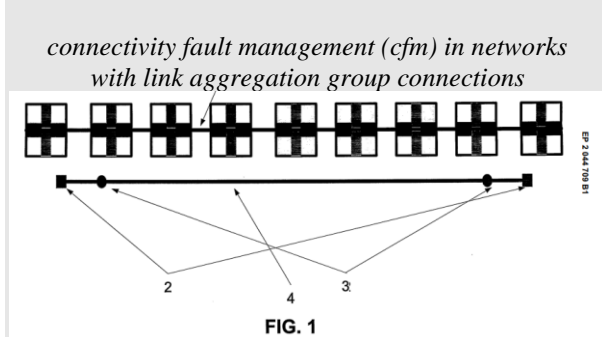


UPC CFI, Central Division Paris, 2 July 2024, Nokia v Mala Technologies

See also:

[IPPT20240502, UPC CFI, CD Paris, Nokia v Mala Technologies](#)

[IPPT20240621, UPC CoA, Mala v Nokia](#)



PATENT LAW – PROCEDURAL LAW

Application to amend the patent not inadmissible because Defendant failed to initiate the correct workflow in the CMS ([Rule 4.1 RoP](#), [Rule 49.2\(a\) RoP](#))

- [The arguments underlying the Application to amend were brought to the attention of the court and Plaintiff within the 2-month time limit of R 49 \(1\), \(2\) RoP. No disadvantage arose for Plaintiff because Defendant failed to open a separate workflow.](#)

11. The Rules of Procedure have to be interpreted with reference to the principles of fairness and proportionality ([Preamble No. 2 RoP](#)). As stated in ORD_19619/2024 ACT_580198/2023, UPC_CFI_367/2023, it is not readily apparent to the CMS user that the CMS requires an independent reaction to the Application to amend a patent by opening a separate workflow. Ambiguities arising from the CMS, particularly shortly after the launch of the UPC, should not be to the detriment of the parties and should not render a submission inadmissible (see also Ordonnance ORD_25657/2024 ACT_578871/2023 UPC_CFI_360/2023).

12. The Order [ORD 576853/2023 UPC CFI 15/2023](#) of the Munich Local Division which has been mentioned by Plaintiff states correctly that the parties are obliged under [rule 4.1 RoP](#) to use the correct workflow. The Order does not consider the submission to be inadmissible because the wrong workflow was used. The order left open whether in the future submissions filed in the wrong workflow may be inadmissible. This issue doesn't have to be decided in this order. At least for now the use of the wrong workflow does not render a submission inadmissible.

13. However, the parties are strongly encouraged to use the correct workflows in the future, as this makes the case management system more transparent and more accessible.

14. The arguments underlying the Application to amend were brought to the attention of the court and Plaintiff within the 2-month time limit of [R 49 \(1\), \(2\) RoP](#). No

disadvantage arose for Plaintiff because Defendant failed to open a separate workflow.

Source: [Unified Patent Court](#)

UPC Court of First Instance, Central Division Paris, 2 July 2024

(Haedicke)

UPC_CFI-484/2023

Order

of the Court of First Instance of the Unified Patent Court Central Division (Paris Seat)

lodged in the revocation action No. ACT_595045/2023 delivered on 2. July 2024

Applicant:

Nokia Technology GmbH, represented by its Managing Directors Marc Malten and Kristina Marie Vainio, Carl-Theodor-Strasse 6, 40213 Düsseldorf, Germany, [...]

– Plaintiff –

Representative: Rechtsanwalt Boris Kreye, Bird & Bird LLP, Maximiliansplatz 22, 80333 Munich, Germany

Defendant

Mala Technologies Ltd., represented by its Managing Director, Izhak Tamir, 41 Yosef Tzvi Street, 52312 Ramat Gan, Israel, [...]

– Defendant –

Representative: Rechtsanwalt Dr. Thomas Lynker, TALIENS Partnerschaft von Rechtsanwälten mbB, Amalienstrasse 67, 80799 Munich, Germany, thomas.lynker@taliens.com

and

German and European Patent Attorney Dr. Thomas Kurig, Becker Kurig & Partner Patentanwälte

PATENT AT ISSUE:

[EP 2 044 709 B1](#)

PANEL:

Panel 1 of the Central Division - Paris Seat

DECIDING JUDGE:

This order has been issued by the judge-rapporteur Maximilian Haedicke

LANGUAGE OF PROCEEDINGS:

English

SUBJECT MATTER OF THE PROCEEDINGS

Revocation action. Preliminary objection. Hearing Invitation

BACKGROUND

1. On 21. December 2023 Plaintiff has brought a revocation action against the patent at issue ([EP 2 044 709 B1](#)) before this Seat of the Unified Patent Court, registered as number ACT_595045/2023 UPC_CFI_484/2023. Service on Defendant has been effected on 17. January 2024.

2. On 17 March 2024 Defendant filed an Application to amend the patent within the Defence to revocation (p. 29 et seq., mn. 138 et seq.).

