



No. APP_36130/2024
UPC_CFI_88/2024

ORDER
of the President of the Court of First Instance
in the proceedings before the Local Division Hamburg
pursuant to R. 323 RoP (language of the proceedings)
issued on 25/07/2024

HEADNOTE:

- When deciding on a request to change the language of the proceedings to the language in which the patent was granted, all relevant circumstances relating to the case and to the position of the parties shall be taken into account. If the outcome of balancing of interests is equal – here both parties being international companies operating worldwide – the position of the defendant is the decisive factor.

KEYWORDS:

- Change of the language of the proceedings

APPLICANTS (DEFENDANTS IN THE MAIN PROCEEDINGS):

- 1- Tandem Diabetes Care Inc.**
12400 High Bluff Drive, CA 92130, San Diego – U.S.A
- 2- Tandem Diabetes Care Europe B.V.,**
Schiphol Boulevard 359, WTC Schiphol Airport, D-Tower 11th floor, 1118 BJ
Schiphol – The Netherlands

Represented by: Charlotte Garnitsch – Taylor Wessing N.V

- 3- VitalAire GmbH,**
Bornbarch 2, 22848 Norderstedt – Germany

Represented by: Christine Kanz – Hoyng Rokh Monegier

RESPONDENT (CLAIMANT IN THE MAIN PROCEEDINGS):

Roche Diabetes Care GmbH

Sandhofer Straße 116, 68305 Mannheim – Germany

Represented by: Christof Augenstein – Kather Augenstein

PATENT AT ISSUE:

Patent n° EP 2196231.

SUMMARY OF FACTS - SUBJECT - MATTER OF THE PROCEEDINGS:

By a statement of claim filed on 29 February 2024, Roche Diabetes Care GmbH. brought an infringement action against Tandem Diabetes Care, Inc., Tandem Diabetes Care Europe B.V (hereinafter collectively referred to as “Tandem Diabetes”) and VitalAire GmbH, based on EP EP2196231 entitled “*System for ambulatory drug infusion comprising a filling apparatus for flexible containers*” before the Local Division Hamburg.

By a generic procedural application dated 17 June 2024, Tandem Diabetes, referring to R. 323 RoP, requested that the language of proceedings be changed from German to English (hereinafter the “Application”).

By an order dated 18 June 2024, the Claimant in the main action (No. ACT_10800/2024 UPC_CFI_88/2024) was therefore invited, in accordance with R. 323.2 RoP, to state within 10 days its position on the admissibility of the Application and on the use of the language in which the patent was granted (namely English) as language of the proceedings.

The Application was forwarded by the Judge-rapporteur to the President of the Court of First Instance of the UPC pursuant to R. 323.1. RoP.

VitalAire – as third Defendant – and Roche Diabetes Care GmbH submitted their written comments on the Application on 27 and 28 June 2024, respectively.

The panel of the LD Hamburg has been consulted according to R. 323.3 RoP.

INDICATION OF THE PARTIES' REQUESTS:

Tandem Diabetes requests the Application:

- be declared admissible as it was filed together with the statement of defence in accordance with Rule 323.1 RoP;
- be granted on the basis of Rule 323.1 of the Rules of Procedure in conjunction with Article 49(5) UPCA, and therefore the language of the proceedings be changed to English.

VitalAire agrees to the Application to change the language of the proceedings to English.

Roche Diabetes requests the Court to dismiss the Application and in the alternative state that existing pleadings and documents are to be translated at the Defendant's expense.

POINTS AT ISSUE:

Tandem states that the Application shall be granted for the following reasons:

- A decision to change the language of the proceedings to the language in which the patent was granted requires to take into account the respective interests without it being a question of disproportionate disadvantage;
- German is only the language of Defendant 3, on the other hand English – language of the Patent, widely spoken in business and sciences – is the official language of Defendants 1 and 2. Conducting proceedings in German therefore causes unreasonable inconvenience for Tandem while switching the language to English would not incur any disadvantage for Roche, which is an international company and was previously involved in extensive discussions about the challenged products with the adverse party;
- Previous UPC proceedings between the same parties before the Paris Central Division concerning the same patent are also conducted in English, and handling all these disputes in the same language is obviously more efficient for all actors involved;
- Tandem unsuccessfully attempted to amend the language by way of a preliminary objection and the Court indicated in its order of 24 May 2024 that this request should be submitted pursuant to R. 323 RoP.

