

EIP



UPC Claimant Out of Time to Amend: Esko-Graphics Imaging GmbH v. XSYS Germany GmbH & ors

Order of 28 February 2025 (Order no. ORD_3085/2025)[1]

(UPC_CFI_483/2024)

The Claimant had brought a claim against the Defendants for infringement of EP 3 742 231 (“the Patent”), relating to photo-curable printing plates.

In its Statement of Claim dated 27 August 2024, the Claimant alleged that the Patent had been infringed in Belgium, Germany, France and Italy and had sought declarations and injunctions in respect of these alleged infringements in these Member States.

The Claimant had not, however, included similar claims in respect of the Netherlands since, at the date of its Statement of Claim, the national part of the Patent had lapsed in the Netherlands due to late payment of the renewal fee.

On 18 October 2024, the Netherlands Patent Office granted the Claimant’s application for restoration of the Patent. The Claimant therefore sought to amend its Statement of Claim to add in the Netherlands to the list of countries to be covered by its requested declarations and injunctions. This required an “extension of action” in accordance with R. 263 RoP. While the Defendants did not dispute that they did offer and supply the embodiment alleged to infringe in the Netherlands, they nevertheless opposed the Claimant’s application to add in the Netherlands to the scope of the present action, arguing that this should have been done in good time before the end of the Defendants’ deadline to file its Statement of Defence.

The Court considered whether to allow the Claimant's application in accordance with the cumulative requirements of Rule 263.2, which require that the party seeking the amendment satisfy the court both that (a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and (b) the amendment will not unreasonably hinder the other party in the conduct of its action.

The court dealt with (b) first, holding that, since the subject matter of the proceedings was independent of the countries included in the Statement of Claim and the Defendants had accepted that they offered and supplied the relevant embodiment in the Netherlands, it would have no effect on the way in which the Defendants would prepare for the hearing. In the absence of any other reasons being put forward by the Defendants to the contrary, it was decided that the Defendants would not have been hindered by allowing the amendment.

However, as to (a), the Court decided that the Claimant had waited too long to make its application, given that the Claimant had become aware of the reinstatement of the Netherlands part of its Patent on 7 November 2024, yet did not make its application until 17 January 2025. The Court noted that this represented a delay of approximately 10 weeks, when it should have only taken 4 weeks for the Claimant to take advice and decide whether it would amend its claim to add in the Netherlands, in line with the standard of diligence required. As a result, the Court refused the Claimant's application.

In coming to this decision, it was not necessary for the Court to consider whether, as the Defendants alleged, the Claimant's patent attorneys had become aware of the Netherlands Patent Office decision as early as 21 October 2024, nor was it necessary to consider whether the knowledge of the Claimant's patent attorneys could be attributable to the Claimant itself.

Aside from keeping up to date with renewal fees, which would have obviated the need for the Claimant's application in the first place, this decision highlights the importance of acting promptly when seeking to amend a Statement of Claim, particularly where existing deadlines may be relevant. While a reasonable amount of time is afforded to the party seeking to amend, they will need to be confident that they could not, with reasonable diligence, have made their application at an earlier stage.

[1] [Application Order | Unified Patent Court](#)