



Paris Local Division

UPC_CFI_440/2023
Procedural order
of the Court of First Instance of the Unified Patent Jurisdiction, handed
down on 24/07/2024

APPLICANT

Seoul Viosys Co,
Debré 65-16, Sandan-ro 163 beon-gil,
Danwon-gu - 15429 - Ansan-si,
Gyeonggi-do - Republic of Korea

LtdRepresented by Pauline

DEFENDER

Laser Components
Hirschhausen 45B Route des Gardes
92190 Meudon
France

SASRepresented by Helge von

INTERVENING PARTY

Photon Wave Co, Ltd.
52, Jugyang 1763 beon-gil,
Wonsam-myeon, Cheoin-gu,
Yongin-si, Gyeonggi-do, 17166
Republic of Korea

represented by Dorothea Hofer

PATENT IN SUIT

Patent number

Owner

EP3404726

Seoul Viosys Co, Ltd

LANGUAGE OF PROCEDURE: French

COMPOSITION OF THE CHAMBER - FULL PANEL

Chairman and Judge-Rapporteur	Camille Lignières
Legally qualified judge	Carine Gillet
Legally qualified judge	Peter Tochtermann

ORDER

Summary of facts and proceedings :

On 5 December 2023, SEOUL VIOSYS brought an infringement action before the Paris Local Division against LASER COMPONENTS relating to European Patent EP3404726. The statement of claim was served on 18 December 2023.

In an order dated February 12, 2024, the Judge-Rapporteur declared admissible LASER COMPONENTS' request for intervention against its supplier PHOTON WAVE. LASER COMPONENTS filed its statement of defence on March 18, 2024, disputing, among other things, the materiality of the infringement. On March 18, 2024, LASER COMPONENTS filed its statement of defence without a counterclaim for a declaration of invalidity.

On March 18, 2024, PHOTON WAVE filed a brief seeking a declaration that its intervention was admissible, and a brief in intervention, seeking in particular to be able to file, independently of LASER COMPONENTS, a counterclaim for invalidity of the patent and that it be granted a period of two months to do so.

In an order issued on May 6, 2024, the Paris Local Division rejected PHOTON WAVE's claims set out in its statement of defence.

On May 16, 2024, SEOUL VIOSYS then filed a reply to the statement of defence and the statement in intervention of LASER COMPONENTS and PHOTON WAVE of March 18, 2024, reiterating the claims and arguments set out in its statement of claim.

In parallel, on June 5, 2024, PHOTON WAVE filed a revocation action against SEOUL VIOSYS, the owner of the patent, before the Paris Central Division (procedure number 28074/2024) concerning patent EP 3404726, the subject of this infringement action.

Requests of the parties :

PHOTON WAVE filed a rejoinder on June 13, 2024 requesting:

- 1) that the procedure under rule 118 (2) (b) RoP be suspended,
- 2) in the alternative, that the decision on the merits of the infringement claim, including its binding provisions, be made subject to the patent not being held to be wholly or partially invalid by the final decision in the invalidity proceedings, pursuant to Rule 118(2)(a) MOP,
- 3) a technically qualified judge is assigned to the panel (rule 33.1 RoP).

It should be noted that the last part of the brief, entitled "damages", is not a claim.

By Preliminary Order of June 19, 2024, SEOUL VIOSYS and LASER COMPONENTS were invited by the Judge-Rapporteur to submit written comments on PHOTON WAVE's procedural requests by July 2, 2024. SEOUL VIOSYS filed comments on 1^{er} July 2024 in which it intends to oppose PHOTON WAVE's requests, except with respect to the assignment of a technically qualified judge. LASER COMPONENTS did not file any written comments within the deadline.

A status meeting was held online by the judge-rapporteur on July 2, 2024. At this meeting, the registry of the Paris Local Division and the representatives of SEOUL VIOSYS and PHOTON WAVE were present, while the representative of LASER COMPONENTS, who was regularly invited to attend, indicated that he would not be present.

At the meeting, the representatives confirmed their respective positions as set out in their written submissions.

Reasons for the decision

Stay of execution

-the applicable legal texts:

Article 33.4 of the Agreement on a Unified Patent Jurisdiction (AJUB)

" 4. The actions referred to in Article 32(1)(b) and (d) shall be brought before the Central Division. If, however, an infringement action referred to in Article 32(1)(a) has been brought between the same parties in respect of the same patent before a local or regional division, the aforementioned actions may be brought only before the same local or regional division."

Rule 118.2 of the Rules of Procedure of the Unified Patent Jurisdiction (RoP)

" 2. If, during infringement proceedings before a local or regional division, an invalidity action is pending between the same parties before the central division or if an opposition is pending before the European Patent Office, the local or regional division :

- a) may give its decision on the merits of the infringement claim, including its binding provisions, subject to the condition, in accordance with Article 56(1) of the Agreement, that the patent is not declared wholly or partially invalid by the final decision in the invalidity proceedings or a final decision of the European Patent Office or subject to any other condition; or
- b) may stay infringement proceedings pending a decision in invalidity proceedings or a decision of the European Patent Office; it shall stay the infringement proceedings if it is of the opinion that there is a strong likelihood that the contentious claims of the patent will be declared invalid for whatever reason by the final decision in the invalidity proceedings or by the European Patent Office or if it can be expected that this decision of the European Patent Office will be rendered rapidly. "

-the context of the case :

The present case involves, on the one hand, an infringement action before the present Local Division, first seized, in which SEOUL VIOSYS is the plaintiff and the defendant is LASER COMPONENTS and PHOTON WAVE is an intervener in support of the defendant; on the other hand, an action for revocation of the patent in the main proceedings before the Paris Central Division, second seized by PHOTON WAVE and in which SEOUL VIOSYS is the defendant.

a) the criterion of "action pending" before the Paris Central Division

Contrary to what the representative of SEOUL VIOSYS maintained (page 4 of his observations of 1^{er} July 2024), the action before the Paris Central Division is pending to this day, regardless of whether service of the statement of claim has been accepted by the defendant, what must be taken into account is the date of actual registration before the Division. In this case, the case has been registered since 05/06/2024 under number 28074/2024.

