

**UPC CFI, Local Division Munich, 28 February 2025,
Esko v XSYS**

curing of photo-curable printing plates

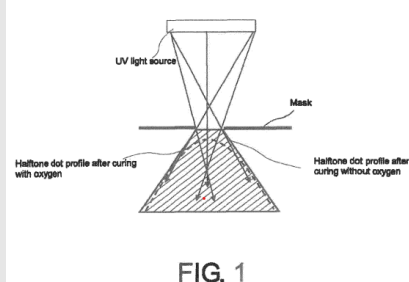


FIG. 1

PATENT LAW – PROCEDURAL LAW

Application to add The Netherlands to the list of countries for which a declaration of infringement is requested rejected a late filed (R. 263.2(a) RoP)

- it would have been possible to request the inclusion of the Netherlands in the action by mid-December 2024 instead of 17 January 2025

26. According to the Claimant's own submissions, it became aware of the decision of the Netherlands Patent Office on 7 November 2024. Consequently, from that date onwards, it knew that the Netherlands part of the patent in suit was in force again. From that date onwards, it could and should have addressed the question, with due diligence, of whether this had consequences for the action already pending before the Local Division Munich and, if so, what consequences. To this end, it could have sought legal advice and discussed with its (UPC) representatives whether and how the pending action could also (still) be based on the Netherlands part of the patent in suit.

27. In this context, due regard should also have been paid to a reasonable time frame. It would have been in line with the standard of diligence required in this respect to notify the decision of the Netherlands Patent Office to the (UPC) representatives in a timely manner and to arrange a timely appointment for advice. The Court assumes that such an appointment would in any case have been possible within four weeks. The appropriateness of the time frame depends also on the complexity of the factual and legal issues to be clarified. As can be seen from the other arguments in the Claimant's request, a period of three days between deliberation and filing the request was sufficient in this case.

28. In view of this, based on the date of knowledge on 7 November 2024 and considering a possible deliberation appointment within four weeks and the time required to draft the application after the deliberation, it would have been possible to request the inclusion of the Netherlands in the action by mid-December 2024.

Source: [Unified Patent Court](#)

**UPC CFI, Local Division Munich,
27 February 2025**

(U. Voß)

UPC_CFI_483/2024

PROCEDURAL ORDER

of the Court of First Instance of the Unified Patent Court
issued on 28 February 2025

CLAIMANT

Esko-Graphics Imaging GmbH, Zusestraße 4a, 25524 Itzehoe, Germany,
represented by: Dr Steininger, Hogan Lovells International LLP, Karl-Schornagel-Ring 5, 80539 Munich, Germany.

DEFENDANTS

1) XSYS Germany GmbH, Industriestraße 1, 77731 Willstätt, Germany,

2) XSYS Prepress N.V., Oostkaai 50, 8900 Ieper, Belgium,

3) XSYS Italia S.r.l., Corso Di Porta Nuova n. 46, 20121 Mailand, Italy,

represented by: Dr Pansch, rospatt Rechtsanwälte PartGmbH, Emanuel-Leutze-Str. 11, 40547 Düsseldorf, Germany.

PATENT AT ISSUE:

European Patent [EP 3 742 231](#)

PANEL/DIVISION

Panel 2 Local Division Munich

DECIDING JUDGES:

This order has been issued by Presiding Judge Ulrike Voß as Judge-Rapporteur.

LANGUAGE OF THE PROCEEDINGS:

English

SUBJECT MATTER

[R. 263 RoP](#) – Leave to change claim or amend case

SUMMARY OF FACTS

1. The Claimant is suing the Defendants for patent infringement of patent EP 3 742 231 (hereinafter: patent in suit or patent at issue). In the Statement of claim dated 27 August 2024, the Claimant asserted that the patent in suit had been infringed in Belgium, Germany, France and Italy and, with regard to these Member States, applied in point I. of the Statement of claim for a declaration of the (alleged) infringement of the patent in suit and in point II.1 for an injunction against the (alleged) patent infringement. Service of the Statement of claim on the Defendants was on 15 September 2024 and 20 September 2024, respectively.

