

**UPC CFI, Central Division Milan, 3 December 2024,
Pfizer v GlaxoSmithKline**



PATENT AND PROCEDURAL LAW

Request to decline the competence of the Milan Central Division for the revocation action rejected ([Article 33\(4\) UPCA](#))

CD Milan competent, partial overlap of parties

- [The revocation action does not concern the same parties as the infringement action.](#) Claimants 1 and 8 are not sued in the infringement proceedings. [...]. It follows, that there is only a partial overlap between the parties.

- [UPC lacks jurisdiction in infringement action before the grant of the patent \(article 97\(3\) EPC\)](#)

It follows that the UPC would appear not to have jurisdiction for an infringement action in relation to a patent, which is lodged, and hence brought in the context of [Art. 33 par. 4 UPCA](#), before the decision to grant the patent in suit has been mentioned in the European Patent Bulletin.

- [An infringement action that is inadmissible at the time it is lodged, and hence brought in the context of Art. 33 par. 4 UPCA, cannot challenge the competence of the Central Division concerning a revocation action based on the same patent](#)

No hearing before decision on Preliminary objection ([R. 19 RoP](#), [R. 264 RoP](#))

- [Where the parties have had many opportunities to discuss \(legal\) questions and the Court does not have further questions to the parties or need to discuss legal issues, the Court may desist from having an oral earing.](#)

In the present case, parties have submitted written statements in two proceedings. They have both discussed the legal issues which are relevant in this case. Thus, there is no need for an additional hearing in these preliminary proceedings.

No stay of revocation action until final decision on Preliminary objection ([R. 295 RoP](#))

- [The question of the validity of the patent will have to be dealt with in the infringement action, so there is no disadvantage for the defendant to proceed with this revocation action.](#)

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Central Division Milan, 3 December 2024**

(Postiglione, Klein, Wadskov-Hansen)

UPC_CFI_476/2024

Procedural Order

of the Court of First Instance of the Unified Patent Court delivered on 02/12/2024

Date of receipt of Statement of revocation : Not provided
GlaxoSmithKline Biologicals S.A.

(Defendant) –

Rue de l Institut 89 - 1330 –

Rixensart - BE

Statement of revocation served on 16/09/2024

REFERENCE CODE ECLI: Not provided

APPLICANT/S

1) GlaxoSmithKline Biologicals S.A.

(Applicant) - Rue de l Institut 89 - 1330 - Rixensart – BE

Represented by Daniela Kinkeldey

RESPONDENT/S

1) Pfizer Inc

(Respondent) - 66 Hudson Boulevard East - NY

10001-2192 - New York – US

Represented by Gareth Owen Williams

2) Pfizer Europe MA EEIG

(Respondent) - Boulevard de la Plaine 17 –

1050 - Ixelles – BE

3) Pfizer B.V.

(Respondent) - Rivium Westlaan 142 - 2909 LD -

Capelle aan den IJssel – NL

4) Pfizer S.A

(Respondent) - Boulevard de la Plaine 17 –

1050 - Ixelles – BE

5) Pfizer Manufacturing Belgium S.A

(Respondent) - Rijkweg 12 - 2870 - Puurs - BE

6) Pfizer Service Company S.R.L.

(Respondent) - Hoge Wei 10 - 1390 –

Zaventem – BE

7) Pfizer Pharma GmbH

(Respondent) - Friedrichstrasse 110 - 10117 –

Berlin – DE

8) Pfizer Ltd

(Respondent) - Ramsgate Road - CT13 9NJ –

Sandwich, Kent – GB

PATENT AT ISSUE

Patent no. Proprietor/s

[EP4183412](#) GlaxoSmithKline Biologicals S.A.

DECIDING JUDGES

This order has been issued by the Presiding Judge Andrea Postiglione, the Legally Qualified Judge Anna-Lena Klein and the Technically Qualified Judge Steen Lyders Wadskov-Hansen.

