applicable to patents and binding on all the Contracting Member States; and
- (e) national law.



Guillaume de LA BIGNE – Wouter PORS

5

The exception must be strictly interpreted

U.J.U.B.

Rule 5 of the Rules of Procedure (RoP) set specific requirements.

Any European patent should, in principle, be within the jurisdiction of the UPC and only left out in exceptional, clearly defined situations.

Guillaume de LA BIGNE – Wouter PORS

6

Patent co-owner
Haussmann la Riche (new)
not validly identified

Haussmann la Moche is the legal entity that has owned the patent since 2000.

Relatively unknown company Haussmann la Moche then changed its name to Haussmann la Riche.

HELLO
my name is

Haussmann la Riche

Generoso disputes the nature of the transfer of assets. Haussmann La Riche has failed to file any evidence on the provisions of Ruritanian law.

The UPC cannot be expected to apply Ruritanian law *ex officio*.

The burden of proof is on Haussmann cs, especially since Ruritania is not a Contracting Member State to the UPC Agreement.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

7

Details required by Rule 5.3

Proprietors/Applicants pursuant to Rule 8.5.

Haussmann La Riche
Bach Strasse, RT Strelsau

SPCs

Holders of any granted SPC, if different from the proprietors listed above

Rule 5(3)(a) RoP provides that the opt-out application must contain:

"the name of the proprietor or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and all relevant postal and, where applicable, electronic addresses"

The application contains the **postal address** of the liquidated legal entity.

The postal address in this case is the only company data to correctly identify the patent co-owner.

In this case, an **electronic address** is not sufficient to identify the proper legal entity, whereas the postal address does provide complete clarity.

Thus, the opt-out application is invalid.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

8

1. Sender
401 Entwurfstrasse 10d
10119 Berlin 10, 45618

2. Recipient
123 Somewhere Place
Somewhereville, ST
12123-5555

No opt-out by both patent co-owners



U.J.U.B.

Rule 5(1)(a) RoP clearly provides that if a patent is owned by two proprietors, they **both** have to lodge the application to opt out.

(a) Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out. Where the person lodging an Application to opt out is not recorded as the proprietor or applicant in the registers referred to in Rule 8.5(a) and (b), respectively, the person shall lodge a declaration pursuant to paragraph 3(e).

The application to opt out was at best only lodged by Hausmann la Riche (new) on 31 December 2016.

The Rules of Procedure **do not provide for an opt-out in stages**.

An **application to opt out can only be made once** (Rule 5(11) RoP). You cannot opt out, then opt in and then opt out again. An incorrect opt-out application cannot be corrected later on.

11. A patent or application the subject of an Application to withdraw which has been entered on the register may not thereafter be the subject of a further Application to opt out.

Legal certainty is needed !

Guillaume de LA BIGNE – Wouter PORS

9

Patent co-owners not duly represented



Applications were not filed by the patent owners (Hausmann la Riche and – perhaps – Nivartos), but by an **individual**, Barbie Roberts, who **had no legal authority to represent the patent owners**.

The UPC Agreement and the Rules of Procedure do not deal with the issue of who is permitted to act on behalf of a legal entity which is the proprietor of a patent.

Article 24(1)(e) UPC Agreement : is a matter of national law.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

10

Ruritanian law
similar to
French law

U.J.U.B.

Haussmann la Riche **must be represented by its legal representative**, that is Mr. Jon Reelax (see Haussmann cs exhibit 2). However, he did not file the opt-out application.

Ms Barbie Roberts has no delegation of authority or signature
→ no decision to opt-out by Mr. Reelax or Dr. Schweitzer.

The affidavit by Ken Carson, Barbie Robert’s former fiancé, states that Ms. Roberts acted on her own at the very last moment.

Haussmann cs exhibit 5 does not constitute a valid power of attorney to opt out EP 496 under Ruritanian law.

Barbie Roberts did not even claim in the UPC case management system that she filed the opt-out on behalf of the patent owners, but on behalf of herself.

Opt-out Applicant Data

Data available in precompiled fields is retrieved from user profile and company data

Applicant is a company/firm? *

No

First Name *

Barbie

Last Name *

Roberts

Contact e-mail *

barbie.roberts@haussmann-la-riche.com

Guillaume de LA BIGNE – Wouter PORS

Ruritanian law
similar to
French law

U.J.U.B.

