



**Munich Local Division**  
**UPC\_CFI\_114/2024**  
**UPC\_CFI\_448/2024**

**Procedural order**  
**of the Court of First Instance of the Unified Patent Court local division Munich**  
**issued on 2 December 2024**

PLAINTIFFS

- 1) Heraeus Electronics GmbH & Co. KG**
- 2) Heraeus Precious Metals GmbH & Co. KG**

represented by: Paul Szynka (CBH)

DEFENDANT

**Vibrantz GmbH**

represented by: Christian Paul (Jones Day)

PATENT IN SUIT

European Patent No. 3 215 288

PANEL/CHAMBER

Panel 1 of the Munich local division

PARTICIPATING JUDGES

This order was made by presiding judge Dr Matthias Zigann as judge-rapporteur, legally qualified judges Brinkman and Pichlmaier and technically qualified judge Ashley.

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LANGUAGE OF THE PROCEEDINGS

German

OBJECT

- Application for review by the panel pursuant to Rule 333 PANEL (APP\_55548/2024) concerning the refusal of leave to amend the action - extension to include indirect infringement of a procedural claim - pursuant to Rule. 263 RoP (App\_33728/2024).
- Application for leave to amend the action pursuant to Rule 263 RoP - Extension of the action to include claims relating to Romania (App\_53768/2024)
- Application for leave to amend the action pursuant to Rule 263 RoP - Extension of the counterclaim to include Romania (App\_54229/2024)
- Application to replace the defendant by the applicant in the revocation proceedings CC\_43919/2024 pursuant to R. 25.1, 42.2, 305.1 (c) RoP (App\_54645/2024)
- various applications by the applicant (App\_48806/2024).

FACTS OF THE CASE

Plaintiff 1 is suing the defendants for alleged infringement of EP 3 215 288 relating to a metal sintering preparation in Germany, Italy and France (ACT\_13227/2024 UPC\_CFI\_114/2024). The defendants defend themselves, inter alia, with a right of prior use. In the revocation counterclaim (CC\_43919/2024 UPC\_CFI\_448/2024) directed against the second plaintiff as the still registered patent proprietor, it also asserts an obvious prior use on the basis of the right of prior use. For simplification purposes, the counter-defendant is currently listed as plaintiff no. 2.

The applicants' application for leave to extend the action pursuant to Rule 263 RoP to include claims for indirect infringement of procedural claim 5 (DE) and 6 (FR and IT) of 5 June 2024 was rejected by order of the judge-rapporteur of 25 September 2024 (ORD\_36668/2024). The judge-rapporteur stated that claims for infringement of claims 5 and 6 could already have been asserted in the action. On 10 October 2024, the plaintiffs filed an application for review by the panel in accordance with Rule 333 PANEL in due time.

With effect from 1 September 2024, the Republic of Romania acceded to the Agreement on a Unified Patent Court.

By application dated 27 September 2024, the plaintiffs requested that the extension of the action to include claims for patent infringement in Romania be admitted. This included claims for contributory infringement of claim 6. The defendant opposed this, but requested a response period of three months in the event of admission. It argued that the right of prior use under Art. 28 UPCA was governed by national law, in this case Romanian law, and that the defendant needed this period to prepare its defence based on this, among other things.

By application dated 1 October 2024, the defendant requested that the counterclaim be extended to include Romania.

The interim hearing is currently scheduled for 3 April 2024 and the oral hearing for 1. July 2024 is scheduled.

