



Munich local division

UPC_CFI_714/2024 UPC_CFI_155/2025

Order

of the Court of First Instance of the Unified Patent Court

issued on 2 April 2026

HEADNOTES:

1. A stay of proceedings under Rule 295(a) of the RoP is generally not warranted if the date of the oral hearing before the UPC takes place *before* the oral hearing before the Opposition Division of the European Patent Office (EPO).
2. Nor is a stay of proceedings under Rule 295 of the RoP necessarily warranted on the ground that the Opposition Division of the EPO revoked the patent in suit between the oral hearing before the UPC and the date set by the UPC for the pronouncement of the decision.

CLAIMANT AND COUNTER-DEFENDANT

biolitec Holding GmbH & Co. KG, Untere Viaduktgasse 6/9, 1030 Vienna, Austria represented

by: Paul Szynka, CBH Attorneys-at-law

hereinafter “Claimant”

DEFENDANTS AND COUNTERCLAIMANTS

1. **Light Guide Optics Germany GmbH**, Werner-von-Siemens-Str. 39, 53340 Meckenheim, Germany

2. **S.I.A. LIGHTGUIDE International**, Celtniecības iela 8, Līvāni, Līvānu nov., LV-5316, Latvia

represented by: Jörg Schmidt, Wildanger Kehrwald Graf v. Schwerin & Partner mbB

hereinafter “Defendant”

PATENT IN SUIT

EP 3 685 783 B1

LANGUAGE OF THE PROCEEDINGS

German

PANEL AND DECIDING JUDGES

Panel 1 of the Munich local division:

Dr Matthias Zigann, presiding judge

Mojca Mlakar, legally qualified judge

Tobias Pichlmaier, legally qualified judge (judge-rapporteur)

Dr Torsten Duhme, technically qualified judge

ORAL HEARING

17 December 2025

Facts

The claimant is the proprietor of EP 3 685 783 (the patent in suit).

The patent in suit, which relates to an

endoluminal laser ablation device for the treatment of veins

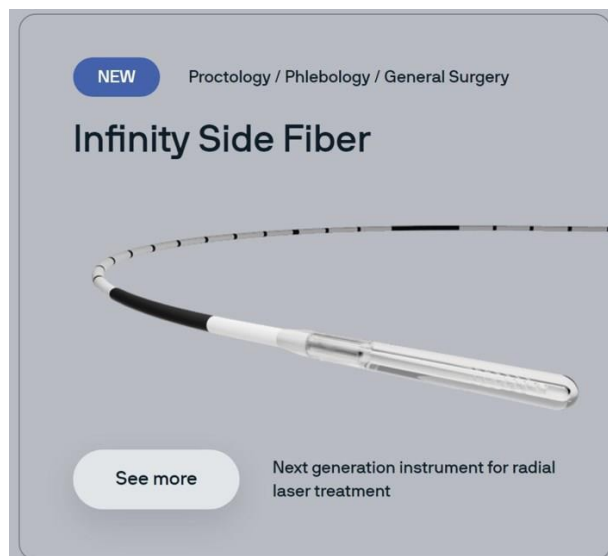
is a patent with unitary effect and derives from a parent application EP 2 974 687 dated 2 March 2009. This is a divisional application of EP 2 620 119, which in turn is a divisional application of EP 2 254 495 (the original application published as WO 2009/108956 A1).

Claim 1 reads as follows in the authoritative English version:

A device for endoluminal treatment of venous insufficiencies, comprising:

- a flexible optical fibre (200, 500, 600, 900) defining an elongated axis,
- a proximal end optically connectable to a source of radiation (424), and
- a distal end designed to be inserted into the vein and comprising radiation-emitting surfaces (208, 210, 508, 510, 608, 610, 908) of the optical fibre (200, 500, 600, 900), which are adapted to emit radiation from the radiation source (424) laterally with respect to the longitudinal axis of the optical fibre (200, 500, 600, 900) and to emit the radiation radially and circumferentially onto an angularly extending portion of the surrounding vein, and
- a substantially transparent cap (206, 506, 606, 906) enclosing the emitting surfaces (208, 210, 508, 510, 608, 610, 908) and fixedly secured to the optical fibre (200, 500, 600, 900) and sealed to it by fusion.

The defendants have developed a product called 'Lightguide Infinity Side Fiber' and advertise it on the website www.lightguide.de as follows:



Defendant 1) is responsible for the website www.lightguide.de, on which the contested embodiment is advertised in German, inter alia, for the Federal Republic of Germany. Defendant 2) is responsible for the website www.lightguide.com, on which the contested embodiment is advertised in English for the pan-European market.

As early as 19 July 2024, the first defendant initiated opposition proceedings before the European Patent Office and applied for the complete revocation of the patent in suit. On 22 October 2025, the Opposition Division informed the parties that, in the Opposition Division's preliminary assessment, the patent in suit did not meet the requirements of Articles 76(1) and 123(2) EPC (Annex WKS 13). The Opposition Division gave the parties the opportunity to comment on this by 12 December 2025.

