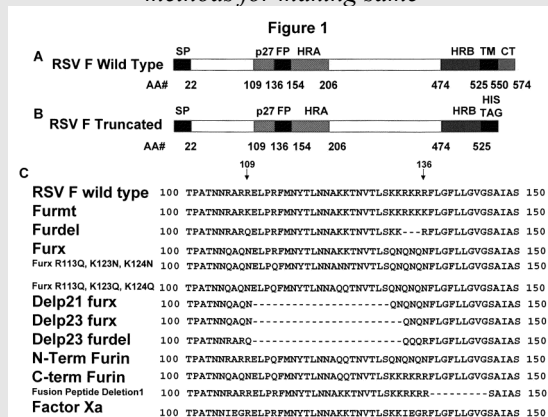


UPC CFI, Local Division Düsseldorf, 4 March 2025, GlaxoSmithKline Biologicals v Pfizer

RSV F protein compositions and methods for making same



PATENT LAW – PROCEDURAL LAW

Bifurcation ordered: revocation action at CD Milan filed at same date as infringement action ([Article 33.\(3\) UPCA](#), [R. 37 RoP](#))

- **Unanimous request by the parties and a referral of the Counterclaim for revocation seems to be appropriate, particularly for reasons of efficiency.**

The Revocation action and the Counterclaim for revocation are essentially based on the same prior art documents and other grounds for invalidity such as added matter, lack of technical contribution and lack of sufficiency. The Defendants themselves state that the Counterclaim for revocation (only) updates and amends the grounds in the Statement for revocation because since the filing of the Revocation action the B-specification of the patent in suit has been published and the UK Patent Courts handed down a judgement by which two further related patents were held to be invalid and not infringed. The Central Division is therefore already familiar with the subject matter of the counterclaim for revocation.

- **No stay of infringement action at this stage: question of high likelihood of invalidity requires a detailed examination, taking into account the entire content of the file**

The Panel is of the opinion that a stay of the proceedings would not be appropriate at this stage. The question of whether there is a high likelihood of invalidity requires a detailed examination, taking into account the entire content of the file. For this reason, given the stage of the proceedings, it does not appear effective to deal with the issue of invalidity at this point in time.

However, the Panel reserves the right to reconsider the possibility of staying the infringement proceedings at a later stage (cf [UPC CFI 14/2023 \(LD Munich\)](#), [Order of 2 February 2024 - Sanofi v Amgen](#)).

Time period for the Defendants' Rejoinder to the reply to the statement of defence extended with one month ([R. 9.3 RoP](#))

- **Exceptional case. Given that the bifurcation decision was taken only relatively shortly before the expiry of the time period for lodging the Rejoinder, it appears appropriate to grant the Defendants an extension by one month.**

Source: [Unified Patent Court](#)

UPC Court of First Instance, Local Division Düsseldorf, 4 March 2025

(Thomas, Schumacher, Postiglione)

Lokalkammer Düsseldorf

UPC_CFI_468/2024

UPC_CFI_687/2024

Procedural Order

of the Court of First Instance of the Unified Patent Court issued on 4 March 2025

concerning [EP 4 183 412](#)

CLAIMANT:

GlaxoSmithKline Biologicals SA, Rue de l'Institut 89, 1330 Rixensart, Belgium,

Represented by: Attorney at law Oliver Jan Jüngst, Attorney at law Luca Brons, Bird & Bird LLP, Carl-Theodor-Straße 6, 40213 Düsseldorf, Germany,

Participating: Patent Attorney Dr. Daniela Kinkeldey, Patent Attorney Dr. Anna Schadel, Bird & Bird LLP, Maximiliansplatz 22, 80333 Munich, Germany,

Electronic address for service: oliver.jan.juengst@twobirds.com

DEFENDANTS:

1. **Pfizer Europe MA EEIG**, Boulevard de la Plaine 17, 1050 Ixelles, Belgium,

2. **Pfizer Manufacturing Belgium NV**, Rijksweg 12, 2870 Puurs, Belgium,

3. **Pfizer Pharma GmbH**, Friedrichstraße 110, 10117 Berlin, Germany,

4. **Pfizer Corporation Austria GmbH**, Floridsdorfer Hauptstraße 1, 1210 Wien, Austria,

5. **Pfizer SA**, Boulevard de la Plaine 17, 1050 Ixelles, Belgium,

6. **Pfizer Aps**, Lautrupvang 8, 2750 Ballerup, Denmark,

7. **Pfizer Oy**, Tietokuja 4, 00330 Helsinki, Finland,

8. **Pfizer SAS**, 23-25 Avenue du Docteur Lannelongue, 75014 Paris, France,

9. **Pfizer S.r.l.**, Via Isonzo 71, 04100 Latina, Italy,

10. **Pfizer B.V.**, Rivium Westlaan 142, 2909 LD Capelle aan den IJssel, The Netherlands,