COMPOSITION OF PANEL – FULL PANEL

Presiding judge Andrea Postiglione

Judge-rapporteur Anna-Lena Klein

Technically qualified judge Steen Lyders Wadskov-Hansen

LANGUAGE OF PROCEEDINGS: English

SUBJECT-MATTER OF THE PROCEEDINGS:

Preliminary Objection

SUMMARY OF FACTS

On August 14th, 9 seconds past midnight, claimants

- (1) Pfizer Inc.
- (2) Pfizer Europe MA EEIG
- (3) Pfizer B.V.
- (4) Pfizer S.A.
- (5) Pfizer Manufacturing Belgium S.A.
- (6) Pfizer Service Company S.R.L.
- (7) Pfizer Pharma GmbH
- (8) Pfizer Limited

(referred to collectively as *Pfizer*”, except where otherwise stated) filed a revocation action against defendant GlaxoSmithKline Biologicals S.A. (referred to as “*Glaxo*” in the following), concerning EP 4 183 412, entitled “*RSV F protein compositions and methods for making same*” (referred to as “*EP412*”) with the Milan Central Division.

The revocation action was served to defendant on September 16th, 2024.

On August 5th, Glaxo had already filed an infringement action concerning the same patent against fourteen entities within the Pfizer Group with the LD Duesseldorf. Six of the entities sued in the infringement action act also as claimants in the revocation action. Two of the claimants in the revocation action (claimants 1 – Pfizer Inc., based in the USA, and 8 – Pfizer Limited, based in the UK) are not sued in the infringement action. On September 20th, 2024, Pfizer filed a preliminary objection in the infringement proceedings before the LD Duesseldorf.

The EPO Examining Division decided to grant the patent on July 18th, 2024 (see D3). The notice of the decision to grant the patent was published in the European Patent Bulletin on August 14th. On August 22nd, the EPO communicated to the patentee that the date of registration of unitary effect was August 22nd, 2024, and (referring to [Art. 4 par. 1 Regulation EU No. 1257/2012](#)), that the unitary effect took effect on the date of publication of the mention of the grant, i. e. August 14th, 2024.

Glaxo lodged a preliminary objection on October 15th, 2024, in the revocation proceedings, objecting to the competence of the Central Division (Section Milan) according to [R. 48, 19.1 lit. b\) RoP](#).

STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES

The Defendant (Glaxo) requests:

- I. to allow the Preliminary Objection according to [R. 21.1, s. 1 RoP](#);
- II. to issue the decision on the Preliminary Objection ([R. 20.1 RoP](#)); and
- III. to decline the competence of the Milan Central Division for the revocation action and to reject the revocation action as inadmissible ([Art. 33 para. 4 s. 2 UPCA](#)).
- IV. to stay the proceedings until there is a final decision on the Preliminary Objection ([R. 295 lit. m\) RoP](#));
- V. on an auxiliary basis, and in the event that the Court does not reject the revocation action as inadmissible as requested under III., to decline the competence of the Milan Central Division for the revocation action with

respect to Claimants 2 to 7 and to reject the revocation action with respect to Claimants 2 to 7;

VI. on an auxiliary basis, and in the event that the Court is not inclined to grant the Defendant’s requests under III. or V., to hear the parties in a hearing before a decision on the Preliminary Objection is taken ([R. 20, 48, 264 RoP](#));

VII. on an auxiliary basis, and in the event that the Court does not reject the revocation action as inadmissible with the final decision on the Preliminary Objection, the proceedings are stayed until the Defendants in the proceedings (ACT_45141/2024, UPC_CFI_468/2024) pending before the Düsseldorf Local Division of the Unified Patent Court have filed their statement of defence (and any counterclaim);

VIII. on an auxiliary basis, and in the event that the proceedings are not stayed as requested under IV. and VII., the deadline to lodge a defence to the revocation ([R.49.1 RoP](#)) is extended by one month ([R. 48](#) and [19.6 RoP](#)); i.e. until 16 December 2024;

IX. the Claimants are ordered to pay the costs of the proceedings ([Art. 69.1 UPCA](#));

X. the spelling of the Defendant be corrected to GlaxoSmithKline Biologicals SA (instead of GlaxoSmithKline Biologicals S.A. as indicated by the Claimant).

