



Local division Mannheim
UPC_CFI_332/2024

Order
of the Court of First Instance of the Unified Patent Court, Mannheim
Local Division
issued on 31 July 2024
concerning EP 2 568 724
App_43962/2024
ORD_44597/2024

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-shi - 571-8501 - Osaka - JP
represented by Christopher Weber

defendant:

Xiaomi H.K. Limited, Suite 3209, 32/F, Tower 5, The Gateway, Harbour City, 15 Canton Road, Tsim Sha Tsui, Kowloon, Hong Kong, represented by its legal representatives, *ibid.*

Guiding principles:

1. A further attempt to serve the application under an alternative procedure or at another place pursuant to Rule 275.1 RoP is not required as soon as all possibilities of service under Rules 270-274 RoP have been exhausted and the central authority of the requested State competent under the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters seriously and definitively refuses service because and as long as the designation of the defendant's place of business by the plaintiff does not correspond to its policy.
2. There shall be no censorship or redaction by the Court of the documents filed by the parties before the Unified Patent Court at the request of the Central Authority of the State requested to be served.
3. The Order under Rule 275.2 RoP, which recognises steps already taken to bring the application to the defendant's attention as valid service, must be published on the homepage of the single court if service of the Order under Part 5, Chapter 2 on the defendant is unlikely to succeed for the same reasons.

STREITPATENT:

EUROPEAN PATENT NO. EP 2 568 724

SPRINGKÖRPER/KAMMER: Mannheim local division

CONTRIBUTING JUDGES:

This Order was issued by the Chairman and judge-rapporteur, Dr Tochtermann. LANGUAGE OF THE

PROCEEDINGS: German

SUBJECT: Refusal of service, alternative service

FACTS OF THE CASE

In the main proceedings, the plaintiff brought an action for patent infringement against various companies in the Xiaomi group of companies. These companies also include the defendant in the now separated and separately conducted proceedings.

The severance took place because service on the defendant here at the business address of defendant 3, Xiaomi Technology Germany GmbH with a business address in Düsseldorf, Germany, given by the plaintiff, was not successful. Rather, the representatives of defendant 3 stated the following at the end of a notice of opposition:

"We hereby give notice on behalf of the defendant 3), Xiaomi Technology Germany GmbH, that service of process on the defendants 1), 2), 7) and 8) has been effected at the address of the defendant 3).

3) is not possible. Service of the application on the defendants 1), 2), 7) and 8) has therefore not taken place. We ask the court to indicate whether the application addressed to defendants 1), 2), 7) and 8) should be destroyed or returned to the court."

Subsequently, on 22 November 2023, the plaintiff filed an application to order that the service of the statement of claim on defendants 1, 2, 7 and 8 at the business address of defendant 3 constitutes valid service on defendants 1, 2, 7 and 8.

This application was rejected by the judge-rapporteur following comments by the opposing party in an Order dated

8 December 2023, because an attempt to effect service must first be made in accordance with the Rules of Procedure, in this case the Hague Service Convention. The application for review by the adjudicating body was unsuccessful.

After the plaintiff had in the meantime provided the translations required for service and the software company responsible for maintaining the court's CMS had, after considerable delays, created the conditions for separating the proceedings against the defendant in the CMS, the statement of claim and annexes were sent to the receiving authority responsible for Hong Kong, SAR, China, in accordance with the requirements of the Hague Service Authority. In detail, the posted items contained

- the form to be used in accordance with the HZÜ concerning the request for service in duplicate in the original (with the corresponding designation "Hong Kong Special Administrative Region of the People's Republic of China").

- the statement of claim in a double certified copy in Chinese translation.
- a certified copy of the statement of claim in German.
- a simple English translation of the statement of claim.
- All attachments to the statement of claim are simply in the language version as they were uploaded to the CMS.
- the court's additional documents concerning a note on the separation, the access code to the CMS and an information letter addressed to the defendant.

