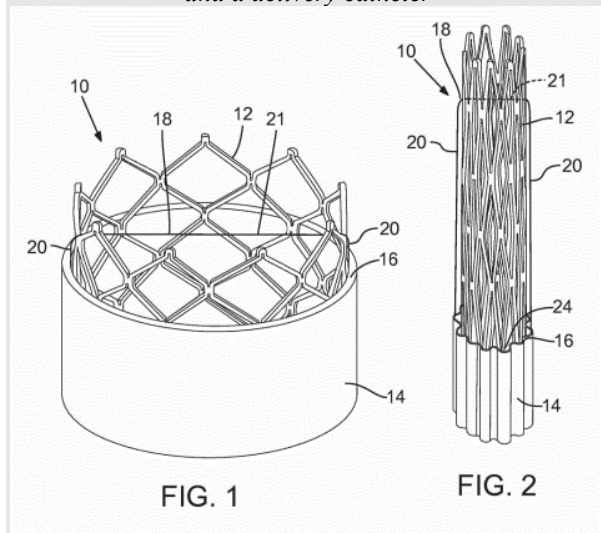


**UPC CFI, Local Division Munich, 6 September 2024,  
Edwards Lifesciences v Meril**

*a system comprising a prosthetic valve  
and a delivery catheter*



**PATENT LAW – PROCEDURAL LAW**

Order after interim conference ([Rule 105.5 RoP](#))

Leave to unconditionally limit claim

- [and new auxiliary claim equal to the previous main claim \(Rule 263.3 RoP\)](#)

Request for stay and dismissal to be argued and decided at oral hearing ([Rule 295 RoP](#))

- [Panel decided on 5 September 2024 that the oral hearing is not re-scheduled and that the question of a stay is to be argued and decided at the oral hearing.](#)

Requests to hear parties' experts or appoint a court expert refused

- [With the exception of evidence for or against the same effect,](#) these requests must be refused. There is no need to hear the parties' experts or to appoint a court expert. With respect to the same effect, the Claimant has indicated that it has not had an opportunity to file a response to the Defendants' submissions, including the Defendants' party expert report. Therefore, this issue will be referred to the Panel and will be reconsidered by the Panel at the oral hearing

Source: [Unified Patent Court](#)

**UPC Court of First Instance,  
Local Division Munich, 6 September 2024  
(Zigann)**

UPC\_CFI\_15/2023

**PROCEDURAL ORDER**

of the Court of First Instance of the Unified Patent Court  
Local Division Munich  
issued on 6 September April 2024

**CLAIMANT**

1) **Edwards Lifesciences Corporation** (claimant) - One Edwards Way - 92614 - Irvine - US

Represented by: Boris Kreye, Elsa Tzschope (Bird & Bird) Bernhard Thum, Dr. Jonas Weickert (Thum & Partner) Siddharth Kusumakar, Tessa Waldron and Bryce Matthewson (Powell Gilbert)

**DEFENDANTS**

1) **Meril GmbH**

2) **Meril Life Sciences Pvt. Ltd.**

represented by: Dr. Andreas von Falck, Dr. Roman Würtenberger, Dr. Lukas Wollenschlaeger, Beatrice Wilden, Dr. Alexander Klicznik, Dr. Felipe Zilly (Hogan Lovells) Peter-Michael Weisse, Ole Dirks, Dr. Eva Maria Thörner (Wildanger)

**PATENT AT ISSUE**

European patent n° [3 646 825](#)

**PANEL/DIVISION**

Panel 1 of the Local Division Munich

**DECIDING JUDGE/S**

This order has been issued by the Presiding Judge Dr. Matthias Zigann acting as judgerapporteur.