The defendants subsequently **applied** in the present proceedings, by a document dated 28 October 2025,

1. the proceedings be stayed and
2. to cancel the dates set for the interim hearing on 21 November 2025 and for the oral hearing on 17/18 December 2025.

By order of 29 October 2025, the judge-rapporteur gave the claimant the opportunity to comment on the defendants' application for a stay and cancellation of the hearings by 7 November 2025. In its response of 7 November 2025, the claimant opposed the applications.

The interim hearing took place on 21 November 2025. At this hearing, the claimant's representatives announced further subsidiary claims in light of the Opposition Division's preliminary assessment, in order to ensure that the filing of claims in the opposition proceedings and the present counterclaim could proceed in parallel. The defendants objected to this on the grounds that it was out of time. The following course of action was then discussed with the parties at the interim hearing: the Claimant is to submit the announced alternative claims in writing without delay; the defendants are to be given the opportunity to comment on these in writing before the oral hearing (17 December 2025); a decision on the admissibility of the alternative claims will then be made at a later date, in any event not before receipt of the defendants' written comments.

By document dated 21 November 2025, the Claimant submitted the relevant alternative claims (B alternative claims). The defendants submitted their comments on this on 5 December 2025, in accordance with the order of the judge-rapporteur dated 23 November 2025. The defendants are of the view that the claimant should have submitted the B-claims by 7 November 2025. There is no admission of the B-claims pursuant to Rule 30(2) of the RoP, nor is there an application to that effect in which the claimant would have explained why the additional claims are admissible by way of exception; such an application would have had to be filed at the same time as the claim.

By decision of 3 February 2026 (Annex WKS 15), the Opposition Division declared the patent in suit invalid. The decision is not final.

The claimant submits that the defendants infringe the patent in suit by manufacturing and distributing the contested embodiment. The contested embodiment exhibits all the features of claim 1 of the patent in suit and therefore makes use of the subject-matter of claim 1 of the patent in suit.

The defendants are of the view that the contested embodiment does not make use of the features of the patent in suit. Furthermore, they argue that the patent in suit should be declared invalid because its subject-matter

- is not novel
- not inventive and
- not workable and
- furthermore goes beyond the content of the originally filed version and the content of the earlier applications on which the patent in suit is based.

The defendants have filed a counterclaim for declaration of invalidity. The claimant has consequently applied for the counterclaim to be dismissed and, in the alternative, for the patent in suit to be upheld in a limited form. The claimant submitted the B auxiliary claims, filed by document on 21 November 2025, in the following order at the oral hearing on 17 December 2025: 10B, 1B, 2B, 3B, 4B, 5B, 6B, 7B, 8B, 9B. Sub-claim 10B reads:

1. A device for endoluminal treatment of ~~venous insufficiencies and~~ varicose veins, comprising:
 - a flexible optical fibre (200, 500, 600, 900) defining an elongated axis,
 - a proximal end optically connectable to a source of radiation (424), and
 - a distal end designed to be received within the vein and comprising radiation-emitting surfaces (208, 210, 508, 510, 608, 610, 908) of the optical fibre (200, 500, 600, 900), which are formed by grooves and are adapted to emit radiation from the radiation source (424) laterally with respect to the longitudinal axis of the optical fibre (200, 500, 600, 900) and to emit the radiation radially and circumferentially onto an angularly extending portion of the surrounding vein, and

- a ~~substantially transparent~~ cap (206, 506, 606, 906), substantially transparent to the emitted radiation, enclosing the emitting surfaces (208, 210, 508, 510, 608, 610, 908) and fixedly secured to the optical fibre (200, 500, 600, 900) and sealed to it by fusing the cap (206, 506, 606, 906) to the core of the optical fibre (200, 500, 600, 900), wherein the cap (206, 506, 606, 906) defines an optical fibre-gas interface that refracts emitted radiation laterally with respect to the longitudinal axis of the optical fibre (200, 500, 600, 900).

The claimant considers that the contested embodiment also constitutes an infringement in relation to the alternative claims raised in the counterclaim for declaration of invalidity.

Reasons

1. The local division currently takes the view that the patent in suit, as granted, is invalid.

It is true that the original application indicates that, in some embodiments, a cap is fixed to a distal end of the fibre ('In some embodiments, the device includes a cap fixedly secured to a distal end of the fibre', para. [0033]).

However, a *fusion* – which, according to the original disclosure, is one of the explicitly mentioned types of permanent connection (“...fused, bonded or otherwise fixedly secured”) – is disclosed only insofar as it occurs in relation to the cap and *the fibre core* (“...fused, bonded or otherwise fixedly secured to the fibre core...”). A fusion with other fibre elements cannot be directly and unambiguously derived from the original disclosure.

The local division therefore concurs with the Opposition Division that the omission of the term ‘core’ in this context constitutes an impermissible extension. In its granted version, claim 1 of the patent in suit is therefore, in the local division’s view, invalid.

