

UPC CFI, Local Division Milan, 7 April 2025,
Dainese v Alpinestars



PATENT LAW – PROCEDURAL LAW

Leave to limit a claim unconditionally, which shall always be granted (**R. 263.3 RoP**)

- applies both in cases where a) the claimant limits the relief sought (petitum), for example by reducing the relief sought (e.g. injunction or damages); and b) the claimant limits the cause of action (causa petendi), for example after starting the proceedings to protect a plurality of patents, then it renounces one of them.

- Differently from rule 265 RoP (withdrawal), rule 263 RoP does not provide the regulation of the proceeding costs, because the proceedings continue against the defendant in relation to other claims. This solution doesn't go against the "losing party bears the costs" principle, established by **Article 69 UPCA**: indeed, the unconditional limitation requested by the claimant will be considered by the Court regulating the costs decision.

Source: **Unified Patent Court**

UPC Court of First Instance,
Local Division Milan, 7 April 2025
(Perrotti, Zana, Klein, Ashley)

UPC_CFI_472/2024

Act. no. 45469/2024

App. No, 8545/2025

Order n. 10964/2025

issued on 7 April 2025

Headnotes

Rule 263, para. 3, RoP applies both in cases where a) the claimant limits the relief sought (petitum), for example by reducing the relief sought (e.g. injunction or damages); and b) the claimant limits the cause of action (causa petendi), for example after starting the proceedings to protect a plurality of patents, then it renounces one of them. Differently from **rule 265 RoP**, **rule 263 RoP** does not provide the regulation of the proceeding costs, because the proceedings continue against the defendant in relation to other claims. This solution doesn't go against the "losing party bears the costs" principle, established by **Article 69 UPCA**: indeed, the unconditional limitation requested by the claimant will be considered by the Court regulating the costs decision.

Keywords

rule 263 RoP, **rule 265 RoP**

APPLICANT

Dainese S.p.A (Claimant in the main proceedings)

RESPONDENTS

Alpinestars S.p.A. (Defendant 1 in the main proceedings)

Alpinestars Research S.p.A. (Defendant 2 in the main proceedings)

Motocard Bike S.I. (Defendant 6 in the main proceedings)

PATENT AT ISSUE

Patent no. Proprietor/s

EP4072364 Dainese S.p.A.

EP3498117 Dainese S.p.A.

DECIDING JUDGE

Full Panel

COMPOSITION OF PANEL – FULL PANEL

Presiding judge Pierluigi Perrotti

Judge-rapporteur Alima Zana

Legally qualified judge Anna-Lena Klein

Technically qualified judge Graham Ashley

LANGUAGE OF PROCEEDINGS:

English

Summary of facts

1. On 17 February 2025, Dainese spa - claimant in the main proceedings - filed an application for leave to limit claims pursuant to **Rule 263.3 RoP** (after EPO's decision) requiring:

- to exclude all the arguments, requests and pleading related to the infringement of EP'117, maintaining its claims regarding EP'364;

- to partially reimburse the fees paid for an amount of 12,000 EUR. In addition, the Claimant specified that at the time of the lodging of this action it was not possible to predict that at the end of the appeal proceedings before the Board of Appeal of the EPO, the scope of EP '117 would be limited to the combination of subject-matter defined in claims no. 1, 6, 8 and 9. Indeed, the patent had been maintained unamended after the first-instance opposition proceedings. Unexpectedly, only a few weeks before the oral proceedings, the Board of Appeal issued negative opinion concerning the validity of the patent.

2. By preliminary order filed on 5 March 2025, the Judge rapporteur requested the Defendants to comment on the application.

3. On 27 March 2025, Defendants filed three identical defensive briefs with the following conclusions:

A) issue a cost decision pursuant to **Rule 265(2) RoP**, ordering the Claimant to reimburse to Defendants 1), 2) and 6) 100.000 EUR each;

B) in the alternative, separate the proceedings to the extent it refers to the alleged infringement of EP'117, declare the action closed under **Rule 265 RoP** and issue a cost decision pursuant to **Rule 265(2) RoP**;

C) reject Claimant's request for partial reimbursement of Court fees and reconsider the previous orders to the extent they granted a partial reimbursement of the Court fees to Claimant.

In essence, the Defendants qualified Dainese's application as a partial withdrawal governed by [Rule 265 RoP](#) rather than [Rule 263 RoP](#): with the consequence that the claimant must pay the costs of the proceedings.

Grounds of the decision

4. General consideration

This order is adopted in accordance with:

- [Rules 263.3](#) and [265 RoP](#); [Art. 69 UPCA](#);
- UPC case Law, in particular

(i) [UPC CoA no. 456/2024 - Apl. no. 44633/2024, 11 November 2024](#) ("Not every new argument constitutes an "amendment of a case" requiring a party to apply for leave under [R. 263 RoP](#). An amendment of a case occurs when the nature or scope of the dispute changes. For example, in an infringement case, this occurs if the plaintiff invokes a different patent or objects to a different product); (ii) [UPC CoA no. 1144/2024 - Apl. no. 5395/2024 App. no. 12629/2024, 11 March 2024](#) ("Pursuant to [R. 263.1 RoP](#) a request to be granted leave to amend the case by broadening the basis of the claims - and where necessary change the claim(s) as a result thereof - by adding another patent, may be made").