**LANGUAGE OF THE PROCEEDINGS**

English

**SUBJECT-MATTER OF THE PROCEEDINGS**

Patent infringement – R 105.5

**DATE OF THE INTERIM CONFERENCE**

5 September 2024

**SUMMARY OF FACTS**

Claimant filed for infringement of EP 3 646 825 on 1 June 2023. The statement of claim was served on the defendants on 7 July 2023 and 1 August 2023. Meril Italy srl filed a revocation action with the Central Division Section Paris on 4 August 2023. Defendants filed counterclaims for revocation with the Local Division Munich on 2 November 2023. With order dated 28 March 2024 the Local Division Munich bifurcated and referred the two counterclaims to the Central Division Section Paris for decision (ORD\_1340/2024). The Central Division Section Paris rendered a decision on 19 July 2024 (ACT\_551308/2023, CC\_584916/2023, CC\_585030/2023). The patent was upheld according to auxiliary request 2. This decision had been appealed (UPC\_CoA\_457/2024, UPC\_CoA\_458/2024 and UPC\_CoA\_464/2024). No date for the appeal hearing has yet been set.

In the infringement action a videoconference had been held on 14 March 2024 (App\_11151/2024).

The following order had been issued according to [Rule 105.5 RoP](#):

1. The language of the proceedings is changed to English
2. The parties are invited to submit available (computer) translations into English of their pleadings within one month from the date of this order, as specified in 9. above
3. Edwards request (App\_11151/2024) to file a further submission on Meril's public interest argument, is rejected. The other requests in the same application (regarding experts and regarding the allegedly infringing product Octacor) will be addressed at a later stage (the IC)

4. Edwards request (App\_12541/2024) to reject Meril's submission of 29 February 2024 (App\_11028/2024) is granted. This submission will not be part of the (written) proceedings.

The interim conference had been scheduled for 5 September 2024. The date for the oral hearing had been set to 24 September 2024.

On 1 December 2023, the Board of Appeal of the European Patent Office revoked the [EP 3 583 920](#) ("EP '920"), a patent related to the patent in suit.

By order dated 4 September 2024 (APP\_46733/2024) parties were granted the right to submit further pleadings as follows:

The parties are each allowed to file a further written submission by 4 September 2024, addressing and limited to:

(i) the decision of the UPC Paris Central Division of 19 June 2024

insofar as it addresses the construction of terms used in the claims of the Patent-in-Suit;

(ii) the LANDMARK Clinical Trial results.

By now the following major briefs have been exchanged:

Party		German	English
K	Statement of Claim 1 June 2023 K1-42	ACT_459987/2023	App_20292/2024
B	Preliminary objections 6 September 2023 HL1-8	ACT_459987/2023	App_20230/2024 HL-E1
K	Comments to Preliminary Objection 26 September 2023 K43-49	ACT_459987/2023	App_22063/2024
B	Klageerwiderung 2 November 2023 HL19a-52	ORD_585014/2023 (ORD_585009/2023)	App_20230/2024 HL-E2a,b
B	Counterclaim for revocation 2 November 2023 HLNK1-50	CC_584916/2023 (CC_585030/2023)	App_20230/2024 HL-E4a,b
K	Replik 9 January 2024 K50-95 NKB1-3 HA0-1	App_1057/2024 CC_584916/2023	App_20292/2024
B	Duplik 11 March 2024 HL53-65	ACT_459987/2023	App_20230/2024 HL-E3a,b

B	Reply to the Defence 11 March 2024 HLNK51-60	CC_584916/2023	App_20230/2024 HL-E5a,b
K	Rejoinder to the Reply to the Defence 11 April 2024 NKB04 ARI-VI EDW-E01	CC_584916/2023	App_911/2024 App_19689/2024
B	Rejoinder to the Reply to the Defence 13 May 2024		App_911/2024 App_20230/2024 HL-E6a,b
K	Further written pleading 4 September 2024		App_46733/2024
B	Further written pleading 4 September 2024		App_46733/2024

## REQUESTS SUBMITTED PRIOR TO THE INTERIM CONFERENCE

### Claimant's requests:

#### ORD\_43137/2024, dated 29. August 2024

(1)

*I. to be allowed to submit to the Court a sample of the infringing embodiment "Octacor" as means of evidence under [Art. 53\(1\) \(f\) UPCA](#), [R. 170.1 \(c\) RoP](#);*

(3)

*II. that the parties be allowed to use PowerPoint slides during the Oral Hearing on 24 September 2024 to present their case, whereby figures, illustrations, tables, etc. shall be limited to those already included in the written proceedings and no new or amended figures, illustrations, tables, etc. shall be allowed;*

(5)

