



Central Division (Section Munich)

UPC_CFI_252/2023

Order informing the parties that the Preliminary objection will be dealt with in the main proceedings (Rule 20.2 RoP) of the Court of First Instance of the Unified Patent Court delivered on 04/10/2023

HEADNOTES:

Objections based on articles 29 and 30 Brussels Ibis Regulation may be the subject of a Preliminary objection under Rule 48 in connection with 19.1(a) RoP. Preliminary objection is to be dealt with in the main proceedings for reasons of procedural economy and efficiency (Rule 20.2 RoP).

KEYWORDS:

Rule 48, 19.1(a) RoP Preliminary objection. Jurisdiction. Lis pendens. Related actions. Articles 29 and 30 Brussels Ibis Regulation. Rule 20.2 RoP (yes).

REFERENCE CODE ECLI: Not provided

APPLICANT/S

- 1) **President and Fellows of Harvard College** Represented by Axel Berger
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Cambridge, MA - US

RESPONDENT/S

- 1) **NanoString Technologies Europe Limited** Represented by Daniela Kinkeldey
(Respondent) - Suite 2, First Floor, 10 Temple
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RELEVANT PROCEEDING PARTIES

1) **NanoString Technologies Europe Limited** Represented by Daniela Kinkeldey
(Claimant) -
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- BS1 6FL -
Bristol - GB

2) **President and Fellows of Harvard College** Represented by Axel Berger
(Defendant)
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Street -
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PATENT AT ISSUE

<i>Patent no.</i>	<i>Proprietor/s</i>
EP2794928	President and Fellows of Harvard College

PANEL/DIVISION

Panel 1 of the Central Division (Section Munich).

DECIDING JUDGE

This is an order of the Judge-rapporteur András Kupecz ('JR').

LANGUAGE OF PROCEEDINGS:

English

SUBJECT-MATTER OF THE PROCEEDINGS

Preliminary objection in revocation action. Rule 48, 19.1(b) Rules of Procedure of the Unified Patent Court ('RoP').

BACKGROUND OF THE CASE AND SUMMARY OF THE FACTS

- On 27 July 2023, Claimant in the main proceedings, respondent in the Preliminary objection, (herein referred to as 'Claimant'), brought a revocation action against European Patent¹ EP 2 794 928 ('the Patent') to the Unified Patent Court ('UPC'), Central Division (Section Munich) requesting revocation of the Patent in its entirety for the territory of the UPC member states Germany, France and the Netherlands and further requests. The revocation action is pending under number ACT_551180/2023 ('the UPC Revocation action').
- On 28 July 2023, notification of service of the UPC Revocation action was sent to the Defendant in the main proceedings, requesting party in the Preliminary objection proceedings, (herein referred to as 'Defendant'),
- On 28 August 2023, Defendant lodged a Preliminary Objection including a request for security for costs (Rule 158 RoP).
- On 11 September 2023, Claimant provided comments to the Preliminary Objection and the Defendant's request for security for costs.
- On 15 September 2023, a preliminary order was issued by the JR setting deadlines for the parties to provide further comments in the Preliminary objection proceedings and separating the security for costs issue from the Preliminary objection (the "Preliminary Order").
- On 22 September 2023, Defendant provided further comments to the Claimant's comments and to the Preliminary Order.
- On 28 September 2023, Claimant provided further comments in response to the Defendant's further comments and to the Preliminary Order.
- On 28 September 2023, Defendant submitted its Defence to revocation in the UPC Revocation action requesting rejection of the revocation action and further (alternative) requests.
- In 2022 (on 29 July) NanoString Technologies Germany GmbH brought a revocation action against the German national part of EP 2 794 928 to the German Federal Patent Court ("the German Revocation action").
- The Claimant in the UPC Revocation action, NanoString Technologies Europe Limited, and NanoString Technologies Germany GmbH have the same parent company: NanoString Technologies, Inc. (USA).
- The German Revocation action is pending at the German Federal Patent Court. An oral hearing in said action is scheduled for 7 May 2024.

STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES IN THE PRELIMINARY OBJECTION

In the Preliminary objection proceedings, Defendant, is requesting:

1. The preliminary objection to be allowed (R 21.1 RoP).
2. The revocation action to be rejected as inadmissible as far as it concerns the German part of EP 2 794 928.
3. In the alternative, the revocation action to be stayed as far as it concerns the German part of EP 2 794 928 until a legally binding decision was rendered by the German Federal Court of Justice.

¹ Used in accordance with the definition of Article 2(e) UPCA: a patent granted under the provisions of the EPC, which does not benefit from unitary effect by virtue of Regulation (EU) No 1257/2012.

