

procedural order
of the Court of First Instance of the Unified Patent Court local division
Düsseldorf
issued on 27 June 2024
concerning EP 3 490 258 B1

LEADERSHIPS:

1. If the defendant deals extensively with licence negotiations between himself and a patent pool in the context of the justification of the FRAND objection raised by him, the plaintiff can only respond comprehensively to this submission if he can consult with employees of the patent pool. If the plaintiff is initially prevented from such consultation by an application aimed at the protection of trade secrets (R. 262A VerFO), his right to be heard can be taken into account by extending his time limit for defence to this submission accordingly upon application.
2. Even if an application for the protection of secrets only relates to a definable part of a document, such as the statements on the FRAND objection, a partial extension of the time limit, limited to the part concerned, can be dispensed with in the interest of effective proceedings and to prevent a permanent divergence of time limits if the conduct of the oral hearing is not jeopardised by an extension of the time limit relating to the entire document.

KEYWORDS:

Extension of time limit; protection of trade secrets; R. 262A application; FRAND objection; partial extension of time limit

Plaintiff:

Dolby International AB, represented by its EMEA Finance Director Susan Way, 77 Sir John Rogerson's Quay, Block C, Grand Canal Docklands, Dublin, D02 VK60, Ireland,

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Access Advance LLC, represented by its CEO Peter Moller, 100 Cambridge Street Suite 21400,
Boston, MA 02114,

represented by: Attorney Dr Volkmar Henke, Attorney Dr Tilman Müller,
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defendant :

1. **HP Deutschland GmbH**, represented by its managing directors, Mr Adrian Müller and Mr Peter Kleiner, Herrenberger Straße 140, 71034 Böblingen, Germany,
2. **HP Inc.**, represented by its managing directors, 1501 Page Mill Road, Palo Alto, California 94304, U.S.A,
3. **HP International SARL**, represented by its managing directors, Route du Nant-d'Avril 150, 1217 Meyrin, Switzerland,
4. **HP Austria GmbH**, represented by its managing directors, Technologiestrassen 5, 1120 Vienna, Austria,
5. **HP France SAS**, represented by its Managing Directors, Meudon Campus Bât. 1, 14 Rue de la Verrerie, 92190 Meudon, France,
6. **HP Belgium SPRL**, represented by its Managing Directors, Hermeslaan 1a, B-1831 Diegem (H.P. Inc.), Belgium,

7. **HP Inc Danmark ApS**, represented by its managing directors, Engholm Parkvej 8, 3433 Allerød, Denmark,
8. **HP Finland Oy**, represented by its managing directors, Piispankalliontie, 02200, Espoo, Finland,
9. **HP Italy S.r.l.**, represented by its Managing Directors, Via Carlo Donat Cattin, 5 - 20063 Cernusco sul Naviglio (MI),
10. **Hewlett-Packard Nederland BV**, represented by its managing directors, Startbaan 16, 1187 XR Amstelveen, The Netherlands,
11. **HP PPS Sverige AB**, represented by its managing directors, Gustav III:s Boulevard 30, 169 73 Solna, Sweden,
12. **HPCP - Computing and Printing Portugal, Unipessoal, Lda**, represented by its directors, Building D. Sancho I, Quinta da Fonte, Porto Salvo, 2770-071 Paço de Arcos, Lisbon, Oeiras, Portugal,
13. **Hewlett-Packard d.o.o.**, represented by its managing directors, Tivolska cesta 48, 1000 Ljub- ljana, Slovenia,
14. **Hewlett-Packard Luxembourg SCA**, represented by its Managing Directors, Vegacenter, 75 Parc d'Activités, Capellen, L-8308 Capellen, Luxembourg,
15. **HP Inc Bulgaria EOOD**, represented by its Managing Directors, Mladost Region, Business Park Sofia, Building 10, Sofia 1766, Bulgaria,