The Claimants (Pfizer) request that

a. The Court reject the Preliminary Objection and accept the patent revocation action as admissible;

b. The decision on the Preliminary Objection is issued as soon as practical in accordance with [Rule 20\(1\) RoP](#);

c. In the alternative, in the event that the Court is not inclined to reject the Defendant’s Preliminary Objection in its entirety, the Court stay its decision concerning the competence of the Milan Central Division for the revocation action with respect to Claimants 2 to 7 pending a final unappealable decision from the Court on the Preliminary Objection in related proceedings ACT_45141/2024, UPC_CFI_468/2024 ([Rule 295\(m\) RoP](#)) before the Düsseldorf Local Division; and

d. In the alternative, and in the event that the Court is not inclined to reject the Defendant’s Preliminary Objection in its entirety, to hear the parties in an oral hearing before a decision on the Preliminary Objection is taken in accordance with [Rules 20\(1\) & 264 RoP](#).

POINTS AT ISSUE

Glaxo is of the opinion that the Central Division does not have competence to decide on the validity of the patent in suit pursuant to [Art. 33 para. 4 UPCA](#) because of the existence of an earlier filed infringement action between the same parties and based on the same patent. Glaxo stipulates that this revocation proceedings and parallel counterclaim proceedings before the LD Duesseldorf would conflict with the principle of procedural economy, [R. 260.2 RoP](#). Glaxo maintains that the dispute must be heard by the Düsseldorf Local Division, the court first seized with the matter.

Glaxo maintains that their infringement action is admissible and the preliminary objection brought in the infringement action by Pfizer (claimants in this revocation action) is inadmissible due to the time

limitations of preliminary objections. Although the infringement action was brought before the mention of the grant of the EP was published, Glaxo maintains that Glaxo asserts the rights resulting from the granted patent in dispute only from the date of the publication of the mention of grant, i.e. 14 August 2024. Glaxo highlights that the patent in suit had already been granted at the time of service of the action on Pfizer in the infringement proceedings, and also at the time of the oral proceedings on the merits, which has not yet been scheduled by the Court. Glaxo stipulates that in fact the patent was already granted on 18th July, 2024, and only the effect of the grant depended on the publication. Glaxo is of the opinion that the scope and existence of rights are not uncertain once the decision to grant is taken. Rather, the decision is “*set in stone*”, and the formal grant pursuant to [Art. 97 par. 3 EPC](#) is simply an administrative procedure. Glaxo claims that Pfizer knew in advance what the scope of the patent would be, referring to the fact that 9 seconds after midnight on the date of formal grant, Pfizer was able to file a substantive revocation action. Glaxo is of the opinion that the handling of the case of 10x Genomics/Harvard vs. NanoString by the LD Munich and the CoA as well as the handling of the case of Alexion Pharmaceuticals vs. Amgen and Alexion Pharmaceuticals vs. Samsung Bioepis by the LD Hamburg confirm their opinion and that admissibility must generally (only) be present at the end of the oral proceedings.

Glaxo stresses that the actions concern the same patent and – in the correct broad interpretation of the word – the same parties. Glaxo highlights that identity between revocation claimants 2, 3, 4, 5, 6, and 7 and Defendants 1, 10, 5, 2, 14, and 3 in the infringement action is not disputed. According to Glaxo, it follows from this significant overlap between the parties that the Central Division does not have jurisdiction to decide on the revocation action which is, in Glaxo’s opinion, really about Pfizer’s RSV vaccine Abrysvo. Glaxo considers the possibility that Pfizer strategically decided to use multiple claimants although one would have sufficed and filed the action in the middle of the night in an attempt to circumvent the provisions of the UPCA, in particular [Art. 33 para. 4 s. 2 UPCA](#). Claimants 1 and 8 in this revocation action – both not defendants in the infringement action, and both located outside of the UPC Contracting member states – have not shown their “*concern*” by the patent in the sense of [Art. 47 par. 6 UPCA](#), Glaxo argues.

