Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Düsseldorf Local Division
UPC_CFI_347/2024

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 26 July 2024
concerning EP 3 320 602 B1

HEADNOTES:

1. The scope of R. 263 RoP is not limited to the main proceedings. It also applies to applications for provisional measures. The applicant may also apply for leave to change its claim or to amend its case.

2. If the applicant adds a feature to its claims which was previously only "alternatively" claimed, this narrows the scope of a possible preliminary injunction or other preliminary measures. Embodiments which satisfy all the other features but not the now added feature are no longer covered by a possible preliminary injunction. This is therefore a limitation of the claim. If this limitation is unconditional, R. 263.3 RoP applies.

KEYWORDS:

Leave to change the claim; application for provisional measures; limitation of a claim; unconditionally limitation; scope of R. 263 RoP; motions; features alternatively

APPLICANT:

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Contributing European patent attorneys:	Nicolas Cardon, Amandine Ricard, Florian Saadi, Valeo Electrification, Cergy,

DEFENDANTS:

1. **Magna PT B.V. & Co. KG,** Herrmann-Hagenmeyer-Str. 1, 74199 Untergruppenbach, Germany, represented by its general partner, Magna PT Management B.V., with the same address, which is jointly represented by the managing directors Thomas Klett and Sandro Gildo Morandini, with the same address,

2. **Magna PT s.r.o.,** Perinska cesta 282, Kechnec 044 58, Slovakia, represented by its managing directors Martin Hluchý und Katarína Vaškovičová, with the same address,

3. **Magna International France,** SARL, 4 route de Gisy Bâtiment 26, Biévres 91570, France, represented by its managing directors Thierry Servouse and Franz Trummer, with the same address,

All Defendants represented by:	Attorney-at-law Klaus Haft, Attorney-at-law Sabine Agé, Attorney-at-law Sebastian Kratzer, Hoyng, ROKH, Monegier, Steinstraße 20, 40213 Düsseldorf, Germany,
Collaboratoring attorney:	Attorney-at-law Dr Wolfgang Kellenter, Hengeler Müller, Benrather Straße 18-20, 40213 Düsseldorf, Germany,
Collaboratoring European Patent attorney:	European Patent Attorney Jan Ackermann, Cohausz & Florack, Bleichstraße 14, 40211 Düsseldorf, Germany,

PATENT IN SUIT:

EUROPEAN PATENT NO. EP 3 320 602 B1

PANEL/DIVISION:

Panel of the Düsseldorf Local Division

DECIDING JUDGES:

This order was issued by Presiding Judge Thomas acting as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT: R. 263 RoP – Request for leave to change the Applicant's claim

SUMMARY OF THE FACTS:

By written submission dated 1 July 2024, the Applicant filed an application for provisional measures based on an alleged infringement of EP 3 320 602 B1.

The application reads as follows (extract, underlining added by the Court):

I. The Defendants are ordered to refrain from,

in the Federal Republic of Germany and/or the French Republic and/or the Slovak Republic,

making, offering, placing on the market or using, or importing or storing the product for those purposes,

1. rotary electric machines having

- a stator,
- a rotor,
- a casing,
- a shaft, and
- at least one rolling bearing mounted between said casing and said shaft,

the casing having a reservoir configured to receive a lubricant intended to lubricate said rolling bearing,

the machine having a cooling circuit designed to allow the flow of a cooling liquid, for example an oil, for cooling the stator and/or the rotor, said reservoir being delimited by a base, a first rim formed in said casing and a second rim formed by an external ring of said rolling bearing,

(infringement of claim 1 of EP 3 320 602 B1)

alternatively:

wherein the shaft has at least one lubricant outlet designed to fill said reservoir,

(infringement of claim 6 of EP 3 320 602 B1)

[…]

By brief of 16 July 2024 the Applicant requests the Court for leave to change the Applicant's claim of the application dated 1 July 2024 by deleting the word "alternatively".

POINTS AT ISSUE:

The Applicant is of the opinion that it wishes to limit the claim unconditionally (R. 263.3 RoP). Therefore, it is not necessary to convince the Court that the amendment in question could not have been made earlier with reasonable diligence.

