



Paris Local Division

UPC_CFI_358/2023
Procedural order
of the Court of First Instance of the Unified Patent Court,
handed down on 21/08/2024

APPLICANT

HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P
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77389, USA - 77389 - Harris County - US

Represented by
Grégoire
DESROUSSEAUX

DEFENDER

LAMA FRANCE
241 Rue du Companet
69140 - Rillieux-la-Pape - FR

Represented by Henri BOURGEOIS

PATENT IN SUIT

<i>Patent number</i>	<i>Owner</i>
EP2089230	HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P
EP1737669	HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P

JUDGE WHO RULES

Chairman and Judge-Rapporteur **Camille Lignieres**

LANGUAGE OF PROCEDURE: French

ORDER

Facts and procedure

An infringement action was initiated by HEWLETT-PACKARD DEVELOPMENT COMPANY (hereinafter "HPDC") against LAMA FRANCE (hereinafter "LAMA") before the Local Division of Paris on October 11, 2023.

On August 2, 2024, LAMA filed an application for dismissal registered in the CMS under no. 44722/2024 concerning the brief filed by HPDC on July 15, 2024 entitled "Reply brief to the reply brief, reply brief to the defence to an application to amend the patent".

The judge-rapporteur invited HPDC to produce its written observations on this request within 14 days, i.e. by 16 August 2024, which it did by email dated 15 August 2024, copying all the parties, due to technical difficulties in recording it in the CMS on that date.

In its procedural motion, LAMA requests that the rejoinder to HPDC's reply filed with the JUB on 15 July 2024 declare inadmissible the entire contents of the following sections:

- PRELIMINARY REMARKS FOR THE STATUS CONFERENCE (section 1)
- PREJUDICIAL AND LEGAL MATTERS (section 2)
- THE JUB'S COMPETENCE TO HEAR MATTERS PRECEDING ITS ENTRY INTO FORCE AND THE APPLICABLE BASIS (section 2.1)
- THE JUB'S JURISDICTION TO RULE ON COMPETITION LAW ISSUES (section 2.2)
- ASSESSMENT OF RIGHTS (section 2.3)
- DISCLOSURE (section 2.4)
- COUNTERFEIT (section 4)
- COUNTERFEIT ACTS (section 4.1)
- EVIDENCE (section 4.2: Assessment of the evidence; Assessment of the evidence relating to the infringement of clones; Assessment of the evidence relating to the infringement of IPNA cartridges; CSIC report; HPDC certificate; Compatibility tests)
- THE REQUEST FOR INFORMATION (section 5)
- CONFIRMATION OF HPDC APPLICATIONS (section 6)
- LIST OF DOCUMENTS (section 7).
- and to purely and simply remove from the proceedings all of HPDC's developments relating to the sections set out above, as well as all of HPDC's exhibits 85 to 99 and 101 to 101bis, and the case law JP19 to JP23 relating to these developments.

In support of its claim, LAMA argues that by applying Rules 12 and 29(e) of the Rules of Procedure (RoP), and by respecting the main stages of the written procedure at first instance provided for in the texts before the JUB, HPDC could not reply on the points relating to the infringement action, nor produce, without justification, documents and case law relating to acts of infringement.

In response, HPDC requested that LAMA's application be dismissed and, in the alternative, asked the judge-rapporteur to reject LAMA's Exhibit 49 and all the arguments based on that evidence to the effect that LAMA was not a manufacturer.

In support of its motion to dismiss, HPDC argues that it only responded to the new arguments raised by LAMA in its last submission of June 15, 2024 in order to provide the clarifications necessary for the JUB to properly understand the dispute, but did not formulate any new arguments. HPDC adds that in its submission of 15 June 2024 LAMA did not simply respond to the elements present in HPDC's reply, but that LAMA did not hesitate to bring new elements and evidence that could have been communicated earlier, which had repercussions on several of its arguments. HPDC concludes that if the judge-rapporteur were to set aside LAMA's response, then certain elements, and in particular LAMA's Exhibit 49, should also be set aside, failing which HPDC would be deprived of the opportunity to respond and defend itself.

HPDC also submits that a more flexible interpretation of the procedure should be adopted by the judge-rapporteur for a quality decision as required by the texts and in particular the principles of the preamble to the Rules of Procedure in points 2, 4 and 5 and in accordance with Articles 41, 42, 52 and 76.2 of the AJUB, which must take precedence over the procedural rules, in particular Rule 29(e).