“Barbie Roberts is very reliable and conscientious” **is not a legal argument** under any national law for attributing the power to represent a legal entity.

Ms Barbie Roberts is an employee. Haussmann’s **Exhibit 1 ter** clearly shows that a power of attorney is needed to represent a company, even for senior employees, such as Dr. Schweitzer.



Guillaume de LA BIGNE – Wouter PORS

Fraudulent attempt to lodge an application to opt out



Generoso's management was told at the end of May, by former Nivartos Human Resources Director, Mr Alan Condek, who recently (29 May 2017) joined Generoso, that in December 2016, relations between co-owners Haussmann La Riche and Nivartos had deteriorated.

Haussmann La Riche was no longer in favour of opting out the European patent EP496 contrary to Nivartos intention.

Thus, Dr Schweitzer decided to postpone any opt out application relating to EP496.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

13

Fraudulent attempt to lodge an application to opt out



At the end of December 2016, Ms. Roberts was thinking of leaving Haussmann La Riche and moving to Nivartos, as evidenced by the email sent by Alan Condek to Ms. Roberts (Generoso Exhibit 4).

Thus, it is likely that she fraudulently filed the application to opt out the EP patent, despite Dr Schweitzer's instructions to postpone it, in order to make a good impression on her potential employer.

U.J.U.B.

Guillaume de LA BIGNE – Wouter PORS

14

Serious doubts whether Nivartos is a co-owner of EP 496

Exhibit 1 is an affidavit by a Mr. Jonas Clever, **who claims that he and not Nivartos**, owns 50% of EP 496.

Generoso disputes that the "corrective declaration" by Mr. Clever (Haussmann Exhibit 1 bis) is true. It is hard to believe that they would make such an error.

There is o trace of a power of attorney, either on behalf of Nivartos or on behalf of Mr. Clever, to Barbie Roberts.



U.J.U.B.

Guillaume de LA BIGNE – Wouter PORIS

15

Conclusion

Preliminary objections as submitted by Haussmann la Riche and Nivartos should be rejected.

The UPC has to assume jurisdiction to hear the revocation action with regard to EP 496,

Haussmann la Riche and Nivartos should be ordered to remunerate all costs incurred by Generoso in relation to these preliminary objections.

Generoso will submit a specification of these costs during the main proceedings and hereby requests a cost order under Rule 150(2), to be taken in the decision on the merits of this case.



U.J.U.B.

Guillaume de LA BIGNE – Wouter PORIS

16

UNIFIED PATENT COURT

CENTRAL DIVISION PARIS SEAT

CAVEAT

This document is part of a mock trial held on 6 June in Paris based on the 18th draft of the Rules of procedure of the Unified Patent Court (19 October 2015) and on the UPC Case Management System as tested in the first months of 2016.

It is not written in a form agreed by the future UPC judges; so it is not a model but only a written contribution made for the interest of the mock trial.

2017/00001

DECISION ON A PRELIMINARY OBJECTION

6 June 2017

Decided by Ms Marie COURBOULAY, Judge-Rapporteur

The parties to the Preliminary objection

Hausman La Riche,

a company governed by Ruritanian law,
with its registered office located in Beethoven Strasse 1770, Strelsau, Ruritania

Nivartos,

a company governed by Ruritanian law,
with its registered office located in Mozart Strasse 1756, Strelsau, Ruritania
claimants to the Preliminary objection,
defendants in the main proceedings,

represented by:

Mr Emmanuel Gougé, (representative of record for the purpose of service)

attorney-at-law, Pinsent Masons

Member of the Paris Bar, Solicitor (England & Wales),

21-23 rue Balzac, 75008 Paris, France

emmanuel.gouge@pinsentmasons.com

Mr Kevin Cordina,
European Patent Attorney, Olswang
kevin.cordina@olswang.com

Generoso,

a company governed by Italian law,
with its registered office located in Strada dell'Orto 2016, Milano, Italy,
respondent to the Preliminary objection,
claimant in the main proceedings,

represented by:

Mr Wouter Pors,
attorney-at-law, Bird & Bird
Zuid-Hollandplein 22, 2596 AW The Hague, the Netherlands
wouter.pors@twobirds.com

Mr Guillaume de La Bigne, (representative of record for the purpose of service)
European Patent Attorney, LLR, 11 boulevard de Sébastopol, 75008 Paris, France
labigne@llr.fr

* * *

The facts

The pharmaceutical company Haussmann La Riche located in Strelsau (Bach Strasse), Ruritania, was the holder of a European patent EP 0 813 496 B1 relating to the treatment of corns by applying "*A composition for use with an electronic treatment device, which composition comprises a peptide of up to 100 amino acids, the peptide having a repeating amino acid sequence - MASE-(n) where n is at least 3*".

