

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 19 December 2024
on submission of new evidence in the appeal proceedings (R.222.2 RoP)

HEADNOTES:

- A party has submitted new evidence in the appeal proceedings. In view of the fact that the party had submitted other pages from the same publication in the proceedings before the Court of First Instance, the Court of Appeal considers that the party has not justified that additional pages from the same publication could not reasonably have been made during the proceedings before the Court of First Instance. The evidence will thus be disregarded by the Court of Appeal.
- Evidence relating to a possible new version of a contested embodiment, following statements made by the alleged infringer that a product ingredient has been changed, will be regarded in view of explanations on when and why samples of the product were purchased and analysed.

KEYWORDS:

- New evidence, R.222.2 RoP

APPELLANT (AND RESPONDENT BEFORE THE COURT OF FIRST INSTANCE)

- 1. Sumi Agro Limited**
- 2. Sumi Agro Europe Limited**

1–2 both UK registered companies with registered branch offices in Allershausen, Germany
(hereinafter jointly ‘Sumi Agro’)

1–2 represented by: Gareth Williams, European Patent Attorney (Marks & Clerk LLP, London, UK),
Johannes Heselberger, Rechtsanwalt, Dr. Axel B. Berger, Patentanwalt, Dr. Kerstin Galler, Rechtsanwältin
and Dr. Markus Ackermann, European Patent Attorney (Bardehle Pagenberg, Munich, Germany)

RESPONDENT (AND APPLICANT BEFORE THE COURT OF FIRST INSTANCE)

Syngenta Limited, Bracknell, Berkshire, UK
(hereinafter ‘Syngenta’)

represented by: Dr. Jörn Peters, Benjamin Grzimek and Aylin Cremers, Rechtsanwälte
(Fieldfisher, Düsseldorf, Germany), Prof. Dr. Aloys Hüttermann, Patentanwalt

(Michalski, Hüttermann & Partner, Düsseldorf, Germany), Dr. Filip Alois J. De Corte,
and Dr. Christopher Andrews, Patentanwälte (Syngenta Crop Protection AG, Basel, Switzerland)

PATENT AT ISSUE

EP 2 152 073

PANEL AND DECIDING JUDGES

This order has been adopted by the second panel consisting of
Rian Kalden, Presiding judge and legally qualified judge
Ingeborg Simonsson, legally qualified judge and judge-rapporteur
Patricia Rombach, legally qualified judge
Arwed Burrichter, technically qualified judge
Anna Hedberg, technically qualified judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

Local Division Munich, 27 August 2024, ACT_23636/2024, UPC_CFI_201/2023

SUMMARY OF FACTS AND INDICATION OF THE PARTIES' REQUESTS

1. With the appeal, Sumi Agro is challenging the impugned order whereby the Local Division ordered provisional measures against Sumi Agro.
2. Sumi Agro has submitted new facts and evidence in the appeal proceedings (Statement of appeal, paras 32–35 and Exhibit SA17).
3. Syngenta requests that Exhibit SA17 is not admitted into the proceedings. Should Exhibit SA17 be admitted into the proceedings, Syngenta requests to also admit Exhibits FF28 and FF29 into the proceedings. Syngenta has, for its own part, submitted new facts and evidence (Exhibits FF24–29).
4. Sumi Agro objects to the admission of new facts and evidence concerning the alleged infringement by Kagura 2024. On the condition that paragraphs 32 – 35 and Exhibit SA17 from Sumi Agro's Statement of appeal, all related to validity, are admitted to the proceedings, Sumi Agro does not object to the admission of Syngenta's new facts and evidence related to validity, namely concerning the FFA content of rapeseed oil.

SUBMISSIONS OF THE PARTIES

Syngenta argues – in essence – as follows.

1. Sumi Agro has submitted Exhibit SA17 to support its reasoning that the subject matter of claim 1 of the patent at issue cannot be found novel over the cited prior art, or at least, in view thereof, is not based on an inventive step.
2. Exhibit SA17 is an excerpt from the book "Baileys Industrial Oil and Fat Products 2005". A different section of this book was already filed by Sumi Agro as Exhibit SA15 in their written pleadings of 1 July 2024. Thus, Sumi Agro were well aware of the book already in the first instance and it can be strongly

assumed that they could and should have filed this excerpt already with said pleadings if it is of interest to support their case.

3. On Exhibits FF24-27, those are
 - an invoice showing a purchase of the contested embodiment Kagura on July 4, 2024 (Exhibit FF24)
 - a local notary report about the state of the sample (Exhibit FF25)
 - a lab report dated September 9, 2024 and related affidavit (Exhibits FF26 and FF27).
4. These new submissions could not reasonably have been made during the first instance proceedings because until June 4, 2024, Syngenta had no reason to believe that there could be a different version of Sumi Agro's product in the market.
5. Syngenta has submitted Exhibits FF28-29 as counter evidence in case Sumi Agro would be allowed to bring Exhibit SA17. Exhibits FF28-29 are
 - the publication of Mag et al "Further Processing of Canola and Rapeseed Oil", Exhibit FF28, and
 - a scientific study of the EU (EFSA Journal 2016;14(11):4593), Exhibit FF29
6. Syngenta argues that the filing of Exhibit FF28 cannot be too late if Exhibit SA17 is accepted. Also it should be pointed out that Exhibit FF28 is actually cited in Exhibit SA17 itself.

