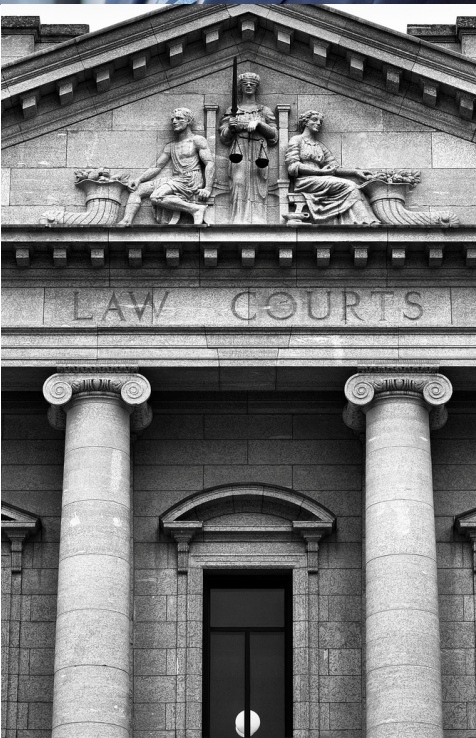


CASE COMMENT

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UPC PROCEEDINGS: A PRAGMATIC TAKE ON ARTICLE 33(3) UPCA AND BIFURCATION

On 19 December 2023, the Düsseldorf Local Division issued a short procedural order ([UPC_CFI_201/2023](#)) regarding the application of Article 33(3) UPCA, which governs the further proceedings if the defendant in a patent infringement action files a counterclaim for revocation of the patent in suit. Article 33(3) UPCA leaves to the discretion of the division concerned to either proceed with the infringement action and the counterclaim for invalidity together or to refer the counterclaim for decision to the central division or, with the agreement of the parties, refer the case for decision to the central division.

The Court first ruled that a decision under Article 33(3) UPCA at an early stage of the proceedings, i.e. before the end of the written procedure, seems justified for reasons of procedural efficiency in the current situation where the Court is still under construction. This will allow an early assignment of a technically qualified judge who can then be involved in the case management as soon as possible.

The Court then decided in this case against the bifurcation and to deal with both the infringement and the counterclaim, in terms that are likely to be often cited, either by other local divisions or parties arguing against the bifurcation. The joint hearing is “appropriate [...] for reasons of efficiency” and “preferable” because it allows a “uniform interpretation of the patent by the same panel composed of the same judges”.

The Court also dismissed the arguments based on the complexity of the technical field (in the present case, the chemical/pharmaceutical field): after having ruled that it was more efficient to have the technical qualified judge assigned at an early stage rather than at a later stage, the Court states that such an assignment allows for the Local Division to be “undoubtedly capable of deciding” on the validity and infringement of the patent at issue.

This order has been rendered by the Düsseldorf Local Division, i.e. a UPC division comprising two German judges who are accustomed to a national bifurcated system, making it even more noteworthy.