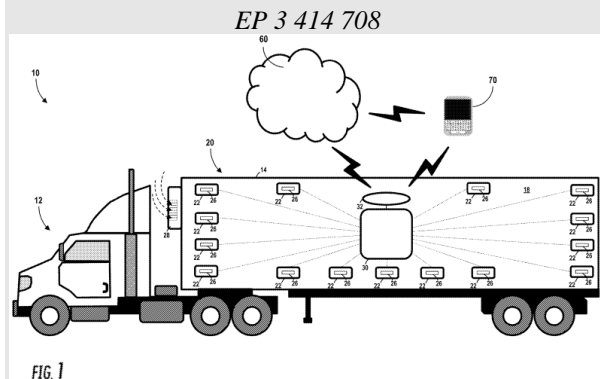


**UPC CFI, Central Division Paris, 30 April 2024,  
Carrier v Bitzer Electronics**



**PATENT LAW – PROCEDURAL LAW**

**Application to amend the patent in the Defence to  
(the Counterclaim for) revocation**

- **must refer to claims that have been challenged and is therefore inadmissible to the extent it concerns unchallenged claims (Rule 30 RoP, Rule 50 RoP)**

18. No provision contained in the ‘RoP’, the ‘EPC’ or other relevant sources of law (as indicated in [Article 24 ‘UPCA’](#)) explicitly addresses the issue of amending a claim that has not been challenged; therefore, the relative assessment has to be carried out taking into account the general principles governing proceedings before the Unified Patent Court, the principles of proportionality, flexibility, fairness and equity, which guide the interpretation of the ‘RoP’, and the reported rationale of the provisions relating to the right to amend a patent.

19. In the framework of the Unified Patent Court procedural provisions, the patent amendment during litigation serves as a tool that the patent proprietor may use in order to react to an invalidity challenge and, therefore, to avoid a declaration of invalidity of the patent – total or partial –, while preserving enough scope of the title to prevent infringements. From a strictly procedural standpoint, hence, it functions as a defence for the patent proprietor to counter the invalidity claim lodged by a third party.

20. The nature of the right to amend the patent during litigation as a mere defence leads to the conclusion that the patent may be amended only to the extent that it is necessary to react to the invalidity challenge; this allows the proprietor to preserve patent validity through claim modifications, ultimately aiming for rejection of the invalidation claim.

21. It follows that the request to amend the patent may not introduce new subject matter that broadens the scope of the proceedings, as set by the invalidity claim. Therefore, applicant’s request to amend the patent with regard to claims not challenged by the revocation action shall be declared inadmissible to that extent and, consequently, the proposed amendments relating to claims other than claim 1 (the sole target of the

revocation action) shall be excluded from consideration in the current proceedings.

Source: [Unified Patent Court](#)

**UPC Court of First Instance,  
Central Division Paris, 30 April 2024  
(Catalozzi)**

**ORDER**

of the Court of First Instance of the Unified Patent Court  
Central division (Paris seat)  
issued on 30 April 2024

concerning the application ‘RoP 333’ No.  
App\_20743/2024 lodged in the proceedings  
UPC\_CFI\_263/2023

**HEADNOTES:** The request to amend a patent must refer to claims that have been challenged and, therefore, it is inadmissible to the extent that it concerns unchallenged claims.

**KEYWORDS:** Request to amend the patent; unchallenged claims.

**REFERENCE CODE ECLI:**

**APPLICANT:**

**Carrier Corporation** - 13995 Pasteur Blvd. - FL 33418  
- Palm Beach Gardens - US

Represented by Gregory Lees, Dehns

**RESPONDENT:**

**BITZER Electronics A/S** - Kærvej 77 - 6400 -  
Sønderborg - DK

represented by Tilman Pfrang, Meissner Bolte

**PATENT AT ISSUE:** European patent n° [EP 3 414 708](#)

**PANEL:**

François Thomas Presiding judge

Paolo Catalozzi Judge-rapporteur

Ulrike Keltsch Technically qualified judge

**DECIDING JUDGE:**

This order has been issued by the panel.

**SUMMARY OF FACTS AND PARTIES’  
REQUESTS:**

1. On 29 June 2023 the BITZER Electronics A/S brought a revocation action against Carrier Corporation before this Seat, registered as No. ACT\_555899/2023 UPC\_CFI\_263/2023, asking for the revocation of the patent at issue to the extent of claim 1.