It is not disputed that these are two actions concerning the "same patent", i.e. EP 3404726, as regards both the infringement action before this Division and the revocation action before the Paris Central Division.

The other contested point is the notion of "same parties", a criterion mentioned in both rule 118.2 RoP and article 33.4 UPCA [AJUB]. This is a criterion that requires harmonised interpretation within the UPC.

b) the notion of "party":

The Court noted that the intervener, after its intervention has been declared admissible, must be "treated as a party" in the infringement action, in accordance with rule 315.4 RoP.

PHOTON WAVE is undoubtedly a party to the patent revocation action before the Paris Central Division as plaintiff in the main action.

c) the concept of "identity of the parties":

The representative of SEOUL VIOSYS maintains that PHOTON WAVE does not have the same standing in the two actions in question since it is an intervener in the infringement action before the local division (page 3 of the written observations of 1^{er} July 2024), and not a defendant in the main proceedings.

The representative of SEOUL VIOSYS also points out that the concept of "same party" has been strictly interpreted by the JUB (CD Paris, 13/11/2023, Meril v. Edwards Lifesciences) refusing that a subsidiary and the parent company of the group should be considered as one and the same party.

"same party".

However, this reference is not relevant in the context of our case, regardless of the status of the parties in a given dispute. More specifically, the parties to the dispute must be the same in both instances, regardless of their procedural positions, the plaintiff may be a defendant in the second instance and vice versa, in order to avoid several divisions being seized of the question of the validity of the same patent by the same parties, for the sake of efficiency, economy of means and to avoid the risk of irreconcilable decisions within the JUB. (cf in this respect, *Traité "Unified Patent Protection in Europe"*, W. Tilmann and C. Plassmann, 1st edition, Oxford University Press, page 655, point 108).

The Court also notes that both article 33.4 of the UPCA [AJUB] and rule 118.2 of the RoP are special and autonomous rules specific to internal jurisdiction within the divisions of the JUB. However, in order to interpret the concept of "same parties", it is relevant to reason by analogy with the rules of jurisdiction between the different courts within the EU in matters of "lis pendens" (Brussels I Regulations [Regulation no. 1215/2012 of 12 December 2012 known as "Brussels I bis Regulation" and Regulation no. 44/2001 of 22 December 2000 known as "Brussels I Regulation" or the 1968 Brussels Convention), the aim of which is also to avoid the risk of contradictory decisions. According to the case law in 'The Ship Tatry', if the parties to the two pending proceedings are not identical in all respects, but only in part, the court second seised is only obliged to decline jurisdiction insofar as the parties to the dispute before it are also parties to the proceedings previously brought, and it is possible to continue between the other parties. (ECJ, 6 December 1994, The Ship Tatry, aff-C-406/92, pt 36).

Finally, it should be noted that in the present case, according to PHOTON WAVE itself, in its application for revocation before the Paris Central Division, it made a preliminary request that the Paris Local Division be declared competent to rule on the invalidity of the patent.

d) conclusion

In the light of all these factors, the Court considers that, even where the parties are partially identical, it is highly likely that the Central Division will not retain jurisdiction to rule on the revocation claim. In that case, such a claim for invalidity of the patent on which the infringement action is based could only be brought before the Local Division in the context of a counterclaim. (cf. in this respect, *Traité "Unified Patent Protection in Europe"*, W. Tilmann and C. Plassmann, 1st edition, Oxford University Press, page 655, point 108).

In addition, the Court, more generally when deciding on an application for a stay of proceedings (rule 295 (g) and (m) RoP), must take into account, in the light of the guiding principle of effectiveness of the Rules of Procedure of the JUB (preamble, point 7), the state of the respective proceedings within the two divisions concerned in order to decide whether it is appropriate to await the decision of the Paris Central Division on the question of jurisdiction. In the present case, the time limits for the written procedure phase have already expired in the infringement action before this division, whereas the action before the Central Division is only at the stage of notification of the statement of claim.

For all these reasons, and without it being necessary to analyse the *prima facie* validity of the patent in question, the request for a stay pending the decision of the Central Division does not appear justified in the present case and will be rejected.

On the request for the allocation of a technical judge to the panel

In accordance with rule 33 of the RoP and taking into account the agreement of the parties on this point as well as the technical complexity of the present dispute, the request for the allocation of a technical judge to the panel in charge of ruling on the infringement action will be accepted.

For these reasons,

the Court

- Dismisses PHOTON WAVE's application for a stay of proceedings pending the decision of the Paris Central Division in action number ACT_28074/2024 - UPC_CFI_238/2024,
- grants the request for the allocation of a technically qualified judge to the panel,
- says that the judge-rapporteur will set the dates for the status conference and the oral hearing in a forthcoming order.
- points out that this order may be appealed in accordance with the provisions of R. 220.2 RdP.

Paris, 24 July 2024.

Chairman and Judge-Rapporteur

Camille Lignières

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Legally qualified judge

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Peter Tochtermann

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DETAILS OF THE ORDER

Order n° ORD_41423/2024 in ACTION N° ACT_588685/2023 UPC n° :
UPC_CFI_440/2023

Type of action: Infringement action