*III. that Defendants' request for a stay of the proceedings and the further requests of 23 August 2024 (App\_48488/2024) be dismissed.*

(4)

*IV. for leave to change its claim pursuant to [R. 263.1 RoP](#).*

(6)

*V. the party experts [---] and [---] be heard on the facts submitted as evidence by their expert opinions (Exhibits K 53 and K 54);*

(7)

*VI. a Court expert be appointed according to [R. 170.1, 2\(e\)](#), [R. 185 RoP](#) and that the order be issued to obtain an expert opinion on the facts submitted as evidence according to [Art. 53 \(1\)\(e\) UPCA](#), [R. 170.1, 2\(e\)](#), [R. 185 RoP](#);*

(7)

*VII. the Court expert be summoned at the oral proceedings, that he be heard at the oral proceedings, and that the parties be allowed to question him in accordance with [Art. 53 \(1\)\(e\) UPCA](#), [R. 170.2\(e\) RoP](#). **ORD 46734/2024 (defendant 1) and ORD 46735/2024 (defendant 2), dated 12 August 2024:***

(4)

*On behalf of Claimant, we request*

*leave to change our claim pursuant to [R. 263.1 RoP](#):*

*I. orders Defendants to cease and desist with respect to a system comprising: a prosthetic heart valve comprising: a collapsible and expandable annular frame configured to be collapsed to a radially collapsed state for mounting on a delivery apparatus and expanded to a radially expanded state inside the body; wherein the frame is made of a nickel-cobalt-chromium-molybdenum alloy and comprises a plurality of rows of angled struts, the angled struts joined to each other so as to form a plurality of rows of hexagonal cells, wherein the frame is made up entirely of hexagonal cells, and wherein each of the hexagonal shaped cells is defined by six struts, including: two opposing side struts extending parallel to a flow axis of the valve, a pair of lower angled struts, extending downwardly from respective lower ends of the side struts and converging toward each other, and a pair of upper angled struts extending upwardly from respective upper ends of the side struts and converging toward each other; and a delivery*

catheter comprising an inflatable balloon; wherein the prosthetic heart valve is crimped in its radially compressed state on the balloon of the delivery apparatus, and wherein the balloon is configured to be inflated to expand to radially expand the prosthetic heart valve at the desired deployment location, preferably within a native aortic valve, wherein the frame of the prosthetic heart valve does not include any struts that do not form part of one of the hexagonal cells, except for any struts that extend axially away from an inflow end or an outflow end of the frame for mounting the frame to the delivery catheter.

(independent claim 1 of the Patent-in-Suit),

from offering, placing on the market, using, or importing or storing it for the said purposes within the territory of the Agreement on a Unified Patent Court at the time of the oral hearing – except in Malta–, in the alternative in Belgium, Bulgaria, Denmark, Germany, Estonia, Finland, France, Italy, Latvia, Lithuania, Luxembourg, the Netherlands, Austria, Portugal, Sweden and Slovenia

especially if

~~the frame is made of a plastically expandable material, preferably selected from a group comprising stainless steel, a nickel based alloy,~~

~~a nickel cobalt chromium alloy, polymers or a combination thereof;~~

~~(dependent claim 5 of the patent in suit),~~

~~and/or~~

a system of claim 1, further comprising a leaflet structure comprising a plurality of leaflets, and a sealing skirt;

(dependent claim 2 6 of the Patent-in-Suit),

and/or

a system of claim 2 6, wherein each leaflet has a tab portion adjacent an upper free edge of the leaflet;

(dependent claim 4 11 of the Patent-in-Suit),

~~and/or~~

~~a system according to the dependent claim 11, further comprising at least one reinforcement strip that covers the tab portion of a respective leaflet;~~

~~(dependent claim 12 of the patent in suit),~~

and/or

a system of any of claims 2 6 and/or 4 11 and/or 12, wherein the skirt is made of a fabric, the fabric preferably made of PET or UHMWPE;

