



## Hamburg - Local Division

**UPC\_CFI\_559935/2023**

### **Decision**

**of the Court of First Instance of the Unified Patent Court issued on**

**25 January 2024**

Principle: On the admissibility of an application for review by the panel of judges of a decision by the rapporteur upholding the objection pursuant to Rule 333 of the Rules of Procedure

Key words: favourable opposition decision, rapporteur, review under Rule 333 VerFO

Date of receipt of the complaint: 08/08/2023

#### DISPUTE PARTIES

**Fives ECL,**  
Schallmoser (applicant) - 100 rue Chalant -  
59790 Ronchin - France

SASRepresented by Konstantin

**REEL**  
Schröer (Defendant) - Rudolf Diesel Straße 1 -  
97209 Veitshöchheim - Germany

GmbHRepresented by Dr Benjamin

DECIDING JUDGE:

Presiding judge, rapporteur	Sabine Klepsch
Legally qualified judge	DrStefan Schilling
Legally qualified	judgeMojca Mlakar

LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT OF THE PROCEEDINGS:

Determination of damages

BRIEF DESCRIPTION OF THE FACTS:

In a statement of claim dated 8 August 2023, received in paper form by the Hamburg Local Court on the same day in accordance with Rule 4.2 VerfO, the plaintiff filed an action for damages. This was preceded by patent infringement proceedings between the parties here - in addition to other defendants - before the Düsseldorf Regional Court, file number 4c O 1/21. In these proceedings, the defendant (defendant 1)) was ordered by judgement of 9 August 2022 to, among other things August 2022, the defendant (defendant 1) was ordered, among other things, to refrain from offering service modules for a series of electrolysis cells intended for the production of aluminium by fused-salt electrolysis, which are equipped with the features of patent claim 1 of the German part of EP 1 740 740 B1 (hereinafter: patent in dispute), in the Federal Republic of Germany. In the aforementioned judgment, it was also determined that the defendant is obliged to compensate the plaintiff for all damages that it has suffered and will suffer as a result of the acts described in more detail in Section I.1. committed since 2 December 2016. The judgement is final. Neither party has lodged an appeal.

The defendant lodged an objection pursuant to Rule 19 of the Rules of Procedure by analogy in a written submission dated 6 October 2023 and asserted that the court seised did not have jurisdiction to decide on the determination of damages.

By decision dated 17 November 2023, the rapporteur upheld the objection. The applicant objected to this in a written submission dated 4 December 2023 and requested a review of the decision by the entire panel in accordance with Rules 331.1, 333.4 of the Rules of Procedure.

The defendant was given the opportunity to comment on the application for a review of the decision and the deadline was extended until 12 January 2024.

#### MOTIONS BY THE PARTIES:

The applicant claims that the Court should:

- I. The rapporteur's decision of 17 November 2023 is submitted to the entire panel for immediate review in accordance with Rules 331.1, 333.4 of the Rules of Procedure.
- II. The decision on the objection of 17 November 2023 is annulled in accordance with Rule 335 of the Rules of Procedure and the objection proceedings are continued before the entire panel.
- III. An interim hearing will be held.
- IV. The defendant's objection is rejected.

The defendant requests:

- I. The application for review is rejected as inadmissible.
- II. The defendant shall also bear the further costs of the legal dispute insofar as these were triggered by the application for review.

in the alternative,

- III. The decision of the rapporteur of 17. November 2023 is confirmed and the request for review is rejected.
- IV. The defendant also also the further costs of the legal dispute, insofar as these were triggered by the request for review.

#### REASONS FOR THE ORDER:

The application for examination by the entire panel against a favourable objection by the judge-rapporteur is inadmissible.

Pursuant to Rule 21.1 RP, an appeal under Rule 220.1(a) RP is admissible against a favourable opposition in one of the decisions referred to in Rule 220.1(a) or (b) RP. A favourable opposition decision is a decision under Rule 220.1(a) RP.

There is no scope for the applicability - directly or by analogy - of Rule 333.1 of the Code of Procedure.

