



Local Division Munich
UPC_CFI_437/2024

Order
of the Court of First Instance of the Unified Patent Court
issued on 14 February 2025

CLAIMANT

GXD-Bio Corporation, B1, 13, Seoun-ro, Seocho-gu, Seoul 06732, Republic of Korea,

represented by: Dr Rauh, Vossius & Brinkhof UPC Litigators, Siebertstrasse 3, 81675 München, Germany.

DEFENDANTS

1. **Myriad International GmbH**, Nattermannallee 1,50829 Cologne, Germany,
2. **Myriad GmbH**, Staffelseestraße 6, 81477 Munich, Germany,
3. **Myriad Service GmbH**, Staffelseestraße 6, 81477 Munich, Germany,
4. **Myriad Genetics GmbH**, Leutschenbachstraße 95, 8050 Zurich, Switzerland,
5. **Myriad Genetics S.A.S.**, 13 rue Camille Desmoulins, 92130 Issy les Moulineaux, France,
6. **Myriad Genetics B.V.**, Schiphol Boulevard 231, 1118BH Schiphol, The Netherlands,
7. **Myriad Genetics S.r.l.**, Via Schiaffino 11, 20158 Milano, Italy,
8. **Myriad Genetics Inc.**, 322 North 2200 West, Salt Lake City 84116, United States of America,
9. **Eurobio Scientific**, 7 avenue de Scandinavie ZA de Courtaboeuf, 91940 Les Ulis, France,

represented by: Dr Hölder, Hoffmann Eitle, Patent- und Rechtsanwälte Partnerschaftsgesellschaft mdB, Arabellastraße 30, 81925 Munich, Germany.

PATENT AT ISSUE

European patent no° EP 3 346 403

PANEL/DIVISION

Panel 2 of the Local Division Munich

DECIDING JUDGE

This Order has been issued by the Presiding Judge Ulrike Voß acting as Judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS

English

SUBJECT-MATTER OF THE PROCEEDINGS

Preliminary Objection R. 19.1 (a) RoP, R. 20.1 RoP

SUMMARY OF FACTS

1. By Statement of Claim dated on 24 July 2024, the Claimant is suing the Defendants for (alleged) infringement of the European patent EP 3 346 403 (hereinafter referred to as the patent at issue or the patent in suit), the mention of the grant of which was published on 17 June 2020. The patent in suit is in force in Germany, Austria, Belgium, France, Italy, Luxemburg and The Netherlands.
2. The Claimant seeks, inter alia, an order to provide information on (allegedly) infringing acts (request II. of the Statement of Claim) and a declaration that Defendant 1-8 are liable for all damages that incurred and will incur due to (allegedly) infringing acts committed since 17 June 2020 (request IV. of the Statement of Claim).
3. Previous proprietors of the patent in suit were Abion, Inc., and Gencurix, Inc. In 2024, the Claimant was entered in the respective national registers of the above-mentioned Contracting Member States as the proprietor of the patent in suit.
4. The Statement of Claim was served on the Defendants 1-8 on 12 August 2024, 16 August 2024, 18 August 2024, 19 August 2024, 20 August 2024, 2 September 2024 and 3 September 2024, respectively. By pleading dated on 9 September 2024, the Defendants 1-8 filed a preliminary objection. The Claimant responded to this in a pleading dated 26 September 2024, to which the Defendants 1-8 replied in a submission dated 29 January 2025.

PARTIES' REQUESTS

5. Defendants 1-8 request (the judge-rapporteur),
 - I. to reject requests II. and IV. of the Complaint to the extent they concern any act allegedly committed or damages allegedly incurred
 - in Germany before June 7, 2024
 - in France before July 24, 2024
 - in Luxemburg before July 3, 2024
 - in Austria, Belgium, Italy and The Netherlands, before Claimant has been registered as the proprietor of the patent in suit in the respective CMS,

in the alternative

- II. to decide that this preliminary objection to be dealt with in the main proceedings.

6. Claimant requests,

- I. to reject Defendants' 1-8 preliminary objection of 9 September 2024,

in the alternative

- II. to decide that this preliminary objection to be dealt with in the main proceedings.

