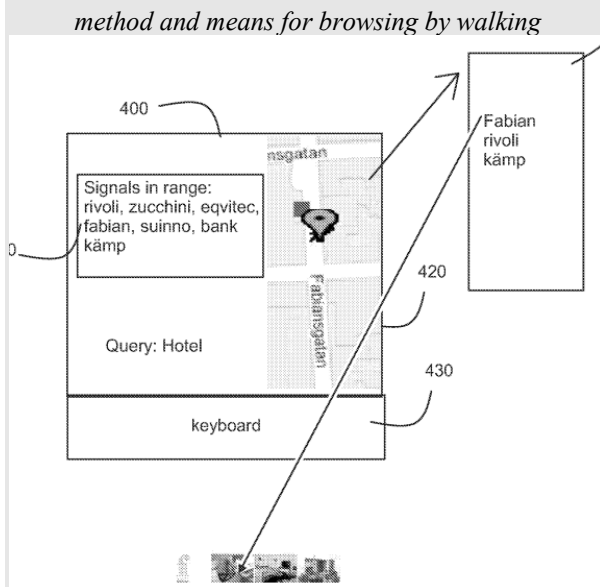


UPC CFI, Central Division, Paris Seat, 26 November 2024, Microsoft v Suinno

Confirmed in appeal:

IPPT20241223, UPC CoA, Microsoft v Suinno - II



PATENT LAW – PROCEDURAL LAW

Unconditional reduction of damages sought in an infringement action is a limitation of the claim that must be granted (R. 263(3) RoP)

- **if it is filed with due explanation and unconditionally and irrespective of the subjective intention underlying the application. No re-considering of already paid fees on an application lacking substantive argumentation**

The Court disagrees with the respondent, considering that even if the wording used by the applicant is not always clear and unambiguous from the comprehensive examination of the application it can be concluded that its subject matter is the grant of the leave for a change of the claim and not for the amendment of the value of the proceedings, which will be determined by the judge-rapporteur during the interim procedure pursuant to [Rules 22, 104](#) and [370 \(6\) 'RoP'](#).

The Court further notes that the subjective intention underlying the application does not play a role in the assessment of whether to grant the leave or not and that the applicant has justified the desired reduction of the damages sought with more accurate evidence on the consequences of the alleged infringement.

- 8. In addition, the applicant requests the Court to reconsider the fees already paid, pursuant to [Rule 263 \(4\) 'RoP'](#). However, the request lacks any substantive argumentation beyond a mere citation of the relevant provision, failing to provide the Court with any basis upon which to exercise its discretion to re-consider the amount of the fees. Therefore, this latter request cannot be granted.

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Central Division, Paris Seat, 26 November 2024**
(Catalozzi, Zhilova, Samoud)

ORDER

of the Court of First Instance of the Unified Patent Court Central division (Paris seat) issued on 26 November 2024 concerning the Application [RoP263](#) No. App_55394/2024 UPC_CFI_164/2024

HEADNOTES:

1. The reduction of the damages sought in an infringement action should be considered as a change of the claim, more precisely as a limitation of the claim, and if it is filed with due explanation and unconditionally must be granted by the Court, pursuant to [Rule 263 \(3\) 'RoP'](#).

APPLICANT:

Suinno Mobile & AI Technologies Licensing Oy - Fabianinkatu 21, 00130 Helsinki, Finland. represented by [...]

RESPONDENT:

Microsoft Corporation - One Microsoft Way, Redmond Washington 98052-6399, USA represented by Tilman Müller-Stoy, Bardehle Pagenberg

PATENT AT ISSUE:

European patent n° [EP 2 671 173](#)

PANEL:

Panel 2

Paolo Catalozzi Presiding judge and judge-rapporteur
Tatyana Zhilova Legally qualified judge
Wiem Samoud Technically qualified judge

DECIDING JUDGE:

This order has been issued by the panel.