This patent was filed at the end of 1997, granted in 1999 and will expire at the end of 2017.

In 2000, Haussmann La Moche located in Strelsau (Beethoven Strasse), Ruritania, was provided with the assets of Haussmann La Riche, which had been liquidated the same year.

In 2001, Haussmann La Moche changed its name to Haussmann La Riche (II) but remained located at Beethoven Strasse.

The transfer and change of name was registered with the UK, FR, DE and NL Patent Offices. It was not done in the EPO Register because these changes occurred after the grant of the patent.

In 2012, Haussmann La Riche (II) shared the co-ownership (50%) of patent EP 496 with another Ruritanian company: NIVARTOS, located in Strelsau, Mozart Strasse.

This assignment was recorded with the UK, FR, DE and NL Patent Offices.

On 31 December 2016, Ms Barbie ROBERTS, secretary to Dr SCHWEITZER, head of the IP department of Haussmann La Riche (II) and European Patent Attorney, filled in an online form for an opt-out of this patent.

She indicated that the proprietor was Haussmann La Riche, Beethoven Strasse; she specified that the applicant was not a company and mentioned her name as the applicant as well as her professional email address at Haussmann La Riche.

On 2 January 2017, she corrected the form by mentioning Nivartos as the co-owner.

The case

On 15 March 2017, Generoso lodged at the UPC Registry a Statement for revocation of patent EP 496, arguing that the opt-out was not valid and that the UPC Central Division was consequently competent.

The service of the Statement for the two holders was done by the Registrar on 7 April 2017 in accordance with Rule 273 (Ruritania is not a Contracting Member State).

The presiding judge of the panel was designated as judge-rapporteur in accordance with Rule 18.

On 5 May 2017, Haussmann La Riche (II) and Nivartos lodged a Preliminary objection contesting

that the UPC has jurisdiction for the revocation of the patent which has been opted out.

On 20 May 2017, Generoso submitted written comments on the Preliminary objection.

On 26 May 2017, Haussmann La Riche (II) and Nivartos submitted a reply to the written comments on the Preliminary objection.

On 3 June 2017, Generoso submitted a rebuttal to the written comments on the Preliminary objection.

The oral hearing took place on 6 June 2017.

The grounds of the claimant to the Preliminary objection.

Generoso says that the opt-out of EP 496 was made on behalf of a company that no longer exists (Hausmann La Riche (old)) and on behalf of a company that is not a co-owner of EP 496 (Nivartos), by a person who is not authorised to represent any relevant company, and without lodging the application on behalf of both patent co-owners.

Therefore, whoever currently owns EP 496, they are subject to the jurisdiction of the UPC, which is the main rule in any case, the original intention of the Contracting Member States and the best court in Europe to defend your patent in.

Haussmann has argued that it is quite well known, so it really would not matter whether the opt-out was done correctly by a person authorised to do so. This of course cannot set aside the need for legal certainty.

The instruction to apply procedural rules with proportionality, flexibility, fairness and equity also does not change this, as it is clearly proportionate, fair and equitable to have patent revocation actions handled by the UPC. Flexibility can be applied where needed, but especially with regard to opt-out not to the detriment of legal certainty.

Generoso claims that its request for revocation is perfectly valid, as Generoso could rely on the information contained in the national patent registers in the United Kingdom, Germany, France and the Netherlands. Besides, the defendants have appeared to defend their case, which means that the

UPC has jurisdiction under Article 26 in combination with 71(b)(2) Brussels I Regulation, since both Haussmann La Riche and Nivartos have made an appearance in court without contesting jurisdiction on grounds other than Article 83 UPC Agreement.

The final conclusion therefore is that the preliminary objections as submitted by Haussmann La Riche and Nivartos should be rejected, the UPC has to assume jurisdiction to hear the revocation action with regard to EP 496 against these two defendants and Haussmann La Riche and Nivartos should be ordered to remunerate all costs incurred by Generoso in relation to these preliminary objections. Generoso will submit a specification of these costs during the main proceedings and hereby requests a cost order under Rule 150(2), to be taken in the decision on the merits.

