



**UPC_CFI_54/2023
procedural order
of the Court of First Instance of the Unified Patent Court issued on
04 June 2024**

DISPUTE PARTIES

- 1) **Avago Technologies International Sales Pte. Limited**
(plaintiff and defendant) - 1 Yishun Avenue 7
- 768923 - Singapore - SG
Represented by Florian Schmidt-Bogatzky
- 2) **Tesla Germany GmbH**
(defendant and counterclaimant) -
Ludwig- Prandtl-Straße 27-29 - 12526
Berlin - DE
Represented by Dr Marcus Grosch
- 3) **Tesla Manufacturing Brandenburg SE**
(defendant and counterclaimant) - Tesla
Str. 1 - 15537 Grünheide (Mark) - DE
Represented by Dr Marcus Grosch

ORDERING JUDGE

Judge-rapporteur PARTIES' APPLICATIONS

On 15 May 2024, the defendants filed a further application under Rule 190.1 of the UPC Regulation requesting that the plaintiff be ordered to produce the following documents:

1. *The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. to authorise [. . .] to grant the p o w e r o f a t t o r n e y to [...] on behalf of Avago Technologies General IP (Singapore) Pte. Ltd.*
2. *The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. authorising the transfer of the patent-in-suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd. as referred to in the Power of Attorney submitted as Annex EIP 11.*
3. *The power of attorney referred to in the power of attorney document submitted as Annex EIP 12 decision of the "Board of Directors" of the[...] to the*

Authorisation of [...] to grant power of attorney to [...] to act on behalf of [...] Corporation.

4. *The resolution of the Board of Directors of [...] authorising the transfer of the patent-in-suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd. as referred to in the Power of Attorney submitted as Exhibit EIP 12.*

The defendants have argued that the adoption of resolutions by the executive bodies of the companies in the plaintiff's group of companies is an internal process that is not accessible to the defendants. The power of attorney documents submitted (Annexes EIP 11 and EIP 12) refer to the fact that the signatory [...] was allegedly authorised by the Board of Directors to grant further sub-authorisation. There were doubts as to whether the authorisations submitted as Annexes EIP 11 and EIP 12 had been validly granted.

They asserted that there were also reasonable doubts as to whether [...] had acted within the scope of the power of representation allegedly granted to him by the power of attorney documents submitted as Annexes EIP 11 and EIP 12 for Avago Technologies General IP (Singapore) Pte. Ltd. and [...]. The power of attorney documents expressly stipulated that authorisation of the respective transfer by the Board of Directors was a prerequisite for effective action with power of representation. There were no indications that the Board of Directors had authorised the transfer of the patent in dispute.

By Order dated 21 May 2024, the applicant was given the opportunity to comment. The applicant opposed the application.

The plaintiff argues that the defendants are no longer concerned, as they were initially, with the admissibility of the internal transaction, but with the internal decision-making at the management level. There are no doubts that such a decision-making process has taken place. At most, the applications under 1 and 3 regarding the authorisation of [...] could have something to do with the present case.
to do with this topic.

It is also of the opinion that the application for the submission of resolutions of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. and [...] is clearly not "plausible evidence", as expressly required by R. 190.1 of the Rules of Procedure. There were no connecting facts that the corresponding resolutions of the plaintiff's group of companies had not been adopted or had not been adopted effectively. This is because the companies involved [...] and Avago belonged (and still belong) to the same group of companies. The transfer of the patent in suit (and the other patents of the transaction at the time) had also been "lived" on a daily basis for many years. In addition, the transferring, former patent holder [...] could at best be involved. Avago General IP as the "recipient" of the patent transfer was not affected and, according to the documents, nothing had to be "authorised by the Board".

REASONS FOR THE ORDER

1.

Pursuant to Rule 190.1 of the Rules of Procedure, upon a reasoned application by the party that designated the evidence, the court may order the production of that evidence by the opposing party or the third party if a party has produced all reasonably available and plausible evidence in support of its claims and has moved to

The court must ensure that the party has designated evidence that is at the disposal of the opposing party or a third party as the basis for these claims.

The defendants have denied the plaintiff's legitimacy to sue and have objected to the lack of effective authorisation of the persons acting, in particular due to inadmissible self-dealing. This application is a follow-up application following receipt of the power of attorney documents submitted by the plaintiff in Annexes EIP 11 and 12. The defendants had already previously requested the submission of the following documents in the statement of defence and in a separate application dated 15 April 2024:

1. The power of attorney ("Power of Attorney") referred to in the expert opinions of [...] dated 17 May 2018 (Annex EIP 9) and [...] ("Advice on Validity of Assignment of Patents") dated 16 May 2018 (Annex EIP 10), according to which Avago Technologies General IP (Singapore) Pte. Ltd. grants several persons the power to act on its behalf with respect to certain legal transactions ("Power of Attorney"), signed by [...] as its "Chief Financial Officer" on 17 October 2016.