(dependent claim 5 13 of the Patent-in-Suit),

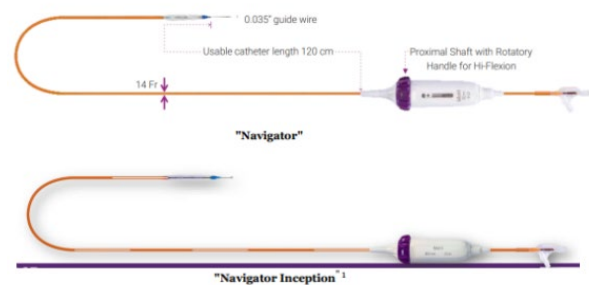
especially if the system contains

a) a transcatheter heart valve prosthesis with the designation "Myval Octacor" as shown below



and/or

b) a delivery apparatus of the type "Navigator" and/or "Navigator Inception" as shown below



II. In the alternative,

orders Defendants to cease and desist with respect to a system comprising: a prosthetic heart valve comprising: a collapsible and expandable annular frame configured to be collapsed to a radially collapsed state for mounting on a delivery apparatus and expanded to a radially expanded state inside the body; wherein the frame comprises a plurality of rows of angled struts, the angled struts joined to each other so as to form a plurality of rows of hexagonal cells, wherein the frame is made up entirely of hexagonal cells, and wherein each of the hexagonal shaped cells is defined by six struts, including: two opposing side struts extending parallel to a flow axis of the valve, a pair of lower angled struts, extending downwardly from respective lower ends of the side struts and converging toward each other, and a pair of upper angled struts extending upwardly from respective upper ends of the side struts and converging toward each other; and a delivery catheter comprising an inflatable balloon; wherein the prosthetic heart valve is crimped in its radially compressed state on the balloon of the delivery apparatus, and wherein the balloon is configured to be inflated to expand to radially expand the prosthetic heart valve at the desired deployment location, preferably within a native aortic valve;

(independent claim 1 of the Patent-in-Suit),

from offering, placing on the market, using, or importing or storing it for the said purposes within the territory of the Agreement on a Unified Patent Court at the time of the oral hearing – except in Malta–, in the alternative in Belgium, Bulgaria, Denmark, Germany, Estonia, Finland, France, Italy, Latvia, Lithuania, Luxembourg, the Netherlands, Austria, Portugal, Sweden and Slovenia

especially if

~~the frame is made of a plastically-expandable material, preferably selected from a group comprising stainless-steel, a nickel-based alloy, a nickel-cobalt-chromium alloy, polymers or a combination thereof;~~

~~(dependent claim 5 of the Patent-in-Suit ),~~

~~and/or~~

a system of claim 1, further comprising a leaflet structure comprising a plurality of leaflets, and a sealing skirt;

(dependent claim 6 of the Patent-in-Suit),

and/or

a system of claim 6, wherein each leaflet has a tab portion adjacent an upper free edge of the leaflet; (dependent claim 11 of the Patent-in-Suit), and/or

a system according to the dependent claim 11, further comprising at least one reinforcement strip that covers the tab portion of a respective leaflet; (dependent claim 12 of the Patent-in-Suit ), and/or

a system of any of claims 6 and/or 11 and/or 12, wherein the skirt is made of a fabric, the fabric preferably made of PET or UHMWPE;

(dependent claim 13 of the Patent-in-Suit),

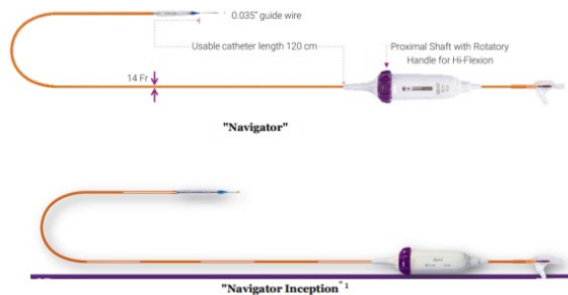
especially if the system contains

c) a transcatheter heart valve prosthesis with the designation "Myval Octacor" as shown below



and/or

d) a delivery apparatus of the type "Navigator" and/or "Navigator Inception" as shown below



III. orders Defendants for each case of violation of the order according to Item I. or II., to make penalty payments to the Court, to be determined by the Court in reasonable proportion to the importance of the order to be enforced, whereby an amount of EUR 20,000 for each case of non-compliance and per infringing product is suggested;