The following objection was raised in the accompanying letter from the receiving authority:

With reference to your request for service of judicial documents as enclosed, we regret that we are unable to accede to it because of the following reasons –

- (i) some of the documents for service (viz. “statement of claim dated July 2023”, “exhibits KAP B 00 – 10” and “court document from June 21st 2024”) are not furnished in duplicate in accordance with Article 3 of the Convention; and
- (ii) references to “Hong Kong” are listed on an equal basis with references to sovereign states like “China” in the documents to be served (see flagged). Please correct “Hong Kong” therein to “Hong Kong SAR, China”, which stands for the Hong Kong Special Administrative Region of the People’s Republic of China, before sending the request to us again.

Kindly be reminded that the above amendments to the request should be typewritten. If you deem typewritten amendments impossible, please provide us with a covering letter confirming and stipulating in details such necessary and appropriate amendments which could not be typewritten to the original for our consideration.

I hereby return all the documents for your action as appropriate, please.

In the Chinese and English translations of the statement of claim, the words "Hong Kong" in the receipt of the statement of claim were marked with flags and underlining and handwritten corrections to the name of the parties of the defendant here as follows:

7. Xiaomi H.K. Limited, Suite 3209, 32/F, Tower 5, The Gateway, Harbour City, 15 Canton Road, Tsim Sha Tsui, Kowloon, Hong Kong, represented by its legal representatives, ibid;
- Authorized representative: N.N. *Hong Kong SAR, China*
- Postal address for service: c/o Xiaomi Technology Germany GmbH, Niederkasseler Lohweg 175, 40547 Düsseldorf
- Electronic address for service: N.N.

– Defendant 7 –

中國香港

- 第六被告 -

7. 小米香港有限公司，香港九龍尖沙咀廣東道 15 號海港城港威大廈 5 座 32 樓 3209 室，由其法定代理人代表公司，同上；

信函授權接收人： 不詳

信函送達地址： 代收人 小米科技德國有限責任公司 (Xiaomi Technology Germany GmbH), 地址: 下卡塞勒-洛街 (Niederkasseler Lohweg) 175, 40547 杜塞爾多夫(Düsseldorf)

電子郵件傳送地址： 不詳

- 第七被告 -

The plaintiff was informed of the outstanding return of the service documents by Order dated 22 July 2024 and given the opportunity to comment.

By document dated 29 July 2024, the plaintiff filed the following applications:

1. die Zustellung gemäß R. 275.1 VerfO nach einem alternativen Verfahren zuzulassen, nämlich

a) durch die Zustellung mittels Einschreiben mit Rückschein oder gleichwertigem Beleg an die bestellten Prozessvertreter (Hogan Lovells) der Beklagten in den Verfahren vor dem Einheitlichen Patentgericht – Lokalkammer München und vor dem Landgericht München;

- b) Hilfsweise zu Antrag zu 1.a)

zusätzlich zu der Zustellung nach 1.a) durch Zustellung mittels Einschreiben mit Rückschein oder gleichwertigem Beleg an die Prozessvertreter (Freshfields) anderer Gesellschaften der Xiaomi-Gruppe in den Verfahren vor dem Einheitlichen Patentgericht – Lokalkammer Mannheim und dem Landgericht Mannheim;

- c) Hilfsweise zu Antrag zu 1.a) oder 1.b)

zusätzlich zu der Zustellung nach 1. a) und/oder 1. b) durch die Zustellung mittels Einschreiben mit Rückschein oder gleichwertigem Beleg bei der Xiaomi Technology Germany GmbH, Niederkasseler Lohweg 175, 40547 Düsseldorf;

- d) Hilfsweise zu Antrag zu 1.a), 1.b) oder 1.c)

zusätzlich zu der Zustellung nach 1.a), 1.b) und/oder 1.c) durch die Zustellung mittels Einschreiben mit Rückschein oder gleichwertigem Beleg bei der französischen Xiaomi Technology France S.A.S., der italienischen Xiaomi Technology Italy S.R.L. und/oder der niederländischen Xiaomi Technology Netherlands B.V.;