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The judge-rapporteur submitted the following proposal to the parties on 15 November 2024:

*The opposing party must be granted a hearing in accordance with Rule 333.2 third sentence RoP.*

*After consultation with the panel, it should be pointed out in advance that the respective applications to extend the action due to Romania's accession may have to be granted because both parties agree on the merits with regard to their respective actions and requests (Art. 43, 76 (1) UPCA). Insofar as the application to extend the action due to Romania's accession is granted, the indirect infringement of procedural claim 6 is also the subject matter of the dispute.*

*For reasons of procedural economy and fairness, and in an effort to avoid divergent decisions through a further action still to be filed for claims for indirect infringement of the procedural claim in Germany, France and Italy, it may be necessary to revise the order of 25 September 2024.*

*As a consequence, each party would prevail with its applications. The value in dispute of the claim and the counterclaim would each have to be increased to € 1.25 million. In this respect, the defendant has not submitted any better figures for the amendment to the claim. The defendant has not submitted any figures at all for the counterclaim amendment. The defendant should be granted a time limit for the defence in relation to Romania. The PANEL considers a time limit of 2 months from the date of admission of the amendment to be sufficient.*

*The PANEL suggests that the parties agree to this proposed handling.*

The plaintiffs agree with the procedure suggested in this procedural order of 15/11/2024. In addition, they point out that in its order of 21 September 2024 (UPC CoA 456/2024 APL 44633/2024 - OrthoApnea), the Court of Appeal adopted a narrow understanding of an amendment to an action within the meaning of R. 263 RoP:

*"Not every new argument constitutes an 'amendment of case' requiring a party to apply for leave under R. 263 RoP. An amendment of case occurs when the nature or scope of the dispute changes. For example, in an infringement case, this occurs if the plaintiff invokes a different patent or objects to a different product."*

The defendant states that it has no objection to the Board's proposed handling of the two extensions of the action to Romania. However, it continues to consider the requested response period of three months to be appropriate. This should ensure adequate preparation of the statement. On the other hand, it considers a revision of the decision of 25 September 2024 regarding the extension to the procedural claim to be inadmissible.

Under App\_48806/2024, the plaintiffs also filed applications relating to their standing to bring the counterclaim.

By order of 25 September 2024, the judge-rapporteur ordered in App\_48806/2024:

*1. It is clarified that the time limits for the defence to the statement of defence and the counterclaim only begin to run when the plaintiffs and their legal representatives have received unredacted versions of the statement of defence and the counterclaim.*

*2. The defendant may comment on the document dated 27 August 2024 within 10 days.*

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In a further order dated 25 September 2024 (ORD\_53396/2024 in APP\_48805/2024), the judge-rapporteur stated, in the context of an objection to the counterclaim by claimant 2, that

- *R. 25.1 RoP is to be understood as meaning that the action for annulment may also be brought against  
could be directed to the "R. 8.6 holder" (the counter-defendant);*
- *R. 25.1 RoP should also be understood as a reference to R. 42.2 RoP.*

Under App\_54645/2024, the plaintiffs then filed an application under Rule 305.1 (C) RoP in relation to the counterclaim. The defendant did not comment further on this application despite the opportunity to do so.

The judge-rapporteur referred all the applications dealt with here to the panel for a joint decision.

#### APPLICATIONS BY THE PARTIES

##### **The applicants apply in APP\_5548/2024:**

*Pursuant to R. 333.1 RoP, we request the review of the order (ORD\_36668/2024) of 25 September 2024 by the panel to the extent of the rejection of the application under II.2 (indirect violation of the procedural claim) and the subsequent claims relating thereto.*

**With regard to the applications of the plaintiffs in App\_33728/2024, reference is made to the order dated 25 September 2024 (ORD\_36668/2024) is referred to.**

##### **The defendant requests in App\_54229/2024:**

*we request, pursuant to R. 263 RoP, that the extension of the counterclaim for a declaration of invalidity to include the Romanian part of the patent in suit be admitted as follows: (amendments emphasised):*

1. *The European patent EP 3 215 288 is declared invalid in the territory of the Federal Republic of Germany (DE), the French Republic (FR), the Italian Republic (IT) and the Republic of Romania (RO).*
2. *Orders the defendant to pay the costs of the counterclaim.*

##### **The applicants apply under App\_48806/2024:**

1. *Pursuant to R. 9.1 RoP, we request that the court grant the parties a fair hearing on their right to be heard pursuant to R. 361 RoP and suggest that the counterclaim pursuant to R. 361 RoP be dismissed.*