PARTIES' SUBMISSIONS

7. Defendants 1-8 submit that the preliminary objection concerns the Court's lack of competence to adjudge Claimant's requests II. and IV. of the Statement of Claim to the extent they concern acts predating recordal of Claimant in the national registers under Rule 8.5(a)(c) RoP and thus rest on an alleged assignment of the concerned claims.
8. In the view of the Defendants 1-8, the Contracting Member States have only conferred specific competences to the UPC, in particular a catalogue of specific actions, as evidenced by Art. 32(2) UPCA. The actions for which competence has been conferred are limited with respect to (i) the subject matter of the action and (ii) to the persons who may bring an action. Actions for actual or threatened infringement can only be brought by the proprietor or (under further conditions) by a licensee (Art. 47(1) to (3) UPCA). Accordingly, other persons cannot bring an infringement action before the UPC. This includes persons to whom certain rights have been assigned which may have arisen from the infringement of a patent, such as claims for damages. Furthermore, Art. 68(1) UPCA provides that the UPC can award damages only to, and at the request of, the injured party. According to this provision, the UPC cannot award claims for damages for harm (allegedly) suffered by third parties. It is, as a result, not possible to assert claims for damages that the claimant has acquired by way of assignment. When considering Art. 47(1) to (3) and 68(1) UPCA together, claims for damages (or information) can only be asserted by patentees and/or licensees having incurred the harm themselves. In order to allow former patentees and licensees to enforce claims for damages for harm they suffered in the past, Art. 47(1) to (3) UPCA must be interpreted to the effect that it refers to the patent proprietor or licensee at the time of injury. Conversely, a person who has been patent proprietor for a certain period is not entitled to bring an infringement action regarding a time before or after this period of its proprietorship.
9. According to the Defendants 1-8, the question whether also assigned claims can be adjudged by this Court independent from patent ownership at the time they arose is inherent to what kind of requests can be brought before this Court, and thus the scope of

actions for infringement this Court has been entrusted with (Art. 32(1)(a) UPCA). Art. 47(1)(3) and Art. 68(1) UPCA are to be considered when interpreting the scope of the Court's jurisdiction under Art. 32(1) UPCA. There is thus no reason to exclude the doubts raised on the scope of Art. 32(a) UPCA from the challenge by the preliminary objection.

10. The Claimant, on the other hand, is of the opinion that the preliminary objection is unfounded and must therefore be rejected. The arguments raised in the preliminary objection obviously relate exclusively to alleged lack of standing of Claimant to bring suit over these claims, but do not raise issues about the competence of the Court to generally hear such claims. The list of objections according to Rule 19.1 RoP is exhaustive.
11. According to the Claimant, the aspects whether it has the right to pursue such claim and thus the foundation of part of the claim requests raised in the Statement of Claim, do obviously neither concern the general jurisdiction or competence of the Court. It is therefore plainly incorrect when Defendants state that the Court's competence is "limited with respect to ... (ii) the persons who may bring an action". Only the subject matter of the action is a question of competence. Art. 32 UPCA very clearly sets out the Court's competence. The person entitled to bring the action is mentioned nowhere in Art. 32 UPCA, and neither in Art. 33 nor 34 UPCA. Defendants – correctly – do not even claim that, but – incorrectly – rely on Art. 47 and 68 UPCA for the preliminary objection. However, Defendants' interpretation of Art. 47 and 68 UPCA is wrong and cannot be followed, neither as part of the preliminary objection nor in the main proceedings. In particular, the Claimant lawfully acquired the patent in suit from the former patent proprietors by way of a Patent Purchase Agreement, including the rights that are being asserted with the Statement of Claim.

REASONS FOR THE ORDER

12. The preliminary objection of Defendants 1-8 is rejected. In their preliminary objection, Defendants 1-8 have not raised any of the grounds set out in Rule 19.1 RoP. The preliminary objection is therefore inadmissible or at least unfounded. The UPC has jurisdiction over the action pursuant to Art. 32(1)(a) UPCA, Art. 2(g), Art. 3(c) UPCA.

I.

13. According to Rule 19.1 RoP, the defendant may lodge a preliminary objection concerning the "jurisdiction and competence" of the Court (Rule 19.1(a) RoP, Art. 32 UPCA), the "competence" of the division of the Court (Rule 19.1(b) RoP, Art. 33 UPCA), and the "language" of the Statement of Claim (Rule 19.1(c) RoP). This list of grounds for preliminary objection set out in Rule 19.1 RoP is exhaustive, which is why a preliminary objection cannot be based on other grounds (Court of Appeal, CoA_188/2024, Grounds for the Order of 03.09.2024 - Aylo/Dish).
14. The Defendants 1-8 have not raised any of the grounds for objection listed. They dispute the Court's competence with respect to some of the claims raised by the Claimant, so that (it may appear that formally) Rule 19.1(a) RoP could be considered as a point of connection. However, the grounds put forward by the Defendants 1-8 in support of their

preliminary objection do not appear to concern the Court's jurisdiction and competence under Article 32 UPCA, but only the question of the Claimant's standing to bring an action and/or the question of whether the Claimant has acquired substantive ownership of the claims it has asserted.