11. **Laboratórios Pfizer, Lda.**, Lagoas Park, Edifício 10, 2740-244 Porto Salvo, Portugal,

12. **Pfizer AB**, Solnavägen 3H, 113 63 Stockholm, Sweden,

13. **Pfizer Luxembourg S.a.r.l.**, Rond-point du Kirchberg 51, Avenue J.F. Kennedy, I 1855 Luxembourg,

14. **Pfizer Service Company S.r.l.**, Hoge Wei 10, 1930 Zaventem, Belgium,

All represented by: Patent Attorney Gareth Williams, Marks & Clerk LLP, 15 Fetter Lane, London, EC4A 1BW, United Kingdom,

Attorney at law Dr. Claudia Milbradt, Attorney at law Dr. Tobias J. Hessel, Clifford Chance Partnerschaft mbB, Königsallee 59, 40215 Düsseldorf, Germany, Electronic address for service: MCL-RSV@marks-clerk.com

PATENT AT ISSUE:

European patent n° [EP 4 183 412 B1](#)

PANEL/DIVISION:

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This decision was issued by Presiding Judge Thomas, legally qualified judge Dr Schumacher acting as judge-rapporteur and legally qualified judge Postiglione.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement action – [R. 37 RoP](#); [Art. 33\(3\)UPCA](#) (bifurcation) and [R. 9.3\(a\)](#) (extension of a time period)

SUMMARY OF THE FACTS:

On 5 August 2024, the Claimant filed a patent infringement action against the Defendants in respect of EP 4 183 412 (patent in suit).

The mention of the publication of the grant of the patent in suit was published on 14 August 2024.

On the same day, 14 August 2024, Defendants 1., 2., 3., 5., 10., 14. and two other Pfizer entities filed a revocation action with the Milan Central Division.

Defendants 4., 6., 7., 8., 9., 11., 12. and 13. filed a counterclaim for revocation on 14 November 2024.

Together with its Reply to the counterclaim for revocation dated 13 January 2025, the Claimant filed an application to amend the patent in suit.

On the same day, the Claimant filed its Defence to the revocation action and a further application to amend the patent with the Milan Central Division.

The Defendants request a two-month extension of the time periods for filing the Rejoinder to the Defence to the counterclaim and the Defence to the application to amend the patent.

By Preliminary Order of 14 February 2025, the judge-rapporteur has informed the Parties that the Panel intends to take an earlier decision under [R. 37.2 RoP](#) on how to proceed with the counterclaim for revocation. The Parties were invited to submit observations. The Claimant and the Defendants agree that the Counterclaim for revocation should be referred to the Central Division. However, they disagree on whether to proceed with the infringement proceedings in the event of a referral. The Claimant seeks to proceed and requests the Court to set a timely date for the oral hearing, even if the oral hearing then takes place before the oral hearing on the Counterclaim for revocation in Milan. The Defendants request a stay of the proceedings pending a final decision in the revocation action. They base their request primarily on the alleged high likelihood of invalidity of the patent in suit. Apart from that, they argue that the validity issue should be addressed first anyway.

The judge-rapporteur has also informed the Parties that the Panel considers an extension of one month for the filing of the Rejoinder to be sufficient. While the Defendants maintain their request for a two-month

extension, the Claimant opposes any extension of the deadline.

By Procedural Order dated 19 February 2025, the Central Division has set a date for the oral hearing in the revocation proceedings for 10 November 2025.

GROUND FOR THE DECISION:

I. Pursuant to [R. 37.2 RoP](#), the Local Division takes an earlier decision on the question of how to proceed with regard to [Art. 33\(3\) UPCA](#) before the end of the written procedure.

1. If a counterclaim for revocation has been brought in the case of an infringement action, [Art. 33\(3\) UPCA](#) states that the local or regional division concerned shall, after having heard the parties, have the discretion either to:

- (a) proceed with both the action for infringement and with the counterclaim for revocation and request the President of the Court of First Instance to allocate from the Pool of Judges in accordance with [Art. 18\(3\)](#) a technically qualified judge with qualifications and experience in the field of technology concerned;
- (b) refer the counterclaim for revocation to the central division and stay or proceed with the action for infringement; or
- (c) with the agreement of the parties, refer the case to the central division.

2. In the present case, the Local Division exercises its discretion to refer the counterclaim for revocation to the Central Division and to proceed with the infringement action ([Art. 33\(3\)\(b\) UPCA](#)).

While in general there are advantages in having the infringement action and the counterclaim for revocation being heard together by the same panel, the circumstances of this case call for a different decision.

