



**UNIFIED PATENT COURT
COURT OF FIRST INSTANCE
LOCAL DIVISION MILAN**

**UPC_CFI_703/2025
- UPC_CFI_1757/2025**

**Order issued on
16 April 2026**

PLAINTIFF

PRNOTH SPA

represented and defended by solicitors Renato Bocca, Stefano Grassini and Camilla Scalvini, and by agents Mauro Eccetto and Angelo Cicchetti,

DEFENDANT

XELOM s.r.l.

represented and defended by Niccolò Ferretti, Gherardo Piovesana, Sergio Francini, Emanuela Grazia

PATENTS AT ISSUE

EP2507436

EP EP1995159

DECIDING JUDGE

Alima ZANA, Reporting Judge

LANGUAGE OF THE PROCEEDINGS

Italian

The proceedings

1. On 3 April 2026, Prinoth spa – the claimant in the infringement proceedings – filed an application pursuant to Rule 9.3(a) of the Rules of Procedure (RoP), seeking a thirty (30)-day extension of the deadline for filing its pleading, due on 27 April 2026, to 27 May 2026, pursuant to Rules 9(3) and 334 of the RoP.

2. Following the opening of the proceedings, on 15 April 2026 Xelom filed a defence brief authorised by the Court, requesting that the application be dismissed.

Reasons for the decision

3. The Judge-Rapporteur considers that Prinoth's application is well-founded.

In this regard, it is well established that the extension of procedural time limits provided for in ROP 9, para. 3, constitutes an exceptional measure within a system characterised by strict procedural deadlines (see, inter alia, CD Paris, 9 February 2024, UPC_CFI_412/2023; LD Düsseldorf, UPC CFI_363/2023; 20 January 2024).

Indeed, the strict procedural time limits provided for in the Rules of Procedure serve a number of objectives, as highlighted in a previous decision of the Office, the grounds for which are briefly summarised here, namely:

- (i) the swift conclusion of proceedings (see recital 7 of the 'RoP');
- (ii) the principle of due process through procedural rules established in advance for both parties;
- (iii) the principle of the impartiality of the judge, which would be compromised if the Court were to arbitrarily alter the time limit laid down by law in favour of one of the parties;
- (iv) the legal certainty that a procedural step will be taken within a specified time limit and the parties' confidence in the mandatory nature of the provisions in question. (see Paris CD, 9 February 2024, UPC_CFI_412/2023).

4. That said, the extension of a time limit allows, in specific circumstances, for the right to a fair trial to be guaranteed, in accordance with the adversarial principle, in the service of which the principles of proportionality and flexibility guide the Court's discretion in case management: this power must be exercised *on a case-by-case basis*, taking into account the specific circumstances of the particular case.

5. In particular, for the application to be granted, it must be (i) timely, (ii) substantiated, and (iii) supported by evidence of the impossibility of complying with the prescribed procedural time limits.

6. In the present case, the conditions listed above are met.

In particular:

(i) as regards timeliness, the application was filed on 3 March 2026, a few days after the opposing party filed (on 26 March 2026) the defence submissions setting out the grounds for invoking the remedy provided for in Rule 9 ROP;

(ii) as regards the grounds, Prinoth emphasised that on 27 January 2026 it had filed:

- a document containing his 'Reply to the Statement of Defence';
- his "Defence to the Counterclaim for Revocation";
- an 'Application to Amend the Patents', in which it set out, in the event that the 'Counterclaim for Revocation' were to be upheld, six proposed amendments to EP '436 and five proposed amendments to EP '159, making the consideration of each contingent upon the rejection of the preceding one.