2. At the time the action was filed on 27 August 2024, the national part of the patent at issue was not in force in the Netherlands. The national part of the patent in suit in the Netherlands was deemed to have lapsed at that time due to an overdue payment of the renewal fee (Exhibit HL E 2). On 18 October 2024, the Netherlands Patent Office granted the Claimant's application for restoration filed in November 2023. The national part of the patent in suit is therefore in force again (Exhibits HL E 3, HL E 4).

3. The Defendants have filed a Counterclaim for revocation dated 13 December 2024. In the Counterclaim for revocation, which was served on the Claimant on 7 January 2025, the Defendants request that the patent at issue be declared invalid for the Netherlands as well.

REQUESTS OF THE PARTIES

4. By pleading dated 17 January 2025, the Claimant requests:

The Netherlands is added to the list of countries for which the Claimant, in its Statement of claim dated 27 August 2024, requested a declaration of infringement in point I. and an injunction in point II.1, by way of an extension of the action in accordance with [R. 263 RoP](#).

5. The Defendants' request:

I. The Claimant's application for leave to amend the case lodged on 17 January 2025 is rejected.

II. Leave to appeal is not granted.

SUBMISSION OF THE PARTIES

6. The Claimant is of the opinion that the conditions for allowing the amendment of the case pursuant to [R. 263 RoP](#) are fulfilled. There is no ground for refusal according to [R. 263.2 RoP](#).

7. The amendment could not have been made earlier. The grant of the request for restoration of rights was communicated to the Claimant's patent attorneys by letter dated 30 October 2024. The Claimant was informed of this notification by the patent attorneys on 7 November 2024. The Claimant's lawyers were informed of the restoration of the previous status in the Netherlands in a telephone conversation between the Claimant and the patent attorneys on 14 January 2025. It was only in this context that the Claimant learned from its attorneys that an amendment of the infringement action could be requested in respect of the Netherlands part of the patent in suit, which was now back in force. The Claimant has therefore only been aware of the possibility of amending the claim in the infringement proceedings for a few days. Furthermore, the infringement proceedings are still in the written procedure and the Claimant is filing this request before the exchange of replies and rejoinders.

8. The Claimant further submits that the amendment will not unreasonably hinder the Defendants in the conduct of its action. The Claimant argues that the addition of the Netherlands to the list of countries for which an infringement is to be determined and for which an injunction is sought does not impede the Defendants' conduct of the proceedings. The subject-matter of the proceedings is independent of the countries included in the operative part. Furthermore, the Defendants do not dispute that they offer and supply the challenged embodiment in the Netherlands as well. The requested leave to amend the case has no effect on the way in which the Defendants will defend themselves and prepare for the oral hearing.

9. In view of the Defendants, the requirements of [Rule 263.2 RoP](#) are not met. The Claimant fails to show that it could not have made the amendment at an earlier stage with reasonable diligence.

10. The Defendants denied on grounds of lack of knowledge that the Claimant's patent attorneys became aware of the grant of restoration only on 30 October 2024. The Claimant's patent attorneys in the restoration procedure receive post digitally via MyPage, the digital mailbox used by the Netherlands Patent Office. In normal cases, a decision by the Netherlands Patent

Office is received on MyPage one day after the decision (Exhibit RoP 18). The restoration decision was issued on 18 October 2024, a Friday (see Exhibit HL E4). Therefore, according to the Defendants, the decision must have been received by the patent attorneys on Monday, 21 October 2024.

11. The Defendants also emphasise that the amendment could and should have been made at an earlier stage and clearly before the end of the Defendants' deadline to file the Statement of defence. The circumstances giving rise to the amendment of the case came to the Claimant's awareness as soon as the restoration decision was received by its patent attorneys (presumably as early as 21 October 2024). In the Defendant's opinion, the knowledge of its patent attorneys, as its representatives in the restoration procedure, is to be attributed to the Claimant. The fact that the flow of information was allegedly very slow is irrelevant. The Claimant is obliged to manage its business properly and ensure a proper flow of information.

