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Infringement action after evidence preservation order fails equivalents test

Jozef Frans Nelissen v OrthoApnea S.L., Vivisol B BV (UPC_CFI_376/2023)

Decision of 17 January 2025[1] (ORD_598478/2023)

One of the early evidence preservation orders from the UPC was granted by the Brussels Local Division to seize samples of a product (the "NOA") at a symposium at which it was expected to be exhibited.[2] This order was carried out, and the appointed expert submitted their report to the court on 28 September 2023.

An infringement action then followed, and the judgment has now been issued.

A few interesting points appear from this decision.

Redaction of judgments

Rule 262(1)(a) RoP provides that decisions and orders made by the Court shall be published "following, where applicable, redaction of personal data within the meaning of Regulation (EU) 2016/679". The Registry seems to understand this as meaning that names of individuals must be redacted, even when the individual is a party. This Decision goes further and even redacts the patent being asserted, which seems to go too far on any understanding of "personal data". The individual party name does however appear on the published and searchable case list of the UPC, so is not kept confidential generally. The patent number can also be identified as EP2331036 from the case list.

Time limit for filing infringement action following provisional measures

Rule 198(1) RoP provides that an order to preserve evidence is revoked if proceedings on

the merits are not started with 31 calendar days or 20 working days, whichever is the longer, from the date specified in the Court's order, which in this case was specified as the day after service. The deadline was 23 October 2023, and the infringement action was filed through the UPC CMS on that date. However, the claim was filed in Dutch, and OrthoApnea refused service. The statement of claim was then translated into Spanish, and service was effected on 18 January 2024. OrthoApnea argued that this was the decisive date, and that it was outside the time period specified in Rule 198(1) RoP. However, the court disagreed, and clarified, as expected, that the proceedings are "started" for the purposes of Rule 198(1) RoP when the statement of claim is filed through the UPC CMS. The date of service on the defendant was irrelevant.

No infringement by equivalents

The patent relates to a device wearable in the mouth for treating nocturnal breathing problems such as sleep apnoea. The claim requires a stop that cooperates with a contact surface to prevent further closing of the mouth. The Court held that the accused device does not have the required stop, and therefore ruled out literal infringement. Two tests were proposed by the claimant for determining whether there was infringement by equivalents – the "function-way-result" test and the "insubstantial differences" test. After final written arguments by the parties had been submitted, the UPC decision UPC_CFI_239/2023, Plant-e vs Arkyne considering the application of the doctrine of equivalents at the UPC was issued,[3] and this judgment was discussed at the oral hearing.

The court held that whichever test was adopted, there must be functional equivalence between the claimed element and the corresponding element of the accused product. It considered that the NOA functioned in respect preventing further closing of the mouth in a substantially different way from that achieved by the stop as specified in the claim. Accordingly, it held that there was no infringement by equivalents and there was no need to consider any subordinate issues such as a Gillette-type defence.

In view of this finding, this decision sheds no further light on what precisely should be the test adopted for infringement by equivalents by the UPC in future.

[1] https://www.unified-patent-court.org/en/node/20202

[2] https://eip.com/uk/latest/article/upc_jozef_frans_nelissen_v_orthoapnea_s_l/

[3] https://eip.com/uk/latest/article/upc_finds_patent_infringed_by_equivalence/