Haussmann La Riche II and Nivartos request that the judge-rapporteur:

Having regard to Rules 19.1 (a) and 20.1 of the Rules of Procedure,

As a main claim,

Pursuant to Article 83(3) of the Agreement, Rule 5 of the Rules of Procedure, the Preamble of the Agreement, the Preamble of the Rules of Procedure, and Article 42 of the Agreement:

Hold that the Unified Patent Court is incompetent to hear this case.

Hold that the address is not a validity requirement of the opt-out application.

Hold that there is no restriction to certain persons for applying to an opt-out.

In any case,

Order Generoso to pay the costs of the procedure borne by Haussmann La Riche II pursuant to Article 69 of the Agreement.

About the request to reject the last arguments and evidence developed in the rebuttal of Haussmann La Riche (II) and Nivartos

The reply lodged on 26 May 2016 and the rebuttal lodged on 3 June 2016 may be accepted if they are within the period defined by the judge-rapporteur, because a second round of exchanges is admissible.

The two Statements were lodged within the period defined by the judge-rapporteur, so they are admissible.

But what is not admissible is that the defendant adds new arguments or new evidence which will not be discussed by the claimant, especially when this evidence was known from the beginning of the proceedings. And even if this evidences is known very late, it is not possible to admit it after the

deadline set by the Judge, and this by application of due process.

In this case the rebuttal lodged on 3 June 2016 may be admitted but not the last chapter named “*additional arguments evidencing a fraudulent attempt to lodge an application of opt-out*” and exhibit 4 of the defendant.

So this chapter and exhibit 4 will be deleted from the proceedings and the debate about the role of Ms Roberts, her willing to join Nivartos and the suspicious email sent by Mr Conderk will not be examined.

The grounds of the decision

Rule 19 named “*Preliminary objection*” says:

1. Within one month of service of the Statement of claim, the defendant may lodge a Preliminary objection concerning:

- a) the jurisdiction and competence of the Court, including any objection that an opt-out pursuant to Rule 5 applies to the patent that is the subject of the proceedings;*
- b) the competence of the division indicated by the claimant [Rule 13.1(i)];*
- c) the language of the Statement of claim [Rule 14].*

2. A Preliminary objection shall contain:

- a) particulars in accordance with Rule 24(a) to (c);*
- b) the decision or order sought by the defendant;*
- c) the grounds upon which the Preliminary objection is based; and*
- d) where appropriate the facts and evidence relied on.*

3. The Preliminary objection shall be drawn up in the language pursuant to Rule 14.

...”

First of all, the Preliminary objection was lodged on 5 May 2017, i.e. within one month of the service upon the holders of patent EP 496 on 7 April 2017, in accordance with Rule 19 of the RoP.

The conditions prescribed at the second paragraph are met.

So the judge-rapporteur is duly seized of the Preliminary objection.

Analysis of the opt-out.

The opt-out was made by Ms Barbie Roberts on 31 December 2016 on the deadline of the sunrise period.

The name of Haussmann La Riche is entered in with the address of Bach Strasse.

Opting out is governed by Rule 5 of the RoP entitled “*Lodging of an Application to opt out and withdrawal of an opt-out*”.

It is not discussed that the name of Nivartos, co-owner of the patent, was added on 2 January 2017 by Ms Barbie Roberts.

Nor is it discussed that the fees were paid in accordance with the Rule 5.5 and the opt-out entered by the Registrar.

But is under debate the UPC’s jurisdiction to deal with the Statement for revocation filed by Generoso and this question is dependent on the validity of the opt-out made by Haussmann La Riche (II) and Nivartos.

If the opt-out is valid, the UPC has no authority to deal with the Statement for revocation of patent EP 496 lodged by Generoso.

But if the opt-out is not valid, the UPC has jurisdiction over the case of the revocation of patent EP 496.

So there are three questions under debate:

1- is the incorrect address of Haussmann La Riche a clerical error of no consequence or may it be considered that the opt-out was made in the name of Haussmann La Riche (I)?

2- was the opt made correctly in the name of Nivartos?

3- in the alternative, did Ms Barbie Roberts have the capacity to represent Haussmann La Riche (II) and Nivartos, and is there a need to designate a representative to fill in the form of an opt-out?

1- The effect of the incorrect address of Haussmann La Riche (II) in the form.