The Panel observes that [Rule 263 RoP](#) governs the amendment of a case, that "occurs when the nature or scope of the dispute changes"¹

The amendment comprises the limitation of the claim, as provided for in [rule 263, paragraph 3, RoP](#), requiring an unconditional request; in this case "Leave to limit a claim in an action unconditionally shall always be granted". This means that acceptance is not subject to the checks provided for in paragraph 2 for other cases requesting amendments.

This instrument covers both cases wherein the Claimant amends:

✓ the relief sought (*petitum*), for example by reducing the relief sought (e.g. injunction or damages²);

✓ the cause of action (*causa petendi*) for instance, in case he/she initially sued the defendant for infringement of one patent, then adding a new patent (see [UPC Court of Appeal, Ord. 13028/2024 11 March 2024, Netgear v Huawei Apl. no. 5395/2024](#)).

Therefore, [Rule 263, para 3, RoP](#) regulates also the opposite case, wherein the patentee, after starting the proceedings to protect a plurality of patents, then renounces one of them. Indeed, the verb "limit" used in [rule 263, para 3, RoP](#) is not accompanied by any further specification.

Differently from [rule 265 RoP](#), [Rule 263 RoP](#) does not provide the regulation of the proceeding costs, because the proceedings continue against the defendant in relation to other claims. This solution does not go against the "losing party bears the costs" principle, established by [Art. 69 UPCA](#); indeed, the unconditional limitation

decided by the claimant will be considered by the Court when assessing the final decision on costs.

5. The case at hand

In the case at hand, the infringement action concerns a plurality of the patents: EP'117 and EP'364. The Claimant's application unconditionally requests limitation of its claims to the latter.

In light of the above considerations, the application filed by the Claimant is ruled by [263, para 3, RoP](#), which governs the leave to limit a claim in an action:

A) unconditionally.

B) reducing the case of action to only one - EP 364 - of the two patents initially invoked. The main proceedings are not concluded for any of the Defendants, as Dainese's claims to the EP'364 patent are maintained.

Therefore, the different instrument governed by [rule 265 RoP](#), concerning the case in which the claimant withdraws the action - all its claims- against one defendant, is not applicable here.

6. In addition, Dainese requests the Court to reimburse in part the fees already paid, pursuant to [Rule 263 \(4\) 'RoP'](#).

The application is based only on [rule 370.9\(b\)\(i\) RoP](#) ("in case of withdrawal of an action the party liable for the Court fees will be reimbursed: (i) by 60% if the action is withdrawn before the closure of the written procedure"), which, however, regulates the different case of withdrawal. Therefore, as well as specified in other decisions "the request lacks any substantive argumentation beyond a mere citation of the relevant provision, failing to provide the Court with any basis upon which to exercise its discretion to re-consider the amount of the fees".³ This latter Claimant's request cannot be granted.

7. Finally, the Defendants request that a decision on costs pursuant [Rule 265\(2\)](#) be issued ordering the Claimant to reimburse to Defendants 1), 2) and 6) 100.000 EUR each. The Court notes that, differently from [Rule 265 RoP](#), [the Rule 263 RoP](#) does not provide the regulation of the proceeding costs, because the proceedings continue against the Defendant in relation to other claims. Therefore, the Defendants' request to reimburse the costs is postponed until the final decision and will be dealt with in the main proceedings. This solution does not go against the so-called "losing party bears the costs" principle, established by [Art. 69 UPCA](#): indeed, the unconditional limitation requested by the claimant will be considered by the Court regulating the costs decision. Therefore, the Defendants' concern that a party would be allowed to drop a claim - even a substantive one - without any consequence of costs, is unfounded. The conclusions regarding costs are postponed until the final decision is taken.

ORDER

more precisely as a limitation of the claim, and if it is filed with due explanation and unconditionally must be granted by the Court, pursuant to [Rule 263 \(3\) 'RoP'](#)"

³ See [Paris Central Division, issued on 26 November 2024, concerning the Application RoP 263 App no. 55394/2024 - UPC CFI no. 164/2024](#), already cited above.

¹ See [UPC CoA 21 November 2024 \(Grabinski, Blok, Germano\) UPC CoA 456/2024 APL 44633/2024](#).

² See [Central division \(Paris seat\) issued on 26 November 2024 concerning the Application RoP263 No. App 55394/2024 UPC CFI 164/2024](#) "The reduction of the damages sought in an infringement action should be considered as a change of the claim,

1. the Court grants the Claimant leave to limit its claims, excluding all the arguments, requests and pleading related to the infringement of EP '117, maintaining its claims regarding EP '364;

2. the Court rejects the request to partially reimbursing the fees paid by the Claimant; 3. the costs decision requested by the Defendants will be dealt with in the main proceedings. Issued in Milan on 7 April 2025.

Presiding Judge Pierluigi Perrotti

Judge-Rapporteur Alima Zana

Legally qualified judge Anna-Lena Klein

Technically Qualified Judge Graham Ashley

Order details

Order no. ORD_10964/2025 in ACTION NUMBER:
ACT_45469/2024

UPC number: UPC_CFI_472/2024

Action type: Infringement Action

Related proceeding no. Application No.: 8545/2025

Application Type: Application for leave to change claim
or amend case/pleading (RoP263
