



Hamburg - Local Division

UPC_CFI_537/2024

Procedural Order

of the Court of First Instance of the Unified Patent Court

delivered on 28/10/2025

CLAIMANT

Malkie Innovations Ltd.

(Claimant) - The Glasshouses GH2, 92 Georges Street
Lower Dun Laoghaire - A96 VR66 - Dublin - IE

Represented by Dr. Marc
Grunwald

DEFENDANTS

1) **Nintendo Co., Ltd.**

(Defendant) - 11-1 Hokotate-cho, Kamitoba,
Minami-ku - 601-8501 - Kyoto - JP

Represented by Johannes
Heselberger

2) **Nintendo of Europe SE**

(Defendant) - Goldsteinstraße 235 - 60528 -
Frankfurt am Main - DE

Represented by Johannes
Heselberger

PATENT AT ISSUE

Patent no.

Proprietor/s

EP2579551

Malkie Innovations Ltd.

SUBJECT OF THE PROCEEDINGS

Infringement action and counterclaim for revocation

COMPOSITION OF PANEL

Presiding judge	Sabine Klepsch
Judge-rapporteur	Dr. Stefan Schilling
Legally qualified judge	Marije Knijff
Technically qualified judge	Ulrike Keltsch

DECIDING JUDGE

Judge-rapporteur Dr. Schilling

SUMMARY OF THE INTERIM CONFERENCE

The judge-rapporteur hereby summarizes the main contents of the online interim conference conducted WEDNESDAY, 22 October 2025, at 15:00 CEST, alongside with the decisions taken following the conference, R. 105.5 RoP. The language of the interim conference was English.

1. VALUE OF THE CASE

1. The parties gave their consent to set the value of the infringement action to 3 million € and the counterclaim - with a 50% addition - to a value of 4,5 million €, resulting in a total for the proceedings of 7,5 million €.

2. PROPOSAL FOR AN AGREEMENT ON REIMBURSABLE LEGAL COSTS

2. The parties agreed to find an out-of-court settlement for the reimbursable legal costs on the basis of the judge-rapporteur's proposal of around 50% of the ceiling.

3. OBTAINING INFORMATION ON THE STATUS OF ANY PARALLEL PROCEEDINGS

3. The Claimant provided updates on the current status of the nullity action before the German Federal Patent Court and the number of other cases pending in the U.S. not related to the patent in suit (regarding both EP2579551 and EP2448225).

4. CLAIMANT'S OPERATIONAL REQUEST REGARDING THE COUNTERCLAIM FOR REVOCATION

4. The Claimant clarified that the operational request regarding the counterclaim for revocation shall regard the unconditional amendment of the patent by means of the new main claim. The operational request shall thus read:

The Counterclaim for revocation is dismissed, wherein EP2579551 is amended and maintained on basis of the claim set submitted as "Main Request" (see pages 1 and 2 of Exhibit PS 6a and 6b).

5. ADMISSIBILITY OF PATENT SALE AGREEMENT AND PATENT ASSIGNMENT AGREEMENT (EXHIBITS PS 7 AND 8)

5. The judge-rapporteur indicated that he will admit the Patent Sale Agreement ("PSA") and Patent Assignment Agreement (Exhibits PS 7 and 8) to the case. Front-loaded does not mean that everything has to be a part of the very first submission. Rule 171.1 RoP provides that a party who makes a factual claim that is contested by another party or is likely to be contested must indicate the evidence for that claim. However, when a Claimant is the registered owner of the patent in suit, no further proof is needed in the SoC. In the present case, the Claimant has introduced the documents without undue delay after the ownership was contested. Whether or not the PSA and PAA as presented are sufficient to prove the Claimant's entitlement to sue, is left to the examination of the merits of the case.

6. ADMISSIBILITY OF CHANGE OF CLAIM, R. 263 RoP;

6. The applications to change the claim under R. 263 RoP are admitted. An unconditional leave to limit a claim shall always be granted, R. 263.3 RoP. Also, changes reflecting the introduction of auxiliary requests to amend the patent have to be admitted as it has to be possible for the patentee to make corresponding amendments with regard to the infringement action based

on the amended patent claims. The rules regarding the change of claim under R. 263 RoP are more liberal than regarding the introduction of auxiliary requests to amend a patent under R. 30.1 and 30.2 RoP. Hence, also the second round of amendments to the operational (injunctive) requests is admissible as they limit the scope of the requested injunction.

