



A caution on the availability of extensions

ITCiCo Spain S.L. v Bayerische Motoren Werke Aktiengesellschaft (UPC_CFI_412/2023)

Order dated 9 February 2023 (ORD_4804/2024)

Background

A revocation action was brought in the Paris Central Division by BMW AG ("the Respondent") against a patent belonging to ITCiCo ("the Applicant"). The Applicant lodged an application for an extension of the deadline to serve their statement of defence. When asked for its comment the Respondent requested that the extension request should be rejected. The application was denied by the Order of the Judge-rapporteur dated 9 February 2024 and hence the Applicant was not allowed to serve a defence. The reasoning of the Judge-rapporteur provides some insight on the circumstances which will be taken into account when deciding whether to grant extensions to time periods.

Interpreting the rules on extensions

The Court's power to extend the deadline derives from Rule 9 of the Rules of Procedure (RoP), and specifically paragraph 3 of that rule, which grants to the Court a discretionary power to modify any procedural deadlines. The Order notes that, when exercising this power, the Court must 'observe the principles of proportionality, flexibility, fairness and equity mentioned in the preamble 2 and 4 of the 'RoP''. The Judge-rapporteur expanded on the effect of these principles on Rule 9, noting, at paragraphs 13 – 16 of the Order, that the fundamental purpose of procedural deadlines is:

- to ensure the rapid and respectful conclusion of proceedings, where possible, within the one-year period set in preamble 7 of the RoP;
- to safeguard the principle of a fair trial by setting in advance the rules with which

- both parties have to comply;
- to protect the impartiality of the judge in circumstances where, if extensions were granted arbitrarily, they would favour one party; and
- to provide legal certainty as to when procedural activities will be performed.

Against these points, the Judge-rapporteur noted the general right of a party to file a defence and that where a party suffered an objective difficulty the statutory rules should be interpreted in a 'flexible and equitable way'. The Order emphasises a focus on the objective difficulties suffered by a party, stating that even 'an impossibility or an extreme difficulty to meet the deadline which is attributable to the party requesting the extension of the deadline or its representative does not come into consideration, as it may not be deemed as objective.' Further the "principle of fair trial obliges a party to submit a request for time extension as soon as it appears clear that the meeting of the deadline will not be possible".

The Applicant's grounds for seeking an extension to the deadline can be summarised as falling under two heads. The first was a series of issues related to accessing some of the documents in the claim for revocation, particularly exhibits to the statement of claim which were only provided electronically through the UPC's Case Management System. The second ground was that of ill health on the part of their long-standing European Patent Attorney.

The Applicant's grounds for seeking an extension were rejected. All of the Applicant's arguments for seeking an extension were criticised as lacking 'relevant' and/or 'sufficient' evidence and the application as a whole was criticised on the basis that it was brought only the day before the relevant deadline when the issues the Applicant sought to rely on were, or at least should have been, apparent much earlier. The Order states that parties are 'expected to seek a solution in an appropriate time and act accordingly', the implication being that failure to do this will be held against any party seeking the extension of a time period.

The Applicant has therefore lost their opportunity to respond to the revocation action. The Judge-rapporteur notes at the end of the Order that the Applicant may seek review of the Order by the panel under Rule 333 RoP within 15 days.

Comment

The main takeaway from this case is that time extensions for deadlines may not be as forthcoming in the UPC as compared to some national courts. An application for an extension should focus on the objective reasons for the extension, be thoroughly evidenced and be brought as soon the relevant party is aware they may not be able to

meet any such deadline. A more proactive approach by parties, to seek extensions earlier and to keep the court and other parties in the case aware of any issues, would seem to be more in line with the principles of fairness highlighted in the Order.

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