15. However, these questions are irrelevant for the assessment of jurisdiction under Art. 32 UPCA. Jurisdiction deals only with the question of what type of dispute is assigned to a court for decision. The second requirement put forward by the Defendants 1-8 ((ii) to the persons who may bring an action) is not found in Art. 32 UPCA. The persons who are entitled to bring an action are not mentioned in this provision. Nor is there any reference to other provisions that may affect this aspect. Consequently, the Court's jurisdiction or competence is not linked to whether a person that brings an action is ultimately entitled to bring the action and/or whether that person is in fact fully entitled to the asserted claims.
16. Neither the provisions of Art. 47 UPCA nor those of Art. 68 UPCA are implicitly part of Art. 32 UPCA. This particularly follows from the systematic structure of the UPCA. Art. 47(1) to (3) UPCA sets out which parties generally have standing to bring actions before the Court. It is located in Part III ("Organisation and procedural provisions"), Chapter I ("General provisions") of the UPCA. Art. 68(1) UPCA deals with the power of the Court to award damages when it found that a patent has been infringed. It is in Part III ("Organisation and procedural provisions"), Chapter IV ("Powers of the Court") of the UPCA. The rules on jurisdiction and competence, on the other hand, are in a different part and chapter of the UPCA, namely in Part I ("General and institutional provisions"), Chapter VI ("International jurisdiction and competence") of the UPCA. There is also no reference to the rules on jurisdiction and competence in Articles 47 and 68 UPCA. There is also no apparent reason why the Court's jurisdiction and competence should depend on whether the facts submitted to it for decision actually cover or support the asserted claims. There is no recognisable indication that the Contracting Member States would have wanted to make the Court's jurisdiction and competence dependent on this.
17. The issues raised by the Defendants 1-8 concern (only) the merits of the action. They should therefore be discussed in the main proceedings.

II.

18. Pursuant to Art. 32(1)(a) UPCA, the UPC has, inter alia, exclusive competence in respect of actions for actual or threatened infringements of patents, whereby this subject-matter jurisdiction also exists pursuant to Art. 2(g) UPCA for infringement proceedings relating to a European patent that has not yet lapsed at the time of entry into force of the UPCA pursuant to Art. 3(c) UPCA. Accordingly, the UPC has subject-matter jurisdiction in the present case. The Claimant is asserting claims for (alleged) use of a European patent (without unitary effect) that had not yet expired on 1 June 2023.

III.

19. Since the objections of Defendants 1-8, as stated, are not (admissible) grounds for a preliminary objection, the alternative request of Defendants 1-8 must also be rejected.

IV.

20. In accordance with Rule 20.1 RoP, the parties are informed that the proceedings will be continued in accordance with the Rules of Procedure as the preliminary objection is rejected. The parties have the opportunity to submit any outstanding pleadings in due time.

V.

21. Pursuant to Rule 21.1 RoP, an Appeal may only be lodged against a Decision of the Judge-rapporteur to reject the preliminary objection in accordance with Rule 220.2 RoP. Appeal must therefore be allowed, which is at the discretion of the Judge-rapporteur. Taking into account Recital 8 of the Rules of Procedure, appeal is allowed in the present case. The Decision concerns a question of law that may be relevant to a number of cases, so that a uniform application and interpretation of the UPCA's rules of jurisdiction is appropriate.

ORDER

1. The preliminary objection of the Defendants 1-8, including the auxiliary request, is rejected.
2. The proceedings will be continued.
3. Appeal is allowed.

INFORMATION ON APPEAL

An Appeal against the Order may be lodged in accordance with Rule 21.1 RoP in conjunction with Rule 220.2 RoP within 15 days of service of the Order.

DETAILS OF THE ORDER

Order no. ORD_68782/2024 in ACTION NUMBER:	ACT_43382/2024
UPC number:	UPC_CFI_437/2024
Action type:	Infringement Action
Related proceeding no. Application No.:	51844/2024
Application Type:	Preliminary objection

14 February 2025

Ulrike Voß
Presiding Judge