Defendants 1) to 15) represented by: Dr Frank-Erich Hufnagel, lawyer

lawyer Dr Nina Bayerl, lawyer Dr Stephan Dorn,
 lawyer Dr Sabrina Biedermann, lawyer Eva Acker,
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reshfields.com STREITPATENT:

European Patent No. EP 3 490 258 B1

ADJUDICATING BODY/CHAMBER:

Judges of the Düsseldorf local division:

This Order was issued by presiding judge Thomas as judge-rapporteur. LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT: R. 9.3 (a) RP - Extension of the time limit for replying to the action for infringement and the time limit for replying to the action for annulment

BRIEF DESCRIPTION OF THE FACTS:

The plaintiff is suing the defendants for infringement of the European bundle patent EP 3 490 258. It has contributed its HEVC-essential patent portfolio, including the patent in dispute, to a patent pool managed by Access Advance LLC (hereinafter: Access Advance).

In a document dated 3 May 2024, the defendants requested that access to the passages highlighted in grey in Part II of the defence (non-technical part) of the same date and marked as "access restricted" and to some of the documents attached to this document be restricted to certain persons, as the relevant information constitutes business and trade secrets. The application for protection of secrets covers in particular statements on the licence negotiations conducted between the defendants and Access Advance.

In an Order dated 6 May 2024, the Düsseldorf local division granted the plaintiff's legal representatives named in the proceedings to date access to the unredacted version of the document classified by the defendants as confidential, including the annexes, obliged them to maintain confidentiality and gave them the opportunity to comment on the application for confidentiality protection.

In a statement dated 17 May 2024, the plaintiff requested the inclusion of Access Advance in the group of persons entitled and obliged to receive and stated in justification that it should be able to exchange information with Access Advance employees in order to make a comprehensive defence to the arguments concerning the negotiations between Access Advance and the defendant.

After the Düsseldorf local division subsequently notified the parties to the proceedings of its intention to include Access Advance in the group of parties entitled to access by way of an Order dated 21 May 2024, the defendants opposed such inclusion in a document dated 3 June 2024. At the same time, the defendants expressed their unwillingness to accept a procedural order providing for the inclusion of Access Advance in the group of authorised parties, insofar and as long as Access Advance is not involved in the proceedings as an intervener or party. In response, the plaintiff announced a motion to intervene by Access Advance in a document dated 17 June 2024. At the same time, it requested that the decision on the R. 262A application be postponed as far as Access Advance is concerned and that the group of authorised parties be expanded to include the employees named by the plaintiff. The Düsseldorf local division issued an Order to this effect on the same day.

By document dated 20 June 2024, Access Advance filed an application to intervene pursuant to R. 313 of the Rules of Procedure, which the Düsseldorf local division declared admissible by Order dated 26 June 2024. At the same time, the Düsseldorf local division announced in a preliminary procedural order that Access Advance would be included in the group of authorised representatives. The parties have the opportunity to raise any objections to the issuance of the intended procedural order by 1 July 2024.

APPLICATIONS BY THE PARTIES:

The applicant claims that the Court should,

1. Declare that the time limit for filing the Reply to the Statement of Defence and the time limit for filing the defence to the action for annulment begin to run from the date on which the applicant and its legal representatives have access to the Statement of Defence and Access Advance LLC, intervening in the dispute, has been served with the documents in which the statements relating to the negotiations with the patent pool are not redacted;
2. in the alternative: to extend the time limit for filing the Reply to the Statement of Defence pursuant to Rule 29(a) of the Rules of Procedure and the time limit for replying to the action for annulment pursuant to Rule 29(a) of the Rules of Procedure to two months from the date on which the applicant and its authorised representatives have access to the unredacted Statement of Defence and Access Advance LLC, intervening in the dispute, has been served with the documents in which the statements on the negotiations with the patent pool have not been redacted.

The defendants did not make use of the opportunity granted to them to comment on the plaintiff's applications.