1.a)

Rule 333.1 VerfO does not apply directly. This is because Rule 333.1 VerfO only applies to "procedural decisions or orders". The decision that the plaintiff is requesting to be reviewed is not procedural. It follows from the term "leading proceedings" that the decision may not be a final decision and thus not "terminating proceedings" (Tilman/Plassmann/Chakraborty/Dormann, Unified Patent Protection in Europe, R. 333 VerfO para. 4). This is confirmed by the examples for the conduct of proceedings listed in Rule 332 RP. None of the procedural measures mentioned therein is a termination of proceedings or a decision on the admissibility or merits of the action or application. Rather, the following measures are in favour of the proceedings

Decisions and measures relating to the procedure leading to the decision, not the decision on the admissibility or merits of the action or application itself. The present final decision, which terminated the proceedings by rejecting the application, therefore does not fall within the scope of Rule 333 of the Rules of Procedure.

Rule 102.2 of the Rules of Procedure, to which the applicant refers, does not apply in the present case either. This is because Rule 102 of the Rules of Procedure also only applies to the tasks of the judge-rapporteur in conducting proceedings, in particular in interlocutory proceedings. Since the decision whose review is requested was neither procedural nor was it issued in interlocutory proceedings, but in written proceedings, Rule 102.2 of the Rules of Procedure does not apply.

b)

An analogous application of Rule 333.1 VerfO does not apply in the present case either. There is neither an unintended regulatory gap nor a comparable situation of interest.

In the applicant's view, it is incompatible with the UPCA for the judge-rapporteur to dismiss an action or a request in response to an opposition if there is no possibility of a review of that decision by the entire panel. The same follows from Art.

8 (1) UPCA, which generally stipulates that all panels of the Court of First Instance are multinational.

This is not convincing. In the present case, it is not the question of the composition of the panel that is in dispute, but the question of which decisions are to be taken by the entire panel and which by the judge-rapporteur alone. Article 8(1) UPCA does not state that all decisions on the admissibility or merits of an action or application must always be taken by the entire panel. Rather, the UPCA stipulates in Art. 41 UPCA that it is the Rules of Procedure that regulate the details and thus also the decision-making competence. Rule 20 of the Rules of Procedure expressly provides that the rapporteur decides on the opposition. In this respect, there is no contradiction with Art. 8 para. 1 UPCA precisely because the competence of the rapporteur for decisions concluding the proceedings in the case of an upheld opposition is limited to the cases enumerated in Rule 19.1 lit a) to c) RP. Only in these cases is the judge-rapporteur authorised to take a final decision, which is otherwise the responsibility of the panel as a whole. The legislator has thus assigned the rapporteur a limited decision-making competence for the cases provided for in Rule 19 para. 1 of the Code of Procedure, which do not have to be decided by the adjudicatory body. Accordingly, Art. 19 para. 2 EPGs, to which the defendant correctly refers, also provides that the RP may provide that certain tasks may be transferred from the panel to a judge, which is precisely in line with the competence regulated for objections under Rule 19 et seq. VerfO, which is precisely in line with the jurisdiction regulated for objections under Rule 19 et seq.

In this respect, an unsuccessful opponent is not without rights. This is because an appeal may be lodged directly against a decision that upholds the objection in accordance with Rule 220 Para. 1 lit. a) VerfO. The Court of Appeal is thus directly authorised to review the correctness of the decision. Nothing else would happen if the entire panel had reached a final decision.

An unintended regulatory gap is therefore not recognisable.

Nothing to the contrary can be inferred from the drafting history of the VerfO. In this respect, the plaintiff refers to comments made by the persons involved in the preparation of the VerfO. From these remarks, the plaintiff deduces that they were of the opinion that Rule 333.1 of the Rules of Procedure applies directly to a decision granting the objection. However, this cannot be inferred from the comments referred to by the plaintiff. The comments are very brief and do not make clear the specific context in which they stand. In this respect, it cannot be established that the intention was to express that Rule 333.1 VerfO should apply directly in cases such as the present one. In this respect, it only refers to a decision that is not specified in more detail. It is therefore conceivable, as the defendant also points out, that this refers to the decision of the judge-rapporteur as to whether the objection is to be decided in isolation or together with the main proceedings. This is a procedural measure that could actually fall under Rule 333.1 of the Rules of Procedure.