Pfizer maintains that their revocation action is admissible.

Pfizer stresses that their preliminary objection in the infringement proceeding is admissible and was lodged in time and that in fact the infringement action is inadmissible. Pfizer primarily contends that the UPCA and the RoP only relate to infringement actions in relation to granted patents, see [Art. 2](#), [Art. 83 UPCA](#), in accordance with [Art. 64](#), [97 par. 3 EPC](#).

The EPO Examining Division’s decision under [Article 97\(1\) EPC](#) does not assist Glaxo’s position, according to Pfizer. Pfizer stresses that such a decision does not

immediately result in a granted patent and, as such, did not directly provide Glaxo with the rights conferred by a granted patent. Pfizer highlights that the Examining Division’s decision explicitly states that the decision will only take effect on the date on which the European Patent Bulletin mentions the grant ([Art. 97\(3\) EPC](#)) and that the publication serves as the public notice of the grant.

Pfizer underlines that the decisions taken by the LD Hamburg/ Munich (referred to by Glaxo) may not serve as reference, since applications for preliminary relief may by their specific nature be distinguished from infringement proceedings. Neither the UPCA nor the Rules of Procedure provide basis for Glaxo’s assumption that for an infringement action to be admissible a patent need only be granted at the time of the oral hearing. The German system, Pfizer argues, is not comparable to the situation before the UPC. As such, the LD Munich (ORD_46277-2024 (UPC_CFI_74/2024)) held that the patent could not have been asserted before the day of its grant. The Court allowing (infringement or revocation) actions before the patent was granted might lead to a “*race to the Courthouse*”. This race could be held on unfair conditions since the patentee might have more insights into the grant procedure.

The term “*same parties*” should be interpreted strictly, and the Central Division should only decline their jurisdiction as far as the actual same parties were concerned, Pfizer maintains. Pfizer stipulates that claimants 1 and 8 are both concerned by the patent (cf. Reply to the PO, pages 10/11). Furthermore, [Art. 47 par. 6 UPCA](#) should be understood in a broad sense. Pfizer contends that the defendant does not need an extension of the “*usual*” timeline.

GROUND FOR THE ORDER

The preliminary objection is not well founded.

Admissibility

The Preliminary Objection is admissible. The requirements of [art. 19 RoP](#) are met.

On the merits

It is not well founded.

I. On requests I.- to III.-, to decline the competence of the Milan Central Division for the revocation action and to reject the revocation action as inadmissible

The request to decline the Central Division’s competence and to reject the revocation action as inadmissible is rejected because it is not well founded. The infringement action before the LD Duesseldorf and the revocation action before the Central Division Milan do not relate to “the same parties” in the sense of [Art. 33 par. 4 UPCA](#).

1. [Article 33 par. 4 of the UPCA](#) states:

Actions referred to in [Article 32\(1\)\(b\) and \(d\)](#) shall be brought before the central division. If, however, an action for infringement as referred to in [Article 32\(1\)\(a\)](#) between the same parties relating to the same patent has been brought before a local or a regional division, these actions may only be brought before the same local or regional division.

“Parties” in the sense of [Art. 33 par. 4 UPCA](#) relates to legal entities. The term may not be understood in a broad sense as to refer to “entities belonging to the same corporate group” (see, in this tendency, [CD Paris, order of 13 November 2023, Meril Italy – Edwards Lifesciences, ACT 551308/2023, UPC CFI 255/2023, App 572915/2023](#), marginal 41, 42).

“Same parties” means that there is identity of parties as between the two actions. A partial overlap between the parties is not enough to find for a situation of [Art. 33 par. 4 s. 2 UPCA](#). Each party must be considered independently when considering if the parties of a revocation action and of an infringement action are the “same” in the sense of [Art. 33 par.4 s.2 UPCA](#).