Legal framework

R 12 RoP - Exchange of briefs (infringement action) :

" 1. The written procedure includes :

a) the filing of a statement of claim (by the claimant) [Rule 13] ;

b) the filing of a statement of defence (by the defendant) [Rules 23 and 24]; and, optionally

c) the filing of a reply to the statement of defence (by the claimant) (Rule 29(b));

and (d) the filing of a rejoinder to the statement of defence (by the defendant) (Rule 29(c)).

2. The statement of defence may include a counterclaim for a declaration of invalidity [rule 25, § 1].

3. If a counterclaim for nullity is filed :

a) the applicant and any proprietor who becomes a party under Rule 25(2) (hereinafter in this Rule 12 and Rules 29 to 32, "the proprietor") shall file a statement of defence to the counterclaim for invalidity [Rule 29(a)], which may include a request for amendment of the patent by the proprietor [Rule 30] ;

*b) the defendant may file a reply to the statement of defence to the counterclaim (Rule 29(d));
and*

c) the claimant and the proprietor may file a rejoinder to the statement of defence to the counterclaim (Rule 29(e)).

4. If an application to amend the patent is filed by the proprietor, the defendant shall file a defence to the application to amend the patent in the reply to the defence to the counterclaim, the proprietor may file a reply to the defence to the application to amend and the defendant may file a rejoinder to that reply [Rule 32].

5. The judge-rapporteur may authorise the exchange of other pleadings within time limits that he or she shall specify [rule 36].

R 29 RoP - Filing of a defence to the counterclaim for a declaration of invalidity, a reply to the defence and a rejoinder to the reply :

(e) Within one month of service of the reply to the statement of defence to the counterclaim, the claimant may file a rejoinder to the statement of defence with any reply to the statement of defence to an application for amendment of the patent under Rule 32, if applicable. The rejoinder to the statement of defence is limited to a response to the issues raised in the statement of defence.

R 32 RoP: Filing of the defence to the application to amend the patent, the reply to the defence and the rejoinder to the reply:

3. The proprietor may file a rejoinder to the statement of defence to the application for amendment of the patent within one month of service of the statement of defence and the defendant may file a rejoinder to the statement of defence within one month of service of the statement of defence. The rejoinder shall be confined to the issues raised in the reply.

Reasons for the order

It is clear from R 12 RoP that the Rules of Procedure divide the written procedure into several successive stages:

- a step 1 or workflow 1 relating to the infringement claim itself, comprising a set of 4 entries,
- then, a stream 2 of entries dedicated to the validity of the patent in the event of a counterclaim for invalidity of the patent in question,
- finally, a stream 3 specifically dedicated to the amendment of the patent in question if this is requested. In stream 1, the defendant to the infringement claim has the last word, in this case LAMA.

In Flow 2, the defendant to the attack on the validity of the patent in question has the last word, in this case HPDC.

Finally, for Flow 3, in the event of a request to amend the patent in question, the defendant to this request has the final say, in this case LAMA.

These flows, accompanied by strict deadlines, have been designed to ensure the most efficient and economical procedure possible before the JUB, in accordance with point 4 of the preamble.

In order to ensure that the principles of flexibility and adaptability and the general principle of justice and fairness set out in point 2 of the preamble are respected, R 36 of the Rules of Procedure allows the parties to request additional written submissions from the judge-rapporteur on a reasoned request.

Moreover, R 29(e) expressly states that the "rejoinder to the statement of defence is limited to a response to the questions raised in the statement of defence".

In the present case, in its submission of 15 July 2024, which is part of flows 2 and 3 of the written procedure, HPDC had to limit itself to responding to points 3 and 4 on the validity of the patent (including the proposed amendment) developed in LAMA's submission of 15 June 2024, and if HPDC considered that new arguments on the infringement claim justified an additional exchange of views, it was up to it to request this from the Judge-Rapporteur by means of a reasoned request on R 36 RDP.

The Court notes that only point 3 of HPDC's submission of 15 July 2024 deals with the validity of the patents at issue (pages 25 to 41), i.e. the subject concerned by flows 2 and 3.

Point 1 of the memorandum in question is devoted to the preparation of the status conference. However, the judge-rapporteur will provide the parties with prior information on this subject after 30 August, the date announced for the closure of the written procedure, and the question of the hearing of witnesses at the oral hearing will be dealt with in parallel in the following days, in the context of the separate procedural request submitted to the judge-rapporteur on 15 July 2024 by HPDC.

