



Central Division
Paris Seat

ORDER
of the Court of First Instance of the Unified Patent Court
Central division (Paris seat)
issued on 31 March 2025
concerning the generic procedural applications Nos. App_3752/2025
and 3753/2025
UPC_CFI_412/2023

HEADNOTES: 1. The circumstances contemplated by Rule 356 'RoP' (clerical mistakes, errors in calculation, obvious slips) all consist of a discrepancy between the judge's intended decision and its material representation, provided that this can be deduced from a comparison between the part affected by the error and the considerations contained in the reasoning. These kinds of errors are the ones that do not concern the identification and evaluation of the relevant elements of the case and the subsequent formation of the judgment, but rather the external expression of the judgment itself.

2. The application to set aside the decision by default constitutes an internal procedural remedy and, as such, is not suitable for giving rise to a decision on the merits and, therefore, does not require a decision on the obligation to bear the associated costs. Consequently, the costs incurred by the successful party in this step can be claimed and assessed within the proceedings for a cost decision related to the main proceedings which concluded with the decision by default.

KEYWORDS: rectification of decisions and orders; decision by default; procedure for cost decision.

APPLICANT:

Bayerische Motoren Werke Aktiengesellschaft - Petuelring 130, 80809 München, Germany
represented by Johannes Lang, Bardehle Pagenberg Partnerschaft mbB

RESPONDENT:

ITCiCo Spain S.L. - C/Pau Piferrer 17, 07011, Palma de Mallorca, Spain
represented by Robin Hayes, Whitney Moore LLP

PATENT AT ISSUE:

European patent n° EP 2 796 333

PANEL:

Panel 2:

Paolo Catallozzi

Presiding judge and judge-rapporteur

Tatyana Zhilova

Legally qualified judge

Dörte Otten-Dünnweber

Technically qualified judge

DECIDING JUDGE:

This order has been issued by the panel.

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 24 January 2025 the applicant filed an application requesting to rectify the order of 9 January 2025 (no. ORD_58414/2024) to supplement it by ordering that the defendant also bears the costs of the proceedings for the application to set aside the Court's decision by default. In the alternative, the applicant requested the Court to order by way of separate order that the defendant also bears the costs of the proceedings for the application to set aside the Court's decision by default and, in the further alternative, to confirm by way of separate order that the decision in principle on the obligation to bear the legal costs of the Court's decision by default extends also to the costs of the proceedings for the application to set aside that decision.
2. Despite a request to do so, the respondent did not file any written comment.

GROUND FOR THE ORDER

Rectification of decisions and order and lack of assessment of the obligation to bear costs of the proceedings.

3. On 16 September 2024 this panel issued a decision by default (no. ORD_51965/2024) upon the request of the applicant in the revocation action concerning the patent at issue, registered as No. ACT_585518/2023 UPC_CFI_412/2023, and revoked the patent in its entirety with regard to the territories of the Contracting Member States for which it had effect at the date of the filing of the revocation action. Hence, the panel ordered that the costs of the proceedings shall be borne by the defendant.
4. The respondent filed an application pursuant to Rule 356 of the Rules of Procedure ('RoP') requesting the Court to set aside the decision by default. This application was dismissed by order

issued by the panel on 9 January 2025 (no. ORD_58414/2024), which contains no provision regarding the obligation to bear the legal costs associated with the examined application.

5. The applicant argues that the absence of the decision in principle on the obligation to bear the legal costs “seems to be an obvious slip in the order” as Article 69 (1) of the Unified Patent Court Agreement provides that the unsuccessful party is ordered to bear the legal costs and the corresponding request was filed by the party.
6. Pursuant to Rule 353 ‘RoP’ the Court may, by way of order, rectify clerical mistakes, errors in calculation and obvious slips in the decision or order. According to this panel the circumstances contemplated by Rule 353 ‘RoP’ (clerical mistakes, errors in calculation, obvious slips) all consist of a discrepancy between the judge’s intended decision and its material representation and this discrepancy must be deduced from a comparison between the part affected by the error and the considerations contained in the reasoning, from which it can be inferred that the error is due to an oversight or a lack of attention.
7. These kinds of errors are the ones that do not concern the identification and evaluation of the relevant elements of the case and the subsequent formation of the judgment, but rather the external expression of the judgment itself. As such, they can be rectified through an administrative-type intervention that restores the correspondence between what the judgment intended to declare and what it formally declared.
8. It follows that an error subject to rectification is solely that consisting of a mere oversight by the judge which has resulted in the non-expression or inaccurate expression of a judgment that was, however, already formed and can be inferred from the context of the ruling. Errors that constitute the expression of a lacking or at least deficient judgment do not fall into this category.
9. Hence, errors which occur when the obligation to bear legal costs is not addressed in the operative part of the decision cannot be considered as clerical errors – and as such, rectifiable pursuant to Rule 353 ‘RoP’ – where no useful elements for its assessment can be gleaned even from the reasoning.
10. Indeed, the rectification of decisions or order is possible only in cases where there is no logical inconsistency between the reasoning and the operative part of the decision and not where an interpretative activity of the actual decision would be necessary.

Application to set aside a decision by default and costs of the proceedings.

11. It may be added that in the Unified Patent Court's procedural system, the cost allocation occurs upon the decision on the merits and, if applicable, a decision for the determination of damages, which identifies the party or the parties liable for such costs [see Rule 118 (5) ‘RoP’]. For these purposes, a “decision on the merits” must be understood as a decision that concludes litigation proceedings, that is proceedings where the ascertainment of a right is sought by one party against another and is capable of producing the effects of res judicata on conflicting subjective positions and from which a situation of the defeat of one party with respect to another may arise, justifying the award of costs (see Paris CD, order issued on 8 January 2025, UPC_CFI_189/2024).

12. Rule 356 (1) 'RoP' allows the defaulting party to lodge an application to set aside the decision by default. This application constitutes an internal procedural remedy – also referred to as an objection by Article 37 of the Statute of the Unified Patent Court – available to the party against whom a decision by default has been issued, allowing them to prevent it from becoming final and concluding the proceedings at first instance. This is achieved by asserting the reasons justifying the failure and, consequently, demonstrating the absence of the prerequisites for the decision by default.
13. As an internal proceeding of the main proceedings, it is not suitable for giving rise to a decision on the merits and, as such, does not require a decision on the obligation to bear the associated costs. The fact that this phase occurs after the issuing of a decision on the merits is irrelevant for this purpose, as it does not constitute an autonomous proceeding but rather serves the sole function of stabilizing and rendering final the first-instance decision. It follows that the costs incurred by the successful party in this step can be claimed and assessed within the proceedings for a cost decision related to the main proceedings which concluded with the decision on the merits, namely the decision by default.

ORDER

The panel,

having regard to Rules 150 and 356 'RoP',

rejects the application filed by Bayerische Motoren Werke Aktiengesellschaft on 24 January 2025.

Issued on 31 March 2025.

The Presiding judge and judge-rapporteur

Paolo Catallozzi

The legally qualified judge

Tatyana Zhilova

The technically qualified judge

Dörte Otten-Dünnweber

ORDER DETAILS

Order no. ORD_15677/2025 in ACTION NUMBER: ACT_585518/2023

UPC number: UPC_CFI_412/2023

Action type: Revocation Action

Related proceeding no. Application No.: 3752/2025

Application Type: Generic procedural Application