The case decided by the [LD Paris in UPC CFI 440/2023 \(order dated 24 July 2024\)](#), referred to by the defendant, does not take a broader approach for the definition of the term “same parties”, but decided to proceed with their case based on several special circumstances present in that case.

2. As such, the revocation action does not concern the same parties as the infringement action. Claimants 1 and 8 are not sued in the infringement proceedings. While the decision if Claimants 1 and 8 have a right to sue in the present revocation action is not a question of admissibility but of the merits, and while they are not (as Glaxo states) “concerned by the infringement action”, nothing indicates that they are not concerned by the patent in suit, c.f. [Art. 47 UPCA](#). Consequently, as a starting point they appear to have a right to sue in this revocation action. It follows, that there is only a partial overlap between the parties.

II. On request V.-, request to decline the competence of the Milan Central Division for the revocation action with respect to Claimants 2 to 7 and to reject the revocation action with respect to Claimants 2 to 7

Request V.- to decline the competence of the Milan Central Division for the revocation action with respect to Claimants 2 to 7 and to reject the revocation action with respect to Claimants 2 to 7 is not well founded either.

The infringement action that was lodged before the patent in suit was granted appears to have been inadmissible at the time it was brought and thus may not challenge the Central Division’s competence to hear the revocation action.

1. Legal background

a) An infringement action is “brought” before a division in the sense of [Art. 33 par. 4 UPCA](#) when it is lodged ([CD Munich, UPC-CFI 1/2023, order issued on 24.08.2023, Sanofi-Aventis v Amgen, marginal 4.22 et sequi](#)). Service or a subjective element like knowledge of the action is not required to fulfil the term “brought”. Likewise, the requirement for an assessment of the respective actions in two (or more) divisions of the UPC at a later point in time would complicate the proceedings and would make the outcome inherently less predictable, which is to be avoided.

b) The UPC only has jurisdiction for actions for infringements of granted patents.

The UPC has jurisdiction for actions for infringements of patents, [Art. 32 par. 1, lit. \(a\) UPCA](#). “Patent” in this sense is an EP or an EP with unitary effect, [Art. 2 lit. \(g\) UPCA](#). The term “European Patent” refers to a patent granted under the provisions of the EPC, [Art. 2 lit. \(e\) UPCA](#), while “European Patent with unitary effect” refers to a patent granted under the provisions of the EPC which benefits from unitary effect by virtue of [Regulation \(EU\) 1257/2012, Art. 2 lit. \(f\) UPCA](#).

c) A patent is granted under the EPC, when the decision to grant the patent is mentioned in the European Patent Bulletin.

A patent is only granted once the decision to grant the patent is mentioned in the European Patent Bulletin, [Art. 97 par. 3 EPC](#). (Only) From this date, a European patent shall confer exclusive rights on the patentee, [Art. 64 par.1 of the EPC](#). The effects of a unified patent only enter into force once the decision to grant the patent is mentioned in the European Patent Bulletin, [Art. 4 par. 1 regulation 1257/2012](#).

The decision of the EPO to grant the patent as such is, thus, not decisive for the exclusive effects the patent confers. Between the time of the decision to grant a patent and the mention of the decision to grant the patent, proceedings for grant are still considered to be pending under the EPC. Hence, proceedings can still be suspended (cf. J 7/96, IIC 1999, 796), the applicant can still file divisional applications under [R 36 par.1 Implementing Regulations to the EPC](#), and the application may be transferred to another proprietor. Thus, the final form of the patent is not final when the decision to grant the patent is taken by the EPO. Hence, as a matter of principle – and setting aside the specific circumstances of the present case – a patent, which the EPO has decided to grant, will not necessarily mature into a right on the date foreshadowed in the decision issued by the examining division or with the proprietor listed in the EPO register when the EPO decides to grant a patent. Even if such a chain of events may be very probable, it cannot be concluded a priori that this is necessarily what will happen. Regardless, taking as point of departure the examining division’s decision to grant as regards the jurisdiction of the UPC would at least require an assessment at a later point in time that would make the outcome inherently less predictable, which is to be avoided. Hence this is a non sequitur; there is no direct connection between neither the proprietor nor the date of the mention of grant set out in the decision to grant issued by the examining division and the actual proprietor and the actual date of the mention of grant of the patent, respectively. It follows, especially with a view to the necessity to ascertain legal certainty not only for the patentee, but also the public, that the mention of the decision to grant the patent in the European Patent Bulletin is the decisive act.