IV. finds that the Patent-in-Suit was infringed by Defendants in respect to the products described above under Item I. or II.;

V. orders Defendants, under penalty of a periodic fine of EUR 1,000 for each day of delay, within a period of three weeks from the date of service of the decision, to provide Claimant with information on the extent to which Defendants have committed the acts referred to in Item I. or II. since 17 March 2021, specifying:

1) the origin and distribution channels of the infringing products,

2) the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the infringing products, and

3) the identity of any third person involved in the production or distribution of infringing products;

VI. orders Defendants, under penalty of a periodic fine of EUR 1,000 for each day of delay, within a period of one week from the date of service of the decision, to recall from the commercial customers the products described above under Item I. or II. that have been placed on the market since 17 March 2021, with reference to the infringement of the products determined by the Court and with the binding promise to pay any fees and necessary packaging and transport costs, as well as customs and storage costs associated with the return, and to take back the products to have them finally removed from the distribution channels;

VII. orders Defendants, under penalty of a periodic fine of EUR 1,000 for each day of delay, within a period of one week from the date of service of the decision, to destroy the products referred to above in Item I. or II. and/or materials in their direct and/or indirect possession and/or ownership (including any products and/or materials that come into their direct and/or indirect possession and/or ownership pursuant to Item ~~VI~~ VI. above or otherwise) or, at its option, to hand them over to a bailiff to be appointed or commissioned by Claimant for the purpose of destruction;

VIII. allows Claimant to publish the Court's decision in whole or in part, including the announcement of the decision, in five public media including industry journals of its choice;

IX. orders Defendants to publish the operative part of the Court's decision on their websites;

X. finds that Defendants are obligated to reimburse Claimant for any damages (including interest) incurred by Claimant since 17 March 2021 due to the actions described above under Item I. or II. as well as those yet to be incurred;

XI. orders Defendants to pay preliminary damages, with the amount of the security at the discretion of the Court, where at a minimum Claimant's projected costs of the damages and compensation proceedings must be covered and an amount of at least EUR 663,000.00 is suggested;

XII. orders Defendants to pay the costs of the proceedings, including those relating to the measures requested in Item I. to ~~VI~~ IX. above;

XIII. attaches to the decision an order for its immediate enforceability;

**alternatively,**

in the event a security is ordered, permits Claimant to provide it by bank or savings institution guarantee and determine the amount of the security separately for each claim granted and for the decision of costs,

**alternatively,**

permits Claimant to avoid compulsory enforcement with respect to the costs against provision of security;

XIV. issues a decision by default in the event that Defendants fail to take action within the time limit foreseen in these Rules of Procedure or set by the Court

or fail to appear at an oral hearing after having been duly summoned.

10

**App\_33373/2024 (262.1.b), dated 10 July 2024:**

I. the application be dismissed and access to all written pleadings and evidence in the present infringement action be denied;

in the alternative,

II. the application be dismissed to the extent that any written pleadings or evidence submitted by the parties that do not concern the patent in suit itself or its validity be excluded from access and that Claimant is given the opportunity to specify the pleadings, sections thereof and evidence to be excluded within a deadline set by the Court; in the further alternative, in the event that the application is granted in full or in part,

III. the Applicant be ordered to keep the written pleadings and evidence he was given access to confidential;

IV. the Court grants leave to appeal the order granting access in full or in part; and

V. such order is not enforceable pending a final decision of the Court of Appeal.

**Defendants' requests:**

**ORD\_43137/2024, dated 29. August 2024**

(5)

I. the infringement proceedings (ACT\_459987/2023) be stayed pending a final decision of the Court of Appeal in cases UPC\_CoA\_457/2024, UPC\_CoA\_458/2024 and/or UPC\_CoA\_464/2024 on the (in)validity of EP 825;

(5)

II. in the alternative, the oral hearing scheduled for 24 September 2024 be postponed until a date after a final decision of the Court of Appeal in cases UPC\_CoA\_457/2024, UPC\_CoA\_458/2024 and/or UPC\_CoA\_464/2024 on the (in)validity of EP 825.

