



**LISBON – LOCAL DIVISION**

**UPC\_CFI\_317/2024**

**ACT\_35572/2024**

**ORDER**

of the Court of First Instance of the Unified Patent Court

issued on **16 August 2024**

APPLICANT IN PRELIMINARY INJUNCTION PROCEEDINGS:

TELEFONAKTIEBOLAGET LM ERICSSON

represented by Mr. Wim Maas

Eelco Bergsma

Manuel Durães Rocha

DEFENDANTS IN PRELIMINARY INJUNCTION PROCEEDINGS:

1. ASUSTEK COMPUTER INC
2. ARVATO NETHERLANDS B.V.
3. DIGITAL RIVER IRELAND LTD.

all represented by Mr. Alex Wilson

Ari Laakkonen

Adam Rimmer

Sara Nazaré

Joana Piriquito Santos

PATENT AT ISSUE:

EUROPEAN PATENT NO EP 2 819 131 B1

PANEL ISSUING THE ORDER:

Presiding judge and

Judge-rapporteur: Rute Lopes

Legally qualified judge: Sam Granata

Legally qualified judge: Petri Rinkinen

LANGUAGE OF THE PROCEEDINGS:

English

SUBJECT-MATTER OF THE APPLICATION

- 1** In its application from 14 June 2024 in the related main proceedings, Ericsson (hereafter Applicant) indicated, stating compliance with R. 13.1(h) Rules of Procedures (hereafter RoP), that:

*Grant of the Patent was not opposed in the EPO.*

*The Patent was not opted out of the UPC.*

*In the UPC, there are no prior or pending proceedings relating to the Patent.*

*In particular, no prior request for a preliminary injunction or other provisional measures has been submitted relating to the Patent.*

- 2** On 12 July 2024, the Applicant by its own initiative lodged a generic application (App\_41354/2024) to complete the information regarding R. 13.1(h) RoP and provided additional info about proceedings concerning the patent in certain European countries.
- 3** Defendants in the main proceedings, AsusTeK, Arvato and Digital River (hereafter Defendants) were given the opportunity to reply to the 12 July application together with their opposition in the main proceedings.
- 4** In their opposition, Defendants raised an issue regarding the Applicant's lack of compliance with R. 13.1(h) RoP requesting the Applicant to be ordered to comply with R. 13.1(h) RoP within 14 days of the Order and to provide copies of (a) all prior art relied on in all of the referenced proceedings, together with (b) pleadings, (c) statements of case and (d) expert reports from such proceedings (para. 499-519 of the opposition).
- 5** Defendants presented the following arguments (in summary):
- The non-compliance may be harming for the Defendants' defense in this urgent proceeding, for example, if there is a prior invalidity proceeding referring to an anticipating prior disclosure, that would be a material fact which the Defendants would wish to investigate for their reply.
  - R. 13.1(h) RoP - was not complied with from the beginning, and the Court did not

invite the Applicant to supplement the R. 13.1(h) RoP information.

- The lodging of the Applicant by its own initiative has no legal ground and appears to assume that the Court or the Applicant has the power to supplement defective R. 13.1(h) RoP disclosure.
- Non-compliance with R. 13.1(h) RoP gives the Court the power to give a decision by default.

6 The Applicant was given the opportunity to reply to the Defendants' request (ORD\_46326/2024) and, in response, the Applicant submitted a final overview, as Annex 1, with all prior proceedings relating to the Patent and a European family member of the Patent (EP 1 721 324), further informing the Court that the cases in which the validity of the Patent was attacked were unsuccessful and that the prior national proceedings initially omitted have not resulted in a decision as to the infringement or validity of the Patent nor did these prior proceedings have progressed to a stage that one could derive any indication from the respective courts regarding the alleged non-infringement or invalidity of the Patent.

7 The Applicant requested the Defendants' request to be dismissed in its entirety for the following reasons (in summary):

- A functional and systemic interpretation of Rule 13.1 (h) RoP as the Applicant has done entails that only pending and prior UPC and EPO proceedings should be listed in compliance with R. 13.1(h) RoP as only these can be checked by the Registry. Nevertheless, R. 13.1(h) RoP was complied with at least by the submission of the aforementioned Annex 1;
- R. 13.1(h) RoP does not require the information about proceedings outside of Europe relating to a foreign family member of the Patent, such as proceedings relating to US 7151430;
- R. 13.1(h) RoP does not require full disclosure of all prior art asserted in prior and pending proceedings relating to the Patent nor does it require the pleadings, statements of case and the expert report from such proceedings.

#### Grounds for the ORDER

8 Rules 13 and 206.2(a) RoP set out the requirements that the application for provisional measures must fulfil. Regarding R. 13.1(h) RoP, the application shall provide, where applicable, information regarding prior or pending proceedings before the UPC, the EPO and any other court or authority relating to the patent at issue. Furthermore, R. 13.1 (h) RoP emphasizes the need to inform about any action for revocation or declaration of non-infringement pending before the central division and the date of any such action.