d) It follows that the UPC would appear not to have jurisdiction for an infringement action in relation to a patent, which is lodged, and hence brought in the context of [Art. 33 par. 4 UPCA](#), before the decision to grant the

patent in suit has been mentioned in the European Patent Bulletin.

e) It appears that Pfizer did not submit to the jurisdiction and competence of the LD Duesseldorf.

As stated by [Rule 19.7 RoP](#), the defendant's failure to lodge a preliminary objection within the specified time period shall be treated as a submission to the jurisdiction and competence of the Court and the competence of the division chosen by the claimant. As stated by [Rule 271.6\(b\) RoP](#), where service takes place by registered letter (...) such letter shall be deemed to be served on the addressee on the tenth day following posting. This presumption of service may be rebutted ("unless (...)"). However, this possibility of rebuttal refers to the position of the addressee to guarantee his rights where service actually took place later or not at all. Thus, even if service was effected earlier, the addressee is deemed to have been served on the 10th day after posting (cf. [LD Munich, order of August 25th, 2023, UPC CFI 52/2023, Tesla v. Avago](#)).

The Court's Case Management System ("CMS") confirms that Glaxo's Statement of Claim in the Infringement Proceedings was provided to the courier for postage on 12 August 2024 (with respect to Pfizer Defendants 3 and 9) and on 26 August 2024 (with respect to all other Pfizer Defendants).

The Court's CMS further confirms that Glaxo's Statement of Claim in the Infringement Proceedings was delivered to each of the Pfizer Defendants on the following dates:

Pfizer Defendant 3 - 14 August 2024

Pfizer Defendant 9 - 16 August 2024

Pfizer Defendants 1, 2, 5, 8, 13 and 14 - 28 August 2024

Pfizer Defendants 4, 6, 10 and 12 - 29 August 2024

Pfizer Defendant 11 - 30 August 2024

Pfizer Defendant 7 - 4 September 2024.

Thus, the infringement action seems to be deemed served only on August 22nd, so the time period to lodge the preliminary objection in the infringement proceedings seems to have expired only on September 22nd, 2024. The preliminary objection was lodged before that date.

f) An infringement action that is inadmissible at the time it is lodged, and hence brought in the context of [Art. 33 par. 4 UPCA](#), cannot challenge the competence of the Central Division concerning a revocation action based on the same patent.

An infringement action that is lodged, and hence brought in the context of [Art. 33 par. 4 UPCA \(CD Munich, UPC-CFI 1/2023, order issued on 24.08.2023, Sanofi-Aventis v Amgen\)](#), before the date of the grant of the patent appears to be inadmissible.

At this point, the Panel does not need to decide if an infringement action that is lodged before the mention of the grant in the EPO bulletin can "grow" into admissibility or not, or if so when such a "growth" would happen. As such, this Panel does not need to await the decision of the LD Duesseldorf. If the LD Duesseldorf decides that the infringement action is admissible, this decision does not have a bearing on the Central Division's competence: It is clear that an action