The parties' grounds

Generoso explains that the opt-out was made in the name of "Haussmann La Riche I, Bach Strasse, Strelsau", a corporate entity which has no longer a legal existence so the opt out is of no effect.

Generoso adds that the principles of proportionality and flexibility have not to be taken into account when the judges have to apply the rules about the validity of an opt-out and that the rules have to be interpreted strictly and not broadly as they have been listed in Rule 5.

Haussmann La Riche (II) and Nivartos reply that since mention of the company's address is not required by Rule 5 as an element of identification, indicating an erroneous address for a company correctly named is of no consequence.

They say that they do agree that the requirements to validly lodge an opt-out application should not be interpreted broadly but that a strict interpretation should not be made at the expense of the general principles of law regarding the need for proportionality, flexibility, fairness and equity

The judge-rapporteur's grounds

Recital 6 of the Preamble consecrates the principles according to which the judges have to strike a fair balance between the interest of right holders and other parties and to take into account the need for proportionality and flexibility.

These principles are repeated in Article 42 of the UPCA.

There is no debate about the fact that these principles have to be taken into account at each step of proceedings and when interpreting a rule even a rule with an effect on validity of an application. The purpose of this is to assure legal certainty to every party.

The opt-out is not an exception. It is an option in the hands of the proprietor of the patent. The lodging of the opt-out is based on a single declaration from the owner of the patent or the applicant.

Rule 5.3 says :

The Application to opt out shall contain:

- a) the name of the proprietor or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and all relevant postal and, where applicable, electronic addresses;*
- b) where such proprietor, applicant or holder have appointed a representative, the name and postal address and electronic address for service of the representative;*
- c) details of the patent and/or application including the number;*
- d) details of any supplementary protection certificate granted based on the patent concerned, including the number; and*
- e) for the purposes of paragraph 1(a), a Declaration of proprietorship that the person lodging the Application to opt out is the proprietor or applicant pursuant to Rule 8.5 and entitled to lodge the Application to opt out.*

Rule 5.1 a) specifies:

- a) Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out. Where the person lodging an Application to opt out is not recorded as the proprietor or applicant in the registers referred to in Rule 8.5(a) and (b), respectively, the person shall lodge a declaration pursuant to paragraph 3(e).*
- b) The Application to opt out shall be made in respect of all of the Contracting Member States for*

which the European patent has been granted or which have been designated in the application.

It is the power of the judge-rapporteur to appreciate, regarding the particular circumstances of the case, if requirements of Rule 5.3 are met. There is nothing in the RoP about the nullity and especially no requirement of prejudice.

When the opt-out was made, the name of Haussmann La Riche and the address Bach Strasse and not Beethoven Strasse were already and automatically mentioned in the form because Haussmann La Riche I was the claimant of the patent when the patent was granted.

That means that the company mentioned in the form was Haussmann La Riche (I).

But despite this fact, the incorrect address may be considered as a clerical error with no consequence on the validity of the opt-out because:

- Haussmann La Riche I has no longer existed since 2002 and the transfer operation had assigned to Haussmann La Riche (II) all the assets of Haussmann La Riche I.

- Haussmann La Riche (II) is the current owner of patent EP 496 and its name and address have been registered at the FR, DE, UK and NL Patent Offices instead of the name and address of Haussmann La Riche (I).

- the service of the Statement for revocation of the patent done at the request of the Registrar had delivered the statement to Haussmann La Riche (II) at the right address.

So I consider that the person designated in the opt-out is Haussmann La Riche (II) and not Haussmann La Riche (I), and the mention of Bach Strasse instead of Beethoven Strasse is a simple error in the address and not the person who owns the opted-out patent.

In this particular case and because of the circumstances listed above, the error in the address may be considered as a clerical error with no consequence on the validity of the opt-out.

The arguments about the notoriety of Haussmann La Riche (II) in Ruritania and even in the world (regarding Haussmann La Riche (II) exhibit 3) are of no interest for the case.

This objection is rejected.

2- The opt-out made in the name of Nivartos

The parties' grounds

Generoso argues that the opt-out was not made in the name of Nivartos, although this company is the co-owner of the patent.

In its rebuttal, Generoso also contests that Nivartos is co-owner of the patent EP 496 because of the attestation written by Mr Clever.

The wording of the attestation indicates that he personally owns the shares of the Haussmann La Riche (II) .

