



Mannheim Local Division
UPC_CFI_79/2025
(CCR: UPC_CFI_605)

Order
of the Court of First Instance of the Unified Patent Court
issued on 29 July 2025
concerning EP 3 716 655
concerning App_31764/2025
(Application pursuant R. 362, 361 RoP)

CLAIMANT

Malikie Innovations Ltd.

- GH2, 92 Lower George's Street, Dun Laoghaire - A96
VR66 - Co. Dublin - IE

represented by Miriam Kiefer

DEFENDANTS/APPLICANTS

1)

Discord Inc.

- 444 De Haro Street, Suite 200 - CA 94107 -
San Francisco - US

represented by Tobias Wuttke

2)

Discord Netherlands B.V.

- Schiphol Boulevard 195 - 1118BG - Schiphol
- NL

represented by Tobias Wuttke

PATENT AT ISSUE:

European patent 3 716 655

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order is issued by the presiding judge Tochtermann, the legally qualified judge Böttcher as judge-rapporteur and the legally qualified judge Rinkinen.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: infringement action – R. 361, R. 362 RoP

BRIEF SUMMARY OF THE FACTS:

Alongside their statement of defence and their counterclaim for revocation, Defendants filed a request pursuant to R. 361, 362 RoP.

They state that, contrary to its obligations under sec. 25(1) German Patent Act (GPA), Claimant - despite having neither its residence nor its principal place of business nor an establishment in Germany - neither has registered a domestic representative for the German national part of the patent-in-suit with the competent German Patent and Trademark Office (GPTO) nor did Claimant produce a power of attorney that fulfils the requirements of said provision. These deficiencies would result in Claimant not being allowed – inter alia – to assert its rights deriving from the German part of the patent-in-suit.

The translation of Sec. 25 GPA submitted by Defendants reads as follows:

Section 25

(1) Any person who has neither their residence nor principal place of business nor an establishment in Germany may participate in the proceedings before the German Patent and Trade Mark Office or the Federal Patent Court which are regulated under this Act and assert the rights deriving from a patent only if that person has appointed as their representative a lawyer (*Rechtsanwalt*) or patent attorney (*Patentanwalt*) who is entitled and authorised to represent them in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting the patent, as well as to apply for criminal prosecution.

(2) The place where a representative appointed pursuant to subsection (1) has his or her commercial premises is deemed, within the meaning of section 23 of the Code of Civil Procedure (*Zivilprozessordnung*), to be the place where the asset is located; if there are no such commercial premises, the place where the representative is residing in Germany is decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.

(3) The legal termination of the appointment of a representative in accordance with subsection (1) does not become effective until the German Patent and Trade Mark Office or the Federal Patent Court has been informed of both the termination of such appointment and the appointment of another representative.

According to Defendants, the cumulative requirements of entitlement and authorization to represent the foreign patentee before the German Federal Patent Court and in civil litigation ensures that the nullity action brought by an alleged infringer in response to an infringement action can be validly and promptly served on the appointed representative without the need for international administrative assistance, thus preventing delay, which is essential for an alleged infringer's defence on grounds of invalidity.

Defendants argue that Art. 83(1) UPCA explicitly provides the option to choose national nullity proceedings in response to a UPC infringement action. Being applicable in the present case pursuant to Art. 24(1) lit. e), (2) lit. a) UPCA in connection with Art. 8(1) Rome II Regulation (in addition to the fact that the UPC is not to be treated any different than a German court under Art. 71a(1) Brussels I bis Regulation), sec. 25(1) GPA would also safeguard the alleged infringer's right to choose the forum for its invalidity attack on the patent-in-suit under Art. 83(1) UPCA.

If Sec. 25(1) GPA were to be disregarded, this would deprive an alleged infringer of the option to

timely defend himself in German national nullity proceedings and push him towards a counterclaim for revocation before the UPC, which would be against the clear objective of Art. 83(1) UPCA as well as the principle of fair trial under Art. 47 of Charter of Fundamental Rights of the European Union.

Defendants point out that Claimant deliberately and intentionally took the decision not to register a domestic representative with the GPTO and to start the civil litigation at hand without producing a power of attorney meeting the requirements of Sec. 25(1) GPA, thereby referring for the first point to an excerpt from the Official Register of the GPTO containing a communication dated 29 April 2024 (exhibit BP2).

