

EIP

Language change refused by the UPC

MED-EL v Advanced Bionics (UPC_CFI_410/2023)

Order of 15 April 2024 (ORD_13321/2024)[1]

MED-EL Elektromedizinische Geräte Gesellschaft m.b.H. filed an infringement action in the German language at the Mannheim local division of the UPC, based on EP4074373, against three Advanced Bionics entities, Advanced Bionics AG (Switzerland), Advanced Bionics GmbH (Germany) and Advanced Bionics Sarl (France).

Before filing their defence, Advanced Bionics filed a request under Rule 323 RoP to change the language of proceedings to English, the language of the patent. The claimant opposed this request. The Court issued an Order (in English) denying the request.

As an initial point, the claimant pointed out that Rule 323 prescribes that such a request should be filed in the Statement of Defence, in the case of a defendant. It therefore argued that the request was inadmissible when filed earlier than the Statement of Defence. However, consistent with previous decisions,[2] the Court considered that the wording of Rule 323 did not preclude that the request be filed earlier. The request was therefore considered admissible.

On whether the language should actually be changed, Advanced Bionics had pointed to the existence of other proceedings relating to the same patent family which were conducted in English. The Court however considered that these resulted from strategic choices made by Advanced Bionics and were not themselves relevant to the issue of whether the language should be changed before the UPC.

The Court also noted that two of the Advanced Bionics entities had their seats located in Germany and Switzerland respectively, where German is an official language, while the

third one is an affiliated entity. The Court moreover noted that Advanced Bionics had not pointed to any imbalance of financial resources or any particular circumstance of the case likely to create a significant disadvantage to their detriment; rather their arguments related to the costs and inconvenience of parallel related proceedings in different languages, which was not considered sufficient to allow a language change under Rule 323.

Accordingly, the request for change of language to English was rejected.

One of the related proceedings relied on to justify a language change was a revocation action filed by Advanced Bionics AG (the first defendant in this infringement action) against EP4074373 at the Central Division Paris Section before the infringement action was filed by Med-El against Advanced Bionics. These revocation proceedings are in English, the language of the patent, as specified in Article 49(6) UPCA. In the present infringement action, Advanced Bionics had requested the infringement action to be transferred to the Central Division so that the actions could be heard together. This request was rejected^[3] by the Mannheim local division in an order of 22 February 2024 for a number of reasons.

First, Article 33(5) UPCA allows an infringement claimant to file an infringement action at the central division OR at a local division when a revocation action relating to the same patent between the same parties is already pending at the central division. While considering that Article 33(5) UPCA might in any case not be applicable, because the infringement action included two defendants who were not parties to the revocation action, the Court considered that it would frustrate the scheme of Article 33(5) UPCA if the infringement claimant, having exercised its choice to bring the infringement action at a local division and not at the central division, had that choice frustrated by transfer of the infringement action to the central division.

Secondly, and irrespective of the interpretation of Article 33(5) UPCA, the Court exercised its discretion not to refer the infringement action to the central division because the revocation action there was already at a more advanced stage. It would therefore delay those proceedings if the infringement action was referred to the central division. Also, it would require a change in the language of the infringement proceedings from German to English, since proceedings at the central division are always in the language of the patent.

Thus, it can be seen that a language change request implicit in the request for referral of the infringement action to the central division that was rejected in the earlier order, was again rejected in the present order.

The present order of 15 April refusing the change of language was issued just before the

Court of Appeal decision allowing a language change that had been refused at first instance,[4] and so the outcome might have been different had that guidance from the Court of Appeal been available.

[1] <https://www.unified-patent-court.org/en/node/668>

[2] <https://eipamar.com/en/knowledge-hub/article/should-the-language-of-proceedings-be-changed-balancing-the-interests-of-the-parties/> ;
<https://eipamar.com/en/knowledge-hub/article/aarke-ab-v-sodastream-industries-ltd-order-of-16-january-2024/>

[3] <https://www.unified-patent-court.org/en/node/604>

[4] <https://www.unified-patent-court.org/en/node/661>