

UPC CFI, Local Division Milan, 15 January 2025,
Dainese v Alpinestars



PATENT LAW – PROCEDURAL LAW

Instead of staying the proceedings, the deadline for the statement of defence and any counterclaims is extended to 27.2.2025 ([R. 9 RoP](#), [R. 295 RoP](#))

- [because of oral hearing in the EPO appeals proceedings scheduled for 13 February 2025](#)

[...]. allows for a more overall procedural efficiency, on one hand not staying this proceedings – in the power of the Court - and on the other hand waiting for the upcoming EPO's decision.

- [Possibility of further exchange of written pleadings \(R. 36 RoP\)](#)

On a reasoned request by the other parties, both the plaintiff and the other defendants, they may be granted a period within which to submit their observations on the EPO's decision, in accordance with the procedural faculty provided for in [Rule 36 of the Rules of Procedure](#). It follows that the solution adopted does not violate the adversarial principle and complies with the equality of the parties in the right of defence;

Source: [Unified Patent Court](#)

UPC Court of First Instance,
Local Division Milan, 15 January 2025
(Zana)

UPC_CFI_402/2023

UPC_CFI_472/2024

Procedural Order

of the Court of First Instance of the Unified Patent Court
delivered on 15/01/2025

Order no. ORD_1495/2025

Dainese S.p.A Claimant

against

Alpinestars S.p.A. Defendant 1

Alpinestars Research S.p.A. Defendant 2

Omnia Retail S.r.l. Defendant 3

Horizon Moto 95 - Maxxess Cergy Defendant 4

Zund.Stoff Augsburg/Ulrich Herpich E.K. Defendant 5

Motocard Bike S.l. Defendant 6

PATENT AT ISSUE

Patent no. Proprietor/s

[EP4072364](#) Dainese S.p.A.

[EP3498117](#) Dainese S.p.A.

DECIDING JUDGE

Judge-rapporteur Alima Zana

COMPOSITION OF PANEL – FULL PANEL

Presiding judge Pierluigi Perrotti

Judge-rapporteur Alima Zana

Legally qualified judge Anna-Lena Klein

Technically qualified judge Graham Ashley

LANGUAGE OF PROCEEDINGS: English

Headnotes

1. The coordination between the appeals proceedings before the EPO and the proceedings before UPC may be achieved in the most efficient way, taking into account the position of all parties, for instance by extending the time limits for filing the statement of defence and the counterclaim for revocation, allowing for a more overall procedural efficiency, on one hand not staying the proceedings – in the power of the Court – and on the other hand waiting for the upcoming EPO's decision.

2. On a reasoned request, the other parties may be granted a deadline within which to submit their observations on the EPO's decision, in accordance with the procedural faculty provided for in [Rule 36 of the Rules of Procedure](#). It follows that the solution adopted does not violate the adversarial principle and complies with the equality of the parties in the right of defence. The principle of efficiency is therefore guaranteed, at the same time guaranteeing the right to a full adversarial principle, which takes the form of knowledge and examination of the decisions of the EPO.

Keywords. [Rule 9 RoP](#). [Rule 118 RoP](#); [Rule 295 let.](#)

[A, RoP](#), (iv) [Art. 33\(10\) UPCA](#) (“ Summary of facts On 9 January 2025, Alpinestars S.p.A. (defendant n. 1) filed an application under [rule 9 RoP](#) requesting to extend the deadline for filing its Statement of Defense and counterclaim for revocation under [Rule 23 RoP](#) until 27 February 2025. The applicant specified that:

- the deadline for filing the Statement of defense for Defendant 1 currently is set to expire on 20 January 2025;

- In parallel, the oral hearing in the appeals proceedings regarding the opposition against EP 3 498 117 (“EP 117”) brought by Defendant 1 before the EPO is currently scheduled for 13 February 2025. We are submitting the summons to the hearing;

- This is also in the interest of Claimant and the overall procedural efficiency, since the EPO hearing would generally be sufficient grounds for a stay of the proceedings in accordance with [Art. 33\(10\) UPCA](#) and [R. 295 \(a\) RoP](#), as the decision by the EPO is expected to be given “*rapidly*” in the understanding of the case law of the [Court of Appeal \(see, e.g., UPC CoA 511/2024, APL 50205/2024\)](#). The moderate extension, also, does not contravene the overall goal to conclude the proceedings expeditiously. A hearing has not yet been scheduled in the present case. Therefore, granting the extension will result in a better position for Claimant compared to the potential stay; By order filed on 9 January 2025, the Judge rapporteur invited the other parties to comment the application.

1. The coordination between the appeals proceedings before the EPO and the proceedings before UPC may be achieved in the most efficient way, taking into account the position of all parties, for instance by extending the time limits for filing the statement of defence and the counterclaim for revocation. allowing for a more overall

procedural efficiency, on one hand not staying the proceedings – in the power of the Court- and on the other hand waiting for the upcoming EPO's decision.