9 And the contents of the Statement of Claim as stipulated in R. 13, and more specifically its extent and detail, are to be read in view of their purpose. As mentioned hereafter R. 13.1(a) to (j) RoP serve a purpose to enable the Registry to formally check the necessary elements and upon examination to forward the Statement of Claim to the Defendants, to record the file in the Registry, to attribute a date to the Statement of Claim and to assign the case to a panel of a division. R. 13.1.(h) RoP specifically serves the purpose to limit the risk of contradictory decision and *lis pendens* situations, which can formally be

avoided based on the requirements to inform the UPC of prior or pending proceedings relating to the patent concerned before the case is attributed to a panel.

- 10** In light of that purpose, the Court considers, contrary to the Applicant, that R. 13.1(h) RoP requires the indication of the actions before other courts or authorities related to the patent in order for the Court to assess their relevance within the proceedings. The Court further notes that, in case of a possible *ex parte* proceedings, R. 206.4 RoP demands even higher requirements – any pending proceedings and/or any unsuccessful attempt in the past to obtain provisional measures in respect of the patent.
- 11** Noncompliance with providing the information required by R. 13.1(h) RoP is to be assessed by the Registry in accordance to R. 16.2, 16.4 as well as 208 RoP which in that event invites the claimant to correct the deficiencies within 14 days of service of such notification and informs the claimant that if the claimant fails to correct the deficiencies a decision by default may be given, in accordance with Rule 355 RoP. In any case, a decision by default would only be admissible after the applicant had the opportunity to correct it and failed to do so (R. 16.3 and 5 RoP). And, regarding the correction of deficiencies, there is no legal impediment preventing the compliance with R. 13.1(h) RoP by the Applicant on its own initiative as soon as possible, particularly when urgent procedures are to be considered.
- 12** Based on R. 16.2 RoP the Registry shall, as soon as practicable after the lodging of the Statement of claim, examine whether the requirements of Rules 13.1 (a) to (j), .2, 14 and 15.1 have been complied with. The assessment to be made by the Registry is formal: whether any information at all has been provided. The Registry has no obligation to verify that the information provided is correct.
- 13** The Court further acknowledges that there is no legal impediment for the noncompliance with the accuracy or the completeness of the information outside of the scope of the Registry's checking duties to be raised by the other party, as it was in this case, enabling the Court to take a position on the missing information. In this particular case, the applicant in response submitted by its own initiative a final overview with regard to the information (as Annex 1), eventually anticipating an order from the Court on that regard.
- 14** In conclusion, the Court finds that compliance with R. 13.1(h) RoP has been rightly checked by the Registry and furthermore that the Applicant has acted reasonably in supplying the missing information, even if later during the written phase and on its own initiative.
- 15** Regarding the request of the Defendants for the Applicant to provide copies of (a) all prior art relied on in all of the referenced proceedings, together with (b) pleadings, (c) statements of case and (d) expert reports from such proceedings, there is no legal basis, so the request is to be dismissed.
- 16** The Defendants did not provide legal basis for their request, other than R. 13.1(h) RoP. As this provision only requires information, and not any kind of annexes or evidence such as requested by the Defendants – differently from R. 13.1(f) and (j) RoP, where evidence must accompany and it is part of the information requested, R. 13.1(h) RoP *per se* does not provide legal ground for the required information.

- 17 Furthermore, when deciding, the Court has to balance the interests of both parties (see UPCA preamble). Taking that into account, the Court acknowledges that particularly in light of the information provided by the Applicant regarding other proceedings (see para. 6 above), for the Applicant to present the required pleadings, statements of case and expert reports in regard to all proceedings would represent a burden that does not seem compatible with the urgency of this preliminary injunction case in which the assessment of the Court is based on the balance of probabilities that it is more likely than not that the patent is valid and infringed (CoA, 26 February 2024, UPC\_CoA\_335/2023).

#### ORDER

The request of the defendants for the Applicant to be ordered to comply with R 13.1(h) RoP within 14 days of the Order and to be ordered to provide copies of (a) all prior art relied on in all of the referenced proceedings, together with (b) pleadings, (c) statements of case and (d) expert reports from such proceedings is dismissed.

#### INFORMATION ON THE APPEAL

Leave to appeal is granted, Rule 220.2 RoP.

An appeal against the present order may be lodged by any party who has been unsuccessful in whole or in part in its submissions within 15 days of notification of the order (Art. 73 (2) (b) Agreement on a Unified Patent Court, R. 220.2 RoP).

#### Presiding Judge Rute Lopes

**Rute Alexandra  
Da Silva Sabino  
Lopes** Assinado de forma digital  
por Rute Alexandra Da  
Silva Sabino Lopes  
Dados: 2024.08.16  
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#### Legally qualified judge Samuel Granata

**Samuel Rocco  
M Granata** Digitally signed by  
Samuel Rocco M Granata  
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#### Legally qualified judge Petri Rinkinen

*Petri Rinkinen* Hyväksyn  
dokumentin  
16.08.2024

*ORDER DETAILS*

Related Proceeding: 46326/2024

UPC number: UPC\_CFI\_317/2024

Main proceeding: 35572/2024 - Application for provisional measures