



Central Division
Paris Seat

ORDER

of the Court of First Instance of the Unified Patent Court

Central division (Paris seat)

issued on 5 April 2024

lodged in the revocation action No. ACT_555899/2023

UPC_CFI_263/2023

HEADNOTES: rule 105 'RoP'

KEYWORDS:

REFERENCE CODE ECLI:

CLAIMANT:

BITZER Electronics A/S - Kærvej 77 - 6400 - Sønderborg - DK
represented by Tilman Pfrang, Meissner Bolte

DEFENDANT:

Carrier Corporation - 13995 Pasteur Blvd. - FL 33418 - Palm Beach Gardens - US
represented by Gregory Lees, Dehns

PATENT AT ISSUE:

European patent n° EP 3 414 708

PANEL:

Presiding judge François Thomas

Judge-rapporteur Paolo Catallozzi
Technically qualified judge Ulrike Keltsch

DECIDING JUDGE:

This order has been issued by the judge-rapporteur Paolo Catallozzi

PANEL:

Panel 2 of the Central Division - Paris Seat

Presiding judge and judge-rapporteur	Paolo Catallozzi
Legally qualified judge	Tatyana Zhilova
Technically qualified judge	Stefan Wilhelm

DECIDING JUDGE:

This order is issued by the presiding judge and judge-rapporteur Paolo Catallozzi

SUMMARY OF FACTS

1. On 2 April 2024 this judge-rapporteur held the interim conference regarding the revocation action lodged by the claimant against patent at issue (EP '708) before this Seat of the Court of First Instance of the Unified Patent Court, registered as No. ACT_555899/2023 UPC_CFI_263/2023.
2. In that conference, the following topics have been discussed:
 - a) Validity of priority claim of the patent at issue.

The judge-rapporteur asked the representatives of the claimant to clarify and give a more detailed reasoning on the assertion in paragraph 9 of the statement of claim that the priority claim of the patent at issue is invalid.

The claimant explained why the priority claim has to be considered invalid.

Then, the judge-rapporteur deemed that, contrary to the defendant's request, the issue of the alleged lack of entitlement to priority of the patent at issue shall not be excluded from consideration, as it was sufficiently raised in the statement for revocation.

- b) Allowable form of amendments.

The judge-rapporteur stated that the issue concerning the admissibility of the amendments filed by the patent proprietor, in the part where they do not relate to the claim 1, which is the subject of the revocation action, will be addressed by the panel at the oral hearing.

Therefore, the issue concerning the disputed admissibility of the challenge of the twelfth auxiliary request filed by the patent proprietor will also be addressed at the oral hearing, as strictly dependant from the previous one.

c) Late-filed attacks.

The judge-rapporteur stated that late-filed attacks to the validity of the patent – that is, the filing of grounds of invalidity of the patent which have not been submitted in the statement for revocation or do not relate exclusively to the amended version of the patent – are not admissible in principle, as they are not allowed by the Rules of Procedures and, in general, are contrary to the front-loaded character of the Unified Patent Court proceedings.

Therefore, the novelty attacks based on MB5 and MB6 raised in the claimant’s reply to defence to revocation and defence to the application to amend (paragraphs 57 to 83) shall be excluded from consideration.

Actually, those attacks – even if targeted to the amended version of the patent – could (and should) have been filed against the original version of the patent with the statement to revocation, as the amended patent may not contain subject-matter which extends beyond the content of the patent as granted.

The judge-rapporteur deemed that a different conclusion is required with the regard to the sufficiency attacks, as they are targeting the amended version of the patent and, so, they relate specifically and exclusively to the patent as amended and not the patent as granted.

d) Value of the proceedings for the purpose of applying the scale of ceilings for recoverable costs.

The parties agreed with the value of the proceedings being set at euro 250,000.

e) Organization of the oral hearing.

The judge-rapporteur asked for updates about the development of the Court of Appeal proceedings concerning the appeal lodged by the defendant against the order of the panel rejecting the request of stay of the proceedings and the opposition proceedings pending before the European Patent Office.

The parties’ representatives have informed the Court that the appeal proceedings will be discussed on 2 May 2024, while to hearing before the European Patent Office is scheduled for 24 October 2024.

The judge-rapporteur deemed appropriate to confirm the date of the oral hearing for 21 June 2024, 09.30 CET, as, apparently, no decision by the European Patent Office on the opposition will be issued earlier, provided that if the Court of Appeal upholds the appeal and stay the proceedings, a new date for the oral hearing shall be set.

ORDER

The judge-rapporteur,

pursuant to Rule 105 (5) ‘RoP’,

sets out the following decisions taken at the interim conference held on 2 April 2024:

- a) the issue of the alleged lack of entitlement to priority of the patent at issue shall not be excluded from consideration;
- b) the issues concerning the admissibility of the amendments filed by the patent proprietor, in the part where they do not relate to the claim 1, and of the challenge of the twelfth auxiliary request filed by the patent proprietor will be addressed at the oral hearing;
- c) the novelty attacks based on MB5 and MB6 raised in the claimant's reply to defence to revocation and defence to the application to amend (paragraphs 57 to 83) shall be excluded from consideration;
- d) the sufficiency arguments raised in the claimant's reply to defence to revocation and defence to the application to amend shall not be excluded from consideration;
- e) the value of the proceedings for the purpose of applying the scale of ceilings for recoverable costs has been set at euro 250,00;
- f) the date and time for the oral hearing has been confirmed for 21 June 2024, 09.30 CET.

Issued on 5 April 2024.

The Judge-rapporteur

Paolo Catallozzi