12. But even according to the Claimant's own submission, the Claimant became positively aware of the restoration decision by 7 November 2024 at the latest – i.e., more than six weeks before the end of the deadline for filing the Statement of defence (20 December 2024). According to the Defendants, the Claimant therefore had more than enough time to seek legal advice and to file the application to amend the case at a time when it would have been possible for the Defendants to consider the amendment in their Statements of defence without delay. The Claimant even filed several other statements since the restoration decision was issued

REASONS FOR THE ORDER

I.

13. Pursuant to [R. 263.1 RoP](#) a party may at any stage of the proceedings apply to the Court for leave to change its claim or to amend its case, including adding a counterclaim. Any such application shall explain why such change or amendment was not included in the original pleading. The application must therefore have a certain content.

14. Provisions in the Rules of Procedure as to how the Court is to rule on an application under [Rule 263.1 RoP](#) are found in [Rule 263.2 RoP](#) and [Rule 263.3 RoP](#). While paragraph 3 prescribes the admissibility of the amendment in a particular situation, [Rule 263.2 RoP](#) deals with the situation in which the application is to be refused, and the amendment is therefore rejected. Consequently, the conditions for a negative decision by the Court are explicitly regulated, whereby the conditions are also formulated negatively. [Rule 263.2 RoP](#) reads:

“Subject to paragraph 3, leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot satisfy the Court that:

(a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and
(b) the amendment will not unreasonably hinder the other party in the conduct of its action.”

15. As the word 'and' at the end of (a) indicates, (a) and (b) are cumulative requirements. Consequently, if the

Court is not satisfied that the requirements of (a) and (b) are met, it must refuse the application. It has no discretion in this respect.

16. If the negative formulation of the first part of the sentence of Rule [263.2 RoP](#) is resolved and formulated positively, this means that leave to change claim or amend case will be granted if the applicant satisfies the Court that (a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and (b) the amendment will not unreasonably hinder the other party in the conduct of its action.

17. It follows from the above paragraphs that if the Court is 'only' satisfied that only the conditions under (a) or only the conditions under (b) are met, the application must (also) be refused. This is because, in this case, the Court is not satisfied that (a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and (b) the amendment will not unreasonably hinder the other party in the conduct of its action (same result: Local Division Munich, UPC_CFI_41/2024, ORD_25797/2024, 6 August 2024. See also: Court of Appeal, UPC_CoA_44/2024, Order of 11 March 2024, APL_5395/2024, App_12629/2034 – Netgear/Huawei).

II.

18. Applied to the present case, this means the following:

1)

19. The Claimants request of 17 January 2025 is a request to amend the action pursuant to [Rule 263.1 sentence 1 RoP](#). An amendment of a case occurs when the nature or the scope of the dispute changes ([Court of Appeal, UPC CoA 456/2024, Order of 21 November 2024, APL 44633/2024](#)). The addition of a further Member State to the list of countries in respect of which a judgment for patent infringement is sought extends the scope of the original action.

20. The Claimant has also stated in its request, in accordance with [Rule 263.1 sentence 2 RoP](#), why the requested amendment was not included in the Statement of claim dated 27 August 2024. At the time the action was filed, the national part of the patent at issue was not in force in the Netherlands. The Claimant has therefore fulfilled the requirements regarding the content of the application

2)

21. The application is nevertheless to be rejected in accordance with [Rule 263.2 RoP](#). The Claimant could not satisfy the Court that (a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and (b) the amendment will not unreasonably hinder the other party in the conduct of its action.

a)

22. The Court assumes that the Defendants are not unreasonably hindered in their conduct of the proceedings, [Rule 263.2 \(b\) RoP](#). The Claimant has argued that the subject-matter of the proceedings is independent of the countries included in the operative part. Furthermore, the Defendants offer and supply the challenged embodiment in the Netherlands as well.

Therefore, the requested leave to amend the case will have no effect on the way in which the Defendants will defend themselves and prepare for the oral hearing. The Defendants have not objected to this. They have not presented any (other) reasons why they are unreasonably impeded in their conduct of the proceedings.