7. ADMISSIBILITY OF FIRST OF APPLICATIONS TO AMEND THE PATENT WITH RESPECT TO THEIR NUMBER, R. 30.1 (c) RoP

7. The first set of applications to amend the patent are admitted. According to Rule 30.1(c) RoP, conditional requests for amendment of the patent must be reasonable in number, taking into account the circumstances of the case. In order to decide whether the number of conditional requests is reasonable, the court must weigh up all the relevant circumstances of the case and the interests of the parties, such as the number of features or the number of prior art references asserted in the nullity (counter) action (LD Hamburg, 10.07.2025 - UPC_CFI_173/2024, ACT 19746/2024 – Nera ./ Xiaomi, under sect. A. IV. 2.; see also CD Munich, order of 19 April 2025, UPC_CFI 526/2024, ACT 51533/2024). In this respect, the Local Division Hamburg had considered in the previously mentioned decision that the decisive question is whether the auxiliary requests are corresponding in their nature or whether they introduce more than two or three lines of demarcation in terms of the content of the patent (LD Hamburg, 10.07.2025 - UPC_CFI_173/2024, ACT 19746/2024 – Nera ./ Xiaomi, under sect. A. IV. 2.).
8. In the present case, the even-numbered auxiliary requests all include the added features of the Main Request that refer to detecting when a physically movable component is physically *separated* from the electronic device [thus, detached]. The odd-numbered auxiliary requests all include the features of Auxiliary Request 1 which refer to detecting when such a component is *attached*. This makes it two strains of auxiliary requests based on the movement of the component, either detaching or attaching. Given that these two strains of auxiliary requests constitute, after the dropping of Auxiliary Requests 6, 7 and 12 to 15, five to six [when including AR 32/33] lines of demarcation countering five documents of prior art, the number of auxiliary requests can be considered as within the limits of R. 30.1 (c) RoP.
9. The decision as to whether the amendments satisfy the substantial patentability requirements of Rule 30.1(b) RoP, however, is left to a decision on the merits (comp. LD Hamburg, Order of 30. December 2024, UPC_CFI_173/2024 und 424/2024).

8. ADMISSIBILITY OF PRIOR ART DOCUMENTS D6 TO D9;

10. As already indicated, documents D6 to D9 are admitted to the case. It has to be seen as a reasonable reaction to introduce new pieces of prior art in light of the amended main request and more than 30 auxiliary requests to amend the patent. The fact that the Claimant had already discussed some features in mn 86. to 97. of its SoC (“Use of Additional Aspects of the Invention”) does not determine the scope of the response by the Defendants, as long as these aspects were not relevant for the request in the SoC and thus, no comment and discussion were needed, so far. Therefore, it is not relevant whether the Defendants were aware of the subject matter of these additional aspects from the outset of the proceedings; this changed by the introduction of the new main request and the auxiliary requests in the Claimant’s Defence to the Counterclaim.

9. ADMISSIBILITY OF SECOND ROUND OF APPLICATIONS, R. 30.2 RoP

11. After hearing the parties in the interim conference and reconsideration, the second round of applications to amend a patent are admitted to the case. With its Rejoinder of 4 September

2025, the Claimant introduced a second round of Auxiliary Requests under R. 30.2 RoP changing Auxiliary Requests 8, 9, 28, 29, 36, and 37 from (abbreviated):

wherein the electronic device includes a touch-sensitive display that essentially comprises one side of the electronic device, and wherein the at least one physically movable component comprises a user interface including physical buttons, switches or keys and a trackpad, joystick, trackball, or other navigation device,

to

the electronic device includes a touch-sensitive display that essentially comprises one side of the electronic device, and wherein the at least one physically movable component comprises a user interface including a joystick

12. Auxiliary Requests 16, 17, 24, 25, 34, and 35 were changed from (abbreviated):

and wherein the electronic device comprises at least one slot formed therein and configured to receive the plug-like member, wherein the at least one slot comprises a locking mechanism or a retaining mechanism,

to

wherein the at least one slot comprises a locking mechanism or a retaining mechanism other than a friction fit.

