



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 26 February 2025

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 to replace with the applicant R. 25.1, 42.2, 305.1 (c) RoP (App_54645/2024) the defendant in the revocation proceedings CC_43919/2024 pursuant to
- Corrigendum to the Order of 2 December 2024 (App_54645/2024)
- Application applicant by the pursuant to Rule 362 RoP in relation to the counterclaim concerning the German part of the European patent 3 215 288

FACTS AND APPLICATIONS

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 action for revocation directed against the second plaintiff as the still registered patent proprietor (CC_43919/2024 UPC_CFI_448/2024), it also asserts an obvious prior use on the basis of the right of prior use.

I. Correction

In the Order (App_54645/2024) of 2 December 2024, the Board stated under the item "Correction of the asset 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.

However, there is no corresponding Order in the operative part. This needs to be corrected. The parties were heard.

Heraeus has executed:

There is no need to comment further on the intended correction of the Order of 2 December 2024 (replacement of the counter-defendants) following the reasons for the Order of 25 September 2024 (legitimacy of the previous counter-defendants).

Vibrantz explained:

The request for substitution dated 7 October 2024 was filed . "on behalf of the defendant and the plaintiff" Pursuant to Rule 42.2 RoP, only the registered proprietor file a request for substitution (English version: "...each such registered proprietor shall as soon as practicable after service of the Statement for revocation apply to Court..."). The application of the - unregistered - plaintiff must therefore be rejected. 2 With regard to the defendant's application for substitution, we merely note that

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the counterclaim revocation counterclaim not until filed two months after service of the , even though the transfer of the patent-in-suit was supposed to have taken place before the infringement action was filed (see Rule 42.2 "as soon as possible"). The decision on the substitution, the binding of the plaintiff joining the counterclaim to the previous state of the proceedings and the costs are left to the discretion of the court.

II. absolute procedural obstacle

In App_2369/2025 Heraeus has applied for:

The court decides by way of an Order that there is an absolute procedural bar to the continuation of the proceedings insofar as they are directed against the German part of EP 3 215 288 due to conflicting res judicata.

Heraeus has the reasons for this:

With regard to the German part of the patent in suit, the nullity counterclaim disregards the conflicting res judicata effect of the preceding national nullity judgement and is therefore inadmissible. In this respect, there is an absolute procedural obstacle to the continuation of the proceedings.

Vibrantz has applied:

The application is rejected.

In this respect, we request as a precautionary measure that the decision of the Federal Patent Court be refused recognition pursuant to Art. 45 (1) (a) Brussels I Regulation for a decision of the court on the maintained part of the patent in suit.

Vibrantz the reasons for this, among other things:

The decision of the Federal Patent Court does not constitute a final decision in the sense of an absolute procedural bar pursuant to R. 362 RoP.

The judge-rapporteur issued guidance on this on 30 January 2025

Heraeus applied for:

In this respect, we request that the counterclaimant's application (SSTZ of 30 January 2025, para. 27) be rejected.

Heraeus has the reasons for this:

The following should be noted in advance with regard to the court's reference: When the court decides on the application in App_2369/2025 is, of course, at the discretion of the court. However, insofar as - a decision in accordance with the application and a corresponding assuming appeal by the counterclaimant - the latter should lead infringement proceedings , to a delay in the due to a uniform hearingthe

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The indicate .defendant did not a decision before the oral hearing

Vibrantz explained:

In addition, a decision on the application pursuant to Rule 362 RoP in the sense of a holistic examination and a possible appeal with subsequent remittal and separation is not from the point of view of the plaintiff for annulment.appropriate

REASONS

Re I:

The Order of 2 December 2024 must corrected in the operative part in accordance with Rule 353 RoP by inserting an Order corresponding to the grounds. This was simply overlooked in December.

Re II:

A decision before the oral hearing would jeopardise the further progress of the proceedings due to Rule 363.2 RoP. This is because clarification by the Court of Appeal is unlikely to be achieved before 1 July 2025, the date of the main hearing. As both parties are ultimately in favour of not jeopardising a unified hearing at the main hearing, the Chamber exercises its discretion to decide on the application only after the main hearing.

ORDER

- I. The operative part of the Order of 2 December 2024 (App_54645/2024) is amended as follows: "10. The counter-defendant in the revocation counterclaim proceedings (plaintiff 2) CC_43919/2024 is to be replaced ." by the plaintiff (1)The previous paragraph 10 becomes paragraph 11 and reads as follows: "The appeal is allowed."
- II. The Board will decide on the application pursuant to Rule 362 RoP (App_2369/2025) following the main hearing.

INFORMATION ABOUT THE APPEAL, IF IT AN ORDER UNDER ART. 73 (2) (B) :ISUPCA

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

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INSTRUCTIONS TO THE LAW FIRM

The Order of 2 December 2024 (App_54645/2024) is to be corrected. The counter-defendant in the revocation counterclaim proceedings (applicant 2) CC_43919/2024 is to be replaced by the applicant (1). accordingly.

ORDER DETAILS

Order No. ORD_9486/2025 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.: 54645/2024

Type of application: Application for change of party

Order no. ORD_2567/2025 in ACTION NUMBER: ACT_13227/2024

UPC number: UPC_CFI_448/2024

Action type: Infringement Action

Related proceeding no. Application no.: 2369/2025

Application Type: Application to bar an action proceeding (RoP362)

Signed in Munich on 26 February 2025

Dr Zigann Presiding judge and judge-rapporteur	
Brinkman Legally qualified judge	
Pichlmaier Legally qualified judge	
Ashley Technically qualified judge	