



Central Division (Section Munich)

UPC_CFI_252/2023
Order RoP 103 / 105.5 RoP
of the Court of First Instance of the Unified Patent Court
delivered on 31/01/2024

REFERENCE CODE ECLI: Not provided

CLAIMANT

- 1) **NanoString Technologies Europe Limited** Represented by Daniela
Suite 2, First Floor, 10 Temple Back - BS1 6FL - Kinkeldey of Bird & Bird
Bristol - GB

DEFENDANT

- 1) **President and Fellows of Harvard College** Represented by Axel Berger of
17 Quincy Street - 02138 - Cambridge, MA - US Bardehle Pagenberg

PATENT AT ISSUE

Patent no.

Proprietor/s

EP2794928

President and Fellows of Harvard College

PANEL/DIVISION

Panel 1 of the Central Division (Section Munich).

DECIDING JUDGE

This Order is an order of the Judge-rapporteur András Kupecz ('JR').

LANGUAGE OF THE PROCEEDINGS:

English.

SUBJECT-MATTER OF THE PROCEEDINGS

Revocation action. Order following interim conference.

BACKGROUND AND FACTS

NanoString Technologies Europe Limited ('Claimant') has brought a revocation action against President and Fellows of Harvard College ('Defendant') in relation to European patent EP 2 794 928 B1 ('the Patent'). The action is pending under number ACT_551180/2023 UPC_CFI_252/2023 in the Central Division (Section Munich) of the Unified Patent Court ('UPC').

Following the exchange of the written pleadings in accordance with Rule 43 RoP, the judge-rapporteur – after having informed the parties of his intention to do so – closed the written procedure pursuant to Rule 58 in connection with Rule 35 RoP on 24 January 2024.

Parties were invited for an interim conference on the date set in the Rule 28 RoP order. The interim conference was held accordingly on 25 January 2024 by video conference (Rule 105.1 RoP). At the interim conference, the parties appeared before the judge-rapporteur.

On behalf of the Claimant, the interim conference was attended by:

Dr. Daniela Kinkeldey, mentioned above, Oliver Jan Jüngst, LL.M., Dr. Jan van Dieck, Dr. Anne Halbach, Dr. Moritz Schroeder, Dr. Anna Schadel and Dr. Alexander Bothe, all from the firm Bird & Bird. Also present was ...

On behalf of the Defendant, the interim conference was attended by:

Dr. Axel Berger, mentioned above, German and European Patent Attorney, Dr. Kerstin Galler, Attorney-at-law, Dr. Martin Drews, Attorney-at-law and Monika Harten, LL.M., Attorney-at-law, all from the firm Bardehle Pagenberg. Also present was ...

Ulrike Voß (presiding judge) and Eric Enderlin (technically qualified judge), members of the panel, were present as observers.

The interim conference was audio recorded and the participants were informed accordingly (Rule 106 RoP).

The judge-rapporteur discussed several issues with the parties in preparation for the oral hearing. The decisions taken at the interim conference are as set out below.

DECISIONS TAKEN AT THE INTERIM CONFERENCE AND FURTHER DIRECTIONS (RULE 105.5 IN CONNECTION WITH RULE 103 RoP)

Requests

The parties confirmed that they maintained their requests as brought forward during the written procedure.

In relation to Claimant's request made in the Statement of Revocation that document D40 (Decision 7 o 2693/22 of 17 May 2023 of the Regional court Munich I) need not be translated to English, the Defendant put forward no objections. The judge-rapporteur also had no objections. The request was therefore granted.

With respect to the application to amend the patent/auxiliary requests, in the context of a request made by the Claimant, the judge-rapporteur indicated that the Court sees no legal basis for pre-emptively and categorically ruling out the submission of any further auxiliary requests. Nor does the Court see any legal basis to order the Defendant to make the auxiliary requests more convergent. The judge-rapporteur did make it clear that an announcement reserving the right to amend, e.g. combine, these Auxiliary Requests, as required, and/or to change the order of the auxiliary requests in the further course of the proceedings is not considered as an auxiliary request on file because it lacks a concrete proposal. This statement is, as far as the Court is concerned, a general announcement without any legal status or implications. The judge-rapporteur emphasized the front-loaded character of UPC proceedings, also where it concerns auxiliary requests (with reference to 50.2 Rule in connection with Rule 30.2 RoP). Last-minute requests and submissions are not what is intended in UPC proceedings.

The possibility to make amendments to a party's case (for example the re-ordering of requests) was discussed. Parties' attention is drawn to Rule 263 RoP. Parties are hereby informed that any applications to change their case will be duly considered – without prejudice to whether such applications will be granted or not – until **15 March 2024**. Amendments introduced after that date will be presumed to be in violation of the requirements of Rule 263.2(a) RoP.

Admissibility of document D46

Document D46 was filed by the Claimant with the Reply to the Defence to Revocation (on 27 November 2023) and is relied upon as prior art in the context of novelty and inventive step. In the Rejoinder to the Reply to the Defence to Revocation, the Defendant objected to the filing of D46 and argued that it should be disregarded as being late-filed.