13. The judge-rapporteur identified in the Interim Conference as a problem for admissibility that the Claimant explained the reason for the second round as follows (mn. 164 of the Rejoinder of 4 September 2025):

164 The amendments to the Auxiliary Requests are mere limitations or clarifications of two features already present in the previously filed set of requests. In addition, all amendments are directly in response to Nintendo's objections raised in their Rejoinder. The limitation to a joystick (in Auxiliary Requests 8, 9, 28, 29, 36, and 37) addresses a lack of original disclosure objection of Nintendo. The further clarification of the "retaining mechanism" (in Auxiliary Requests 16, 17, 24, 25, 34, and 35) addresses a clarity objection raised by Nintendo.

14. The judge-rapporteur rose the question, whether the Defendants' introduction of (to be admitted) new prior art D6 to D9 really had necessitated these amendments as a direct and proportionate response. The answer would be affirmative when it is due to a new set of prior art, but negative – as proposed by the Defendants – when it is based only on an alleged lack of original disclosure and/or clarity. The reason is, that clarity and disclosure are issues which should have been taken care of from the outset, especially when an amendment of a claim is not based on [granted] dependent claims, but on parts of the description.

15. The Claimant countered in the Interim Conference, that clarity and disclosure were two aspects, which had to be addressed, but that both limitations shall first and foremost overcome the challenges based on the newly introduced D6 and D7. They referred to mn. 224 f. of the Rejoinder, where distinguishing the new amended claim from D6 and D7 is – indeed – discussed. According to the Claimant, the amendment mentioning a "joystick" should be seen as a limitation (in Auxiliary Requests 8, 9, 28, 29, 36, and 37) as it had already been part of the first round of AR (*interface including physical buttons, switches or keys and a trackpad, joystick, trackball, or other navigation device*). The Defendants challenged these assertions.

16. Regarding the clarification of the “locking or retaining mechanism” (in Auxiliary Requests 16, 17, 24, 25, 34, and 35) the Claimant argued in the Interim Conference that the clarity objection is linked to a broad interpretation favored by the Defendants (comp Rejoinder, mn 242 f.). The Claimant explained to try to clarify with this amendment that it does not want to cover other mechanisms than *a friction fit*.
17. The judge-rapporteur reconsidered his initial position and sees the Claimants explanations sufficient to grant admission of the second round of amendments. This decision reflects also the position of the panel.
18. In exercising its discretion, the court must observe the principles of proportionality, flexibility, fairness and equity set out in the preamble to the Rules of Procedure (see UPC_CFI_255/2023 (CC Paris), order of February 27, 2024, para. 30 - Meril v. Edwards). It must be avoided that the patentee, by successively filing various amendments, deprives the opponent of the opportunity to react at an early stage and the court of the opportunity to deal with the requests in an appropriate manner (LD Düsseldorf, 12 September 2025, UPC_CFI_733/2024 and UPC_CFI_255/2025). In light of the patentability discussion in the Claimant’s submission with respect to the newly introduced documents D6 and D7 and in light of the fact, that the subject-matter of the auxiliary requests in question is not changed drastically, but reduced to features like the joystick and excluding a friction fit, the second round can be admitted. They limit the scope of the claimed matter and stay inside the path already described in the previous auxiliary requests. Neither fairness nor efficiency require a dismissal of the second round of amendments to the patent.
19. Fairness requires on the other hand, that the Defendants are given the right to respond in writing to these new amendments as requested by the Defendants with their submissions 06 October.

