

EIP

UPC Refuses to Admit Further Amendment Requests

Meril Italy v Edwards Lifesciences UPC_CFI_255/2023 (Revocation action at Paris Central Division)

Order of 28 February 2024 (ORD_7283/2024)[1]

This order relates to the action brought by Meril Italy for revocation of Edwards' patent EP 3646 825. As explained in our earlier post, [\[2\]](#) the Central Division in Paris allowed this separate revocation action by Meril Italy to proceed as well as counterclaims for revocation of this patent by Meril Germany and Meril India in the infringement proceedings against them in Munich Local Division, on the basis that Meril Italy, the claimant in this revocation action, was a different legal entity.

Edwards filed a defence to the revocation action including a conditional application to amend the patent. Meril Italy then filed a reply to the defence together with a reply to the application to amend the patent. Edwards then filed its rejoinder to the reply to the defence together with the reply to the defence to the application to amend the patent. In this rejoinder Edwards requested the Court for leave to amend its case, pursuant to Rule 263 (1) RoP with regard to a new main request to amend the patent, as well as 41 auxiliary requests based on 9 individual amendments.

Meril Italy then filed a procedural application requesting that the Court not admit this further request to amend the patent. The judge-rapporteur decided to refer this request to the full panel, and not decide it alone.

The Court decided that the appropriate rule governing the request by Edwards to file further claim amendments was not Rule 263 (1) – this situation did not correspond to

amending a party's case. Rather, the applicable rule is Rule 50 (2) RoP, which states that "Rule 30(2) shall apply", namely "Any subsequent [after the time of filing the defence to the revocation action] request to amend the patent may only be admitted into the proceedings with the permission of the Court."

The Court declined to admit the further amendments. It did not consider that consistency with the revocation counterclaim taking place at the Local Division in Munich was a sufficient reason; it opined that if necessary one of the Divisions might consider staying its proceedings to avoid inconsistent decisions.

The Court therefore decided that the present proceedings would continue without taking into account the amendments proposed with the rejoinder to the reply to the statement of defence and reply to the defence to the application to amend the patent. It noted however that this did not preclude the parties from agreeing, during the proceedings, on a new set of amendments that may incorporate some of those previously rejected by this order, if such amendments align with their best interests.

In addition, in a further Order issued by the judge-rapporteur alone, ^[3] the Court refused Meril Italy's request to file further written pleadings after the rejoinder. Meril Italy's justification for the request was that new arguments had been introduced by Edwards into proceedings in the rejoinder. However the judge-rapporteur pointed out that in such a situation the appropriate action by the Court would be to disregard new arguments in the rejoinder (since Rule 52 RoP specifies that the rejoinder 'shall be limited to a response to the matter raised in the reply'). Therefore, the claimant has no need to reply to these matters.

[1] <https://www.unified-patent-court.org/en/node/634>

[2]

<https://eip.com//knowledge hub/article/separate revocation claim and counterclaim both to proceed/>

[3] ORD_10310/2024 of 27 February 2024

https://www.unified_patent_court.org/en/node/636