In Defendants' opinion, the aforementioned deficiencies cannot be remedied, taking the front-loaded proceedings before the UPCA and the lack of any excuse into account. Any subsequent submission of Claimant in this regard would have to be rejected as late filed (R. 331.1, 334(f) RoP).

Therefore, Defendants conclude that the infringement action at hand is manifestly bound to fail for Germany within the meaning of R. 361 RoP and that there is an absolute bar to proceeding with this infringement action in relation to the German territory within the meaning of R. 362 RoP.

Defendants request

for a declaration that the infringement action is manifestly bound to fail in relation to the territory for Germany and that there is an absolute bar to proceeding with this infringement action in relation to the German territory.

REASONS FOR THE ORDER:

The application pursuant to R. 361 RoP and the request pursuant to R. 362 RoP are unsuccessful for several independent reasons.

1. Sec. 25 GPA is not applicable to proceedings before the UPC from the outset.

According to established German case law (German Federal Court of Justice (GFCJ), order of 11 February 2009 – Xa ZB 24/07, GRUR 2009, 701 paras. 14 et seq., para. 21 – Niederlegung der Inlandsvertretung; Higher Regional Court Dusseldorf, judgement of 13 August 2015 – 15 U 3/14, BeckRS 2015, 16357 paras. 57 et seq.) and in accordance with Defendants' own views, the provision deals with procedural requirements for participating in proceedings before the GPTO or the German Federal Patent Court (GFPC) governed by the GPA or before the civil courts regarding the assertion of rights arising from patent concerned. In contrast, the provision does not constitute a substantive legal requirement for being entitled to assert claims before a court (cf. Busse/Keukenschrijver, Patentgesetz, 9th edition, § 25 mn. 48, with reference to GFCJ, order of 27 January 2000, GRUR 2000, 895 (concerning sec. 96 German Trademark Act)). The fact that the provision is of procedural significance only is confirmed by the fact that a German patent application filed by a foreign patent applicant without appointing a domestic representative is legally valid, in particular has the usual priority effect, but is not processed by the GPTO unless a domestic representative is appointed subsequently (cf. GFCJ, order of 17 December 1968 – X ZB 7/68, GRUR 1969, 437 (438) – Inlandsvertreter (on the previous provision, Sec. 16 of the old version of the GPA)). Accordingly, a patent infringement action brought before the national German Courts by a foreign patent proprietor who does not finally meet the requirements of Sec. 25(1) GPA is dismissed as inadmissible and not as unfounded (cf. Higher Regional Court Dusseldorf, judgement of 13 August 2015 – 15 U 3/14, BeckRS 2015, 16357 para. 60; Busse/Keukenschrijver, Patentgesetz, 9th edition, § 25 mn. 48; Benkard PatG/Rupp-Swient, 12th edition, PatG § 25 mn. 29).

Being a German national procedural provision, Sec. 25(1) GPA does not apply to proceedings before other courts than national German courts in accordance with the *lex fori* principle of international procedural law. Since, by design, the UPC has its own procedural law which is exhaustive, Sec. 25(1) GPA does not apply to the UPC in particular by virtue of Art. 24(1)(e) UPCA or by virtue of the fact that the UPC is a court common to the UPCA member states including Germany.

2. Moreover, Sec. 25(1) 2nd alternative GPA is not applicable to infringement actions before the UPC in accordance with its meaning and purpose on the instant facts.

As Defendants rightfully point out, the purpose of Sec. 25(1) 2nd alternative GPA is to ensure that an action for nullification, which a defendant who is sued for infringement before a national German Court files with the GFPG, can be easily and quickly served on the patentee without the necessity of a cumbersome service abroad, given the fact that such defendant is not able to attack the validity of the patent-in-suit within the German national infringement proceeding but has to separately file such action for nullification with the GFPC once the patent is finally granted. The quick service reduces the risk of the defendant being found infringing solely because of a delay in the service of his action for nullification. Thus, Sec. 25(1) GPA has to be seen in the context of the bifurcation of infringement proceedings and invalidity proceedings in the national German system. On a regular basis, a comparable situation is not given for the defendant in an infringement proceeding before the UPC, because he can file a counterclaim for revocation with the UPC if he wishes to defend himself by invoking the invalidity of the patent-in-suit.

