

EIP

(Non)-Bifurcation at the UPC

Plant-e, Plant-e Knowledge v. Arkyne Technologies S.L. UPC_CFI_239/2023

Order of 15 February 2024 (ORD_8243/2024)[1]

The issue of whether the UPC would bifurcate, namely try a patent infringement case separately from the related counterclaim for revocation of the patent, was the subject of much commentary before the UPC commenced operations. The decision as to whether to bifurcate is taken by the Local Division handling the infringement case, who, according to Article 33(3) UPCA has three options:

- proceed with both the action for infringement and with the counterclaim for revocation
- refer the counterclaim for revocation for decision to the central division (in which case the Local Division also has the choice to suspend or proceed with the action for infringement)
- refer the whole case including the infringement action to the central division, if the parties agree

This Order from the UPC Local Division in The Hague is the latest of several where the Court has decided not to bifurcate – rather than send the revocation counterclaim to the Central Division, it has decided to hear both parts of the action.

A similar Order was issued by the Düsseldorf Local Division in N.V. Nutricia v Nestlé Health Science (Deutschland) GmbH[2]. In both cases, all parties agreed that the Local Division should retain the revocation counterclaim, so it is perhaps unsurprising that the Court proceeded as requested. It is also notable that in both cases the Court made an Order on the issue while the written procedure was still ongoing, rather than after the

close of the written procedure as the Rules of Procedure envisage as the more usual timeline.

On the other hand, in the case of Amgen v Sanofi[3] the Munich Local Division did order the transfer of the counterclaim for revocation to the Central Division (while reserving the decision as to whether there should be any stay of the infringement action). However, there again the order reflected the unanimous request of all parties. Moreover, the situation was unusual because there was already a revocation action filed in the Central Division related to the same patent, with which the counterclaim has now been consolidated.[4]

Therefore, we are yet to see a case where the parties have argued contrary positions on the question of bifurcation. Only then will it become apparent how the UPC approaches the question, and whether there may be a divergence depending on the background of the judges in each local division.

[1] <https://www.unified-patent-court.org/en/node/574>

[2] UPC_CFI_201/2023, Order of 19 December 2023 (ORD_589338/2023) <https://www.unified-patent-court.org/en/node/520>

[3] UPC_CFI_14/2023, Order of 2 February 2024 (ORD_392/2024) <https://www.unified-patent-court.org/en/node/582>

[4] UPC_CFI_1/2023, UPC_CFI_14/2023, Order of 24 February 2024 (ORD_10396/2024, ORD_10398/2024) <https://www.unified-patent-court.org/en/node/593>