that is inadmissible at the time it is lodged, and hence brought in the context of [Art. 33 par. 4 UPCA](#), cannot challenge the Central Division's competence according to [Art. 33 par. 4 UPCA](#). [Art. 33 par. 4 UPCA](#) is based on the endeavour to find an efficient way to deal with parallel proceedings, while also taking into account the interests of the parties to have their case heard before a certain UPC division. As is stated in the [preamble of the UPCA](#), the Agreement is based on the principles of legal certainty, finding a fair balance between the interests of right holders and other parties and takes the need for proportionality and flexibility into account. As such, [Art. 33 par. 4 UPCA](#) clearly refers to a situation where both the infringement action and the revocation action are filed on the day the patent grant is mentioned in the EPO Bulletin or later. Otherwise, there would be no fair balance between the interests of the parties: A certain division's competence might depend on which party had raced to the Courthouse first and lodged a given action. Since the EPO's decision to grant the patent might reach the applicant before the public or any other party would be made aware of the situation, there could be an advantage for the applicant in this race to the Courthouse. Furthermore, there is no direct connection between neither the proprietor nor the date of the mention of grant set out in the decision to grant issued by the examining division and the actual proprietor and the actual date of the mention of grant of the patent, respectively. Thus, the well-balanced allocation of competences according to the UPCA could be challenged if the Court allowed early lodging of patent infringement actions to have any bearings on the competence according to [Art. 33 UPCA](#).

Since the Panel's decision is not related to whether an early lodged infringement case can under certain conditions grow into admissibility in the context of the merits of a given case, the decisions from the LD Munich (and the subsequent decision from the CoA) and the LD Hamburg referred to by the defendant are not relevant to this case. Additionally, the decisions did not deal with competence issues relating to parallel proceedings and were taken in preliminary proceedings. 2. With a view to the legal principles set out above, the infringement action before the Local Division Duesseldorf appears to have been inadmissible at the time it was brought/ lodged and therefore appears not to be capable to challenge this division's competence. The infringement action was brought/ lodged on August 5th, 2024, thus before the date the decision to grant the patent in suit was mentioned in the European Patent Bulletin on August 14th .

The infringement action thus appears to have been inadmissible on the day it was lodged. The revocation action was brought/ lodged on August 14th, thus on the date of the mention of the decision to grant the patent in the European Patent Bulletin. It appears to be, as such, admissible.

Since an infringement action that is inadmissible at the day it was lodged cannot challenge the Central division's competence regarding a revocation action relating to the same patent, even insofar as the two actions concern the

same parties, the revocation action is admissible. The request must be rejected.

III. Regarding request VI., to hear the parties in a hearing before a decision on the Preliminary Objection is taken (R. 20, 48, 264 RoP)

The request is rejected. There is no need to hear the parties in a hearing before this decision is taken

Rule 19, Rule 264 RoP clarifies that the Court may provide an opportunity to be heard either by request to provide written submissions or by inviting the parties to an oral hearing. Where the parties have had many opportunities to discuss (legal) questions and the Court does not have further questions to the parties or need to discuss legal issues, the Court may desist from having an oral hearing.

In the present case, parties have submitted written statements in two proceedings. They have both discussed the legal issues which are relevant in this case. Thus, there is no need for an additional hearing in these preliminary proceedings.

IV. On request IV., to stay the proceedings until there is a final decision on the Preliminary Objection (R. 295 lit. m) RoP)

The request to stay the proceedings until there is a final decision on the Preliminary Objection (R. 295 lit. m) RoP) is rejected.

According to Rule 295 lit. (m) RoP, the Court may stay the proceedings in any (other) case where the proper administration of justice so requires. When deciding on a unilateral request to stay proceedings, the Court needs to take the interests of both sides into account. One of the underlying principles of the UPCA is the endeavour to provide fast decisions, which is clarified by the timelines set out in the RoP, while at the same time providing proportionality and flexibility (Preamble of the UPCA; see also UPC CFI, Central Division Paris, UPC CFI-361/2023, order of April 25th, 2024, marginal 1).