Sumi Agro argues – in essence – as follows.

7. On Exhibits FF24-27, Sumi Agro argues that Syngenta should have acted urgently and without any delay to obtain a sample of Kagura 2024, i.e. a sample of the actual Kagura product sold in the UPC territory. Syngenta has not explained what steps it took either before or since 18 March 2024 to obtain and analyse product offered in the UPC and why it was unable to obtain and analyse such product until after conclusion of the proceedings before the Munich Local Division. Sumi Agro reminds that it offered to provide Syngenta with a Kagura product sample for analysis during pre-action discussions in January 2024. Syngenta has not explained why it did not or could not purchase the sample, ship it to the US and carry out an analysis immediately after 18 March 2024.
8. Moreover, according to Sumi Agro, Syngenta is not adding facts to the first instance case but tries to add a new case, because Kagura 2024 forms a new subject matter. Syngenta commenced and pursued its PI application on the basis of Kagura 2023, a product purchased outside the UPC territory in the Czech Republic in June 2023. The preliminary injunction was granted on the basis of the Munich Local Division's assessment of the facts and evidence relied upon by Syngenta with respect to its analysis of Kagura 2023. The Munich Local Division expressly defined Kagura 2023 to be the (only) "subject matter of the dispute". The impugned order makes no observations with regard to Kagura 2024 purchased in the UPC territory. Syngenta cannot rely on a general belief that products with the same generic name – "Kagura" – are identical in their characteristics in countries outside and inside the territory of UPC patent protection.
9. Sumi Agro takes the position that whether Kagura 2024 infringes the patent is not the subject of the decision under appeal. Including Kagura 2024 now would mean a change of claim pursuant to R.263 RoP after the end of proceedings at first instance. Introducing a new case of infringement in respect of a different product at the appeal stage will prejudice Sumi Agro by restricting its right to be heard and it

will hinder Sumi Agro in the conduct of its action (R.263.2(b) RoP). Syngenta will not be prejudiced if the Court disregards the new facts and evidence because the question of whether Kagura 2024 infringes will be resolved by the Munich Local Division in Syngenta's main infringement claim.

REASONS

Applicable rule

10. Pursuant to R.222.2 RoP, requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal. When exercising discretion, the Court shall in particular take into account (a) whether a party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First Instance; (b) the relevance of the new submissions for the decision on the appeal; and (c) the position of the other party regarding the lodging of the new submissions.

Sumi Agro's submission of Exhibit SA17 (excerpt from Baileys Industrial Oil and Fat Products 2005)

11. In view of the fact that Sumi Agro submitted other pages from the same publication in the proceedings before the Court of First Instance, the Court of Appeal considers that Sumi Agro has not justified that Exhibit SA17 could not reasonably have been made during those proceedings. The Court of Appeal decides to disregard the content of Exhibit SA17.

Syngenta's submission of Exhibits FF28-29

12. Syngenta's submission of Exhibits FF28-29 is conditioned, as it is brought in case the Court of Appeal would allow Sumi Agro to bring Exhibit SA17 as new evidence. In view of this, the Court of Appeal decides to disregard Exhibits FF28-29.

Syngenta's submission of Exhibits FF24-27

13. When considering Exhibits FF24-27, which relate to purchase and analysis of what might be Kagura 2024, the Court of Appeal makes the following initial observations. Syngenta lodged the application for provisional measures on 30 April 2024. Sumi Agro lodged its defence, on 4 June 2024, setting out how it had marketed two versions of Kagura, one outside the UPC territory in Poland and the Czech Republic only (the 2023 Product), and one within and outside the UPC territory in Poland, the Czech Republic, Bulgaria and Germany (the 2024 Product). According to Sumi Agro's statements, the products were made according to the same formulation (recipe) but using different rapeseed oil from two different suppliers. Sumi Agro holds that the 2023 Product is no longer offered anywhere and has been replaced by the 2024 Product.
14. The use of a different ingredient from one point in time for a composition product marketed under one brand and under one set of marketing authorisations, cannot reasonably have been visible to Syngenta.
15. Syngenta states that it purchased a sample of the 2024 Kagura product on July 4, 2024, so one month after the said submissions of Sumi Agro, and that the subsequent analysis was ready after the order of the Local Division was issued. For the purpose of the present assessment, the Court of Appeal will not go into the credibility of the evidence as such, since this would risk pre-judging certain aspects of the case.

As explained, the assessment here is limited to the questions of justification, relevance and the position of the other party.

16. The Court of Appeal considers that Syngenta has justified that the new submissions could not reasonably have been made during the proceedings of the Court of First Instance.
17. The injunction ordered by the Local Division is of a general nature and it is relevant and in the interest of both parties that the evidence relating to the possible existence of two different Kagura products, and their characteristics, be assessed on appeal.
18. The Court of Appeal will consequently not disregard Exhibits FF24-27 and the facts relating thereto. Syngenta is allowed to bring them in the proceedings.

ORDER

1. The Court of Appeal decides to disregard Exhibit SA17, brought in the appeal proceedings by Sumi Agro, and Exhibits FF28-29, brought in the appeal proceedings by Syngenta.
2. Exhibits FF24-27 will be regarded.

Issued on 19 December 2024

Rian Kalden, Presiding judge and legally qualified judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Arwed Burrichter, technically qualified judge

Anna Hedberg, technically qualified judge