VitalAire supports the Application on the same grounds and furthermore indicated that a proper defence requires an important amount of translation work to coordinate with its French parent company Air Liquide Group.

Roche Diabetes Care states as preliminary points that although the Application is presented as an “*objection*”, it is to be understood as a request pursuant to R. 323 RoP – the submission being actually the same as the one dated 17 April 2024 referring to R. 19 RoP – and that according to R. 323.1 RoP, the comments provided according to R. 323.2 RoP are also addressed to the President of the Court of First Instance.

The Respondent further argues that the Application must be dismissed for the following reasons:

- The claimant has the right to choose the language of the proceedings in accordance with R. 14.2 (a) RoP and should the President of the Court of First Instance have to decide on an application pursuant to Art. 49 (5) UPCA, all relevant circumstances must be taken into consideration on a case-by-case basis;
- Tandem don't invoke any such “*relevant*” reason that would call in favor of the requested change – the fact of whether the legal representatives speak the language of the proceedings is expressly irrelevant according to the CofA (order of 17 April 2024, Ref. CoA_101/2024, para. 26) – and the assertion according to which Tandem's managers do not speak German cannot be verified;
- There are instead relevant circumstances in the present case that justify the use of German, namely the situation of Defendant 3 that would be sued at its place of business in another language;
- The claimant is located in Germany and manages its patent portfolio with German-speaking staff;
- It is not important whether the change would be convenient for the plaintiff but rather, whether the interests of the defendant require a change;
- Another parallel dispute in German – in which the language cannot be changed – is pending before the Local Division Düsseldorf regarding the same types of infringement acts;
- The proceedings started before the Central Division in English are not to be considered as the action for declaration of non-infringement is suspended and the panel has already indicated that it intends to decide on both validity and infringement pursuant to R. 37.2 RoP.

Further facts and arguments as raised by the parties will be addressed below if relevant to the outcome of this order.

GROUNDS FOR THE ORDER:

1- Admissibility of the Application

It is firstly noted that the preliminary remarks made by the Respondent do not question the admissibility of the Application, which is not disputed in the present case.

2- Merits of the Application

According to Art. 49(1) UPCA, the language of the proceedings before a local division must be an official language of its hosting Member State or alternately the other language designated pursuant to Art. 49 (2). It is further provided by R. 323 RoP that *“1. If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(5) of the Agreement (...) [t]he President, having consulted [the other parties and] the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements”*.

Regarding the criteria that may be considered to decide on the Application, Art. 49 (5) UPCA specifies that *“(...) the President of the Court of First Instance may, on grounds of fairness and taking into account all relevant circumstances, including the position of parties, in particular the position of the defendant, decide on the use of the language in which the patent was granted as language of proceedings. In this case the President of the Court of First Instance shall assess the need for specific translation and interpretation arrangements”*.

It has furthermore been stated that Art. 49 (5) UPCA must be interpreted in such a way that the decision on whether or not to change the language of the proceedings to the language in which the patent was granted must be determined considering the respective interests at stake, without requiring that it constitute a disproportionate disadvantage (UPC CFI 225/2023 LD The Hague, order of 18 October 2023, UPC CFI 373/2023 LD Düsseldorf, order of 16 January 2024, UPC CFI 410/2023 LD Mannheim, order of 15 April 2024).

By an order dated 17 April 2024, the UPC Court of Appeal (hereinafter “CofA”) ruled that when deciding on a request to change the language of the proceedings to the language of the patent for reasons of fairness, all relevant circumstances must be taken into account. These circumstances should primarily relate to the specific case, such as the language most commonly used in the relevant technology, and to the position of the parties, including their nationality, domicile, respective size, and how they could be affected by the requested change, respectively (UPC_CofA_101/2024, Apl_12116/2024, para. 22-25).

In the event that the result of the balancing of interests is the same in the context of this overall assessment, the CofA found that the emphasis given “in particular” to the position of the defendant under Art. 49 (5) UPCA is justified by the flexibility afforded to the claimant which frequently has the choice of where to file its action – since any local or regional division in which an infringement is actually threatened or taking place is competent – and can generally choose the most convenient timeframe to draft its Statement of Claim, while the defendant is directly bound by strict deadlines.