As is clear from Rule 19 par. 6 RoP, the lodging of a preliminary objection generally does not have any effect on the time periods of the proceedings. Thus, it is the general concept that the lodging of a preliminary objection shall not be the basis for a stay of the proceedings (see also UPC CFI, Central Division Paris, UPC CFI-361/2023, order of April 25th, 2024, marginal 2). In this case, the claimants' interest to expeditious proceedings outweighs the interests of the defendant not to proceed with the revocation action. Even if the CoA finds this revocation action inadmissible (should the LD have a different position from this CD), the question of the validity of the patent will have to be dealt with in the infringement action, so there is no disadvantage for the defendant to proceed with this revocation action.

V. On request VII., to stay proceedings until the Defendants in the proceedings (ACT_45141/2024, UPC_CFI_468/2024) pending before the Düsseldorf Local Division of the Unified Patent Court have filed their statement of defence (and any counterclaim)

The request to stay proceedings until the Defendants in the proceedings (ACT_45141/2024,

UPC_CFI_468/2024) pending before the Düsseldorf Local Division of the Unified Patent Court have filed their statement of defence (and any counterclaim) is rejected. The state of the proceedings in Duesseldorf are unknown to the panel. If the infringement action is deemed inadmissible, there might not be a statement of defence to file. As such, the interest of the claimants to proceed with the revocation action for now outweigh the interest of the defendant to stay the proceedings. The need to be able to react to possible discussions laid out in a possible statement of defence in the infringement proceedings is taken into account by the fact that the time period to lodge the statement of defence to revocation has already been extended. As made clear in the order issued on November 14th, upon justified request, the time period could be extended again.

The parties are invited to inform the Judge Rapporteur on the state of infringement proceedings before the LD Duesseldorf, if they deem it necessary.

VI. On request IX, that Claimants are ordered to pay the costs of the proceedings (Art. 69.1 UPCA)

The costs of the proceedings shall be dealt with in the main proceedings.

VII. On request X., that the spelling of the Defendant be corrected to GlaxoSmithKline Biologicals SA (instead of GlaxoSmithKline Biologicals S.A. as indicated by the Claimant)

The spelling of the defendant shall be corrected to GlaxoSmithKline Biologicals SA. The spelling is to be corrected because of an obvious error. The claimants did not object to defendant's request.

ORDER

For these grounds, having heard the parties on all aspects of relevance for the following order, the Court

I. Rejects the request to allow the preliminary objection, to decline the competence of the Milan Central Division for the revocation action and to reject the revocation action as inadmissible.

II. Rejects the auxiliary request to decline the competence of the Milan Central Division for the revocation action with respect to Claimants 2 to 7 and to reject the revocation action with respect to Claimants 2 to 7;

III. Rejects the auxiliary request to hear the parties in a hearing before a decision on the Preliminary Objection is taken (R. 20, 48, 264 RoP);

IV. Rejects the request to stay the proceedings until there is a final decision on the Preliminary Objection (R. 295 lit. m) RoP);

V. Rejects the auxiliary request that the proceedings are stayed until the Defendants in the proceedings (ACT_45141/2024, UPC_CFI_468/2024) pending before the Düsseldorf Local Division of the Unified Patent Court have filed their statement of defence (and any counterclaim);

VI. States that costs shall be dealt with in the main proceedings;

VII. Corrects the spelling of the Defendant to GlaxoSmithKline Biologicals SA.

INSTRUCTIONS TO THE REGISTRY

The spelling of the Defendant shall be corrected to GlaxoSmithKline Biologicals SA.

INFORMATION ABOUT APPEAL

Leave to appeal is granted.

This order may be appealed together with the appeal against the final decision of the Court of First Instance in the main proceedings, or be appealed within 15 days of service of the Court's decision to that effect ([Art. 73 \(2\)\(b\) UPCA](#), [Rules 21 \(1\)](#), [220\(2\)](#), [224\(1\) RoP](#)).

ORDER DETAILS

Order no. ORD_58802/2024 in ACTION NUMBER:

ACT_45928/2024

UPC number: UPC_CFI_476/2024

Action type: Revocation Action

Related proceeding no. Application No.: 56246/2024

Application Type: Preliminary objection