(8)

III. a court expert ([Rule 170.1, .2 lit. e](#)), [Rule 185 RoP](#)) be appointed and it be ordered that an expert opinion is provided on the facts to be proven;

(8)

IV. the court-appointed expert be summoned to the oral hearing, the court-appointed expert be heard at the oral hearing, and the parties be allowed to question him;

(9)

V. in the alternative, the party expert [---] be heard with regard to the facts to be proven by his expert opinions (Exhibits HL 11/11a and HL 14) ([R. 181 RoP](#)).

(12)

VI. the oral hearing be conducted in part by video conference in accordance with [Rule 112.3\(a\) RoP](#).

**App\_48488/2024, dated 23 August 2024:**

(11)

I. the infringement action be dismissed.

In the alternative, we request that

(5)

II. the infringement proceedings (ACT\_459987/2023) be stayed pending a final decision of the Court of Appeal in cases UPC\_CoA\_457/2024, UPC\_CoA\_458/2024

and/or UPC\_CoA\_464/2024 on the (in)validity of EP 825;

(5)

III. in the alternative, the oral hearing scheduled for 24 September 2024 be postponed until a date after a final decision of the Court of Appeal in cases UPC\_CoA\_457/2024, UPC\_CoA\_458/2024 and/or UPC\_CoA\_464/2024 on the (in)validity of EP 825;

(11)

IV. in the utmost alternative, a decision – if in Claimant's favour – be rendered under the condition subsequent pursuant to [Art. 56\(1\) UPCA](#) that the patent is not held to be wholly or partially invalid by the final decision in the revocation proceedings, whereby the requests under items no. II. to IV. are conditional on Claimant being granted leave to amend its claims asserted in the infringement proceedings. Otherwise, the action would have to be dismissed already because it is based on an invalid patent.

(12)

**App\_48489/2024, dated 23 August 2024:**

the oral hearing, currently scheduled for 24 September 2024, be conducted partly by videoconference in a hybrid format in accordance with [R. 112.3\(a\) RoP](#).

(4)

**App\_49780/2024, dated 2 September 2024:**

We refer to our request for the stay of proceedings and the alternative requests filed with submission of 23 August 2024 in workflow App\_48488/2024 and submit:

1. the Statement of grounds of appeal, submitted in the name and on behalf of Defendant 1) and Defendant 2) on 30 August 2024 in the appeal proceedings registered under case no. UPC\_CoA\_457/2024 and UPC\_CoA\_458/2024, as Exhibit HL-Stay 5 and

2. the Statement of grounds of appeal, submitted in the name and on behalf of Meril Italy S.r.l. on 30 August 2024 in the appeal proceedings registered under case no. UPC\_CoA\_464/2024, as Exhibit HL-Stay 6.

In addition to our comments in Section A.I. of the submission referred to above, these statements of grounds of appeal further demonstrate that EP 3 646 825 is highly likely to be revoked also in the version of, for example, Auxiliary Request II.

(4)

**App\_46734/2024, dated 4 September 2024:**

the applications [on [R 263 RoP](#)] be dismissed and leave not be granted.

(2)

**App\_50157/2024, dated 4 September 2024:**

to be allowed to submit to the Court an enlarged 3D-model of the frame of the attacked embodiment Myval™ Octacor for the purpose of inspection and as a means of evidence pursuant to [Art. 53\(1\)\(f\) UPCA](#), [R. 170.1\(c\)](#), [2\(f\) RoP](#).

(10)

**App\_33373/2024 (262.1.b), dated 10 July 2024:**

I. that the R.262-Request be dismissed and access to all written pleadings and evidence in the present proceedings be denied;

II. in the strict alternative, that the R.262-Request be dismissed to the extent that any written pleadings, evidence or other submissions as further specified below in Section B.3.c) be excluded from access;

III. in case the R.262-Request is granted in part or in full, that it be ordered that the applicant is required to keep the written pleadings and evidence the applicant was given access to confidential and not to use the information obtained against Defendants, be it in court proceedings or out of court (see Section C.).

For the requests App 48489/2024 and App 48488/2024 an oral hearing had been ordered to take place during the interim conference.