2. On 20 November 2023 Carrier Corporation has lodged a statement of defence, as well as an application to amend the patent, registered as No. App\_588353/2023.

3. With its defence to the application to amend the patent, lodged on 19 January 2024, the claimant in the revocation action objected that the request to amend the patent was inadmissible in so far as it concerned non-attacked claims.

4. By order issued on 5 April 2024, pursuant to [Rule 105 \(5\)](#) of the Rules of Procedures (‘RoP’), the judge-rapporteur stated that the issue concerning the admissibility of the amendments filed by the patent proprietor, in the part where they do not relate to the claim 1, will be addressed by the panel during the course of the oral hearing.

5. On 18 April 2024 the applicant requested the Court to set aside the decision taken by the judge-rapporteur and

to exclude the issue of the alleged inadmissibility of the defendant's main and auxiliary requests from consideration, or, failing that, to direct a separate hearing, pursuant to [Rule 334 \(d\) 'RoP'](#), to hear the issue of the admissibility of the its requests and to determine the form of the amendments separately from and in advance of the oral hearing.

#### **GROUNDINGS FOR THE ORDER**

*The review of the order 5 April 2024, sub lett. b).*

6. It is not disputed – and, anyway, it is clear from the content of the written pleadings which have been lodged – that the respondent brought a revocation action requesting the revocation of the patent at issue 'to the extent of claim 1' (which has to be understood with only regard to the claim 1) and that the applicant lodged an application to amend the patent consisting of a main request and twelve auxiliary requests which relate not only to claim 1, but also to other nonattacked claims of the patent.

7. The applicant submits that: i) the judge-rapporteur has erred in failing to exclude the issue of the admissibility of the defendant's requests from consideration, as the facts of the matter were such that a decision could have been taken at the interim conference; ii) should the panel find that the judge-rapporteur was correct that this issue requires consideration by the full panel, the judge-rapporteur has erred in deferring consideration of this matter until the oral hearing of 21 June 2024 and should instead have directed a separate hearing, pursuant to [Rule 334 \(d\) 'RoP'](#), to hear the issue of the admissibility and form of the amendments separately and in advance of the oral hearing.

8. It points out that the Unified Patent Court Agreement ('UPCA') and the 'RoP' do not prescribe how the claims may be amended by the patentee and that it is reasonable to follow an interpretation of the relevant provisions in line with the European Patent Office practice, which allows the amendments of the patent also with regard to non-attacked claims, rather than the so-called 'German national approach', which does not allow to amend an unchallenged dependent claim.

9. It adds that it has interest in a decision on the debated issue before the oral hearing, as it would allow it, in case the Court were to decide that the amendments are not admissible, to refile its amendments in the format prescribed by this Court within a reasonable period.

10. In the light of the applicant's interest in having an immediate decision on the issue and of the underlying right to a proper defence this panel deems appropriate to anticipate the decision at this stage, which also enables to handle the proceedings in a more efficient way.

11. Therefore, applicant's request is allowed and the order of 5 April 2024 is put aside with the extent of the lett b).

#### ***The amend of a patent.***

12. This panel observes that, pursuant to [Rules 30 and 50 'RoP'](#), the patent proprietor may react to a claim or a counterclaim for revocation by lodging of an application to amend the patent and this application shall contain the proposed amendments of the claims and/or specification, including where applicable and

appropriate one or more alternative sets of claims (auxiliary requests), an explanation as to why the amendments satisfy the requirements of [Articles 84 and 123 \(2\) \(3\)](#) of the European Patent Convention ('EPC') and why the proposed amended claims are valid and, if applicable, why they are infringed and an indication whether the proposals are conditional or unconditional.

13. These provisions seem to be in line with [Article 138 \(3\)](#) of the 'EPC' (as amended by the Act revising the European Patent Convention of 29.11.2000), according to which '*In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceedings*'.

14. The consistency of the 'RoP' with the principles of the 'EPC' is made clear also by the fact that the proposed amendments have to meet the criteria set out in [Article 84 and 123 'EPC'](#) with regard to, respectively, sufficient disclosure and respect of the extension of the protection of the patent as granted.

15. The rationale of the provisions concerning the right to amend of a patent (or, to use the 'EPC' term, the limitation of a patent) – either before the administrative authority, or before Courts – lies in the interest to limit the number of the proceedings concerning the validity of the patents – or at least to reduce their complexity – and to increase the legal certainty for third parties.