REASONS FOR THE ORDER:

R. 9.3 (a) VerfO authorises the court to extend time limits. However, this option should only be used with caution and only in justified exceptional cases (UPC_CFI_363/2023 (LK Düsseldorf), Order of 20 January 2024, GRUR-RS 2024, 5106).

Such an exceptional case exists in the present case.

Pursuant to R. 29(a) of the Rules of Procedure, the plaintiff must file a defence to the counterclaim for a declaration of invalidity, together with any defence to the statement of defence and any application for amendment pursuant to R. 30 of the Rules of Procedure, within two months of service of a statement of defence containing a counterclaim for a declaration of invalidity. It follows that the time limit runs from the date of service, even if an application for protection of confidential information (R. 262A RP) has been filed in relation to this defence, on which an Order will be issued at a later date (UPC_CFI_456/2024 (LK Düsseldorf), Order of 24 June 2024, ORD_35. June 2024, ORD_35903/2024 - Dolby v. ASUS; other opinion: UPC_CFI_54/2023 (LK Hamburg), order of 28 November 2023, ORD_589355/2023 - Avago v. Tesla).

However, this does not mean that the party affected by a request and/or an Order for the protection of confidential information is defenceless. Rather, their interests can be taken into account by extending the time limit for filing the Reply to the statement of defence and the time limit for replying to the action for annulment - as here - upon application (UPC_CFI_355/2023 (LK Düsseldorf), Order of 4 April 2024, ORD_18050/2024 - Fujifilm v. Kodak; UPC_CFI_456/2024 (LK Düsseldorf), Order of 24 June 2024, ORD_35903/2024 - Dolby v. ASUS).

With regard to the FRAND objection affected by the defendant's application for secrecy protection, an extension of the time limit to the extent granted is already necessary because the plaintiff has not yet been able to submit its defence.

The plaintiff's representatives had no opportunity to exchange information with Access Advance about the defendants' submissions in the statement of defence, even though the defendants made comprehensive submissions about their negotiations with Access Advance in their statement of defence. In addition, the plaintiff's representatives were initially also prevented from exchanging information with employees of the plaintiff itself due to the provisional secrecy protection order.

Although the defendant's request for protection of secrecy relates exclusively to the Reply Part II together with the annexes and thus to the non-technical part essentially dealing with the FRAND objection, the local division refrained from only partially extending the time limit in the interest of effective conduct of the proceedings and uniformly extended the time limit for the Reply to the statement of defence and the time limit for the reply to the action for annulment. Even if the explanations on the technical aspects on the infringement and legal aspects do not contain any redactions, the present case differs from the factual constellation decided by the Mannheim local division (UPC_CFI_219/2023, Order of 13 June 2024, ORD_35648/2024) in that the date of the oral hearing is not in danger of being jeopardised by the granting of a comprehensive extension of the time limit. The question of extending the deadline arises here at a much earlier stage of the proceedings. Against this background, a deadline extension limited to the FRAND part would lead to a permanent divergence of the deadlines for the technical and non-technical parts. Such a drifting apart of both parts is avoided by the standardised extension of the deadlines, which appears to be preferable in the interests of effective procedural management.

ORDER:

1. The time limit for filing the Reply to the statement of defence pursuant to R. 29 (a) of the Rules of Procedure and the time limit for replying to the action for annulment pursuant to R. 29 (a) of the Rules of Procedure are each extended until 1 September 2024.
2. The remainder of the applicant's applications are dismissed.

ORDER DETAILS:

to the applications App_36218/2024 and App_36222/2024
concerning the main file numbers ACT_590145/2023 and CC_21620/2024

UPC number: UPC_CFI_457/2023

Type of proceedings: Action for infringement and action for annulment

Issued in Düsseldorf on 27 June 2024 NAMES

AND SIGNATURES

Presiding judge Thomas

Ronny
Thomas
Digitally signed by
Ronny Thomas
Date: 2024.06.27
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