## PARTICIPANTS OF THE INTERIM CONFERENCE

### For the Court

Matthias Zigann, Presiding Judge and Judge-rapporteur  
Margot Kokke, LQJ as observer  
Stefan Wilhelm, TQJ as observer

### For the Claimant

Boris Kreye  
Elsa Tzschope  
Bernhard Thum  
Jonas Weickert  
Siddharth Kusumakar  
Bryce Matthewson

### For the Defendants

Andreas von Falck  
Roman Würtenberger  
Lukas Wollenschlaeger  
Beatrice Wilden  
Alexander Klicznik  
Felipe Zilly  
Peter-Michael Weisse  
Ole Dirks  
Iona Hategan

[---]

Yun-Suk Jang

## GROUND FOR THE ORDER

### I. Request no. 4 (leave to change claim)

Under **R 263.3 RoP** leave to limit a claim in an action unconditionally shall always be granted. The new main claim in the action is limited in this sense because additional features have been added to the claim language. The new auxiliary claim in the action is the previous main claim and therefore there is no change. Therefore, the request is to be granted.

### II. Requests no. 5 (stay; re-schedule)

1. Defendants argued, inter alia, in their request for a stay of proceedings / rescheduling of the oral hearing (No. 5) in their pleading of 23 August 2002 that, irrespective of the outcome of the invalidity proceedings at first instance, Claimant was still seeking an injunction on the basis of a patent that would most likely be revoked in its entirety on appeal. The first instance decision of the Central Division Paris Section was manifestly wrong. The Paris Central Division failed to consider important (core) invalidity arguments and thereby violated the defendants' right to be heard:

“A) Although this had been a prominent attack raised by Defendants also against Auxiliary Request II, the Paris

Central Division did not address the inadmissible extension resulting from the omission of the feature "sealing device".

B) The prominent novelty attack on the basis of embodiment 2 (as shown in Figures 44 and 45 of Levi, Exhibit HLNK 39) was not considered by the Paris Central Division.

C) The same (lack of novelty) is true with regard to Levi's first embodiment (cf. p. 47 of Defendants' Rejoinder regarding the Application to amend with further references).

D) The Paris Central Division did not discuss the obviousness of the subject-matter of claim 1 of EP 825 in accordance with Auxiliary Request II when starting from embodiment 2 (Figures 44 and 45) of Levi (Exhibit HLNK 39).

E) The Paris Central Division also did not assess the inventive step attack starting from Alon (submitted as Exhibit HLNK 49 in the counterclaim proceedings) on the basis of Alon alone or when combining it with Fontaine (Exhibit HLNK 25) although these were again prominent attacks of Defendants and even though a similar lack of inventive step led the EPO's Board of Appeal to conclude that family member EP 3 583 920 B1 ("EP 920") in the version of auxiliary request 2 (with a virtually identical claim set as EP 825 in the version of Auxiliary Request II) lacked inventive step (see below, Section A.III.5.c)(3)).”

Claimant countered, inter alia, that all of these issues had been discussed in writing by the parties and had been discussed at the oral hearing in Paris. This was not disputed by the Defendants. The Claimant further argued that it was not necessary for each argument raised by the parties to be specifically addressed in the written reasons for the decision. In any event, the statement in para. 156 of the Decision that "any arguments of the parties which have not been specifically addressed must be deemed absorbed" was sufficient.

2. According to **R 102.1 RoP** the judge-rapporteur may refer any matter to the panel for decision. This is appropriate for this request as the Unified Patent Court will have to decide for the first time how to deal with this situation. The counterclaims were referred to the Central Division for decision. The Central Division has issued a decision. The defendants argue that a stay is still warranted.

The panel decided on 5 September 2024 that the oral hearing is not re-scheduled and that the question of a stay is to be argued and decided at the oral hearing.

Therefore, the oral hearing is to be prepared, and parties are to be summoned to the oral hearing.

### III. Requests no. 11 (dismissal; condition)

According to **R 102.1 RoP** the judge-rapporteur may refer any matter to the panel for decision.

This is appropriate for this request as well. It is to be argued and decided at the oral hearing.

### IV. Requests no. 6-9 (experts)

With the exception of evidence for or against the same effect, these requests must be refused. There is no need to hear the parties' experts or to appoint a court expert. With respect to the same effect, the Claimant has

indicated that it has not had an opportunity to file a response to the Defendants' submissions, including the Defendants' party expert report. Therefore, this issue will be referred to the Panel and will be reconsidered by the Panel at the oral hearing.

