UPC CFI, Local Division Düsseldorf, 19 December 2023, Nutricia v Nestlé

PATENT LAW – PROCEDURAL LAW

Procedural order to hear both the infringement action and the counterclaim for revocation (Article 33(3)(a) UPCA; Rule 37 RoP).

- **Such a joint hearing of the infringement action and the counterclaim seems to be appropriate in particular for reasons of efficiency. It is also preferable because it allows both issues – validity and infringement – to be decided on the basis of a uniform interpretation of the patent by the same panel composed of the same judges**.
- Although validity and infringement issues in the chemical/pharmaceutical field can be demanding, the panel is composed of judges who are very experienced in patent law and familiar with difficult issues in this context. The assignment of the TQJ, who is experienced in the technical field in question, ensures that the Local Division is undoubtedly capable of deciding both matters.

Source: Unified Patent Court

UPC Court of First Instance,
Local Division Düsseldorf, 19 December 2023
(Thomas, Thom, Agergaard and Hedberg)
Düsseldorf Local Division
UPC_CFI_201/2023
Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 14 December 2023
concerning EP 2 359 858
CLAIMANT:
N.V. Nutricia, Eerste Stationsstraat 186, 2712 HM Zoetermeer, Netherlands, represented by the Managing Director …
represented by: Prof. Dr. Nils Heide, Dr. Jan Wohlfahrt, Angelika Link, Gleiss Große Schrell und Partner mbB, Leitzstraße 45, 70469 Stuttgart, Germany
electronic address for service: …
DEFENDANT:
Nestlé Health Science (Deutschland) GmbH, Lyoner Straße 23, 60528 Frankfurt/Main, Germany, represented by the Managing Directors … and … , Germany
represented by: Dr. Matthias Meyer, Dr. Daniel Misch as well as patent attorneys Dr. Daniela Kinkeldey, Dr. Anne Halbach, Bird & Bird LLP, Carl-Theodor-Straße 6, 40213 Düsseldorf
electronic address for service: …
PATENT AT ISSUE:
European patent n° EP 2 359 858
PANEL/DIVISION:
Panel of the Local Division in Düsseldorf
DECIDING JUDGES:
This Order has been issued by the presiding judge Thomas, the legally qualified judge Dr Thom, the legally qualified judge Agergaard and the technically qualified judge Hedberg.
LANGUAGE OF THE PROCEEDINGS:
English
SUBJECT OF THE PROCEEDINGS:
R. 37.1 RoP, art. 33(3) UPCA.
GROUNDS FOR THE ORDER:
Since the parties did not raise any objections after being heard, the question of the procedure to be followed with regard to Art. 33(3) UPCA could already be decided before the closure of the written procedure, with the result to decide according to Art. 33(3) UPCA.
In general, an earlier decision under Art. 33(3) UPCA seems justified in the current situation of the Court, which is still under construction. Since some members of the panel are currently only employed on a part-time or case-by-case basis, it seems appropriate for reasons of procedural efficiency to obtain the assignment of the technically qualified judge (TQJ) at an early stage. Then he/she can be involved in the case management as soon as possible. Otherwise, there would be a considerable risk of delay if the TQJ was not appointed before the interim procedure and therefore could not be included in the timetable at an early stage. In this case, although the TQJ has already been appointed as a result of the application under R. 33 RoP these arguments still apply. An early decision on the bifurcation issue will set the framework for possible questions. This will enable the parties and the Court to manage the case accordingly.
In the present case, the Local Division exercises its discretion to hear both the infringement action and the counterclaim for revocation (Art. 33(3)(a) UPCA). Such a joint hearing of the infringement action and the counterclaim seems to be appropriate in particular for reasons of efficiency. It is also preferable because it allows both issues – validity and infringement – to be decided on the basis of a uniform interpretation of the patent by the same panel composed of the same judges. Although validity and infringement issues in the chemical/pharmaceutical field can be demanding, the panel is composed of judges who are very experienced in patent law and familiar with difficult issues in this context. The assignment of the TQJ, who is experienced in the technical field in question, ensures that the Local Division is undoubtedly capable of deciding both matters.
ORDER:
For these grounds, after having heard the parties, the Court of First Instance of the Unified Patent Court, the Local Division in Düsseldorf, orders that it shall proceed with both the action for infringement and the counterclaim for revocation.
Issued in Düsseldorf, 19 December 2023

NAMES AND SIGNATURES
Presiding judge Thomas
Legally qualified judge Dr Thom
Legally qualified judge Agergaard
Technically qualified judge Hedberg
DETAILS OF THE ORDER:
ORD_589338/2023 related to the mai
DETAILS OF THE ORDER:
ORD_589338/2023 related to the main proceeding ACT_544303/2023
UPC-Number: UPC_CFI_201/2023
Subject of the Proceedings: Patent infringement action – Counterclaim for revocation

---