

# EIP



## UPC Expedites Proceedings by Prioritising Resolvable Issues

### **Advanced Bionics and two other Advanced Bionics entities v. MED-EL Elektromedizinische Geräte GmbH**

(Revocation action UPC\_CFI\_338 /2023 and counterclaim for revocation UPC\_CFI\_410/2023)

#### **Decision of 26 December 2024 [1]**

The Paris Central Division issued a decision in these consolidated proceedings maintaining EP 4 074 373 (EP '373) in amended form based on auxiliary request 0a.

#### **Background**

This decision concerns a revocation action brought at the Paris Central Division by Advanced Bionics in respect of patent EP '373 owned by MED-EL Elektromedizinische Geräte ("MED-EL"). The patent relates to MRI-safe disk magnets for cochlear implants.

The most interesting aspects of this decision are discussed below:

#### **Hearing of Experts**

Both parties requested that their experts be heard at the oral hearing to prove the common general knowledge at the priority date. The Defendants also presented the inventor of the patent in suit as a witness. According to the Rule 177 (1)(b) RoP in conjunction with Rule 181(1) RoP, the Court may order an expert or witness to be heard in person if their opinion is challenged by the opposing party. However, the Court did not

allow the inventor to participate in the oral proceedings as an expert or as a witness. The Court decided that the inventor 'may have a direct interest in the outcome of the case'. Therefore, they did not meet the requirements of Rule 181(1)(a) RoP for impartiality, objectivity and independence. The other experts presented by the Claimants and Defendant were heard in person at the oral proceedings.

### **Retrieval of Documents**

In the written and oral proceedings, both parties based their arguments on the version of the patent issued by the EPO and the original application WO 2011/133747. However, neither party submitted these documents to the Court. Within the regulatory system of the UPC, the Court cannot acquire evidence ex officio. However, in the absence of sufficient case law regarding this matter, the Court decided to independently retrieve these documents without a formal request from either party.

### **Submission of Further Auxiliary Requests**

Together with the defence to revocation, MED-EL submitted various auxiliary requests for the amendments. During the interim conference on 15 July 2024, MED-EL requested for the further submission of auxiliary requests 0a\* and 3a\*. These auxiliary requests consisted of deleting various dependent claims from auxiliary requests 0a and 3a respectively. They argued that these requests would further narrow the scope of the claim and simplify the request to amend the patent. Advanced Bionics alleged that this further submission would affect the interpretation of claim 1 and would also influence the ongoing infringement proceedings before the Mannheim Local Division.

Applying Rule 30 (2) RoP, the Court acknowledged that the issue of the admissibility of further auxiliary requests should be decided before examining the validity of the patent in suit. However, the Court decided for the purposes of efficiency, to examine the more straightforward issues first.

The Court examined the validity of EP' 373 and decided that it was valid in accordance with auxiliary request 0a. The sufficiency and added matter objections raised by Advanced Bionics were dismissed. Additionally, the Court also decided that the subject matter of auxiliary request 0a involved an inventive step. Specifically, the internal magnet of a cochlear implant with a diametrical (rather than an axial) magnetisation and a magnetic dipole arranged parallel to the skin of the user was not considered obvious. This conclusion was based on the common general knowledge combined with the closest prior art, WO 03/081976.

Given that the originally requested amendment 0a was found to be valid, the Court

decided there was no need to assess the admissibility or validity of the additional requests 0a\* and 3a\*.

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### **Decision**

It was ordered that the patent be maintained in amended form, according to auxiliary request 0a. It was also ordered that the costs of the Court and of the parties should be borne by the Claimants and Counterclaimants in the amount of 70%, and by the Defendant in the amount of 30%. The value in dispute was set at € 5,000,000.

[1] - <https://www.unified-patent-court.org/en/node/1396>