The judge-rapporteur reminded the parties of the front-loaded character of UPC proceedings, which means that parties shall set out their full case as early as possible in the proceedings (see e.g. Preamble 7 RoP).

Upon further discussion at the interim conference, it was agreed that the Defendant would get the opportunity to respond to the submissions of the Claimant based on document D46 within 6 weeks after the date of the interim conference, in a written submission having a maximum of 10 pages. Defendant subsequently withdrew its objection.

Accordingly, document D46 is admitted into the proceedings. Defendant is given until **7 March 2024** to respond in writing by way of a submission of a **maximum of 10 pages**. This submission must be strictly limited to responding to the invalidity arguments raised by Claimant based on D46.

Value of the proceedings and further submissions on costs

At the interim conference, the judge-rapporteur informed the parties that he intended to decide the value of the proceedings for the purpose of applying the scale of ceilings for recoverable costs (Rule 104(j) in connection with Rule 152.3 RoP).

Parties were in agreement of the value of the proceedings being set at **EUR 7,500,000** (seven and a half million euro). The Court did not have any objections. The value of the proceedings is set accordingly.

In relation to costs, the Administrative Committee ('AC') has published a table of ceilings for reimbursable costs depending on the value in dispute (24 April 2023 as D-AC/10/24042023_D). According to this table, the ceiling corresponding to a value of EUR 7,500,000 would be set at EUR 600,000 (six hundred thousand euro).

The judge-rapporteur pointed out to the parties the table as drawn up by the AC relates to a ceiling for recoverable costs, i.e. the maximum amount of costs recoverable. In accordance with article 69 UPCA, reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity requires otherwise (up to a ceiling set in accordance with the Rules of Procedure, see above).

In order for the parties and the Court to assess whether costs incurred are indeed reasonable and proportionate and whether or not equity requires otherwise, the Court and parties must have access to information showing at least a detailed description of the number of hours spent working on this particular case, by whom, what for and at what rate. The same applies to any expenses incurred.

To this end, the Court will allow the filing of additional exhibits relating to costs until two weeks prior to the hearing (**3 April 2024**) for all costs incurred until that date. This submission may be

updated by a further submission to be lodged at the latest **noon CET** on the day before the hearing (**16 April 2024**). The last submission may include an estimate of costs incurred for the hearing itself.

The judge-rapporteur informed the parties that the Court will, in principle, respect an agreement between the parties on the amount of costs that is deemed reasonable and proportionate.

Further submissions

The judge-rapporteur requested the parties to submit the Court of Appeal decision in case UPC 2/2023 (in relation to EP 4 108 782), once it is available.

The judge-rapporteur informed the parties that the Court saw no need for further written submissions other than those specifically mentioned at the interim conference/in this order.

Confirmation oral hearing date

The date for the oral hearing, already communicated to the parties in the Rule 28 RoP order, is confirmed for:

Wednesday 17 April 2024, 09.30 CET,

Cincinnatistraße 64, 81549 Munich, Germany

The hearing room will be announced in the summons to the oral hearing (Rule 108 RoP).

The judge-rapporteur explained to the parties that it is the Court's firm intention to conclude the hearing in one day. The second day (18 April 2024, reserved as per the Rule 28 RoP Order) is in principle only reserved for unforeseen events, like technical difficulties.

ORDER

Having heard the parties at the interim conference, in accordance with the above, the Court orders as follows:

1. Document D40 (Decision 7 o 2693/22 of 17 May 2023 of the Regional court Munich I) need not be translated to English.
2. Document D46 is admitted into the proceedings. Defendant is given until 7 March 2024 to respond in writing by way of a submission of a maximum of 10 pages. This submission is to be strictly limited to responding to the invalidity arguments raised by Claimant based on D46.
3. The value of the proceedings for the purpose of applying the scale of ceilings for recoverable costs is set at EUR 7,500,000 (seven and a half million euro).
4. Parties are allowed to file additional exhibits relating to costs until 3 April 2024 for all costs incurred until that date. This submission may be updated by a further submission to be lodged at the latest noon CET on 16 April 2024.
5. Parties are to submit the Court of Appeal decision in case UPC 2/2023 (in relation to EP 4 108 782) once it is available.
6. The date and time for the oral hearing is confirmed for Wednesday 17 April 2024, 09.30 CET.

Issued 31 January 2024
KUPECZ
Judge-rapporteur

ORDER DETAILS

ACTION NUMBER: ACT_551180/2023
UPC number: UPC_CFI_252/2023
ORDER number: ORD_598209/2023 and ORD_598206/2023
Action type: Revocation Action

REVIEW:

Pursuant to Rule 333 RoP, the above order shall be reviewed by the panel on a reasoned application by a party. An application for the review of this order shall be lodged within 15 days of service of this order.