Even if the comments were to be understood to mean that decisions by the judge-rapporteur upholding the objection could also be the subject of an application under Rule 333.1 of the Rules of Procedure, this does not constitute an analogy. This is because the second requirement for an analogy, a comparable situation of interest, is lacking. The interests of a decision by the judge-rapporteur granting an objection, as regulated in Rules 20.1 and 21.1 of the Rules of Procedure, are not comparable with the interests addressed in Rule 333.1 of the Rules of Procedure in the case of decisions or orders directing proceedings. Rule 333.1 of the Rules of Procedure provides for an (immediate) possibility of review precisely because the isolated appeal against the vast majority of procedural decisions and orders is not available as a legal remedy. As they are not listed in the catalogue of Rule 220.1 of the Rules of Procedure, they can only be appealed against together with the final decision (Rule 220.1 Alt. 1 of the Rules of Procedure). Without the possibility of review under Rule 333.1 of the Rules of Procedure, there would therefore be a risk that the proceedings would be conducted on the basis of a procedural decision or order that subsequently - in the context of the appeal against the final decision - turns out to be unlawful. The entire first instance proceedings would therefore have to be conducted again. This problem

does not arise, as the objection was upheld and the application rejected. Pursuant to Rule 21.1, Rule 220.1 (a) of the Rules of Procedure, the plaintiff has direct recourse to appeal.

c)

The decision of the Helsinki Local Chamber of 28 August 2023 - UPC\_CFI\_214/2023 - does not contradict this understanding. This is because the decision of the entire panel there was conditional on the procedural situation. The plaintiff/applicant in the proceedings there had filed both an action for alleged patent infringement and an application for interim measures. In both proceedings, the defendant/respondent lodged identical objections, invoking the lack of jurisdiction of the UPC. The judge-rapporteur then decided to proceed as follows: An oral hearing was scheduled to decide on the application for interim measures. The objection to the application was also to be heard there. As the objection had also been raised against the action with the same content, both objections were to be heard together on this occasion. As the oral hearing on the application for interim measures took place before the entire panel, the panel also had to decide on the objection, an option already provided for in Rule 20.2 of the Rules of Procedure.

Overall, it can therefore be concluded that the applicant's request for a review of the rapporteur's decision of 17 November 2023 by the entire panel is not admissible.

2.

It is not necessary to hold an interim hearing. There are only legal issues in dispute between the parties, which the parties have discussed extensively in writing. It is not apparent that an interim hearing would bring new aspects to light.

3.

This is a decision of the adjudicating body, Rule 333.5 of the Rules of Procedure, which can be challenged on appeal under the conditions of Rule 220.2 of the Rules of Procedure. Since the plaintiff was unsuccessful with its application and the decision concerns fundamental questions of the understanding of the RP, it is considered appropriate to allow the appeal.

FINAL ARRANGEMENT:

1. The application for review of the decision of the Judge-Rapporteur of 17 November 2023 by the panel is rejected as inadmissible.
2. An interim hearing will not be held.
3. Orders the applicant to pay the costs of the review proceedings.
4. The appeal is authorised.

Issued on 25 January 2024

Presiding Judge/Rapporteur Sabine Klepsch Judge with  
legal qualifications Dr Stefan Schilling Judge with legal  
qualifications Mojca Mlakar

Information about the appeal:

This order may be appealed against by any party who has been unsuccessful in whole or in part in its applications together with the appeal against the final decision of the Court of First Instance on the merits, or - after the appeal has been admitted by the Court of First Instance - by any party who has been unsuccessful in whole or in part in its applications within 15 days of service of the relevant decision (Article 73(2)(b), Rules 220.2, 224.1(b), 333.5 of the Rules of Procedure).