



Central Division
Paris Seat

ORDER
of the Court of First Instance of the Unified Patent Court
Central division (Paris seat)
issued on 17 September 2024
concerning the generic procedural applications Nos. App_45333/2024 and
51629/2024
lodged in the proceedings UPC_CFI_189/2024

APPLICANT:

- Meril Life Sciences Private Ltd.** - M1-M2, Meril Park, Survey No.135/2/B & 174/2, Muktanand Marg, Chala, Vapi 396191, India
- Meril GmbH** - Bornheimer Straße 135-137, 53119 Bonn, Germany
- Meril Italy S.r.l.** - Piazza Tre Torri 2, 20145 Milano, Italy

all represented by Emmanuel Larere and Jean-Hyacinthe de Mitry, Cabinet Gide Loyrette Nouel AARPI, and by Jonathan Stafford and Gregory Carty Hornsby, Marks & Clerck LLP

RESPONDENT:

Edwards Lifesciences Corporation - One Edwards Way, Irvine, California, 92614, USA

represented by Siddharth Kusumakar, Tessa Waldron and Bryce Matthewson, Powell Gilbert (Europe) LLP, by Adam Rimmer, Powell Gilbert LLP, and by Jonas Weickert and Bernhard Thum, Thum & Partner

PATENT AT ISSUE:

European patent n. 4 151 181

PANEL:

Panel 2

Paolo Catalozzi	Presiding judge and judge-rapporteur
Tatyana Zhilova	Legally qualified judge
Elisabetta Papa	Technically qualified judge

DECIDING JUDGE:

This order is issued by the presiding judge and judge-rapporteur Paolo Catalozzi

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 15 May 2024 Meril Life Sciences Private Ltd., Meril GmbH and Meril Italy S.r.l. filed a revocation action against Edwards Lifesciences Corporation concerning the patent at issue (EP '181) before this Central Division (registered as No. ACT_22275/2024 UPC_CFI_189/2024). The statement for revocation has been served on the defendant on 16 May 2024.
2. On 16 July 2024 the defendant filed the defence to revocation, as well as application to amend the patent (registered as No. App_42115/2024), which were notified on 17 July 2024, after a request for correction of the defence to revocation dated the same day. The defendant also filed a counterclaim for infringement, registered as No. CC_43159/2024 UPC_CFI_434/2024.
3. On 5 August 2024 the applicant filed an application (registered as No. App_45333/2024) requesting that the judge-rapporteur rejects the respondent's counterclaim for infringement as inadmissible, because it did not meet the two-month deadline set by Rule 49 of the Rules of Procedure ('RoP'), as the counterclaim was lodged only on 23 July 2024.
4. The respondent, asked for written comments, requested that the application is dismissed; in the alternative, that a retrospective extension of the time period set by Rule 49 'RoP' by one week to 23 July 2024, pursuant to Rule 9 (3) 'RoP' and, on this alternative basis, likewise that the application is dismissed; in the further alternative, that the court hears the parties pursuant to Rule 264 'RoP'.
5. On 12 September 2024 the applicant filed a separate application to comment on the respondent's response (registered as No. App_51629/2024), asking, as a main request, that the judge-rapporteur reject as inadmissible the counterclaim for infringement and, in the alternative, the auxiliary requests made by Edwards to obtain that the deadline to file a counterclaim for infringement be extended to 23 July 2024, and the leave to appeal the order denying such requests.

GROUNDINGS FOR THE ORDER

Late filing of the counterclaim for infringement and request for time extension.

6. It is undisputed that the counterclaim for infringement was uploaded on the appropriate workflow of the CMS only on 23 July 2024, and this is after the two months deadline set forth by Rule 49 'RoP' had expired as the statement for revocation was served on the defendant on 16 May 2024.