In the Preliminary objection proceedings, Claimant, is requesting:

1. The preliminary objection be rejected.
 - i. In the alternative to 1 that the proceedings against the German part of the patent be separated and suspended (Rule 302(1) RoP).
 - ii. In the further alternative to 1.i that the original request to revoke the patent in its entirety in the UPC member states Germany, France and the Netherlands is amended in that the patent is revoked in its entirety for the territory of the UPC member states France and the Netherlands (Rule 263(1) RoP).
2. The preliminary objection to be dealt with in the main proceedings (Rule 48, 20.2 RoP).
3. In the alternative to 2 for the parties to be heard in a hearing before a decision on the Preliminary Objection is taken (Rules 48, 20.1, 264 RoP).

POINTS AT ISSUE

Defendant argues that the Central Division (Section Munich) of the Unified Patent Court is not competent to decide on the validity of the German part of the Patent, since there is already a revocation action pending against this patent at the (competent) German Federal Patent Court. Defendant argues that the claimant in the German Revocation Action, NanoString Technologies Germany GmbH, belongs to the same group of companies as the Claimant in the UPC Revocation action and that their interests in the revocation action are identical to and indissociable from each other. Defendant relies on Article 29 and, in the alternative, Article 30 of Regulation (EU) No 1215/2012² (herein also referred to as “Regulation Brussels Ibis”). These articles deal with *lis pendens* and related actions, respectively.

Claimant argues that the international jurisdiction of the UPC should not be dealt with in the context of a Preliminary objection. Preliminary objections, according to Claimant, should be confined to issues of whether the Agreement on a Unified Patent Court (‘UPCA’) applies at all to a patent in suit and/or whether a patent has been opted out. Claimant furthermore argues that Article 29 Regulation Brussels Ibis is not applicable in this case because the Claimant in the UPC Revocation action and the plaintiff in the German Revocation action are not to be considered as the “same parties” within the meaning of Article 29 and that there should be no stay pursuant to Article 30 Regulation Brussels Ibis because this would not be reasonable and would unduly restrict the Claimant’s right to attack the Patent.

GROUNDS FOR THE ORDER

In its Preliminary Order, the Court expressed as its preliminary view that the international jurisdiction of the UPC, including objections based on articles 29 and 30 Regulation Brussels Ibis may be the subject of a Preliminary objection under Rule 48 in connection with 19.1(a) RoP. Rule 19.1(a) RoP explicitly refers to “the jurisdiction and competence of the court”. The (international) jurisdiction of the Court and competence are dealt with in Chapter VI UPCA which is headed “international jurisdiction and competence”. In accordance with Article 31 UPCA, the international jurisdiction of this Court shall be established in accordance with Regulation Brussels Ibis. Accordingly, Rule 19.1(a) RoP (also) pertains to these provisions and these may therefore be the subject of a Preliminary objection as indeed in the present case.

The Court in its Preliminary Order also expressed its understanding that the Preliminary objection relates to the Court’s jurisdiction only in respect of the German part of the European Patent. In view of the limited scope of the objection raised by the Defendant and in view of the different auxiliary requests submitted by the Claimant in response, the parties seem to agree that the UPC at least has jurisdiction for

² Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast), ELI: <http://data.europa.eu/eli/reg/2012/1215/2015-02-26>.

the non-German parts of the patent and that proceedings should continue in any event in relation to these parts. This understanding has been confirmed by the parties in their submissions following the Preliminary Order.

Under these circumstances, for reasons of procedural economy and efficiency, the JR is of the opinion that the present Preliminary objection should be dealt with in the main proceedings (during the oral hearing and decided on in/together with the decision on the merits).

By the time the oral hearing in the present UPC Revocation action will be held, the oral proceedings at the German Federal Patent Court will most likely have been concluded and the case may even have been fully concluded in first instance. In addition, by the time of the oral hearing in the present action, there may have been further relevant developments in relation to the German Revocation action that can be taken into account by this Court. To deal with the Preliminary objection in the main proceedings will furthermore give parties an opportunity to be heard on the Preliminary objection at the oral hearing to be held in the main proceedings.

Finally, the Court notes that in response to the Preliminary Order, in which the Court informed the parties that it was inclined to decide on the Preliminary objection in the main proceedings, none of the parties brought forward any reasons why the Preliminary objection should be dealt with at this stage rather than in the main proceedings.

For these reasons, the JR hereby pursuant to Rules 48 and 20.2 RoP informs the parties that the Preliminary objection is to be dealt with in and to be decided on in the main proceedings. No decision on the Preliminary objection is taken at this point in time.

Furthermore, the parties are to inform the Court of any relevant developments in the proceedings pending at the German Federal Patent Court.

ORDER

- Parties are hereby informed pursuant to Rules 48 and 20.2 RoP that the Preliminary objection is to be dealt with in the main proceedings. Any decision is to be taken in the main proceedings.
- Parties are to inform the Court of any relevant developments in the German Revocation action.

ORDER DETAILS

Order no. 573299 in ACTION NUMBER: ACT_551180/2023

UPC number: UPC_CFI_252/2023

Action type: Revocation Action

Related proceeding no. Application No.: 567718/2023

Application Type: Preliminary objection

Issued on 4 October 2023

KUPECZ

Judge-rapporteur