

**UPC\_CFI\_555/2024**

**Procedural Order**

**of the Court of First Instance of the Unified Patent Court**

**delivered on 28/10/2025**

**CLAIMANT**

**Malikie 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*

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**EP2448225**

**Malikie Innovations Ltd.**

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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 16:25 CEST, alongside with the decisions taken following the conference, R. 105.5 RoP. The language of the interim conference was English.

1. PATENT IN SUIT AS AN EXHIBIT

1. The Claimant is kindly asked to submit the patent in suit in electronic form as an exhibit to the file.

2. VALUE OF THE CASE

2. 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 €.

3. PROPOSAL FOR AN AGREEMENT ON REIMBURSABLE LEGAL COSTS

3. 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.

4. OBTAINING INFORMATION ON THE STATUS OF ANY PARALLEL PROCEEDINGS

4. See UPC\_CFI\_537/2024

5. ADMISSIBILITY OF PATENT SALE AGREEMENT AND PATENT ASSIGNMENT AGREEMENT (EXHIBITS PS 11 AND 12)

5. The judge-rapporteur indicated that he will admit the Patent Sale Agreement ("PSA") and Patent Assignment Agreement (Exhibits PS 11 and 12) 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 standing to sue 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.

7. ADMISSIBILITY OF AUXILIARY APPLICATIONS TO AMEND THE PATENT WITH RESPECT TO THEIR CONDITIONS, R. 30.1 (c)

RoP

7. It was discussed that some requests to amend the patent are made subject to the condition that this amended patent claim is also infringed by the contested embodiment (I.2 to I.7). The condition in request I.8 is subject only to the usual condition of validity. The Claimant explained the reasoning behind such an unusual “double condition”. The judge-rapporteur indicated that the final decision will be referred to the panel and the final order.

8. ADMISSIBILITY OF DOCUMENTS D10 AND D17 TO D20

8. As already indicated, these documents 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 seven auxiliary requests to amend the patent. The fact that the Claimant had already discussed some features in mn. 49 – 54 in the SoC (the alleged “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 injunctive requests 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. The Claimant argued with its Rejoinder 28 August 2025 (mn. 42 ff.) that Documents D10 and D17 to D20 are post-published documents and should be rejected. Whether or not this is correct and whether these documents are valid evidence for common general knowledge is question for the case on the merits which is left to the final order by the panel.
10. The admittance of documents D19c and D19d provided in Japanese require a machine translation into the language of the proceedings, R. 7.1 and .2 RoP. This is regardless of the fact that the Defendants intended only to show their figures and drawings, as the text might reveal important information about the drawings themselves.

9. ADMITTANCE OF INVENTIVE STEP OBJECTIONS STARTING FROM D4, D12 AND D15

11. As indicated in the interim conference, the inventive step objections starting from D4, D12 and D15 in the Defendants’ Reply to the Defence to the Counterclaim are admitted.
12. 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).

13. 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). A Defendant must have the possibility to challenge their validity respectively and to introduce new prior art documents. This concerns the Reply to the Defence to the Counterclaim. Thus, introducing inventive step attacks in the Reply based on already introduced D4 and newly introduced D12 and D15 are not being late filed, in fact, it is the latest possibility to introduce new documents (unless an application under R. 30.2 is present).
14. The Claimant did already have – and use – the opportunity to comment on these attacks in its Rejoinder, as done so in mn. 61 – 165.

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

15. After hearing the parties, the judge-rapporteur deems it the most reasonable approach to admit the contested submissions in the Claimant's brief of 28 August 2025 and to give the Defendants the right to comment on the challenged passages within two weeks in writing.
16. The Defendants argued that the submissions shall be disregarded to the extent that they go beyond the issues related to the amendment of the patent-in-suit, which is particularly the arguments on infringement of claim 1 of the main request (section K, p. 58 f.), mn. 250, 254, 258, 262.
17. While it is true, that additional argumentation on claim interpretation and infringement is not expected to be 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.
18. Fairness requires on the other hand, that the Defendants are given the right to respond in writing to these parts of the submission.

#### 11. CLAIMANT'S REQUEST TO DISREGARD INVENTIVE STEP ATTACKS IN DEFENDANTS' REJOINDER

19. When it comes to the Rejoinder to amend a patent a Defendant must have again the possibility to discuss the validity of the ARs. This 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). Therefore, a discussion of inventive step objections starting from D4 in combination with D3 and regarding disclosure is not late filed.
20. Even though, the oral hearing – as discussed – 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 a first challenge beforehand in writing, which also enables the Court to prepare.
21. Any more arguments will then have to be reserved to the oral hearing; this refers to both sides.

## 12. FILING OF PHYSICAL EVIDENCE

22. The parties are granted permission to file physical evidence in form of samples of the attacked embodiments. The parties are requested to file them well in advance of the oral hearing.

## 13. POWER POINT PRESENTATIONS

23. 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.

## 14. WITNESSES

24. The parties are not required to have their witnesses available during the oral hearing. As written statements by the witnesses were provided as demanded by R. 175.1 RoP the Local Division usually refrains from hearing them in person. If the necessity might arise, this can be done by other means or on another occasion.

## ORDER

1. The Claimant is kindly asked to submit the patent in suit in electronic form as an exhibit to the file within two weeks.
2. The Patent Sale Agreement and Patent Assignment Agreement (Exhibits PS 11 and 12) are admitted to the case.
3. The applications to change the claim under R. 263 RoP are admitted.
4. The decision on the admissibility of the conditions to I.2 to I.7 of the applications to amend the patent under R. 30.1 are referred to the panel and the final decision.
5. Documents D10 and D17 to D19b and D20 are admitted to the case.
6. The admittance of documents D19c and D19d is depending on that the Defendants provide a machine translation into the language of the proceedings within two weeks, R. 7.1 and .2 RoP.
7. The inventive step objections starting from D4, D12 and D15 in the Defendants' Reply to the Defence to the Counterclaim are admitted.
8. The contested passages in the Claimant's brief of 28 August 2025 under section K, mn. 250, 254, 258, 262, are admitted. The Defendants have the right to comment on these passages within two weeks in writing.
9. The inventive step objections starting from D4 in combination with D3 and the objection regarding disclosure in the Defendants' Rejoinder of 29 September 2025 (mn. 217 – 227 and 232 – 245) are admitted. The Claimant has the right to comment on these passages within two weeks in writing.
10. The parties are granted permission to file physical evidence in form of samples of the attacked embodiments in advance of the oral hearing.

ISSUED IN HAMBURG, 28 OCTOBER 2025

Judge-rapporteur