3. Defendant started the workflow for the Application to amend the patent on 13 May 2024 (No. App_26882/2024).

4. Plaintiff requests to reject Defendant's Application to amend as inadmissible, and to revoke the patent in suit in its entirety in the form of auxiliary requests 1 to 7. Plaintiff argues that Defendant's Application to amend is inadmissible because Defendant failed to initiate the correct workflow in the CMS in a timely manner. Defendant should have started the separate "Application to amend" workflow within the CMS and file its auxiliary requests therein at the same time as it lodged its Defence to revocation (see [R. 30.1 RoP](#)). Initiating a separate workflow is essential because [R. 55 RoP](#), in conjunction with [R. 32 RoP](#), establishes a different procedural timetable than the main proceedings. If an application to amend the patent is filed in violation of [R. 4.1, sentence 2 RoP](#), the legal consequence is that the application to amend must be rejected as inadmissible (see [MLD UPC CFI 15/2023, Order of 29/09/2023, p.9](#)).

5. Defendant requests to reject Plaintiff's request. Defendant argues that Auxiliary requests 1-7 were effectively introduced into the proceedings on 17 March 2024, along with the filing of the Defence to revocation, and thus not filed too late but filed within the deadline to file a defence. It does not follow from the Rules of Procedure that the Application to amend the patent in response to a revocation action is to be regarded as something separate from the Defence to revocation. And it does not follow from the Rules of Procedure that an Application to amend the patent is only admissible if filed in a separate workflow of the CMS.

GROUNDS FOR THE ORDER

6. Plaintiff's request to reject Defendant's Application to amend as inadmissible is denied. The Application to amend has been filed within the 2-month time limit of [R 49 \(1\), \(2\) RoP](#).

7. By filing the Application to amend in the same submission as the Statement of Defense, Defendant filed this request on 23 May 2024 and hence in a timely manner.

8. It does not unambiguously follow from the Rules of Procedure that the Application to amend the patent in response to a revocation action has to be filed in a separate workflow.

9. Article [29 \(a\) RoP](#) states:

"Within two months of service of a Statement of defence which includes a Counterclaim for revocation..."

The verb "include" may be interpreted to indicate that neither separate written pleadings nor the use of a separate workflow for the Application to amend the patent is required.

10. However, Article [4 \(1\) RoP](#) provides that

1. Written pleadings and other documents shall be signed and lodged at the Registry or relevant subregistry in electronic form. Parties shall make use of the official forms available online. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt."

This provision indicates that whenever a specific workflow is provided, this workflow is to be used. Hence, Article [4 \(1\) RoP](#) stipulates an obligation to use

the workflows provided by the CMS. However, this provision cannot justify Plaintiff's request to set aside the Application to amend the patent.

11. The Rules of Procedure have to be interpreted with reference to the principles of fairness and proportionality ([Preamble No. 2 RoP](#)). As stated in [ORD_19619/2024 ACT_580198/2023, UPC_CFI_367/2023](#), it is not readily apparent to the CMS user that the CMS requires an independent reaction to the Application to amend a patent by opening a separate workflow. Ambiguities arising from the CMS, particularly shortly after the launch of the UPC, should not be to the detriment of the parties and should not render a submission inadmissible (see also [Ordonnance ORD_25657/2024 ACT_578871/2023 UPC_CFI_360/2023](#)).

12. The Order [ORD 576853/2023 UPC CFI 15/2023](#) of the Munich Local Division which has been mentioned by Plaintiff states correctly that the parties are obliged under [rule 4.1 RoP](#) to use the correct workflow. The Order does not consider the submission to be inadmissible because the wrong workflow was used. The order left open whether in the future submissions filed in the wrong workflow may be inadmissible. This issue doesn't have to be decided in this order. At least for now the use of the wrong workflow does not render a submission inadmissible.

13. However, the parties are strongly encouraged to use the correct workflows in the future, as this makes the case management system more transparent and more accessible.

14. The arguments underlying the Application to amend were brought to the attention of the court and Plaintiff within the 2-month time limit of [R 49 \(1\), \(2\) RoP](#). No disadvantage arose for Plaintiff because Defendant failed to open a separate workflow.

15. Whether the patent in suit can be maintained as requested in any of the auxiliary requests 1, 2, 3, 4, 5, 6, or 7 ([R. 32.1\(b\) RoP](#)) will be decided in due course after the oral hearing.

ORDER

16. Plaintiff's request to reject Defendant's Application to amend as inadmissible is rejected.

17. Whether the patent in suit can be maintained as requested in any of the auxiliary requests 1, 2, 3, 4, 5, 6, or 7 ([R. 32.1\(b\) RoP](#)) will be decided in due course after the oral hearing.

The Judge-rapporteur

Maximilian Haedicke

REVIEW:

Pursuant to [Rule 333 RoP](#), the Order shall be reviewed by the panel on a reasoned application by a party. An application for the review of this Order shall be lodged within 15 days of service of this Order.

ORDER DETAILS

Order no. [ORD_33370/2024](#) in ACTION NUMBER: [ACT_595045/2023](#)

UPC number: [UPC_CFI_484/2023](#)

Action type: Revocation Action

Related proceeding no. Application No.: [29031/2024](#)

Application Type: Generic procedural Application