*R. 361, 363 RoP as manifestly futile.*

2. *As a precautionary measure, we raise an objection pursuant to R. 48, 19.1 (b) RoP, contesting the jurisdiction of the Munich local division and request that the counterclaim be dismissed as inadmissible.*

3. *Furthermore, we request and apply pursuant to R. 9.1 RoP for the issuance of a procedural order clarifying that the time limits set by the Rules of Procedure for the service of the counterclaim (in particular R. 29 (a) RoP) shall run concurrently with the service of the counterclaim.*

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*The time limit for the defence to the statement of defence only begins to run upon service of an unredacted version of the counterclaim together with the annexes*

**The defendant applies under App\_48806/2024:**

*The defendants' applications pursuant to Rules 9.1, 361, 363, 48, 19.1 of 27 August 2024 are dismissed.*

**The applicants apply under App\_54645/2024**

on behalf of the defendant and the plaintiff, we request that the plaintiff be substituted for the defendant in the action for annulment CC\_43919/2024 pursuant to R. 25.1, 42.2, 305.1 (c) RoP.

**The defendant does not file an application under App\_54645/2024.**

REASONS

Addition of claim and counterclaim due to Romania

The two extensions of the claim must be allowed because both parties request that the question of infringement and validity concerning Romania also be heard and decided. In this respect, the defendant has requested the authorisation of an unconditional extension of the counterclaim. Consequently, the defendant has expressed the wish that the question of the validity of the Romanian part of the European patent should be negotiated independently of whether the permission requested by the plaintiff to extend the action concerning Romania is granted. Therefore, both parties are essentially arguing the same thing. Romania should subsequently become the subject of the action and the counterclaim. Consequently, permission should be granted.

Extension of the action to include a procedural claim

In its order of 21 September 2024 (UPC CoA 456/2024 APL 44633/2024 - OrthoApnea), the Court of Appeal adopted a narrower understanding of the existence of an amendment to the claim.

within the meaning of R. 263 RoP than the judge-rapporteur's order was based on:

"Not every new argument constitutes an 'amendment of case' requiring a party to apply for leave under Rule 263 RoP. An amendment of case occurs when the nature or scope of the dispute changes. For example, in an infringement case, this occurs if the plaintiff invokes a different patent or objects to a different product."

Accordingly, the supplementary reference to the procedural claim does not constitute an amendment of the action within the meaning of Rule 263 RoP. This is because, following the example of the Court of Appeal, no further patent is asserted. The allegation of infringement relating to the same product is merely supported by a further patent claim. Accordingly, only Rule 13 in conjunction with point 7 a.E. of the preamble and Rule 9.2 RoP are to be examined.

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This examination shows that, for the reasons of procedural economy set out above, the subsequent extension of the action to include claims for infringement of the procedural claim is not objectionable. Permission is not required. The plaintiffs' application pursuant to Rule 263 RoP of 5 June 2024 must therefore be dismissed in all other respects. The judge-rapporteur's order of 25 September 2024 (App\_33728/2024) must be set aside.

#### Correction of the active rubric

Pursuant to R. 25.1, 42.2, 305.1 (c) RoP, the counter-defendant in the action for annulment (plaintiff 2) CC\_43919/2024 is to be replaced by the plaintiff (1). As the defendant has not raised any objections to this, reference can be made to the grounds of the application.

The plaintiffs' precautionary objection is therefore unfounded and must be rejected.

#### Increase in the amount in dispute

The value in dispute of the claim and the counterclaim is increased to € 1.25 million each. In the absence of any other indications, the Chamber will use the plaintiff's estimate as a basis. The additional court costs are to be paid within 10 working days.