10. DEFENDANTS’ REQUEST TO DISREGARD PARTS OF THE CLAIMANT’S REJOINDER

20. After hearing the parties, the judge-rapporteur deems it the most reasonable approach to admit the contested submissions in the Claimant’s brief of 04 September 2025 and to give the Defendants the right to comment on the challenged passages in writing.
21. The Defendants argued that the submission in the RAtA of 04 September 2025 shall be disregarded to the extent that they go beyond the issues related to the amendment of the patent-in-suit. While it is true, that additional argumentation on claim interpretation and infringement is not part of a submission in the amend a patent case, also the front-loaded character of the UPC proceedings has to give room for a case to develop. It has to be acknowledged that an amendment of the patent and – alongside – a change of claim can require additional arguments as the change of one feature sometimes requires reflectance with regard to other features. The Claimant’s submission – in so far as it is contested by the Defendants – does still fall to some extend into this category.
22. Also here, fairness requires on the other hand, that the Defendants are given the right to respond in writing to these parts of the submission.

10. ADMITTANCE OF CHALLENGED SECTIONS IN DEFENDANTS’ REJOINDER

23. As the application under R. 30.2 RoP is admitted, the documents D10 and D11 have to be admitted to the case, as well, including newly argued validity attacks made by the Defendants. The Claimant is given the right to comment on the documents D10 and D11 and the new validity attacks in writing.

24. According to the case law of the Local Division (see Agfa/Gucci Final Order 30 April 2025 – UP_CFI_278/2023), a counterclaimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in the oral hearing for the first time (comp. LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024; even stricter: CD Paris, 27.11.2024 – UPC_CFI_308/2023, para 27). The formulation of a new inventive step attack in the oral hearing has to be seen as an amendment of the counterclaim pursuant to R. 263 RoP, which would require admission by the Court. In general, a Defendant has to raise these attacks with due care in the counterclaim rejoinder at the latest (LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024).
25. The same applies respectfully in the situation of a subsequent change of the main claim and/or an application to amend the patent. Here, a Claimant is obliged to state from the outset why these amended requests are patentable, R. 30.1 lit. b) RoP, including – explicitly – clarity (Art. 84 EPC) and added matter (Art. 123 II EPC). Hence, when a Claimant introduces another round of amendments to the patent in suit under R. 30.2 RoP a Defendant must again have the possibility to challenge their validity respectively. This also includes adding inventive step attacks based on already provided documents (see CoA, Decision of 3 October 2025 – UPC_CoA 534/2024 – Philips/Belkin, mn. 138).
26. Generally, without an application under R. 30.2 RoP the introduction of new documents for validity attacks in the Amendment Rejoinder is not indicated. With an application under R. 30.2 RoP the situation changes, however. As documents D 10 and D 11 were introduced to counter the second round of amendments to the patented claims, they are to be admitted, as well.
27. Even though, the oral hearing is designed to give sufficient room for a Claimant to argue the inventiveness of its patent, it appears to be the most pragmatic solution to have the Claimant prepare its arguments beforehand in writing, which also enables the Court to prepare. The judge-rapporteur decides not to open up another response for the other party, but to leave any subsequent discussion to the oral hearing.

11. FILING OF PHYSICAL EVIDENCE

28. The filing of physical evidence as addressed by the Defendants – namely samples of the attacked embodiments – is admitted, but requested to be done well in advance of the oral hearing.

12. POWER POINT PRESENTATIONS

29. The use of power point in the Court room could be facilitated via the Webex Video Conference tool that can also be used from within the Court room. Best practice suggests that the party submits the presentation beforehand to the division's clerks and to the opponent to avoid discussions about their content in the oral hearing.

ORDER

1. The Patent Sale Agreement (“PSA”) and Patent Assignment Agreement (Exhibits PS 7 and 8) are admitted to the case.
2. The applications to change the claim under R. 263 RoP are admitted.
3. Both applications to amend the patent under R. 30.1 and R. 30.2 RoP are admitted.

4. Documents D6 to D9 and documents D10 to D11 are admitted to the case. The same applies to the validity attacks in the Defendants' Rejoinder of 6 October 2025. The Claimant is given the right to comment on the documents D10 and D11 and the new validity attacks encompassed in the Defendants' Rejoinder of 6 October 2025 within two weeks in writing.
5. The contested passages in the Claimant's brief of 04 September 2025 regarding claim interpretation and infringement are admitted. The Defendants have the right to comment on these passages within two weeks in writing.

ISSUED IN HAMBURG, 28 OCTOBER 2025

Judge-rapporteur