



**Order of the Court of First Instance of the Unified Patent Court in the
main proceedings UPC_CFI_9/2023 concerning European patent 3 611
989**

**ACT_459771/2023
App_587438/2023 (Rule 263 VerfO) issued
on 11/12/2023**

Guiding principles:

On the admissibility of extending the action to include claims from a further patent in suit after the conclusion of limitation proceedings.

Keywords:

Extension of action; further patent in suit; limitation proceedings; possibility of separation

Applicant

1) Huawei Technologies Co. Ltd
(Plaintiff in the main proceedings) -
Bantian Huawei Base Longgang District
Shenzhen - 518129 - Shenzhen - CN

represented by
Tobias J. Hessel

Defendant

1) **NETGEAR Germany GmbH**
(Defendant in the main proceedings) - Konrad-
Zuse- Platz 1 - 81829 - Munich - DE

represented by
Stephan Dorn

2) **Netgear Inc.**
(Defendant in the main proceedings) -
350 E Plumeria Dr - 95134 - San Jose -
US

represented by
Stephan Dorn

3) **Netgear International Limited**
(Defendant in the main proceedings) - First
Floor Building 3, University Technology
Centre, Curraheen Road - T12K516 - Cork -
IE

represented by Stephan
Dorn

Patents in suit

Patent no.

Proprietor

EP3611989

Huawei Technologies Co. Ltd

COMPOSITION OF THE BODY OF THE JUDGEMENT

Presiding judge and
Rapporteur **Matthias Zigann**
legally qualified **judgeTobias**
Pichlmaier legally qualified judge **Edger Brinkman**

This order was issued by the presiding judge and rapporteur Matthias Zigann.

PROCEDURAL LANGUAGE

German

SUBJECT OF THE PROCEEDINGS

Patent infringement

Here: Application under Rule 263 of the Rules of Procedure for authorisation to extend the action to include claims from European Patent 3 678 321.

APPLICATIONS

The applicant (plaintiff in the main proceedings) requests the court to

to extend the pending action pursuant to Rule 263(1) ROP by the requests specified below based on the further patent in suit EP 3 678 321.

The defendants (respondents in the main proceedings) apply for the following,

reject the plaintiff's application for admission of the extension of the action of 23 November 2023.

FACTS OF THE CASE

The plaintiff is asserting claims against the defendants for infringement of European patents 3 611 989 and 3 678 321. She initially filed an action on 1 June 2023 based solely on European patent 3 611 989. In a statement dated 23 November 2023, she requested that the action be extended to include claims from European patent 3 678 321.

The plaintiff submits that it was prevented from asserting claims based on this patent in the action of 1 June 2023 due to limitation proceedings before the European Patent Office relating to European patent 3 611 989, which took place in the period from 13 April 2023 to 20 October 2023. The extension of the action is directed against the same acts of infringement relating to the WiFi6 functionality of the infringing forms. The extension is therefore economical in terms of litigation. The defendants would not be unreasonably disadvantaged by the authorisation.

The defendants are of the opinion that the existence of the requirements of Rule 263 VerfO has already not been sufficiently demonstrated. In the limitation proceedings, only the features of sub-claim 6 (relating to the method claim) or the identical

Sub-claim 14 (relating to the device claim) was included in the original main claims 1, 2, 9 and 10. These claims are now the new claims 1 to 4 of B3 of EP 321 and all other claims have been deleted. However, no new features had been added to the claims. Consequently, the plaintiff could have made the now limited version the subject of an action as early as 1 June 2023. It was easily possible to base the allegation of infringement on the original main claims and original sub-claims 6 and 14 of EP 321. A subsequent limitation of the asserted claims in order to adapt them to the outcome of the limitation proceedings pending before the European Patent Office would also have been possible without further ado under Rule 263.3 RP. The plaintiff's sole purpose in making the request was to avoid the renewed service of a statement of claim on the defendants. Furthermore, the defendants would be unreasonably hindered in their conduct of the proceedings by the extension of the action.

REASONS

The application for authorisation to amend the complaint is admissible and well-founded.

Pursuant to Rule 263.1 of the Rules of Procedure, a party may apply to the court at any time during the proceedings for the admission of an amendment or addition to the claim, including a counterclaim. The application must state the reasons why the amendment or addition was not already contained in the original pleading. Subject to paragraph 3, leave shall be refused if, having regard to all the circumstances, the party seeking leave to amend is unable to satisfy the court that (a) the amendment in question could not have been made earlier with due diligence and (b) the amendment does not unreasonably prejudice the other party in the conduct of the proceedings.

The application was admissible. The applicant has made submissions on all elements of the offence.

The requirements for refusal of authorisation are not met.

The court is convinced that the amendment in question could not have been made earlier with due diligence. The limitation proceedings ran until 20.10.2023. The application to amend the claim dates from 23.11.2023. The delay can be explained by the need for legal preparation. A diligent plaintiff was also not required to file an action during the ongoing limitation proceedings. Irrespective of the fact that the courts of some EPC states do not permit the assertion of a limited patent claim before the conclusion of limitation proceedings and that it remains to be clarified what the situation is at the Unified Patent Court, the plaintiff would have been forced, in the event of such an action, depending on the outcome of the limitation proceedings, to adapt the action to the events in the limitation proceedings by way of an amendment to the action. The necessity of one amendment to the action would therefore be replaced by the necessity of another amendment to the action. The rejection of the authorisation would therefore bring no benefit in terms of procedural economy.

The court is also convinced that the amendment does not unreasonably hinder the other party in its conduct of the proceedings. A certain degree of obstruction does not preclude admission under the law. Furthermore, in the case of the joint management of both patents within the same infringement proceedings, the court is obliged to grant the defendant largely the same defence options with regard to the second patent.

as in the case of a new, further action. This can be done by granting or extending deadlines for comments. If the subject matter of the extension of the action is separated, this would even be simplified.

The parties will be heard in a separate workflow on the question of whether the subject matter of the extension of the claim can or should be separated.

ARRANGEMENT

1. The request of the applicant (plaintiff in the main proceedings) of 23 November 2023 for admission of the extension of the action pursuant to Rule 263.1 VerfO to include the requests specified in the pleading of 23 November 2023 based on the further patent in suit EP 3 678 321 is granted.
2. Following the extension of the claim, the amount in dispute is set at a total of € 2 million, of which € 1 million is attributable to the subject matter of the extension of the claim.

INSTRUCTIONS TO THE PARTIES AND THE REGISTER

In view of the increase in the amount in dispute, further court fees must be collected. In the event that the subject matter of the extension of the action is separated, these are to be allocated to the newly formed proceedings. It is therefore suggested to wait with the charging of fees. The parties will be given the opportunity to comment on the issue of separation within 14 days.

Dr Zigann
Presiding judge and rapporteur

Matthias ZIGANN Digitally signed by Matthias
ZIGANN
Date: 2023.12.11 14:26:17 +01'00'

DETAILS OF THE ARRANGEMENT

ACTION NUMBER: ACT_459771/2023
UPC number:UPC_CFI_9/2023
Action type: InfringementAction
Related proceeding no. Application No.: 587438/2023
Application Type: APPLICATION_ROP_265

INFORMATION ABOUT THE APPOINTMENT

This procedural order may be reviewed by the adjudicatory body upon a reasoned application by a party (Rule 333 of the Rules of Procedure). The application must be submitted within 15 days of service.