- e) Hilfsweise zu Antrag zu 1.a), 1.b), 1.c) oder 1.d)

zusätzlich zu der Zustellung nach 1.a), 1.b), 1.c) und/oder 1.d) durch die Zustellung an die E-Mail-Adresse service.hk@support.mi.com;

- f) Hilfsweise zu Antrag zu 1.a), 1.b), 1.c), 1.d) oder 1.e)

durch eine andere vom Spruchkörper zu bestimmende angemessene alternative Zustellungsform;

wobei die Zustellung der Klage an dem Tag als zugestellt gilt, an dem die alternative Zustellung bewirkt wurde und wobei – soweit anordnungsgemäß Zustellungen nach Hilfsanträgen zu bewirken sind – der Tag der letzten Zustellung maßgeblich ist und die gesetzliche Frist zur Klageerwiderung ab diesem Zeitpunkt beginnt.

2. Äußerst hilfswiese und aus anwaltlicher Vorsicht einen weiteren Zustellungsversuch vorzunehmen und dabei die von der Empfangsbehörde geforderten Duplikate und Angaben zu ergänzen.

The plaintiff argues that the attempt at service pursuant to Rule 274.1 (a) (ii) RoP failed and that service was wrongly refused. There is no need to serve translated annexes in duplicate, the designation that the receiving authority considers preferable for political reasons is not necessary, and a review of the content of the application should be omitted in any case. The receiving authority's attitude of refusal was, as it were, harassing. Therefore, a new attempt at service was also pointless and the implementation of an alternative service procedure was appropriate.

With regard to the plaintiff's further submissions, reference is made to the document.

REASONS FOR THE DECISION

The local division has now exhausted the options available to it under the Rules of Procedure for formal service in accordance with Rules 270-274 RoP, Sections 1 and 2 of Chapter 2 relating to service.

Service in Germany at the business address of Xiaomi Technology Germany GmbH in the main proceedings was refused.

The subsequent service initiated in accordance with the Hague Service Convention has finally failed, so that no further attempts at service are required:

The Mannheim local division has complied with the formal requirements of the Convention, in particular the application pursuant to Article 3 of the HZÜ was sent in two parts in accordance with the attached model, as was the document to be served. Furthermore, the entries were made in the correct language (Article 7 HZÜ). The terminology used in the address for service was correct in the opinion of the receiving agency. Furthermore, the statement of claim was submitted in two parts in Chinese (Art. 5 (1) and (3) HZÜ). The fact that the other court notes on the separation of the present proceedings from the original proceedings and the cover letter generated by the CMS together with the access code were not submitted in duplicate is just as irrelevant as the fact that the annexes to the statement of claim were enclosed in a simple version. This is because these documents are not a direct part of the document to be served. Whether the statement of claim is sufficiently comprehensible on its own, even without attachments, to be sufficient for formal service is in any case not to be examined by the bodies involved in service in accordance with the HZÜ. Rather, it is the sole decision of the party bringing the action as to what information it considers necessary for the effective bringing of an action against the defendant. Whether a procedural defect can be inferred from this must then be decided by the court called upon to decide in accordance with the applicable national procedural law.

Furthermore, the designation of the defendant's business address as being in "Hong Kong" used by the plaintiff does not preclude service.

How the plaintiff designates the defendant's business address is entirely up to him. There is no place in the Hague Service Convention for censorship of content based on considerations of political expediency. It is neither the task of the authority responsible for service in the receiving state nor of the court requesting service to censor or edit the content of the document to be served. The document must be served in the form in which it was submitted by the party. Changes to the content of the documents submitted by a party - as formulated in auxiliary request no. 2 - by the court itself are prohibited against the background of the independence and impartiality to which the court is obliged.

By its statements and return of the documents to be served, the receiving agency has made it unmistakably clear that service will not be effected without the desired changes. This is contrary to the international treaty obligations of the Hague Service Convention. As the refusal is serious and final, there is no need for a new attempt at transmission, nor is the time limit of Art. 15 (2)(b) Hague Convention to be observed in this case.