2. The local division assumes, however, that the patent in suit is valid in the version of auxiliary claim 10B.

The defendants have objected that the filing of auxiliary claim 10B, with which the Claimant responded to the Opposition Division’s preliminary assessment, was late. For their part, the defendants responded to the Opposition Division’s preliminary assessment by filing a request for a stay of the present proceedings.

Rule 295(a) of the RoP, which allows for a stay in view of parallel preliminary objection proceedings before the European Patent Office, serves the purpose of coordinating nullity proceedings running in parallel before the EPO and the UPC, not only in terms of timing but also in terms of substance. If a decision by the Opposition Division is imminent, whilst a decision by the UPC is not expected before the decision of the Opposition Division, the proceedings before the UPC may be suspended. Once the decision of the Opposition Division, which was awaited due to the suspension,

, the proceedings before the UPC may then be resumed, taking into account the findings of the opposition decision.

However, if the UPC stays proceedings in view of proceedings before the EPO, this only makes sense if applications filed before the EPO can also be taken into account in proceedings before the UPC; otherwise, the UPC would be limited to the auxiliary applications filed with it up to the point of the stay and could not make auxiliary applications filed with the EPO the subject of its own proceedings. This could lead to the UPC revoking a patent solely because auxiliary claims, on the basis of which the patent was examined and, where appropriate, maintained before the EPO, can no longer be taken into account by the UPC. Rule 295(a) of the RoP serves precisely to avoid such a situation.

The local division initially decided not to stay proceedings in cases UPC_CFI_714/2024 and UPC_CFI_155/2025 prior to the oral hearing before the UPC, as the date for the oral hearing before the UPC (17 December 2025) was scheduled to take place before the oral hearing before the Opposition Division on 13 January 2026. Nevertheless, in order to be able to take into account the Opposition Division's decision scheduled for 13 January 2026, it gave the parties the opportunity to comment on this in the order of 27 January 2026 issued following the oral hearing.

Now that the grounds for the Opposition Division's decision are available, a stay is no longer warranted, as a decision by the Board of Appeal is not to be expected in the near future and the proper administration of justice (Rule 295(m) of the RoP) does not imperatively require a stay in view of the revocation of the patent in suit by the Opposition Division.

The amendments in question, dated 21 November 2025, were prompted by the notification from the Opposition Division of the EPO dated 22 October 2025; consequently, they could not have been made any earlier, given the required standard of care. In particular, the claimant was not required to file the amendments as early as 7 November 2025; the relevant time limit for filing a written submission related solely to the claimant's response to the defendant's application for a stay of proceedings and cancellation of the hearing. Nor were the defendants

did not unduly hinder the defendants in the conduct of their proceedings, as they were able to respond to them both in documents and orally.

3. The parties are in dispute, inter alia, as to whether

- whether the helical grooves of the embodiment in question result in lateral emission due to light refraction (the orange arrow in the following illustration is an example of a possible refraction) or whether the grooves cause total internal reflection of the laser radiation (the blue arrow is also an example of a possible reflection),



- the radiation emitted into the groove in this manner is further laterally refracted at the cap, and
- the cap is fused to the core or to the cladding of the optical fibre.

Both parties have conducted tests in this regard and called witnesses to that effect. The tests have yielded differing results, which the local division considers to be irreconcilable. As the local division is unable to determine with certainty which account is accurate, it has decided, in accordance with Rule 185 of the RoP, to appoint a court-appointed expert to clarify these technical issues.

Order

- I. The defendant’s application for a stay of proceedings is dismissed.



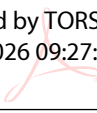


- II. A court-appointed expert is appointed to answer the following questions:
 1. In the contested embodiment, do emissions occur at or into the helical grooves of such a nature that they do *not* constitute (internal) total reflections at the grooves?

 2. Does the cap of the contested embodiment constitute an interface at which the radiation emitted in accordance with point 1 above is refracted in a lateral direction?

 3. In the contested embodiment, is the cap fused to the core or to the cladding of the optical fibre?

- III. The parties are given the opportunity to comment on this order by 17 April 2026 and to make proposals regarding the appointment of a court-appointed expert.

Munich, 2 April 2026

Dr Zigann (presiding judge)	Matthias ZIGANN  Digitally signed by Matthias ZIGANN Date: 02/04/2026 09:12:00 +0200
Mlakar (legally qualified judge)	MOJCAMLAKAR  Digitally signed by MOJCA MLAKAR Date: 2 April 2026 10:30:17 +02:00
Dr Duhme (technically qualified judge)	Digitally signed by TORSTEN DUHME Date: 2 April 2026 09:27:31 +02:00 
Pichlmaier (legally qualified judge; judge-rapporteur)	TOBIASGÜNTHER  Digitally signed by TOBIAS GÜNTHER PICHLMAIER PICHLMAIER Date: 02/04/2026 08:30:32 +02'00'
For the Deputy-Registrar	Catrin Meyer  Date: 02/04/2026 11:05:57 +0200 Digitally signed by Catrin Meyer