EIP

First to file at the UPC

Sanofi-Aventis Deutschland GmbH & Others v Amgen Inc - Order of 24 August 2023

Background

On the opening day of UPC, 1 June 2023, Amgen sued Sanofi for infringement of EP 3,666,797 in the Munich local division and on the same day Sanofi sought revocation of the same patent in Munich central division.

Amgen filed a preliminary objection under rule 48 and rule 19(1)(b) of Rules of Procedure objecting that Munich central division did not have competence to hear the revocation. The argument being that to the best of its knowledge the infringement action was filed before the revocation action and so the revocation should have been filed as a counterclaim in Munich local division. The information visible via search function on CMS showed the 'date of lodging' of the infringement action as 13.33 on 1 June with the revocation having been lodged at 19.32 that day.

On the other hand, the CMS further showed 'date of receipt/effective lodging' attributed to the revocation as being 2 June with 'date of receipt/effective lodging' attributed to the infringement action not until 26 June 2023

Both actions had been lodged in hard copy as the CMS had ceased to function on morning of 1 June. Sanofi had lodged their hard copy revocation papers not at central division in Munich but at the UPC Registry seated at the Court of Appeal in Luxembourg.

The facts established about timing, which neither party disputed, were that the revocation was filed in hard copy at 11.26 am while the infringement action was filed slightly later at 11.45.

Decision

The judge-rapporteur determined the meaning of 'has been brought' in article 33.4 UPCA to be the objectively verifiable time of lodging of an action noting that rule 261 RoP provides that "All pleadings and documents lodged with pleadings shall bear a time and date which shall be the time and date of receipt of pleadings at the Registry". Lodging in the electronic CMS generates an automatic electronic receipt which "shall indicate the date and local time of receipt" (rule 4.1 RoP).

Taking account of the established facts of actual time of filing, he found that the revocation action was filed before the infringement action. Accordingly the Munich central division was competent for the revocation action. The exception provided by second sentence of article 33.4 UPCA requiring filing at the same local division as an infringement claim did not apply.

He also held that, when the CMS has ceased to function (and therefore rule 4.2 RoP permitting hard copy filing applies), lodging in hard copy at Registry of Court of Appeal in Luxembourg was effective to lodge an action at Munich central division.

Further the judge granted leave to appeal of his own motion because of the fundamental nature of the legal questions raised.

Observations

It is interesting to note some of the factors the judge took account of in interpreting the provisions of the UPC and arriving at his decisions. These included:

- The ordinary meaning of the terms in their context and in the light of the object and purpose of the UPCA (bearing in mind article 31.1 of Vienna Convention on the Law of Treaties (1969);
- The rules determining the (internal) competence of UPC must be clear and predictable, which is particularly important for legal certainty;
- The court must be able to assess competence on basis of objectively verifiable facts;
- Article 32.1(a) EU regulation 1215/2012 (Brussels Recast) provides that for the purposes of assessing lis pendens a court shall be deemed to be seised "at the time when the document instituting the proceedings or an equivalent document is lodged with the court";
- The history of rule 4.1 including an explanation in the 17th draft;
- The notion of the UPC as 'one Court' with 'one Registry';
- The Registry Rules, in particular the meaning of rule 3 section 2 about submission of paper documents;

- The Rules of Procedure adopted by the Administrative Committee on basis of article 41 UPCA procedure cannot be superseded by Registry Rules;
- Interpretation should be fair and equitable.