



Mannheim Local Division
UPC_CFI_745/2024
(CCR: UPC_CFI_200/2025)

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 6 June 2025
concerning EP 4 108 413
concerning App_22065/2025
(R. 263 RoP)

CLAIMANT:

Sunstar Engineering Europe GmbH, Emil-Fischer-Straße 1 - 86641 - Rain am Lech - DE,

represented by: Holger Stratmann

DEFENDANT:

CeraCon GmbH, Talstraße 2 - 97990 - Weikersheim,

represented by: Matthias Sonntag

DEFENDANT in the counterclaim for revocation proceedings:

Sunstar Engineering Inc., 3-1 Asahi-machi, Takatsuki - 569-1134 - Osaka - JP,

represented by: Holger Stratmann

PATENT AT ISSUE:

European patent EP 4 108 413

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order is issued by the legally qualified judge and judge-rapporteur Böttcher.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Infringement action – counterclaim for revocation – R. 263 RoP

BRIEF SUMMARY OF THE FACTS:

The Defendant of the infringement proceedings and Claimant of the counterclaim for revocation proceedings (“Claimant CCR”) seeks leave to amend its counterclaim for revocation by introducing a new novelty attack based on the new prior art document Euro-PCT application PCT/JP2019/051559 (published as WO 2021/131055 and EP 3 868 480 A1, “EP’480”).

The counterclaim for revocation (CCR) was filed on 6 March 2025, the oral hearing in the infringement proceedings and the counterclaim for revocation proceedings is scheduled for 10 February 2026.

Claimant CCR filed its application in question on 8 May 2025 (with the other party being notified on 9 May 2025). The brief of the application already contains the statements on the alleged lack of novelty of the patent-in-suit over EP’480 for which admission is sought.

On 9 May 2025, the Defendant of the counterclaim for revocation proceedings (“Defendant CCR”) filed its defence to the counterclaim together with a conditional application to amend the patent.

Claimant CCR argues that neither the highly relevant EP’480 being prior art in terms of Art. 54 (3) EPC nor any family member thereof was included in the search report (exhibit A1). The search report was prepared by a well-known search service provider specialized in prior art searches who purports to have a high success rate, without the Claimant CCR having any reason to distrust the search report. Claimant CCR points out that EP’480 was only included in a report of 16 April 2025 produced by a supporting patent attorney in the course of a search unrelated to the Counterclaim for revocation at hand, which was commissioned by Claimant CCR end of March 2025. According to Claimant CCR, it became aware of the potential relevance of EP’480 for purposes of the proceedings at hand only by 2 May 2025 based on a review of the document by its UPC representatives carried out after EP’480 was brought to their attention on 23 April 2025. Claimant CCR further points out that – as it was of the belief that EP’480 or any of its family members should have been found in the invalidity search of said search provider – it reanalysed the search strings of the invalidity search (exhibit A1) by using the search strings from said search report for a search with a well-known search software, obtaining EP’480 as fifth hit when using the key-string of search 1 (S1) of the invalidity search report (exhibit A1).

Claimant CCR is of the opinion that the requirements of R. 263 RoP, if applied to counterclaims for revocation at all, should at least be applied generously, thereby arguing that neither the UPCA nor the Rules of Procedure explicitly exclude the introduction of new grounds for invalidity in the Reply to the Defence to a counterclaim for revocation. In particular, a provision similar to R. 29 lit. e RoP is lacking which, in the infringement proceedings, restricts the rejoinder to be limited to a response to the reply to the statement of defence. In the alternative, the requirements set out in R. 263 RoP would be met in the present case. Claimant CCR argues that it acted with reasonable diligence when instructing a specialized prior art search agent, such as the search agent commissioned in the case at hand, with an invalidity search that should have revealed EP’480 (R. 263.2 (a) RoP). In Claimant CCR’s opinion, the amendment in question will not unreasonably hinder Defendant CCR in the conduct of its action (R. 263.2 (b) RoP), taking into account that EP’480 is Defendant CCR’s own patent application, which in addition was filed by the very same representatives representing

the Claimant of the infringement action and the Defendant CCR in the present proceedings. When weighing the parties' interests, principles of fairness and equity (s. Preamble 2 RoP) have to be taken into account, after Claimant in the infringement proceedings at hand decided not to discuss EP'480 in the section of its statement of claim dealing with the technical background and the prior art. The fact that EP'480 is prima facie of highest relevance as well as procedural economy, efficiency and costs (s. Preamble 4 RoP) militate in favour of granting leave to the amendment, avoiding a new, separate revocation action.