7. The respondent argues that on 16 July 2024, after paying the fee for the counterclaim for infringement, it intended to lodge its defence to revocation, which included the application to amend the patent and the counterclaim for infringement. It also tried to lodge each of these documents in its dedicated workflow on the CMS, as required.
8. The respondent points out that the first two documents were regularly lodged, but that, due to technical issues with the CMS, the dedicated workflow for filing the counterclaim for infringement was not available to its representatives filing the document.
9. The respondent adds that, given these circumstances and the imminent expiring of the deadline, its representatives immediately proceeded to lodge the counterclaim for infringement (and accompanying exhibits) on the CMS in due time by way of an application under Rule 9 'RoP', which was registered as No. App_42122/2024, and that, in addition to this, emailed the official email address of the Court explaining the technical issues that they experienced, enclosing all the documents to which the email referred and requesting guidance as to any appropriate steps which may have needed to have been taken in order for the counterclaim for infringement and accompanying exhibits to be moved to the correct workflow.
10. The respondent finally alleges that its representatives were able to lodge the counterclaim for infringement, in the original version, in the proper workflow only on 23 July 2024.
11. The judge-rapporteur finds that the evidence presented in the proceedings provides sufficient support for the respondent's version of the facts and considers that, regardless of whether the written submissions filed in the wrong workflow are admissible or not, the situation at hand prompts the Court to extend the time period referred to by Rule 49 'RoP' for the filing of the counterclaim for infringement to 23 July 2024, pursuant to Rule 9 (3) (a) 'RoP', according to the auxiliary request filed by the respondent.
12. This judge-rapporteur is of the opinion that the power to extend the time limit should be used with caution and in justified exceptional cases (see LD Dusseldorf, order of 20 April 2024, UPC_CFI_355/2023; CD Paris, order of 20 February 2024, UPC_CFI_454/2023). In particular, a time extension is appropriate when a party alleges and gives evidence that it will not or was not able to meet it because of a fact that makes the submission of a document or the arrangement of an adequate content of a pleading in the due time objectively impossible or very difficult.
13. Such an exceptional case is given here.
14. Indeed, the evidence show that the respondent was not able to submit the written pleading in the proper CMS workflow due to circumstances that were beyond its reasonable control as the technical difficulties that its representatives experienced do not seem to be attributable to an operator error but rather to a malfunction of the CMS.
15. It also may be noted that the respondent's representatives acted in accordance with the principle of fair trial as they responded promptly to the technical issues lodging the document in a new workflow, specifically opened under the proper proceedings, and informing the competent Court of the issues in the same day.

16. The applicant argues that it did not receive any notification from the Registry of the Court of the filing of the counterclaim in a different workflow and that the respondent did not answer to its official email asking whether such counterclaim had indeed been filed.
17. The applicant claims that the respondent's behaviour was not fair and equitable and that the drafting of the current application drew time and energy from its legal team that could have been devoted to the preparation of its defence to the counterclaim for infringement and that the Court should take this into consideration when assessing the proportion of costs to be borne by both parties at the outcome of the revocation claim
18. In replying to these arguments, this judge-rapporteur notes that granting the requested time extension will not be detrimental to the applicant's right to defence as it will not affect the time period that he is allowed to file its defence to the counterclaim. Indeed, the starting period for lodging such a document will start from the date in which the counterclaim has been served upon the applicant.
19. The Court will consider while deliberating on the costs of the proceedings if and to what extent the respondent's behaviour has an impact on it.

Leave to appeal.

20. The judge-rapporteur decides not to grant leave to appeal because there is no concrete need for a ruling on the meaning of the relevant rules, as a consistent interpretation of them has been already formed.

ORDER

The judge-rapporteur:

- rejects the request filed by Meril Life Sciences Private Ltd., Meril GmbH and Meril Italy S.r.l. on 5 August 2024;
- extends retrospectively the time period referred to by Rule 49 'RoP' for lodging the counterclaim infringement to 23 July 2024;
- refuses to grant leave to appeal.

Issued on 17 September 2024.

The presiding judge and judge-rapporteur

Paolo Catalozzi

ORDER DETAILS

Order no. ORD_45922/2024 in ACTION NUMBER: ACT_22275/2024

UPC number: UPC_CFI_189/2024

Action type: Revocation Action

Related proceeding no. Application No.: 45333/2024

Application Type: Generic procedural Application