Haussmann La Riche (II) and Nivartos recognise that Nivartos was not mentioned in the filing but that the omission of Nivartos as co-owner of the patent in the opt-out was corrected before any litigation through the correction filed by Ms Barbie Roberts on 2 January 2017 in accordance with the Rule 5.6, so the opt-out is valid.

They produce an exhibit 1-bis in which Mr Clever explains that the only co-proprietor of patent EP 496 is Nivartos and that if he appears in the letter of consent produced in exhibit 1 as a personal owner, it is just a clerical error.

The judge-Rapporteur's grounds

Rule 5.1 a) specifies:

a) Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out.

Rule 5.6 says:

“.... If the requirements are missing or incorrectly recorded, a correction may be lodged with the Registry. The date of entry of the correction shall be noted in the register. The opt-out shall be effective from the date of correction.”

The form filled on 31 December 2016 by Ms Barbie Roberts does not mention Nivartos while patent EP 496 has been owned by Haussmann La Riche (II) and Nivartos since an assignment concluded on 1 July 2012 by the two companies.

Regarding Rule 5.1 a), the opt-out was not duly made at the date of the lodging because the name of Nivartos was missing; so the opt-out was ineffective on that date.

The name of Nivartos and the address were added on 2 January 2017.

Contrary to what Generoso said, Rule 5.11 does not have not to be applied to this issue because if the opt-out is a “one shot” possibility, i.e. if you have firstly opted out your patent, and then withdrawn the opt-out, you are not allowed to opt out again the same patent.

Rule 5.6 permits regularisation of missing requirements when an opt-out was made and registered.

So assuming that Nivartos is the co-owner of patent EP 496, the error was corrected on 2 January 2017 and the opt-out has been effective since that date.

Exhibit 1 shows that Nivartos has been the co-owner of the patent since 2012 and consents to the opt-out.

It cannot be said that Mr Clever wrote the letter of consent on 7 December in his personal name because the letter was written on official paper in the name of Nivartos by Mr Clever as General Director, and the wording further in the declaration (when it is written “I Jonas Clever, declare that I have 50% of the ownership of Patent EP476...” is only a clerical error or something like a “*maladresse*”.

More, Exhibit 1-bis confirms this interpretation.

And furthermore, the agreement concluded in July 2012 was recorded with the FR, DE, UK and NL Patent Offices.

Nivartos' argument about the fact that the patent is not really shared by Nivartos and Haussmann La Riche II is not serious, not founded on documents and discordant with its means.

So the correction was made correctly and this objection is rejected.

3- The capacity of Ms Barbie Roberts to represent Haussmann La Riche (II) and Nivartos

The parties' grounds

Generoso contends that the opt-out is invalid because Ms Barbie Roberts had no capacity to register the opt-out, Dr Schweitzer alone having the authorisation to do so on behalf of Haussmann La Riche (II).

Generoso contests that Dr Schweitzer had the authorisation to do so on behalf of Nivartos and that Ms Barbie Roberts was allowed under Ruritanian law to represent the companies.

Generoso adds that the defendants to the Preliminary objection do not provide Ruritanian law so it is impossible to respond in accordance with the national Ruritanian law.

Nivartos and Haussmann La Riche (II) answer that Ms Barbie Roberts did have the capacity to apply for an opt-out, because Rule 5 does not restrict the standing to apply for an opt-out to certain persons.

They argue that Ruritanian law allows the

The judge-rapporteur's grounds

Rule 5.3 c says:

b) where such proprietor, applicant or holder have appointed a representative, the name and postal address and electronic address for service of the representative;

Rule 8 is about the representative

Rule 8 – Party and party's representative

1. A party shall be represented in accordance with Article 48 of the Agreement unless otherwise provided by these Rules [Rules 5, 88.4 and 378.5].

2. For the purpose of all proceedings in relation to a patent, where these Rules provide that a party performs any act or that any act be performed upon a party that act shall be performed by or upon the representative for the time being of the party.

But Rule 5.4 says that Rule 8 does not have to be applied to the declaration of opt-out.

That means that it is not compulsory for the owner of the patent to appoint a representative to fill in the form and if the owner chooses to appoint a representative, he may appoint a representative of his own not only an attorney-at-law or a European Patent Attorney registered on the UPC list.

If there is no representative mentioned in the form, Rule 5 gives no precision on who is the physical person allowed to fill in the form in the name of the legal entity.

