

**EIP**

# 10x Genomics not successful second time around

On the same day that the decision granting 10x Genomics a provisional injunction against NanoString on the basis of the unitary patent EP4108782 was announced (19 September 2023), there also took place a hearing to consider a further provisional injunction application based on EP2794928, a “classical” European patent granted years before the unitary patent system began. The decision in this latter case was announced on 10 October 2023, and while (understandably since the matter related to the same parties and was decided at the same Munich local division) the criteria assessed were very similar, the assessment against those criteria arrived at the opposite conclusion on many of the key issues.

## **Jurisdiction**

The jurisdiction of the Munich local division was contested, on the basis of prior, and ongoing, litigation in Germany. An invalidity action relating to the patent is pending before German Federal Patent Court, which issued a preliminary opinion on 7 February 2023 that the German part of the patent can be maintained in amended form according to auxiliary request 1 filed in the proceedings before the German Court. In addition, two first instance judgments of the Munich (national) Regional Court were already issued and enforced in Germany. Therefore, the Defendants argued that at least in respect of Defendant 2 (Nanostring Technologies Germany GmbH), in respect of which no violation of the existing German injunction was alleged, the case was unfounded, and therefore the Munich local division of the UPC lacked jurisdiction. The Court however considered that there were website offers to sell including in Germany, and noted it was alleged by the Applicants that further promotional events in Germany were planned. It attributed these to all of the Defendants, not just the second Defendant, and considered therefore a

German local division had jurisdiction pursuant to Article 32(1)(a) UPCA (place of threatened infringement). The Court seemed to consider the prior and copending German cases not relevant, noting that while the enforcement of a judgment of the court of a contracting state of the UPCA only concerns infringements in that contracting state, decisions of the UPCA in the case of a European patent according to Art. 34 UPCA are in principle valid for the territory of all contracting states for which the European patent has effect. Thus it saw a legitimate interest in pursuing a UPC case.

### **Admissibility**

Many objections to the admissibility of the application for a provisional injunction were raised, but these were all dismissed by the Court, which emphasised that admissibility is a formal matter and that an application for provisional measures cannot be dismissed as inadmissible on the grounds of obvious lack of merit.

### **Entitlement of Applicants**

Similarly to the earlier case, the Defendants challenged the entitlement of both Applicants to bring the action, but as before, the Court was not convinced by these.

### **Substantive merits**

The first major departure from the earlier case was that this time the Court was **not** convinced that the Defendants infringe the patent. In particular, the Applicants relied on the patent claim being understood with an obvious error corrected – that “probe reagent” should be read as “analyte”. This was held to place the issue of infringement beyond that which could be accepted in provisional proceedings.

Additionally, the Court was **not** convinced of the validity of the patent. It considered that it had to consider the patent in the original wording as granted, not according to an amendment that may be offered later in the proceedings. The German Federal Patent Court preliminary opinion gave rise to doubt as the validity of the patent as granted, even if it might suggest the validity of the amended version.

### **Delay and Necessity of provisional measures**

In the earlier case, the delay of the Applicants in bringing the action was held to be justified by the need to wait for the unitary patent system to commence (and the patent itself was not in fact granted until 7 June 2023). The present case however related to a “classical” European patent granted since 20 February 2019; therefore provisional measures could have been sought in the Netherlands and France prior to 1 June 2023. The Court noted that French practice would have required a central limitation to have

been filed at the EPO before requesting provisional measures to reflect the findings for the German Federal Patent Court, but this had not been done. Therefore, the Court was not convinced of the necessity of granting provisional measures.

## **Conclusion**

Balancing the interests of the parties, the Court, noting that doubt existed both as to the validity of the patent and whether it was infringed, and also considering whether provisional measures could and should have been sought in national court before the commencement of the UPC on 1 June 2023, concluded that the request for a provisional injunction should be refused. The Court ordered that the Applicant should pay the costs of the proceedings.

## **Deadline for appeal**

Our report<sup>[1]</sup> of the earlier case noted that the deadline stated in the decision for appeal (two months) appeared to be incorrect. The present judgment indicates a deadline of 15 days. The discussion of the deadline in the judgment seems to consider in relation to an application for provisional measures that if the application is successful, what results is an Order (which would imply a 15 day appeal deadline according to Art 73(2) UPCA), whereas if unsuccessful, what results is a (dismissal) Decision (which would imply a 2-month appeal deadline according to Art 73(1) UPCA). Rule 21, concerning preliminary objections, is referred to as an example of a situation where a ruling is classed as either an Order or a Decision, depending on the outcome. However, the Court notes that Art. 73(2) UPCA, which is the higher ranking legal provision, provides a uniform time limit for appeal of rulings on applications for provisional measures pursuant to Art. 62 UPCA, whether these are Orders under Art. 62 UPCA, or represent a full or partial deviation from requests for Orders under Art. 62. UPCA (i.e. a complete or partial refusal of the requested Order). Either way the deadline is 15 days, which confirms the view that the appeal deadline in the earlier judgment is incorrect.

[1] [https://eip.com//knowledge\\_hub/article/10x\\_genomics\\_v\\_nanostring/](https://eip.com//knowledge_hub/article/10x_genomics_v_nanostring/)