According to the Defendants, the Applicant has not provided any justification within the meaning of R. 263.1 sentence 2 RoP. The Defendants consider that the Applicant cannot rely on R. 263.3 RoP for three reasons: Firstly, the systematics of R. 263 RoP is such that only para. 1 sets out the requirements for an admissible application, while paras. 2 and 3 set out the circumstances in which leave should not be granted or should be granted by the Court. Secondly, unlike R. 263.1 RoP, which generally mentions the possibility to "amend the case" or "change the claim", R. 263.3 RoP is limited to limitations of the "claim". However, what is meant is a legal claim, not a patent claim, and it is not at all clear from the present application to what extent the legal claim would be affected. In addition, such limitations of a patent claim would make the proceedings more complex in terms of validity aspects and thus would not reduce the burden. Thirdly, R. 263.3 RoP refers to a "claim in an action" but not to a "claim in an application for provisional measures". In this respect, the Rules of Procedure (in contrast to Art. 32(1) UPCA) consistently distinguish between "actions" and "applications".

GROUNDS FOR THE ORDER:

Pursuant to R. 263.1 sentence 1 RoP, a party may at any stage of the proceedings apply to the Court for leave to change its claim or to amend its case. To the extent that R. 263.1 sentence 2 RoP requires an explanation as to why such a change or amendment was not included in the original pleading, such an explanation may be dispensable in the case of an unconditional limitation (R. 263.3 RoP). Such a case arises where, as here, the basis for the limitation has already been created in advance by a corresponding auxiliary request and the earlier submissions can also be used for the limitation.

R. 263.3 RoP is not limited to proceedings on the merits. This Rule also applies to PI proceedings. This is not contradicted by the fact that this Rule refers in part to an "action" ("Klage"). On the one hand, the use of language in this Rule is not uniform and is sometimes broader. On the other hand, Rule 263 RoP is to be found in Part 5 "General Provisions" in "Chapter 1 – General Procedural Provisions" of the Rules of Procedure. The provisions contained in this chapter therefore apply not only to main proceedings, but also to PI proceedings. An application under R. 263 RoP can therefore be made even if it is an application for provisional measures.

Defendants are not unduly prejudiced by the granting of an unconditional limitation of claims in PI proceedings. The amended version of the claim adds a feature to the claim that was previously only asserted "alternatively". This narrows the scope of a possible preliminary injunction and further provisional measures. Embodiments which satisfy all the other features but not the now added feature are no longer covered by a possible preliminary injunction. In this respect, the intended limitation is even favourable to the Defendants.

Nor will the Defendants be hindered in their defence, despite the tight deadlines in PI proceedings. The feature now included in the claim was also included in the original application. The Applicant had already argued in the application that subclaim 6, corresponding to the newly added feature,

is infringed. It was therefore clear to the Defendants from the outset that the additional feature now included in the claim could also become relevant. They had to be prepared for this and take it into account when developing their defence strategy.

Finally, the Applicant is not amending a patent claim by adding the feature to its claim. Rather, the Applicant is adding an additional feature to its claim, which is the basis for the preliminary injunction and other provisional measures that the Applicant is seeking. In other words, the Applicant is narrowing the scope of the preliminary injunction and other preliminary measures sought. It is therefore not an amendment within the meaning of R. 30 RoP or R. 50.2 RoP.

ORDER:

The Applicant is granted leave to change the Applicant's claim under I. of the application dated 1 July 2024 as set out in the draft amended application for provisional and protective measures (Art. 62 UPCA) dated 16 July 2024, so that point I. of the Applicant's claim now reads as follows:

I. The Defendants are ordered to refrain from,

in the Federal Republic of Germany and/or the French Republic and/or the Slovak Republic,

making, offering, placing on the market or using, or importing or storing the product for those purposes,

1. rotary electric machines having

- a stator,
- a rotor,
- a casing,
- a shaft, and
- at least one rolling bearing mounted between said casing and said shaft,

the casing having a reservoir configured to receive a lubricant intended to lubricate said rolling bearing,

the machine having a cooling circuit designed to allow the flow of a cooling liquid, for example an oil, for cooling the stator and/or the rotor, said reservoir being delimited by a base, a first rim formed in said casing and a second rim formed by an external ring of said rolling bearing,

wherein the shaft has at least one lubricant outlet designed to fill said reservoir,

(infringement of claim 6 of EP 3 320 602 B1)

2. an assembly that has a host element with an enclosure and a rotary electric machine as defined in I. 1. inserted into said enclosure.

(infringement of claim 13 of EP 3 320 602 B1)

DETAILS OF THE ORDER:

App_42088/2024 under main file reference ACT_37931/2024

UPC number: UPC_CFI_347/2024

Type of procedure: Application for provisional measures

Issued in Dusseldorf on 26 July 2024
NAMES AND SIGNATURES
Presiding Judge Thomas

Ronny Thomas

Digital unterschrieben von Ronny Thomas
Datum: 2024.07.26 12:49:10 +02'00'