



No. ACT_5164/2024
UPC_CFI_463/2023

ORDER
of the President of the Court of First Instance
in the proceedings before the Local Division DÜSSELDORF
pursuant to R. 323 RoP (language of the proceedings) issued
on 26/02/2024

APPLICANT (DEFENDANT IN MAIN PROCEEDINGS):

Curio Bioscience Inc.
4030 Fabian Way, Palo Alto, CA 94303, USA

Represented by: Cameron Marshall and Agathe Michel-de Cazotte (Carpmaels & Ransford)

RESPONDENT (APPLICANT IN MAIN PROCEEDINGS):

10x Genomics, Inc.
6230 Stoneridge Mall Road 94588-3260 Pleasanton, CA United States

Represented by: Tilman Müller-Stoy (Bardehle Pagenberg)

PATENT AT ISSUE:

Patent n° EP 2 697 391

SUMMARY OF FACTS - SUBJECT - MATTER OF THE PROCEEDINGS:

By statement dated 04 December 2023, 10xGenomics, Inc. has filed an application for provisional measures against Curio Bioscience, Inc. based on EP 2 697 391 entitled “Method and product for localised or spatial detection of nucleic acid in a tissue sample”.

By application filed on 30 January 2024, the defendant in the main proceedings – referring to R. 323 RoP – has requested for a change of the language of the proceedings from German into English (hereinafter the Application). The Application has been forwarded by the judgerapporteur to the President of the Court of First Instance of the UPC pursuant to R. 323.1 RoP.

By order dated 1 February 2024, the applicant in the main action (590953/2023–CFI_463/2023) has therefore been invited in accordance with R. 323.2 RoP to state within 10 days its position on the admissibility of the Application and on the use of the language in which the patent was granted (namely English) as language of the proceedings.

The Respondent – applicant in the main proceedings – has submitted its written comments on the Application on 12 February 2024.

The panel of the LD Düsseldorf has been consulted in compliance with R. 323.3 RoP.

INDICATION OF THE PARTIES’ REQUESTS:

Curio Bioscience Inc. requests pursuant to Art. 49(5) UPCA and R. 322 RoP that:

- the Court decide on the use of the language in which the patent was granted as the language of the proceedings
- in the alternative, the Judge-Rapporteur propose to the parties that the language of the proceedings be changed to the language in which the patent was granted, in accordance with Article 49(4) of the UPCA.

10xGenomics, Inc. opposes the defendant’s application and requests the Court:

- to reject it.
- In the alternative, that the opponent be ordered to provide the Court and the applicant with a certified English translation of the application and those annexes which are not in English without delay and to bear their costs.

POINTS AT ISSUE:

In support of the request, Curio Bioscience Inc. argues that the use of English as language of the proceedings would be justified for reasons of fairness, proportionality and flexibility referred to in the Preamble of the UPCA (para. 6) as:

- Both parties are US companies and the language of the technology at stake is English in which some documents are exclusively available;
- The defendant would save costs of necessary translations from German into English and vice-versa, Curio Bioscience Inc. is an SME and is significantly smaller than the applicant so that they are disproportionately disadvantaged by having to defend themselves within very short time limits in a language with which they are not familiar;
- Adopting English as language of the proceedings will enable the Court of Appeal to use it when needed.

The Respondent states that the Application is unsubstantiated and that there is no supporting evidence of the facts mentioned above, as:

- The defendant fails to provide any translation cost estimates likely to reflect the alleged disproportionality issue;
- It is further invoked that Curio Bioscience Inc. is an “SME” “significantly smaller” than the Applicant while these terms remain undefined in particular with regard to the relating requirements of European law;
- The assertion that the defendant is “not familiar” with the current language of the proceedings appears unclear and not credible as Curio Bioscience Inc. is active globally in particular in Germany, furthermore German is broadly spoken by 30% EU citizens as either native or foreign language;
- The defendant’s representative is admitted to the German bar and its law firm has an office in Munich where several lawyers – including in the relevant technical field at stake – work on a daily basis.