Prinoth stated that on 26 March 2026 the defendant filed a document (namely *the "Rejoinder to the Reply to the Statement of Defence", "Reply to the Defence to the Counterclaim" and "Defence to the Application to Amend the Patents"*) in which:

- ✓ with regard to EP '436:
 - it introduced 7 new documents, using them to formulate (i) 27 objections (out of 39) to the first proposal to amend the original claims; (ii) 49 objections (out of 54) to the second; (iii) 9 (out of 15) to the third; (iv) 9 (out of 12) to the fourth and fifth); (v) 6 (out of 8) against the sixth;
 - articulated 3 new inventive step attacks on the original claims, using a different document as the closest prior art, specifying that the one previously indicated was a typographical error;
 - has raised a total of over 150 objections regarding novelty and inventive step in relation to the main request and the auxiliary requests;
 - it has introduced entirely new defences against the (consistent) infringement of the original claims.
- ✓ with regard to 'EP 159:
 - introduced two new documents not previously mentioned, using them as *new closest prior art* to articulate no fewer than 10 new inventive step arguments against the main request, with new combinations that require the identification of a new *starting point* and necessitate analysis according to a different *problem-solution approach*;
 - it produced a further, extremely substantial technical report (360 pages).

That said, the claimant emphasised the need for a longer period than the thirty days provided for in Rule 29 (e) ROP, given that the opposing party's submission essentially constitutes a new *counterclaim for revocation*. This is to safeguard the claimant's right of defence against a submission entirely outside the procedural framework and contrary to the front-loaded principle.

In this regard, the Court considers that the application is amply substantiated.

(iii) As regards the evidence, the introduction of a truly considerable number of new arguments, documents and objections in the defendant's latest statement – amounting to some 150 objections in total, which is an exceptional number – clearly supports and justifies Prinoth's request for an extension.

To ensure the right to a defence and to adversarial proceedings, which must be effective and not merely formal, it therefore appears necessary to grant Prinoth spa a further extension for the filing of its defence, to be submitted by 27 April 2026.

Moreover, Xelom's defensive strategies have made Prinoth's recourse to this remedy foreseeable.

7. Finally, the Court observes that the time limit requested by Prinoth appears reasonable in view of the numerous issues raised by the opposing party, on which it must take a position, and which, moreover, has a minimal impact on the overall timeline of the proceedings (see Düsseldorf Local Division, UPC_CFI_336/2024 UPC_CFI_605/2024, 19 February 2025), and therefore does not prejudice the objective of a swift conclusion to the proceedings.

Xelom's objections

8. Xelom's objections seeking the dismissal of the application are unfounded, given that:

- This is without prejudice to any assessment by the Panel regarding the defendant's breach of the so-called 'front-loaded' principle – to which reference has been made on several occasions in UPC case law and also by this Local Division – for the purposes of ensuring proper procedural debate; and, consequently, regarding whether or not Xelom's defences, which Prinoth alleges were submitted late, were timely. That assessment is reserved for subsequent stages and plays a neutral role with regard to the granting of the request for an extension;

-the UPC's interpretative guidelines (according to which an extension cannot be based solely on the complexity of the proceedings and the number of *auxiliary requests* filed, since patent proceedings are, by their very nature, complex, technical and often based on multiple lines of attack, experimental evidence and auxiliary requests, which do not constitute an anomaly, but rather constitute the 'normal' scenario which the Rules of Procedure have already taken into account) – as already emphasised above – place the extension of procedural time limits within the scope of the exception, but do not, tout court, pose an obstacle to the application of the remedy under consideration here, given the exceptional circumstances of the specific case, to the granting of the request, as found here;

- although the primary and actual reason for Xelom's defensive strategies, which are being criticised here, may be a direct consequence of the claimant's procedural choices (such as the introduction of *auxiliary requests* that would substantially alter the technical scope of the independent claims compared with the granted version of the patents) the review carried out at this stage by the Court is aimed at verifying whether the right to a defence and to a fair trial is guaranteed or not to the applicant in the specific part of the proceedings subject to the request for an extension;

- the need for Xelom, in turn, to draft its previous defences within equally tight time limits (given that the opposing party had filed 11 auxiliary requests) does not preclude the granting of Prinoth's application, considering that the defendant has not, to date, submitted any reasoned application for an extension of the time limit which has been rejected by this Office on grounds differing from those outlined above. Therefore, there is no breach of the principle of equality of arms.

Having regard to ROP 9, paragraph 3, and 334

ORDER

The Court, in the person of the Judge-Rapporteur, grants Prinoth spa an extension of thirty (30) days to the deadline for filing its pleading (currently due on 27 April 2026), and thus until 27 May 2026.

So ordered in Milan, on 16 April 2026

The Judge-Rapporteur

Alima Zana

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