A transfer has taken place within the meaning of Art. 15 (2)(a) HZÜ, the reasonable steps pursuant to Art. 15 (2)(c) HZÜ have been taken. The declaration of the Contracting State that its judges, notwithstanding Art.

15(1) TCA to decide the dispute, even if a certificate of service has not been received, has been made with Rule 275.2 RoP by the Contracting States of the UPCA by means of the decision of the Administrative Committee of 8 July 2022 on the basis of Article 41 UPCA.

The plaintiff's applications are to be interpreted as meaning that, in their sequence of steps, they are aimed at effecting service without complying with the formalities of Rule 274(a)(ii) RoP in conjunction with the HZÜ. Insofar as the applications are aimed at taking further action, they must be interpreted as meaning that it is now necessary to ensure rapid progress in the proceedings after all formal attempts at service have failed. Therefore, the wording of the request can also be interpreted as including allocation in accordance with Rule 275.2 RoP, especially as the relevant arguments have already been put forward.

In the present case of a serious and final refusal after an actual attempt at service has been made, a further attempt at service is not necessary. All methods of service suggested by the plaintiff have no prospect of success. The defendant's representatives before the Munich local division have not been appointed in the present proceedings, the lawyers of the law firm Freshfields have already refused to accept service, and the same applies to Xiaomi Technology Germany GmbH. Furthermore, it is not apparent that the other foreign companies of the Xiaomi Group would react differently or are even authorised to accept delivery on behalf of the defendant here; sending to the general service email address is also not an option as a method of delivery. This leaves the alternative alternative form of service requested under 1.f) to be determined by the adjudicating body. This also includes alternative service in accordance with Rule 275.2 RoP. Accordingly, it must be ordered that the steps already taken as described above constitute legally valid service.

Otherwise, service would have been impossible due to the defendant's refusal to mandate the legal representatives in the main proceedings, although it was able to do so without further ado in the parallel cases before the Munich local division, as well as the refusal, contrary to international law, of the representatives appointed in accordance with

the competent national receiving authority under the HZÜ. If such steps are not promising for the reasons stated, Rule 275.2 RoP also applies if, after an attempt at formal service in accordance with Rules 270-274 RoP, no further alternative attempt at service in accordance with Rule 275.1 RoP has previously been made.

In order to enable the defendant to take note of the present decision even without service, it was ordered that a separate reference to the present decision be made on the court's publicly accessible homepage.

In the present case, the decision must also be sent to the appointed representatives in the proceedings before the Munich local division by registered letter with acknowledgement of receipt, as they are obliged under German professional law to inform their clients of correspondence that reaches them (Section 11 (1) of the Professional Code for Lawyers). It should be emphasised that this step is not a prerequisite for the alternative service order to be effective.

Formal service of the present Order pursuant to Rule 276.1 RoP was not required. This is because such service would inevitably fail due to the same obstacles that had to lead to the issuing of the present Order.

ORDER

1. The steps already taken to bring the statement of claim in proceedings ACT_36410/2024 UPC_CFI_332/2024 to the defendant's attention constitute valid service.
2. Reference to this Order shall be made on the homepage of the court in the following wording, stating the names of the parties and the action number, so that the Order can be found among the decisions published on the homepage:

"In the proceedings between Panasonic Holdings Corporation and Xiaomi H.K. Limited UPC_CFI_332/2024 App_43962/2024, an Order replacing service was issued by the Mannheim local division on 31 July 2024.

In the proceedings between Panasonic Holdings Corporation and Xiaomi H.K. Limited UPC_CFI_332/2024 App_43962/2024, an order replacing formal service was issued by the Local Division Mannheim on July 31, 2024."

3. This Order is to be sent by the Registry to the appointed legal representatives of the defendants in the proceedings before the Munich local division by registered letter with acknowledgement of receipt.

issued in Mannheim, 31 July 2024

Peter Michael
Dr. Tochtermann

Digitally signed by Peter Michael
Dr Tochtermann
Date: 2024.07.31 15:12:20
+02'00'

Dr Peter Tochtermann
Presiding judge and judge-rapporteur