The Defendant CCR opposes the request.

For further details, reference is made to the pleadings of the parties.

Claimant CCR requests:

Counterclaim Claimant is granted leave to amend its case to the effect that Counterclaim Claimant is allowed to base its Counterclaim for revocation on an additional ground of invalidity, namely on lack of novelty of the patent-in-suit over Euro-PCT application PCT/JP2019/051559, published as WO 2021/131055 and EP 3 868 480 A1.

Defendant CCR requests:

Counterclaim Claimant's application for leave to change its claim by introducing the new prior art document WO 2021/131055 A1, published also as EP 3 868 480 A1, is dismissed.

As an auxiliary request, in case leave is granted,

The Defendant has two months from the date on which the court order granting the Counterclaim Claimant leave is served on the Defendant to respond to arguments of invalidity based on the new prior art document EP 3 868 480 A1.

REASONS FOR THE ORDER:

The application for leave to amend the counterclaim for revocation is dismissed.

1. Contrary to Claimant CCR, a claimant in a counterclaim for revocation is not free, or at least privileged, to amend its case compared to a claimant in an infringement action. Rather, R. 263 RoP applies in full to a counterclaim for revocation (cf. LD Düsseldorf, decision of 08.05.2025, UPC_CFI_11/2024, paras. 103 et seqq. with further reference).

Nothing to the contrary follows from R. 29 (e) RoP which limits the rejoinder in the infringement proceedings to a response to matters raised in the reply to the statement of defence. The provision does not concern an amendment of the subject matter of an infringement action or a counterclaim for revocation. It cannot therefore be inferred from this provision, by way of a reverse argument, that R. 263 RoP is not fully applicable to an amendment of the counterclaim for revocation. Rather, it follows from R. 25 (1) (b), (c) and (d) RoP that the grounds for revocation must already be asserted in the counterclaim for revocation and that the documents on which the claimant in the

counterclaim for revocation bases its arguments must also be submitted there (cf. LD Düsseldorf, decision of 08.05.2025, UPC_CFI_11/2024, para. 106).

2. It can be left open whether, in the case at hand, negligence attributable to Claimant CCR is involved (R. 263.2 (a) RoP) and whether the amendment will unreasonably hinder Defendant CCR (and, if applicable, the Defendant of the infringement action) in the course of its action. Even if R. 263.2 RoP does not exclude to grant leave in the case at hand, such leave is not granted.

When assessing whether leave pursuant to R. 263 RoP is granted, the conflicting interests of the parties must be weighed up, taking into account all the circumstances of the individual case (cf. LD Mannheim, order of 14.05.2025, UPC_CFI_132/2024).

In any case, granting leave to amend the counterclaim for revocation if a simple search could have revealed a document from the prior art which the claimant of the counterclaim for revocation itself considers highly relevant would amount to allowing practically any document found later and the attack on validity based thereon.

In such a situation, the interests of the defendant in a CCR in not having to defend itself against such an attack for the first time in its rejoinder in the revocation proceedings regularly outweighs the interests of the claimant in a CCR in being able to base its counterclaim of revocation on such an attack. Admittedly, there may be a considerable risk that, as the case may be, the defendant of the infringement proceedings may be found liable on the basis of a patent which, in the light of the newly discovered document, proves to be invalid in separate revocation proceedings, because separate revocation proceedings are likely to be concluded only after the decision on the merits in the infringement proceedings. However, there is also an interest of the defendant in a CCR in not having to defend itself in its rejoinder for the first time against an attack based on a document which could easily have been found at an earlier stage. The defendant in a CCR has a significant interest that the content and scope of the invalidity attacks against the patent as granted do not fundamentally change compared to the counterclaim for revocation as originally filed. It bases its defence strategy, including any application to amend the patent, on that content and scope.

Circumstances that would lead to a different outcome in the case at hand are not apparent.

The general principles Claimant CCR invokes do not require a different outcome. In particular, it is not questionable at all that the Claimant of the infringement action had restricted itself to discussing the background of the patent-in-suit based on its description without mentioning EP'480.

ORDER:

The application for leave to amend the counterclaim for revocation is dismissed.

ORDER DETAILS

Order no. ORD_22156/2025 in ACTION NUMBER: ACT_63395/2024

UPC number: UPC_CFI_200/2025

Action type: Infringement Action

Related proceeding no. Application No.: 22065/2025

Application Type: Application for leave to change claim or amend case/pleading (RoP263)

Issued in Mannheim on 6 June 2025

NAME AND SIGNATURE

Böttcher
Legally qualified judge