**V. Requests no. 1-3 and 12 (physical objects; 3D model; PowerPoint; video conference).**

The Defendants have requested a hybrid videoconference to allow a member of the Defendants' legal team to participate from Düsseldorf. This request is to be granted. There are no concerns as this member will not speak during the hearing but will only listen.

The other requests are directed to foster the technical understanding of the members of the panel and are therefore appreciated and allowed. The possible content of the power point presentation is limited what has been already filed via the CMS.

The parties may inspect the physical objects on 17 September 2024 or on the day of the oral hearing after having made an appointment with the Sub-Registry.

**VI. Requests no. 10 (third party access)**

This request is to be dealt with after parties have filed their additional submissions.

**ORDER**

1. Requests no. 1-4 and 12 (physical objects; 3D model; PowerPoint; leave to change claim, video conference) are granted. The physical objects are to be submitted to the SubRegistry of the Local Division Munich by 16 September 2024 and can be inspected there after having made an appointment on 17 September 2024 or on the date of the oral hearing. The submissions must be accompanied by respective CMS workflows.

2. Requests no. 5 (stay; re-schedule) are referred to the panel for decision. Pending a decision by the panel no stay is ordered and the oral hearing stays to be scheduled for 24 September 2024.

3. Requests no. 6-9 (experts) are denied with exception to requests concerning the same effect which are referred to the panel for decision during the oral hearing.

4. Requests no. 10 (third party access) will be considered after parties have filed their additional submissions.

5. Requests no. 11 (dismissal; condition) are referred to the panel for decision during the oral hearing.

6. Parties are summoned to the oral hearing on 24 September 2024, 9.00 a.m., Local Division Munich, room 212, Denisstr. 3 in Munich.

**INSTRUCTIONS TO THE REGISTRY**

1. The physical objects to be submitted to the Sub-Registry according to order no. 1 are to be stored and made available for inspection by the other party on request.

2. A hybrid videoconference is to be set up for the day of the oral hearing. An invitation is to be sent to Dr. Eva Maria Thörner (defendant team).

**INFORMATION ABOUT REVIEW BY PANEL**

Any party may request that this Order be referred to the panel for a review pursuant to [R. 333 RoP](#). Pending review, the Order shall be effective ([R. 102.2 RoP](#))

**INFORMATION ABOUT ORAL HEARING HELD IN COURT**

The oral hearing shall be open to the public unless the Court decides to make it, to the extent necessary, confidential in the interests of one or both parties or third parties or in the general interest of justice or public order ([R. 115 RoP](#)). Suggested text for the section

**INFORMATION ABOUT AUDIO RECORDING**

The oral hearing shall be audio recorded. The recording shall be made available at the premises of the Court to the parties or their representatives after the oral hearing ([R. 115 RoP](#)).

**INFORMATION ABOUT ABSENCE OR DELAY OF A REPRESENTATIVE**

A decision by default may be given, upon request, against a party that was duly summoned but fails to appear at the oral hearing ([R. 355.1 \(b\) RoP](#)).

**INFORMATION ABOUT DECISION BY DEFAULT**

Should a party fail to comply with the present Order within the time period specified, a decision by default may be given in accordance with [R. 355 RoP \(R. 103.1, last subparagraph and .2 RoP\)](#).

**DETAILS OF THE ORDER**

Order no. ORD\_598441/2023 in ACTION NUMBER: ACT\_459987/2023

UPC number: UPC\_CFI\_15/2023

Action type: Infringement Action

Order no. ORD\_48552/2024 in ACTION NUMBER: ACT\_459987/2023

UPC number: UPC\_CFI\_15/2023

Action type: Infringement Action

Related proceeding no. Application No.: 48489/2024

Application Type: Generic procedural Application

Order no. ORD\_48534/2024 in ACTION NUMBER: ACT\_459987/2023

UPC number: UPC\_CFI\_15/2023

Action type: Infringement Action

Related proceeding no. Application No.: 48488/2024

Application Type: Generic procedural Application

Signed in Munich on 6 September 2025

Dr. Zigann Presiding Judge

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