Based on the above, it follows that the position of the defendant (s) is the decisive factor if both parties are in a comparable situation.

In the same decision, the CofA also held that *“for a claimant, having had the choice of language of the patent, with the ensuing possibility that the claimant/patentee may have to conduct legal proceedings in that language, as a general rule and absent specific relevant circumstances pointing in another direction, the language of the patent as the language of the proceedings cannot be considered to be unfair in respect of the claimant”* (para. 34).

In the present case, the assertion that English is the commonly used language in the field of technology in question – namely medical devices and systems – is not disputed by Roche Diabetes Care and can be inferred from the prior art cited, as well as from the language of a large number of annexes submitted with the Statement of Claim.

The official and corporate language of Defendants 1 and 2 – located in the U.S and the Netherlands, respectively – is English which is also the working language of Defendant 3. Indeed, VitalAire is a German company owned by AIR LIQUIDE Deutschland GmbH and therefore, is part of the French AIR LIQUIDE Group.

Roche Diabetes Care is part of the Roche Group headquartered in Switzerland, which is presented by the Claimant as one of the largest biotech companies in the world with entities in over 100 countries. Based on this background, it can be assumed that it uses English internally and for its external communication.

The respective size and resources of the parties in the dispute are comparable for the purpose of deciding on the present Application. The Claimant does not expressly deny that it could handle the dispute in English without difficulties. Rather, Roche alleges that it manages its patent portfolio and conducts its proceedings in German for the sake of convenience without its written submissions being translated.

It follows from the above that the outcome of balancing of interests appears to be equal in the present case, without it being relevant to invoke other parallel proceedings which are concurrently handled in English, before the Central Division of the UPC, and in German – concerning an infringement action based on a German patent – before the Düsseldorf Local Division. Roche’s objection that the Hamburg Local division will not refer the counterclaim for revocation can furthermore not be taken into account, as the language of the patent is generally of importance in both questions of infringement and validity.

The position of the Defendants is thus the decisive factor to be considered here, for the abovementioned reasons identified by the Court of Appeal (UPC_CofA_101/2024, Apl_12116/2024, para. 28 - 30).

It is moreover to be noted that none of the circumstances of the case, as addressed by the parties in the context of the present Application, can be considered as “*specific*” sufficient grounds to deviate from the general rule following which “*the language of the patent as the language of the proceedings cannot be considered to be unfair in respect to the Claimant*” (UPC_CofA_101/2024, Apl_12116/2024, para. 34).

Consequently, the situation/position of the Defendants – including VitalAire, which, having regard to the internal communication within the Air Liquide group, expressly supported the requested change despite having its registered offices in Germany – prevails in the overall assessment and the Application to change the language of the proceedings to the language of the patent must be granted.

3- Consequences of the change of the language in the course of the proceedings

According to R. 324 RoP, an application under R. 321.1 or 323.1 shall specify whether existing pleadings and other documents should be translated and at which party’s costs. If the parties cannot agree, the Judge-rapporteur or the President of the Court of First Instance, as the case may be, shall decide in accordance with R. 323.3 RoP, pursuant to which the deciding judge “*may make the order conditional on specific translation or interpretation arrangements*”.

In the absence of any particular relating request from the Defendants and taking into consideration that a translation of the Statement of Claim has already been provided in English language, it shall be assumed at this stage that further interpretation and translation arrangements are not required.

FOR THESE GROUNDS

- 1- The application is granted and the language of the proceedings (German) shall be changed to English (language in which the patent was granted).
- 2- The present order shall not be conditional on specific translation or interpretation arrangements.
- 3- An appeal may be brought against the present order within 15 calendar days of its notification to the Applicants pursuant to Art. 73. 2 (a) UPCA and R.220 (c) RoP.

INSTRUCTIONS TO THE PARTIES AND TO THE REGISTRY:

The next step is for the Respondent to file the Reply to the Statement of defence within the time period as set by the Judge-rapporteur.

ORDER

Issued on 25 July 2024

NAME AND SIGNATURE

Florence Butin
President of the UPC Court of First Instance