23. The mere reference made elsewhere to the fact that the request for amendment was lodged after the expiry of the time-limit for lodging a Statement of defence is not sufficient. In the absence of further specific submissions, it is not apparent why, in the present case and in the circumstances, it is not sufficient for the Defendants to deal with the alleged infringement in the Netherlands, if at all necessary, in the context of the rejoinder.

b)

24. However, the Claimant has not satisfied the Court that, taking into account all the circumstances, the amendment could not have been made with reasonable diligence at an earlier stage, [Rule 263.2 \(a\) RoP](#).

25. In this context, it is not necessary to decide whether the Defendant's assertion that the Claimant's patent attorney was aware of the decision of the Netherlands Patent Office in the restoration of rights proceedings as early as 21 October 2024 is correct. Nor does the Court need to decide whether the Claimant must accept that its patent attorney's knowledge is attributable to it. Even if this were incorrect, the Claimant did not satisfy the Court that the requested amendment could not have been filed with due diligence at an earlier stage.

26. According to the Claimant's own submissions, it became aware of the decision of the Netherlands Patent Office on 7 November 2024. Consequently, from that date onwards, it knew that the Netherlands part of the patent in suit was in force again. From that date onwards, it could and should have addressed the question, with due diligence, of whether this had consequences for the action already pending before the Local Division Munich and, if so, what consequences, . To this end, it could have sought legal advice and discussed with its (UPC) representatives whether and how the pending action could also (still) be based on the Netherlands part of the patent in suit.

27. In this context, due regard should also have been paid to a reasonable time frame. It would have been in line with the standard of diligence required in this respect to notify the decision of the Netherlands Patent Office to the (UPC) representatives in a timely manner and to arrange a timely appointment for advice. The Court assumes that such an appointment would in any case have been possible within four weeks. The appropriateness of the time frame depends also on the complexity of the factual and legal issues to be clarified. As can be seen from the other arguments in the Claimant's request, a period of three days between deliberation and filing the request was sufficient in this case.

28. In view of this, based on the date of knowledge on 7 November 2024 and considering a possible deliberation appointment within four weeks and the time required to draft the application after the deliberation, it would have

been possible to request the inclusion of the Netherlands in the action by mid-December 2024.

29. However, the request pursuant to [Rule 263 RoP](#) was not filed until 17 January 2025. This is approximately ten weeks after the decision of the Netherlands Patent Office had become known. No convincing reason for this delay has been provided. It has not been explained or otherwise made clear what the Claimant did between 7 November 2024 and 14 January 2025 regarding the restoration of the Netherlands part of the patent at issue. The Claimant's application only reveals that it was not until 14 January 2025 that the restoration of rights was discussed in a telephone conversation with the (UPC) representatives and the patent attorney. From this, it can be concluded that the Claimant itself initially did not take any further action regarding re-establishment of rights and its consequences. It did not forward the decision of the Netherlands Patent Office to its (UPC) representatives either immediately or in a timely manner, nor did it inform the (UPC) representatives of it in any other way. It was not explained why a telephone conversation was not held until 14 January 2025 and why it was not possible to hold a meeting earlier.

30. The reason for the re-establishment of rights being discussed in the telephone conversation has not been stated. Should the reason for this lie in the Counterclaim for revocation that was served to the Claimant a week earlier and in which the Netherlands part of the patent in suit is mentioned, this would not change anything. Due to the knowledge already present, merely reacting to the Counterclaim for revocation did not meet the standard of due diligence.

31. Since the subsequent (additional) knowledge of the Claimant's (UPC) representatives is not relevant, the fact that leave to amend the case was promptly requested from that point on is not decisive.

c)

32. In view of this, the situation described in paragraph 17 applies and leave to amend the case cannot be granted according to [Rule 263.2 RoP](#).

ORDER

The Claimant's application dated 17 January 2025 for leave to amend the case is rejected.

INFORMATION ABOUT REVIEW BY THE PANEL

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