3. The option provided by Art. 83(1) UPCA during the transition period to still bring an action for revocation of a European patent before national courts or other competent national authorities does not lead to a different result.

Sec. 25(1) 2nd alternative GPA does not serve the purpose to facilitate the service of an action for nullification in order to enable a defendant in an infringement action before the UPC to file an action for nullification with the GFPC instead of filing a counterclaim for revocation with the UPC. As discussed supra, the provision has rather to be seen in the light of the bifurcated German system only. The situation under Art. 83(1) UPCA is not comparable to the situation of the bifurcated German proceedings either.

There is no indication in the UPCA or the RoP either that the UPCA has to be interpreted to the effect that an infringement action would be inadmissible or unfounded in a situation, where the patentee does not register a domestic representative with the competent authorities of a UPCA member state and thus is not allowed to assert claims arising from the respective national part before the national courts of that member state.

Contrary to Defendants, Art. 47 of the Charter of the Fundamental Rights of the European Union (CFREU) does not confer the right to a party to have the option to freely choose between several equivalent courts. Rather, the requirements of Art. 47 CFREU are met if the defendant can effectively defend himself which is the case before the UPC where he can invoke the invalidity of the patent-in-suit by filing a counterclaim of revocation.

4. It can be left open whether under special circumstances (e.g. a novelty attack based on an earlier patent application with the GPTO that was only published after the priority date of the patent-in-suit) Sec. 25(1) 2nd alternative GPA or the right to an effective defence call for a deviating result.

Defendants did not set out such special circumstances in their application. They do not even claim that they intend to bring an (additional) action for nullification before the GFPC.

5. Even if Sec. 25(1) 2nd alternative GPA were applicable or if the right pursuant to Art. 83(1) UPCA were to be further protected, the requirements of R. 361 and R. 362 RoP would not be met.

The failure to register a domestic representative in accordance to Sec. 25(1) GPA does not constitute an irremediable defect which would lead to the immediate dismissal of the infringement action. Rather, the patentee is allowed to remedy the procedural defect. To this end, the patentee must be informed of the defect and given the opportunity to remedy it (cf. Higher Regional Court Düsseldorf, judgement of 13 August 2015 – 15 U 3/14, paras. 59 et seq.; GFCJ, order of 17 December 1968 – X ZB 7/68, GRUR 1969, 437 (438) – Inlandsvertreter (on the previous provision, Sec. 16 of the old version of the GPA)).

Contrary to Defendants, the front-loaded character of the UPC proceedings does not result in a defect under applicable national law that is remediable under that law and that the UPC must observe becoming irremediable in the UPC proceedings.

In addition, dismissal of the infringement action pursuant to R. 361 or R. 362 RoP would not be necessary to protect the defendant. Rather, in a situation other than the situation at hand, where a defendant needs protection of the possibility of attacking the validity of the patent-in-suit before national courts or authority, sufficient protection could be ensured by staying the infringement proceedings until such an action for nullification has been served on a claimant who is impeding service by not complying with an obligation to appoint a domestic representative.

Therefore, a dismissal on the grounds of R. 361 or R. 362 RoP would not be justified at this stage of the proceedings.

6. Since the application and the request respectively are dismissed, there is no necessity to hear Claimant first. Should Claimant see any necessity or expedience of remedying the alleged defect, it has opportunity to do so in its forthcoming reply in the infringement proceeding.

ORDER:

The application pursuant to R. 361 RoP and the request pursuant to R. 362 RoP are dismissed.

ORDER DETAILS

Order no. ORD_33792/2025 in ACTION NUMBER: ACT_4816/2025

UPC number: UPC_CFI_79/2025

Action type: Infringement Action

Related proceeding no. Application No.: 31764/2025

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

Issued in Mannheim on 29 July 2025

NAMES AND SIGNATURES

Presiding judge Tochtermann	
Legally qualified judge Böttcher	
Legally qualified judge Rininen	