16. The amend of a patent enables to remove unjustified situations of monopoly and, at the same time, to encourage the innovation, which could be stifled if the lack of validity of particular forms of the protected solution resulted in a complete loss of protection for the invention.

17. Furthermore, by amending the patent during litigation the patent proprietor retain control over its content, avoiding that a declaration of partial invalidity of the patent leads, as a consequence, a modification of the claims outside the proprietors' interest.

#### ***The right to amend of a patent in the course of a UPC proceedings as a defensive tool.***

18. No provision contained in the 'RoP', the 'EPC' or other relevant sources of law (as indicated in [Article 24 'UPCA'](#)) explicitly addresses the issue of amending a claim that has not been challenged; therefore, the relative assessment has to be carried out taking into account the general principles governing proceedings before the Unified Patent Court, the principles of proportionality, flexibility, fairness and equity, which guide the interpretation of the 'RoP', and the reported rationale of the provisions relating to the right to amend a patent.

19. In the framework of the Unified Patent Court procedural provisions, the patent amendment during litigation serves as a tool that the patent proprietor may use in order to react to an invalidity challenge and, therefore, to avoid a declaration of invalidity of the patent – total or partial –, while preserving enough scope of the title to prevent infringements. From a strictly procedural standpoint, hence, it functions as a defence

for the patent proprietor to counter the invalidity claim lodged by a third party.

20. The nature of the right to amend the patent during litigation as a mere defence leads to the conclusion that the patent may be amended only to the extent that it is necessary to react to the invalidity challenge; this allows the proprietor to preserve patent validity through claim modifications, ultimately aiming for rejection of the invalidation claim.

21. It follows that the request to amend the patent may not introduce new subject matter that broadens the scope of the proceedings, as set by the invalidity claim. Therefore, applicant's request to amend the patent with regard to claims not challenged by the revocation action shall be declared inadmissible to that extent and, consequently, the proposed amendments relating to claims other than claim 1 (the sole target of the revocation action) shall be excluded from consideration in the current proceedings.

22. This conclusion is supported by the fact that, in the framework of the Unified Patent Court, the patent proprietor is not entitled to independently request an assessment on the validity of its patent (or on the validity of that patent), in either its granted version or in an amended form, but only to respond to an invalidity challenge by arguing for the patent's validity, whether in an amended version or in the original one.

23. Indeed, the Unified Patent Court is a judicial body and, as such, is bound by the scope of the dispute and cannot address claims for which it has no jurisdiction, as the declaration of the validity of a patent. When faced with an invalidity claim, the Court must address the grounds of invalidity submitted by the claimant and the evidence provided by both parties and, as a general rule, it may not conduct own investigation or gather evidence on its own motion, as it is not allowed to carry out a general assessment of the validity of the patent.

24. No comparison may be made with the European Patent Office practice, as it is an administrative body whose duty is to assess if an invention is worthy of patent protection and not to resolve disputes between parties in an adversarial system. The right to amend of a patent in the course of a UPC proceedings and the principle of proportionality.

25. Limiting the right to amend the patent to the claims that are challenged also aligns with the principle of proportionality which shall guide the interpretation of the Rules of Procedures and has informed the relevant provisions.

26. As apparent from [Rules 30](#) and [50 'RoP'](#) the patent proprietor does not have an unlimited right to amend the patent, as it has to meet several conditions. In particular, the patent proprietor has to request the patent amend in due time – which means within the two-month period from the service of the statement of claim or the counterclaim for revocation – and any subsequent request to amend the patent may only be admitted with the permission of the Court and the proposed amendments; additionally, the proposed amendments, besides meeting various substantive requirements, must

be a reasonable number in the context of the case if they are conditional.

27. Furthermore, excluding from consideration amendments which do not relate to the claimant's challenges can help expedite the proceedings, aligning with the 'UPCA's goal and, at the same time, it is not detrimental to the patent proprietor, who can still seek amendments to its patent by filing a separate request with the competent administrative body.

28. For the reported considerations, the panel deems that it is not necessary to set a separate hearing to hear the addressed issue.

**ORDER**

For these grounds the Court:

- sets aside the order of 5 April 2024 with regard to the point under lett. b);
- declares that the request to amend the patent lodged by the applicant is inadmissible with regard to claims other than claim 1.

Issued on 30 April 2024.

The Presiding judge François Thomas

The Judge-rapporteur Paolo Catalozzi

The technical qualified judge Ulrike Keltsch

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