When the form has been filled in by a person who is not the legal representative of the company, the debate about the capacity of this person to duly represent the company is referred to the judge-rapporteur.

The analysis of the form filled by Ms Barbie Roberts shows that the opt-out was not done by the company but by Ms Barbie Roberts herself [she ticked “no” in the box “company”] even if she mentioned her professional electronic address.

At the moment there are two possibilities:

1- Ms Barbie Roberts has filed the form herself and in her name and not in the name of the company because she did not tick the option “company” and then it is clear that the opt-out is invalid because Ms Barbie Roberts is neither the owner nor the representative.

2- Assuming that Ms Barbie Roberts has filled the form for her employer, Haussmann La Riche (II), we have to remember that there is no specification in the UPC Agreement or the Rules of procedure about how to deal with the issue of who is permitted to act on behalf of a proprietor if the proprietor is a legal entity. It is only provided that such an application has to be filled by the patent proprietors.

That does not mean that there is no restriction to certain persons for applying to an opt-out because the legal person has always to be represented by a physical person.

And more the form is presented to enter the first name, the last name and the electronic address of a physical person after the name of the company.

Furthermore, in order to ensure the security of the patent holders and the other parties, to be valid the opt-out has to be filled on behalf of the legal entity by an authorised person employed by the patent owner.

Under article 24(1)(e) UPC Agreement this issue is a matter of national law. Under the rules of private international law, the question of representation of a legal entity is governed by the national law of the country of incorporation of the legal entity, in this case Ruritanian law.

Even if the judge-rapporteur has not been provided with a legal opinion about the content of Ruritanian corporate law, the judge-rapporteur has to apply this law because there is a claim on this issue.

It should have been more comfortable if the patent owners who contended that Ruritanian law allowed such a representation, had provided it, but in any case, the judge-rapporteur has to find this law in order to apply the law to the case and to give a decision on the Preliminary objection.

Regarding Ruritanian law, which fortunately very close to French law, a company can be represented by its management, in this case, Mr Jon Reelax (Haussmann La Riche (II) exhibit 2).

But it is also possible for the management to delegate authority on specific matters to other officials of the company. For instance, the IP department manager of Haussmann La Riche (II), Dr Schweitzer, might be given delegation of power to perform the opt-out.

That is what appears from exhibit 1-ter of Haussmann La Riche (II) .

But it is not the name of Dr Schweitzer that is written on the form filled in on 31 December 2016 or in the correction made on 2 January 2017.

According to Ruritanian law, it is not possible to sub-delegate a delegation of authority.

And at the end, Dr Schweitzer is not employed by Nivartos; so not being official of the company, he cannot receive a delegation of authority on specific matters. Nivartos has to appoint him as an applicant if it wishes to be represented by him.

So the Preliminary objection is founded and the opt-out of patent EP 496 is declared invalid,

because neither Haussmann La Riche (II) nor Nivartos were regularly represented to lodge the application of opt-out.

And therefore, UPC has jurisdiction over the claim for revocation of patent EP 496 filled in by Generoso on 15 March 2017.

The debate on the recoverable costs of the Preliminary objection will take place at the same time as the debate on the recoverable costs advanced for the judgment on the merits.

DECISION

I, Marie Courboulay, Judge-Rapporteur,

Hold that the chapter named “*additional arguments evidencing a fraudulent attempt to lodge an application of opt-out*” of the rebuttal lodged on 3 June 2017 and the exhibit 4 of the defendants are rejected.

Hold invalid the opt-out lodged on 31 December 2016 and corrected on 2 January 2017.

Hold the UPC has jurisdiction over the Statement for revocation of patent EP 496 owned by Haussmann La Riche (II) and Nivartos lodged by Generoso on 15 March 2017.

Decide the procedural schedule as following:

Haussmann La Riche (II) and Nivartos have to lodge their written comments on the Statement for revocation on 31 August 2017;

Generoso has to reply on 16 October 2017;

Haussmann La Riche (II) and Nivartos have to respond on 30 November 2017;

The interim conference will take place on 15 December 2017 and the date of the oral hearing will be discussed at this time to be held at the beginning of February 2018.

The debate on the recoverable costs of the Preliminary objection will take place at the same time as the debate on the recoverable costs advanced for the judgment on the merits.

The decision may be referred to the panel for review in accordance with Rule 102.2

Done in Paris on 6 June 2017.