Point 2 concerns jurisdictional issues which have already been set out in the applicant's previous pleadings.

Point 4 relates to the infringement itself, i.e. it should be dealt with in Flow 1 exchanges, unless a reasoned request is made on R 36 RoP.

Point 5 on the request for information was dealt with in parallel as part of a separate procedural request on R 191 RoP by an order of the Judge-Rapporteur of 2 August 2024.

As for points 6 and 7 concerning the confirmation of claims and the list of documents, these are merely a restatement of the developments already set out in the earlier pleadings filed by HPDC.

With regard to HPDC's argument that its developments on the infringement action only serve to clarify its arguments in order to help the Court reach a better decision:

In this case, even if the pleadings of the two parties are clearly presented thanks to a precise table of contents and an orderly presentation of the arguments, full repetition of the arguments is superfluous (an explicit reference naming the relevant parties in the previous pleadings would suffice) and this repetition tends to increase the number of pages of the pleadings (to date more than 1,760 pages for all the pleadings on the merits filed in this case alone) which does not help the judges to give a decision of better quality as provided for in point 6 of the preamble to the Rules of Procedure, contrary to what HPDC claims in its reply of 16 August 2024.

Regarding HPDC's argument in response to a new argument put forward by LAMA in its submission of 15 June 2024 :

First of all, it is logical for LAMA to respond to HPDC's allegation concerning its role as a manufacturer of the allegedly infringing products, since it is a defendant in the infringement action. In addition, the criticism that exhibit 49 (its accountant's attestation on LAMA's business) was filed late and that this is contrary to the principle of contradiction is irrelevant in that said exhibit and the related explanations led HPDC to submit a procedural request for information on R 191 RoP on August 2, 2024. In the context of that procedural request, LAMA produced in its reply new documents providing information on the activity and status of its two subsidiaries and the question of their respective roles in the manufacture of the allegedly infringing cartridges, and HPDC's request for R 191 RoP was partially granted by the judge-rapporteur by ordering LAMA to produce certain documents requested by HPDC concerning LAMA's role in the infringing acts of which it is accused. There is therefore no reason to set aside LAMA's exhibit 49 and the explanations relating to that exhibit, as the principle of contradiction has been respected with regard to HPDC.

In the light of the above, the application to exclude the following as inadmissible under R 29(e) in HPDC's submission of 15 July 2024 should be granted, namely:

- all developments other than those relating to point 3 and HPDC exhibits 85 to 101a relating to point 3.

Subsequently, as admitted by LAMA (page 19 of its submission of August 16, 2024, which states that it had replied "on a precautionary basis" to the entire submission of July 15, 2024), it is logical, given the exclusion from the proceedings of part of HPDC's submission of July 15, 2024, that only the replies to point 3 of HPDC's submission should be admitted into the proceedings in LAMA's submission of August 16, 2024.

Consequently, for the same reasons of inadmissibility on the basis of R 32.3 RoP, which states that "the rejoinder shall be limited to the issues raised in the reply", LAMA had to limit its reply in its submission of 16 August 2024 to the question of the validity of the amended form of the patent as proposed by HPDC. All developments other than those in points 3 and 4, as well as the exhibits relating to these points, i.e. LAMA's new exhibits 59 to 64, will therefore be excluded from the proceedings.

For these reasons,

The Judge-Rapporteur orders that the following items be excluded from the proceedings as inadmissible on the basis of rules 12, 29 (e) and 32.3 of the Rules of Procedure:

-in the brief submitted by HEWLETT-PACKARD DEVELOPMENT COMPANY on 15 July 2024:

- all developments except those in point 3, as well as HPDC exhibits 85 to 99 and 101 to 101bis and case law JP19 to JP23 relating to point 3;

-in the brief submitted by LAMA France on 16 August 2024 :

- all developments other than those in points 3 and 4, as well as the exhibits relating to these points, i.e. the new LAMA exhibits 59 to 64.

This order may be reviewed by the Chamber in accordance with rule 333 of the Rules of Procedure.

Rendered in Paris on 21 August 2024.

Camille Lignières, Judge-Rapporteur

 Date :
2024.08.21
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DETAILS OF THE ORDER

Order n° ORD_47694/2024 in ACTION N°: ACT_578697/2023 UPC n° :
UPC_CFI_358/2023

Type of action: Infringement action

Procedural request in Application no. 44722/2024