

Revocation Actions at the UPC: State Your Defense or Risk Losing Your Patent

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By: Andy Rosbrook, Rubén H. Muñoz

The Unified Patent Court (UPC) aims to provide expeditious decisions for its litigants. That means that there is a higher bar for obtaining extensions of time. As exemplified in *BMW v. ITCiCo*, the UPC's reluctance to grant extensions can have serious consequences, including revocation of the patent.

The UPC opened its doors in June 2023 to provide an efficient and patent-knowledgeable forum for adjudicating European patent disputes. Shortly after, claimant BMW brought an action against defendant ITCiCo seeking to revoke a patent directed to warning signals based on a vehicle's speed. Under UPC procedures, within two months of being served, defendant was required to file a "statement of defense" that lays out its evidence and legal arguments for why the revocation action should fail.

Defendant did not file its statement of defense. Instead, on the last day of the two-month filing period, defendant requested an extension of time. Defendant first argued that an extension was appropriate because, although it received a statement of claim from claimant, it did not receive the accompanying exhibits, so it believed the letters were only a courtesy and not formal service. Second, defendant argued it was having difficulties logging onto the Case Management System with its smart card verification device. Third, defendant argued its primary European patent counsel had fallen ill, and it had to find alternate counsel.

The court rejected all three of defendant's arguments. According to Rule 9 of the UPC's Rules of Procedure, "the power to extend the time limit should only be used . . . in justified exceptional cases," including where "a party has an objective difficulty" in preparing its answer. The court found that defendant's circumstances were not an exceptional case.

Regarding defendant's first argument, the court explained that serving a statement of claim can still be valid without the accompanying exhibits so long as it "enables the defendant to assert its rights in legal proceedings before the Court." This was true here, as the statement of claim "state[d] with certainty the subject matter and the cause of action." The court then faulted defendant for failing to provide relevant or sufficient evidence of either its Case Management System difficulties or its need to obtain alternate counsel. Moreover, as to the technical difficulties, defendant was "expected to seek a solution in an appropriate time and act accordingly." Finally, the timing of defendant's request mattered: seeking an extension on the last day of the time period does not comply with "the principles of fairness that must guide the procedural activities of the parties." Thus, the court denied defendant's extension request.

As defendant did not file a statement of defense, claimant subsequently moved for a default decision and revocation, which the court granted. The court found "the facts put forward by the claimant justify the remedy sought" and that claimant "is entitled to a speedy procedure without delay." The patent at issue was therefore revoked in its entirety, due to a lack of novelty or inventive step in view of the prior art.

Practice Tip: Litigants in the UPC should not count on obtaining extensions of time as a matter of course, and must be aware of the potentially severe consequences of missing the deadline to file a statement of defense. Further, litigants should seek extensions as early as possible during their window to respond, and provide objective reasons, along with evidence, as to why a timely response is not possible.

Bayerische Motoren Werke Aktiengesellschaft v. ITCiCo Spain S.L., Paris (FR) Central Division, UPC Court of First Instance, Case No. UPC_CFI_412/2023.

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