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 10 October 2024 the applicant, claimant in the infringement action brought against the respondent before this Central Division, filed, pursuant to [Rule 263 of the Rules of Procedure \('RoP'\)](#), an application (registered as No. App_55394/2024) for leave "to change claim or to amend case" with regard to the amount of the damages sought which are now estimated at a reduced sum of 2 mln. euros. The claimant argues that this estimation is more accurate than the one on which the request in the statement of claim was based.
2. On 19 November 2024 the respondent filed an application (registered as No. App_61770/2024) requesting that the application for leave to amend the case is rejected. The respondent noted that: the application to amend the value in litigation does not fall within the scope of [Rule 263 'RoP'](#); the application was inadmissible, as it constitutes of a purely litigation driven tactic aiming to reduce the amount of the security for the costs which the applicant was ordered to provide that was based on the value of the case declared by the claimant; the requirements indicated in [Rule 263 'RoP'](#)

are not met as the applicant does not provide any valid explanation why the desired reduction of the value in litigation was not included in the original pleading.

GROUND FOR THE ORDER

3. **Rule 263 (1) 'RoP'** allows the parties to change its claim or to amend the case at any stage of the proceedings with the leave of the Court. **Rule 263 (2) and (3) 'RoP'** specify that leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot persuade the Court that the amendment could not have been made with reasonable diligence at an earlier stage and will not unreasonably hinder the other party in the conduct of its action and that leave to limit a claim in an action unconditionally shall always be granted.

4. These provisions serve the purpose of satisfying the need to safeguard the principle of efficiency in the proceedings without, however, compromising the right of defence of the opposing party.

5. A change of the claim may consist in a different claim than the one already proposed, as well as in the extension or reduction of the same claim in qualitative or quantitative terms. **In this regard, the reduction of the damages sought in an infringement action, as requested by the applicant, should be considered as a change of the claim, more precisely in a limitation of the claim, and must be granted by the Court, pursuant to **Rule 263 (3)**, as it is filed with due explanation and unconditionally.**

6. The respondent argues that the applicant filed an application to amend the value in litigation which does not fall within the scope of **Rule 263 'RoP'**. **The Court disagrees with the respondent, considering that even if the wording used by the applicant is not always clear and unambiguous from the comprehensive examination of the application it can be concluded that its subject matter is the grant of the leave for a change of the claim and not for the amendment of the value of the proceedings, which will be determined by the judge-rapporteur during the interim procedure pursuant to **Rules 22, 104 and 370 (6) 'RoP'**.**

7. **The Court further notes that the subjective intention underlying the application does not play a role in the assessment of whether to grant the leave or not and that the applicant has justified the desired reduction of the damages sought with more accurate evidence on the consequences of the alleged infringement.**

8. In addition, the applicant requests the Court to reconsider the fees already paid, pursuant to **Rule 263 (4) 'RoP'**. However, the request lacks any substantive argumentation beyond a mere citation of the relevant provision, failing to provide the Court with any basis upon which to exercise its discretion to re-consider the amount of the fees. Therefore, this latter request cannot be granted.

ORDER

The Court, having reviewed the application and heard the respondent's comments,
- grants Suinno Mobile & AI Technologies Licensing Oy leave to change the claim reducing the request for damages to € 2 mln.;

- rejects Suinno Mobile & AI Technologies Licensing Oy's request to re-consider the fees already paid.

Issued on 26 November 2024

The Presiding judge and judge-rapporteur

Paolo Catalozzi

The legally qualified judge

Tatyana Zhilova

The technically qualified judge

Wiem Samoud

ORDER DETAILS

Order no. ORD_62739/2024 in ACTION NUMBER: ACT_18406/2024

UPC number: UPC_CFI_164/2024

Action type: Infringement Action

Related proceeding no. Application No.: 55394/2024

Application Type: Application for leave to change claim or amend case/pleading (**RoP 263**)
