

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 2 September 2025
concerning a request for a discretionary review (Rule 220.3 RoP)
relating to an application for leave to amend case under R 263 RoP

HEADNOTES:

The exclusion of a grant of a leave for an amendment under R. 263.2 RoP applies if only one of the situations of exclusion set forth under (a) or (b) is met. Accordingly, if the Court is not satisfied, in the exercise of its discretion that, by reference to all circumstances of the case, the amendment could not have been made with reasonable diligence at an earlier stage, it shall refuse to grant leave to amend the case.

KEYWORDS

R. 263 RoP, leave to change claim.

APPLICANT (CLAIMANT IN THE COUNTERCLAIM FOR REVOCATION BEFORE THE COURT OF FIRST INSTANCE)

CeraCon GmbH, Talstraße 2 – 97990, Weikersheim, Germany

(hereinafter referred to as “**CERACON**”)

represented by Dr. Matthias Sonntag, attorney-at-law, law firm Gleiss Lutz, Germany, and other representatives

RESPONDENT (DEFENDANT IN THE COUNTERCLAIM FOR REVOCATION BEFORE THE COURT OF FIRST INSTANCE)

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

(hereinafter referred to as “**SUNSTAR**”)

represented by Holger Stratmann, attorney-at-law, Hoffmann Eitle Patent- und Rechtsanwälte PartmbB, Germany, and other representatives

PATENT AT ISSUE

EP 4 108 413

DECIDING JUDGE

Emmanuel Gougé, legally qualified judge and standing judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- Order of the Mannheim Local Division of 8 August 2025
- Reference numbers: ORD_32795/2025
 App_28086/2025 UPC_CFI_200/2025
 CC_10784/2025 UPC_CFI_200/2025

LANGUAGE OF THE PROCEEDINGS

English

SUMMARY OF THE FACTS

1. In the infringement action lodged by Sunstar Engineering Europe GmbH with the Mannheim Local Division on 24 November 2024 (ACT_63395/2024 UPC_CFI_745/2024), CERACON filed a Counterclaim for revocation of the patent at issue against Sunstar Engineering Inc. ("SUNSTAR") on 6 March 2025 (CC_10784/2025 UPC_CFI_200/2025) and, on 8 May 2025, filed an application (App_22065/2025 UPC_CFI_200/2025) for leave to amend the case (R. 263 RoP) to be 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 (hereafter "EP'480").
2. The application was rejected by the Judge-rapporteur (Order of 6 June 2025, ORD_22156/2025) and, upon a R. 333 RoP application (App_28086/2025 UPC_CFI_200/2025), further rejected in a CFI panel Order of 8 August 2025 (ORD_32795/2025).
3. CERACON filed an application to grant leave to appeal which was rejected by the Mannheim LD (Order of 29 August 2025, ORD_35726/2025).
4. On 27 August 2025, CERACON filed a request for a discretionary review by the Court of Appeal under R. 220.3 RoP.

APPLICANT'S REQUESTS AND SUBMISSIONS

5. CERACON requests the impugned order to be set aside and to be granted leave to amend its case to the effect it is allowed to base its Counterclaim for revocation on an additional ground of invalidity, namely on lack of novelty of the patent at issue over EP'480).
6. CERACON argues inter alia that the CFI finding that, when carrying out prior art searches, CERACON failed to apply reasonable diligence pursuant to R. 263.2 (a) RoP, is based on a wrong understanding of R. 263.2 (a) RoP, as well as of the relevant facts and that, in doing so, the CFI went beyond the boundaries of its discretion and violated the principle of proportionality, fairness, flexibility and procedural efficiency.

GROUND FOR THE ORDER

7. The request for discretionary review is admissible but must be denied.
8. Under R. 263 RoP, which provides for the possibility for a party, at any stage of the proceedings, to apply to the Court for leave to change its claim or to amend its case, including adding a counterclaim (R. 263.1 RoP), leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot satisfy the Court that (a) the amendment in question could not have been made with reasonable diligence at an earlier stage and (b) the amendment will not unreasonably hinder the other party in the conduct of its action (R. 263.2(a) and (b)).
9. The exclusion of a grant of a leave for an amendment under R. 263.2 RoP applies if only one of the situations of exclusion set forth under (a) or (b) is met. Accordingly, if the Court is not satisfied, in the exercise of its discretion that, by reference to all circumstances of the case, the amendment could not have been made with reasonable diligence at an earlier stage, it shall refuse to grant leave to amend the case.
10. In the present case, CERACON has failed to demonstrate that the CFI has been manifestly wrong in the exercise of its discretion in deciding the request for review of the order of the Judge-rapporteur not to grant leave to amend its counterclaim for revocation by introducing a new novelty attack base on a new prior art document (in terms of Art. 54(3) EPC) EP'480.
11. CERACON itself admits that, while the new prior art (EP'480) had not been identified by the service provider it instructed for a prior art search for purposes of the Counterclaim for revocation, one of its patent attorneys later identified said prior art in the course of a search unrelated to the Counterclaim for revocation. It further acknowledges that, using the same search string as the one used by its service provider for the prior art search, it immediately identified EP'480, which came as fifth hit in its search (CERACON R. 263 RoP Application of 8 May 2025, para 6 to 15).
12. Under these circumstances, and without further convincing explanations from CERACON as to the reasons why EP'480, with reasonable diligence, had been excluded from the search report prepared by its service provider for purposes of the Counterclaim for revocation, the CFI did not go beyond the boundaries of its discretion in deciding that CERACON had not satisfied the Court that the amendment could not have been made with reasonable diligence at an earlier stage under R. 263.2(a) RoP.
13. The impugned order, which is not manifestly wrong, has neither contradicted fairness nor the principles of proportionality, flexibility and procedural efficiency.

ORDER

The request for discretionary review is denied.

This order was issued on 2 September 2025.

Emmanuel Gougé, legally qualified judge and standing judge