#### ORDER

1. The judge-rapporteur's order of 25 September 2024 (App\_33728/2024) is set aside. The subsequent extension of the action to include claims for breach of procedural due process is not objected to. In all other respects, the plaintiffs' application pursuant to Rule 263 RoP of 5 June 2024 is dismissed.
2. The plaintiffs' application pursuant to Rule 263 RoP of 27 September 2024 (App\_53768/2024) is granted.
3. The defendant's and counterclaimant's application under Rule 263 of 1 October 2024 (App\_54229/2024) is granted.
4. The further pleading regime is organised as follows - uniformly for the action and counterclaim/amendment of the patent:  
Plaintiffs 14 January 2025 and 14 April 2025  
Defendant 14 March 2025 and 14 May 2025  
The plaintiffs may comment on the extension of the counterclaim to Romania in the document dated 14 January 2025. The defendant may comment on the extension of the claim to Romania and the extension of claim 5 in the document dated 14 March 2025. The plaintiffs may also comment on the defence to the extension of the claim in the document dated 14 April 2025.
5. In all other respects, the applications of the parties are rejected.
6. The written procedure will be closed on 14 May 2025.
7. The date for the interim hearing is postponed to 23 May 2025, 10.00 a.m., by video conference.
8. The main date of 1 July 2025 in presence remains.
9. The value in dispute of the claim and the counterclaim is increased to € 1.25 million each. The additional court costs must be paid within 10 working days.
10. The appeal is authorised.

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INFORMATION ON THE APPEAL IF IT IS AN ORDER UNDER ART. 73(2)(B) UPCA:

This order can be appealed against either

- an appeal against the final decision of the Court of First Instance on the substance of the case may be lodged by any party who has been unsuccessful in whole or in part in its applications, or
- after the Court of First Instance has granted leave to appeal, an appeal may be lodged within 15 days of service of the decision by any party whose applications have been unsuccessful in whole or in part (Art. 73(2)(b) UPCA, R. 220.2, 224.1 (b) RoP)

DETAILS OF THE ORDER

Order no. ORD\_61305/2024 in ACTION NUMBER: ACT\_13227/2024  
UPC number: UPC\_CFI\_114/2024  
Action type: Infringement Action  
Related proceeding no. Application No.: 55548/2024  
Application Type: APPLICATION\_ROP\_333

Order no. ORD\_54024/2024 in PROCEDURE NUMBER: ACT\_13227/2024  
UPC number: UPC\_CFI\_114/2024  
Nature of the action: Action for infringement  
No. of the associated procedure Application no.: 53768/2024  
Type of application: Application for leave to amend or extend the claim (Rule 263 of the Rules of Procedure)

Order no. ORD\_54346/2024 in PROCEDURE NUMBER: ACT\_13227/2024  
UPC number: UPC\_CFI\_448/2024  
Nature of the action: Action for infringement  
No. of the associated procedure Application no.: 54229/2024  
Type of application: Application for leave to amend or extend the claim (Rule 263 of the Rules of Procedure)

Order no. ORD\_55044/2024 in PROCEDURE NUMBER: ACT\_13227/2024  
UPC number: UPC\_CFI\_448/2024  
Nature of the action: Action for infringement  
No. of the related proceedings Application No.:  
54645/2024 Type of application:  
Application for change of party

Order no. ORD\_53066/2024 in PROCEDURE NUMBER: ACT\_13227/2024  
UPC number: UPC\_CFI\_448/2024  
Nature of the action: Action for infringement  
No. of the related procedure Application No.:  
48806/2024 Type of application:  
Template for procedural application

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Signed in Munich on 2 December 2024

<p>Dr Zigann Presiding judge and judge-rapporteur</p>	<p>Matthias ZIGANN  Digitally signed by Matthias ZIGANN Date: 2024.12.02 14:16:29 +01'00'</p>
<p>Brinkman Legally qualified judge</p>	<p>Edger Frank Brinkman  Digitally signed by Edger Frank BRINKMAN Date: 2024.12.03 16:03:05 -03'00'</p>
<p>Pichlmaier Legally qualified judge</p>	<p>Tobias Günther Pichlmaier  Digitally signed by Tobias Günther Pichlmaier Date: 2024.12.02 14:30:18 +01'00'</p>
<p>Ashley Technically qualified judge</p>	<p>Graham William Ashley  Digitally signed by Graham William Ashley Date: 2024.12.03 08:25:26 +01'00'</p>