The Parties have unanimously requested a referral of the Counterclaim for revocation to the Central Division. Unanimous requests by all parties will be granted unless strong counterarguments require a different decision ([UPC CFI 14/2023 \(LD Munich\), Order of 2 February 2024 - Amgen v Sanofi](#)). The Panel does not see any such strong counterarguments. On the contrary, a referral of the Counterclaim for revocation seems to be appropriate, particularly for reasons of efficiency. In the exercise of discretion, procedural efficiency is of particular importance (cf [Preamble 4 RoP](#); see also [UPC CFI 410/2023 \(LD Mannheim\), Order of 10 July 2024 - MED-EL v Advanced Bionics](#)). The Revocation action and the Counterclaim for revocation are essentially based on the same prior art documents and other grounds for invalidity such as added matter, lack of technical contribution and lack of sufficiency. The Defendants themselves state that the Counterclaim for revocation (only) updates and amends the grounds in the Statement for revocation because since the filing of the Revocation action the B-specification of the patent in suit has been published and the UK Patent Courts handed down a judgement by which two further related patents were held to be invalid and not infringed. The Central Division is therefore already familiar with the subject matter of the counterclaim for revocation.

For the avoidance of doubt, it should be noted that the panel refers the counterclaim for revocation filed by all counterclaimants to the Central Division (Defendants 4., 6. to 9., 11. to 13.).

3. The Local Division further exercises its discretion to proceed with the infringement action pursuant to [Art. 33\(3\)\(b\) UPCA](#), [R. 37.4 RoP](#). Where the panel decides to proceed in accordance with [Art. 33\(3\)\(b\) UPCA](#), it may stay the infringement proceedings pending a final decision in the revocation proceedings and shall stay the infringement proceedings where there is a high likelihood that the relevant claims of the patent will be held to be invalid on any ground by the final decision in the revocation proceedings, [R. 37.4 RoP](#).

The Panel is of the opinion that a stay of the proceedings would not be appropriate at this stage. The question of whether there is a high likelihood of invalidity requires a detailed examination, taking into account the entire content of the file. For this reason, given the stage of the proceedings, it does not appear effective to deal with the issue of invalidity at this point in time.

However, the Panel reserves the right to reconsider the possibility of staying the infringement proceedings at a later stage (cf [UPC_CFI_14/2023 \(LD Munich\)](#), [Order of 2 February 2024 - Sanofi v Amgen](#)).

4. To avoid any doubt, it is clarified that the Application to amend the patent is referred together with the Counterclaim for revocation.

II. [R. 9.3\(a\) RoP](#) authorises the Court to extend time periods. However, this possibility should only be used with caution and only in justified exceptional cases ([UPC_CFI_363/2023 \(LD Düsseldorf\)](#), [Order of 20 January 2024 - Seoul Viosys Co., Ltd. v expert e-Commerce GmbH, expert klein GmbH](#)).

This is such an exceptional case. However, the Panel considers an extension of the time period by one month to be sufficient.

Given that the bifurcation decision was taken only relatively shortly before the expiry of the time period for lodging the Rejoinder, it appears appropriate to grant the Defendants an extension by one month. The Panel has also taken into account that the deadlines for filing the Reply to the defence and the Defence to the patent amendment application in the revocation proceedings have been extended and will now also expire on 13 April 2025.

The Panel also had to consider that the bifurcation decision does not mean that the auxiliary requests no longer have any significance for the infringement proceedings. The auxiliary requests are also indirectly relevant to the infringement proceedings and require the Defendants to address them.

As far as the Defence to the counterclaim and the Defence to the application to amend the patent are concerned, the Panel no longer needs to decide on the request for an extension of time periods. Once the referral has been realised, this decision will be taken by the Central Division.

III. The Defendants' proposal to limit their pleadings to the granted version of the patent is rejected.

Such an order would be incompatible with the time limit regime laid down in the Rules of Procedure. The proper conduct of the oral proceedings would also be put at risk. However, the granted extension of the time limit for filing the Rejoinder will allow the Defendants to address all issues relating to the infringement, including the auxiliary requests.

ORDER:

I. The Düsseldorf Local Division refers the counterclaim for revocation to the Milan Central Division and proceeds with the infringement action ([Art. 33\(3\)\(b\) UPCA](#)).

II. The time period for the Defendants' Rejoinder to the reply to the statement of defence is extended until 13 April 2025.

DETAILS OF THE ORDER:

App_4496/2025 related to the main proceeding
ACT_45141/2024 and CC_60908/2024

UPC-Number: UPC_CFI_468/2024 and
UPC_CFI_687/2024

Subject of the Proceedings: Patent infringement action
and Counterclaim for revocation

Issued in Düsseldorf on 4 March 2025

NAMES AND SIGNATURES

Presiding Judge Thomas

Legally Qualified Judge Dr Schumacher

Legally Qualified Judge Postiglione
