

UPC CFI, Central Division, Section Munich, 28 February 2025, UPM-Kymmene v Virdia

PATENT LAW – PROCEDURAL LAW

Substitution of registered proprietor ([R. 42.2 RoP](#))

• **by the [R. 8.5 proprietor](#)**

The request for a change (substitution) in parties is to be granted. A revocation action is to be directed at the proprietor of the patent ([Rule 42.1 RoP](#)). If the registered proprietor is not a proprietor within the meaning of [Rule 8.5\(a\) or \(b\)](#), the registered proprietor shall apply for its substitution by the “[Rule 8.5 proprietor](#)” ([Rule 42.2 RoP](#)). Based on the facts and evidence presented by the Applicant, which have not been disputed by the Claimant, the Court is satisfied that the present Defendant, who is the registered proprietor, is not the [Rule 8.5 proprietor](#). As the present Defendant is not the [Rule 8.5 proprietor](#), it is to be substituted by the [Rule 8.5 proprietor](#). There is no dispute between the parties that the [Rule 8.5 proprietor](#) is International N&H Denmark ApS. Accordingly, the present Defendant shall be substituted by International N&H Denmark ApS.

Source: [Unified Patent Court](#)

**UPC Court of First Instance,
Central Division, Section Munich, 28 February 2025
(Kupecz)**

Action n°: UPC 829/2024

Revocation action

Order

of the Court of First Instance of the Unified Patent Court
Central Division (Section Munich)

Issued on 28 February 2025

CLAIMANT:

UPM-Kymmene Oyj, Alvar Allon katu 1 - FI-00101 -
Helsinki - FI
represented by Clemens Tobias Steins of Hoffmann
Eitle PartmbB.

DEFENDANT (APPLICANT):

Virdia Inc., 1319 Highway 182 - LA 70394 - Raceland -
US

represented by Matthew Naylor of Mewburn Ellis LLP.

PATENT AT ISSUE

European Patent number [2 611 800](#)

PANEL/DIVISION

Panel 1 of the Central Division (Section Munich).

DECIDING JUDGE

This Order is an order of the Judge-rapporteur Andrés
Kupecz.

LANGUAGE OF THE PROCEEDINGS:

English.

SUBJECT-MATTER OF THE PROCEEDINGS

Revocation action. Application for a change
(substitution) in parties.

SUMMARY OF FACTS

Claimant lodged a Statement for Revocation dated 20 December 2024 regarding European patent EP 2 611 800 against Virdia Inc., 1319 Highway 182, Raceland, LA 70394, United States of America.

After service of the Statement of Revocation, the Defendant on 14 February 2025 lodged an application under [Rule 305 of the Rules of Procedure](#) of the Unified Patent Court (‘RoP’) to change parties.

By preliminary order dated 18 February 2025, the Claimant was invited to comment on the request pursuant to [Rule 305.2 RoP](#). The Claimant provided comments in its submission of 24 February 2025.

SUBMISSIONS OF THE PARTIES AND REQUESTS

Defendant submitted as Exhibit ME 01 a copy of a patent assignment executed in 2024 relating to a number of patents. The patents were assigned from Virdia Inc. to International N&H Denmark ApS. Included in the list of patents assigned is EP 2 611 800, which is the subject of the present revocation action. The registered proprietor on the European Patent Register is Virdia Inc. However, the person entitled to be registered as proprietor under the law of each Contracting Member State in which the European patent has been validated is International N&H Denmark ApS.

The Defendant further argues that this application is made as soon as practicable after service, in view of the need to establish the correct ownership position of this patent and also in view of the more complex circumstances raised in the CMS in the revocation action filed in a parallel case against EP 3 540 068.

Further, Defendant considers that no court fees are to be due and it would not be appropriate to make an order as to costs specifically for dealing with this routine application. The Defendant proposes that the Court directs that the date of service of the revocation action on International N&H Denmark ApS is confirmed as the same as the date of service on Virdia Inc., namely 14 January 2025.

On this basis, the Defendant requests:

that the originally-named defendant (Virdia Inc.) is substituted by:

International N&H Denmark ApS

Parallelsvej 16

2800 Kongens Lyngby

Denmark

The Claimant agrees to the substitution. The Claimant also agrees that the case management should not be affected by the substitution.