2. On a reasoned request, the other parties may be granted a deadline within which to submit their observations on the EPO's decision, in accordance with the procedural faculty provided for in Rule 36 of the Rules of Procedure. It follows that the solution adopted does not violate the adversarial principle and complies with the equality of the parties in the right of defence. The principle of efficiency is therefore guaranteed, at the same time guaranteeing the right to a full adversarial principle, which takes the form of knowledge and examination of the decisions of the EPO.

On 14 January 2025 the Plaintiff requested that:

- the Court deny the Defendant 1's request to postpone the deadline for filing the Statement of Defence.
- the Court shall grant a seven-day extension from 13 February 2025, moving the deadline for filing the Statement of Defence from 20 January 2025 to 20 February 2025.

Dainese specified that:

- although Defendant 1 has been aware of the date of the oral hearing in the appeal proceedings concerning the opposition against EP 3 498 117 ('EP 117') since 2 September 2024 (Exhibit 81), Alpinestars SpA did not file his request until 8 January 2025, i.e. very close to the deadline for filing the statement of defence, set - as mentioned - for 20 January 2025;
- in case of acceptance of Defendant 1's request, Alpinestars S.p.A will be the only party in the position "to properly address the decision of the Board of Appeal and to include the outcome of the EPO proceedings in its statement of defence, putting Defendant 1 in an advantageous position not only with respect to the Plaintiff but also with respect to the other Defendants;
- in line of UPC case law, the mere fact that the EPO has granted a request to accelerate the opposition proceedings is not sufficient to stay revocation proceedings before the UPC" (UPC CoA 22/2024, Carrier v BITZER Electronics).

General consideration

This order is adopted in accordance with:

- (i) the following principles set out in the Preamble 2 of the RoP - proportionality, flexibility and fairness;
- (ii) Rule 9, para 4, ROP ("Subject to paragraph 4, on a reasoned request by a party, the Court may: (a) extend, even retrospectively, a time period referred to in these Rules or imposed by the Court; and (b) shorten any such time period. 4. The Court shall not extend the time periods referred to in Rules 198.1, 213.1 and 224.1");
- (ii) Rule 118 RoP the Court (...) (b) may stay the infringement proceedings pending a decision in the revocation procedure or a decision of the European Patent Office and shall stay the infringement proceedings if it is of the view that there is a high likelihood that the relevant claims of the patent will be held to be invalid on any ground by the final decision in the revocation proceedings or of the European Patent Office where such decision of the European Patent Office may be expected to be given rapidly

(iii) Rule 295 let. A, RoP "(The Court may stay proceedings where it is seized of an action relating to a patent which is also the subject of opposition proceeding or limitation proceedings (...) before the European Patent Office)".

(iv) Art. 33(10) UPCA ("A party shall inform the Court of any pending revocation, limitation or opposition proceedings before the EPO, and of any request for accelerated processing before the EPO. The Court may stay its proceedings when a rapid decision may be expected from the EPO").

The case at hand

The mandatory coordination between the appeals proceedings before the EPO and the proceedings before the UPC in this case may be achieved in the most efficient way, taking into account the position of all parties, by extending the time limits for filing the statement of defence and the counterclaim for revocation.

The Judge rapporteur notes that the requested extension allows for a more overall procedural efficiency, on one hand not staying this proceedings – power of the Court- and on the other hand waiting for the upcoming EPO's decision.

The principle of efficiency is therefore guaranteed, at the same time guaranteeing the right to a full adversarial principle, which in the present case also takes the form of knowledge and examination of the decisions of the EPO.

Dainese's exceptions are unfounded having regard that:

- the solution adopted is not merely to stay the proceedings, but a flexible solution, respecting the procedural rights of all parties;
- On a reasoned request by the other parties, both the plaintiff and the other defendants, they may be granted a period within which to submit their observations on the EPO's decision, in accordance with the procedural faculty provided for in Rule 36 of the Rules of Procedure. It follows that the solution adopted does not violate the adversarial principle and complies with the equality of the parties in the right of defence;

- Defendant 1's procedural choice to request an extension of the deadline only in January 2025 will not lead to any significant delay in the proceedings, taking into account in any event the need to verify the outcome of the proceedings before the EPO.

Finally, the extension until 27 February 2025 appears to be consistent with the need to await the EPO's decision, examine it and prepare appropriate defences before the Court.

ORDER

the deadline for Alpinestars S.p.A (the Defendant n. 1) to lodge their statement of defences and any counterclaims is extended to 27.2.2025.

Milan, 15 January 2025

The judge rapporteur

Alima Zana

ORDER DETAILS Order no. ORD_1495/2025 in ACTION NUMBER: ACT_45469/2024

UPC number: UPC_CFI_472/2024

Action type: Infringement Action

Related proceeding no. Application No.: 1176/2025
Application Type: Generic procedural Application