2. The power of attorney referred to in the opinions of [...] dated 17 May 2018 (Annex EIP 9) and [...] ("Advice on Validity of Assignment of Patents") dated 16 May 2018 (Annex EIP 10), according to which [...] Corporation grants several persons the authority to act on its behalf with regard to certain legal transactions ("Power of Attorney"), signed by as its "Secretary" on 17 October 2016.

The plaintiff had voluntarily complied with this application.

Object of the present applications is it, the the authorisation (for sub-authorisation) of [...] by the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. and the Board of Directors of [. . .]. Further subject matter is the submission of the respective resolutions of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. and the Board of Directors of [...] Corporation authorising the transfer of the patent-in-suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd.

2.

The application was to be granted with regard to applications 1, 3 and 4, but rejected in all other respects.

a) In principle, the legitimisation to assert annex claims from European patents is based on the substantive entitlement. The entry in the patent register therefore has a significant indicative effect when assessing the question of who is the substantive owner of the patent (see BGH, judgement of 7 May 2013 - X ZR 69/11, GRUR 2013, 713, para. 57 et seq. - milling process). Nothing else applies on the basis of the UPCA. According to Rule 8.5 VerFO, the following applies

(a) [...] as regards the proprietor of the European patent, the person who, under the law of the Member State for which the European patent has been granted, is entitled to be registered as proprietor of the patent, irrespective of whether that person is actually registered in the patent register of that Member State (hereinafter referred to as the "national patent register"); and

(b)[..]

(c) For the purposes of paragraph 5, there shall be a rebuttable presumption that the person identified in the relevant national patent register and in the European Patent Register maintained by the European Patent Office is entitled to be registered as proprietor or as applicant, as the case may be.

The Board must therefore assume a rebuttable presumption. The CoA has already taken the same approach for patents with unitary effect and assumed that this person is to be treated as the proprietor of the patent with unitary effect on the basis of his corresponding entry in the Register for Unitary Patent Protection, Rule 8.4 RP. As such, it was entitled to request the ordering of corresponding measures, Art. 47(1) UPCA (UPC_CoA 335/2023, Order of 26 February 2024, p. 24).

b) It is true that with regard to the authorisation of the [...] in favour of the [...] no tangible evidence of their absence or incorrectness.

was able to do so. However, since the formation of the plaintiff's will within the company and group is completely withdrawn from the defendants, they must be allowed to submit for examination those resolutions to which the owner of the property right listed in the register, i.e. the plaintiff, has itself referred in the proceedings. In addition, as the plaintiff also admits, there is a connection between the applications under 1 and 3 concerning the authorisation of [...] and the present issue of self-dealing. This justifies a corresponding the corresponding template

arrangement. c)

With regard to application no. 2, however, the requirements of Rule 190.1 VerFO have not been met. This is because it only follows from the power of attorney submitted by the plaintiff as Annex EIP 11 that authorisation by the Management Board is required for the *transfer of rights*, but not for the acquisition of rights. In this respect, the plaintiff rightly relies on the fact that the half-sentence "authorised by the Board" referred to by the defendants expressly refers only to "(i) Patent IP owned by the Company". If, on the other hand, Avago General IP is the recipient of a patent assignment, this provision does not apply, so that there are no indications of authorisation by the Board of Directors.

d)

With regard to application no. 4, however, the requirements of Rule 190.1 VerFO are again met. This is because it also follows from the power of attorney submitted as Annex EIP 12 that authorisation by the Management Board is required for the *transfer of rights*. In this respect, the transfer of IP rights requires authorisation by the board of directors of [...], the absence of which the defendant cannot examine and cannot introduce a n y evidence without having seen it.

ORDER

The applicant is ordered to submit the following documents **within one week**:

1. The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. to authorise the [...] to grant the power of attorney to [...] on behalf of Avago Technologies General IP, as referred to in the Power of Attorney submitted as Annex EIP 11

(Singapore) Pte. Ltd.

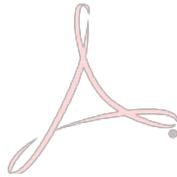
2. ...

3. The resolution of the Board of Directors of [...] referred to in the Power of Attorney submitted as Annex EIP 12 authorising [...] to grant [...] the power *to act on* behalf of [...].
4. The resolution of the Board of Directors of [...] authorising the transfer of the patent-in-suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd. as referred to in the Power of Attorney submitted as Exhibit EIP 12.
5. The further application is rejected.

ORDER DETAILS:

Order No. ORD_28831/2024in App 27608/2024
Procedure number: ACT_463258/2023
UPC number: UPC_CFI_54/2023
Type of procedure: Application for an Order to submit evidence (Rule 190

VerfO) ISSUED IN HAMBURG ON 04 JUNE 2024



Dr Schilling
Judge-
rapporteur