GROUND FOR THE ORDER

The request to change (substitute) the Defendant in this revocation action by International N&H Denmark ApS is admissible and is well-founded.

1. Admissibility

According to [Rule 42 RoP](#):

1. Any action for the revocation of a patent shall be directed against the proprietor of the patent.

2. If the action for revocation is directed against the proprietor in accordance with [Rule 8.6](#) (“the registered proprietor”) but the registered proprietor is not a

proprietor within the meaning of [Rule 8.5\(a\) or \(b\)](#) (“the Rule 8.5 proprietor”) each such registered proprietor shall as soon as practicable after service of the Statement for revocation apply to the Court pursuant to [Rule 305.1\(c\)](#) for the substitution of the registered proprietor by the [Rule 8.5 proprietor](#).

According to [Rule 305.1\(c\)](#), the Court may on application by a party, order a person to be substituted for a party.

Accordingly, the Defendant as the registered proprietor may apply to the Court pursuant to [Rule 305.1\(c\)](#) for its substitution by the [Rule 8.5 proprietor](#). The Court accepts that in view of the circumstances of the case, given the agreement of the Claimant, the application is made as soon as practicable after service.

The application for a change in parties is therefore admissible.

2. The application is well-founded

The request for a change (substitution) in parties is to be granted. A revocation action is to be directed at the proprietor of the patent ([Rule 42.1 RoP](#)). If the registered proprietor is not a proprietor within the meaning of [Rule 8.5\(a\) or \(b\)](#), the registered proprietor shall apply for its substitution by the “[Rule 8.5 proprietor](#)” ([Rule 42.2 RoP](#)). Based on the facts and evidence presented by the Applicant, which have not been disputed by the Claimant, the Court is satisfied that the present Defendant, who is the registered proprietor, is not the [Rule 8.5 proprietor](#). As the present Defendant is not the [Rule 8.5 proprietor](#), it is to be substituted by the [Rule 8.5 proprietor](#). There is no dispute between the parties that the [Rule 8.5 proprietor](#) is International N&H Denmark ApS. Accordingly, the present Defendant shall be substituted by International N&H Denmark ApS.

In agreement with the parties, the Courts sees no reason to exercise its discretion under [Rule 305.3 RoP](#) to make any orders as to payment of court fees and costs as regards the new party specifically for dealing with this application. The court fees for the revocation action have already been paid by the Claimant. There is, furthermore, no reason to make a cost order at this stage of the proceedings.

[Rule 306 RoP](#) requires that the Court gives directions to regulate the consequences of the substitution as to case management. The Court, in agreement with the parties, directs that case management should not be affected by the substitution. For the calculation of deadlines, including time limit for filing the Defence to revocation, the date of service on Virdia Inc., namely 14 January 2025, shall be used as a starting point. The Court understands that the parties wish to, and agrees that, N&H Denmark ApS shall be fully bound by the proceedings as they are constituted at the date of this order ([Rule 306.2 RoP](#)). The Court is aware that International N&H Denmark ApS is represented by the same representative as the Applicant and therefore assumes that this party agrees as well.

ORDER

Having heard the parties, the Court orders that :

1. The originally-named defendant (Virdia Inc.) is substituted by:

International N&H Denmark ApS

Parallelsvej 16

2800 Kongens Lyngby

Denmark

2. For the calculation of deadlines, including the time limit for filing the Defence to revocation, the date of service on Virdia Inc., namely 14 January 2025, shall be used as a starting point.

3. International N&H Denmark ApS shall be fully bound by the proceedings as they are constituted at the date of this order.

4. Any further requests are rejected.

Issued 28 February 2025

KUPECZ

Judge-rapporteur

INFORMATION ABOUT REVIEW BY THE 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).

INSTRUCTIONS TO THE PARTIES AND THE REGISTRY

1. The Registry shall take all necessary steps to effectuate the substitution as ordered as soon as practically possible.

2. Even if would turn out to be impossible to implement this change in the CMS, this order takes precedence.

ORDER DETAILS

Order no. ORD_7966/2025 in ACTION NUMBER: ACT_67479/2024

UPC number: UPC_CFI_829/2024

Action type: Revocation Action

Related proceeding no. Application No.: 7719/2025

Application Type: Application for a change in parties