Further facts and arguments as raised by the parties will be addressed below if relevant for the outcome of this decision.

FOUNDATIONS FOR THE DECISION:

It is firstly noted that in the present case the admissibility of the Application is not disputed.

According to Art. 49(1) UPCA, the language of the proceedings before a local division shall be an official language of its hosting Member State or alternately the other language designated pursuant to Art. 49 (2). It is further provided by R. 323 RoP that “1. If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(5) of the Agreement (...) The President, having consulted [the other parties and] the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements”.

Regarding the criteria that can be considered to decide on the Application, Art. 49 (5) UPCA specifies that “(...) the President of the Court of First Instance may, on grounds of fairness and taking into account all relevant circumstances, including the position of parties, in particular the position of the defendant, decide on the use of the language in which the patent was granted as language of proceedings. In this case the President of the Court of First Instance shall assess the need for specific translation and interpretation arrangements”.

The UPCA states in its preamble – point 6 mentioned by Curio Bioscience – that the Court should be devised to ensure expeditious and high-quality decisions “striking a fair balance between the interests of right holders and other parties and taking into account the need for proportionality and flexibility”. The Rules of procedure of the UPC are accordingly governed by the principles of “proportionality, flexibility, fairness and equity”, the latter being ensured by “having regard to the legitimate interests of all parties” (Preamble of the RoP – points 2 and 5).

It follows from art. 49 (5) UPCA that the decision whether or not to change the language of the proceedings into the language in which the patent was granted shall be determined with regard to the respective interests at stake without it being necessary to constitute a disproportionate disadvantage. As a result, it may be sufficient that – amongst all relevant circumstances also to be considered – the language initially chosen is significantly detrimental to the Applicant (UPC CFI 225/2023 LD The Hague, order of 18 October 2023, UPC CFI 373/2023 LD Düsseldorf, order of 16 January 2024).

In support of the Application, Curio Bioscience Inc. first puts forwards that they are a “small or medium-size enterprise” or SME deserving as such a particular attention, or at least that they are “significantly smaller” than 10xGenomics.

The Applicant however is not referring to any particular item or relevant exhibit likely to substantiate this assessment while in its first statement, 10xGenomics is describing itself as an American Company active in the development and manufacture of highly innovative

biotechnological products – that are sold worldwide and are leading to medical progresses – and is providing with a link to the website of the defendant considered as a direct competitor.

Regardless of the legal definition of an “SME” as referred to in the UPCA and European provisions (namely here 2003/361/EC of the EU Commission) and the interest of this question – which is not to be further examined here in the absence of suggested points of comparison – , the Court has not been provided with detailed information or relevant data explicitly invoked in support of the assertion according to which the Applicant would be entitled to claim this classification.

As regards the other aspects of the proceedings addressed by the Applicant, Curio Bioscience Inc. fails to put forward any particular circumstances of the case which would suffice to raise a fairness issue affecting the possibility of organising efficiently its defence despite the timeframe of an application for provisional measures – which instead, may be undermined by the requested change – as both parties are equally confronted with a foreign language and the relating inconvenience in terms of translation and interpretation needs.

Lastly even if the use of English is in principle advantageous as facilitating the general organisation of judicial activities at both first instance and appeal levels, this mere interest of the Court itself – although concurring with those of the users – cannot prevail in the event where none of the other circumstances of the case at hand call for the requested change.

It follows from the above that the Application shall be rejected and that the present order shall not at this stage be conditional on specific translation or interpretation arrangements.

FOR THESE GROUNDS

- 1- The Application shall not be granted.
- 2- The present order shall not be conditional on specific translation or interpretation arrangements.
- 3- An appeal may be brought against the present order within 15 calendar days of its notification to the applicant pursuant Art. 73. 2 (a) UPCA and R.220 (c) RoP.

INSTRUCTIONS TO THE PARTIES AND TO THE REGISTRY:

The next step is for the Applicant to file a response to the Objection within the time period as set by the Judge-rapporteur.

ORDER

Issued on 26 February 2024

NAME AND SIGNATURE

pp Florence Butin
President of the UPC Court of First Instance