



Local division Mannheim

UPC_CFI_219/2023

UPC_CFI_223/2023

Order

of the Court of First Instance of the Unified Patent Court, Mannheim

Local Division

issued on 09.09.2024

concerning EP 2 568 724

concerning

App_45837/2024

***(Application pursuant to R.333 RoP to
App_42646/2024_UPC_CFI_219/2023)***

concerning EP 2 207 270

concerning

App_45833/2024

***(Application pursuant to R.333 RoP to
App_42650/2024_UPC_CFI_223/2023)***

Plaintiff:

Panasonic Holdings Corporation - 1006, Oaza Kadoma, Kadoma-Shi - 571-8501 - Osaka - JP

defendant:

Xiaomi Technology Germany GmbH

- Niederkasseler Lohweg 175 - 40547 - Düsseldorf - DE

Xiaomi Technology France S.A.S.

- 93 rue Nationale Immeuble Australia - 92100 -
Boulogne-Billancourt - FR

Xiaomi Technology Italy S.R.L.

- Viale Edoardo Jenner 53 - 20158 - Milan - IT

Xiaomi Technology Netherlands B.V.

- Prinses Beatrixlaan 582 - 2595BM - The Hague -
NL

Odiporo GmbH

- Formerweg 9 - 47877 - Willich - DE

Shamrock Mobile GmbH

- Siemensring 44H - 47877 - Willich - DE

PATENT IN DISPUTE:

European Patent No. EP 2 568 724 / EP 2 207 270 SPRUCHKÖRPER:

Mannheim local division

JUDGES:

This Order was issued with the participation of the presiding judge and judge-rapporteur in proceedings UPC_CFI_219/2023 Prof. Dr Tochtermann, the legally qualified judge and judge-rapporteur in proceedings UPC_CFI_223/2023 Böttcher, the legally qualified judge Edger Brinkman and the technically qualified judge Leibner.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Review pursuant to R. 333 RoP regarding an extension of the deadline

FACTS OF THE CASE

With substantively identical petitions for review in all three parallel proceedings concerning the patents EP 270, EP 274 and EP 315, the defendants are each challenging the judge-rapporteur's Order, by which an extension of the time limit for the Reply to the plaintiff's Reply "Part II - non-technical part" requested by application of 19 July 2024 was only partially granted in each case (ORD_42727/2024, ORD_42728/2024, ORD_42730/2024). Previously, the time limit had already been extended in favour of the defendant - largely with the consent of the opposing party - but most recently only for the Reply to the plaintiff's Reply "Part II - non-technical part".

The hearing dates for EP 724 have been set for 7 to 10 October 2024, for EP 270 for 10 and 11 December 2024 and for EP 315 for 4 and 5 February 2025.

The plaintiff initially submitted its Reply in all proceedings with total redactions, which are located in parts of the Reply that are only partially legible even for the court and concern the FRAND aspect of the dispute. In response to various self-directed

In response to the requests for submission, the plaintiff then submitted further documents and attachments, which it labelled "Supplement Reply". The documents now contain extensive, stratified submissions on the settlement licences, which the plaintiff refers to and has submitted. The plaintiff has submitted accompanying applications under Rule 262A RoP for each of these consecutively submitted further written submissions. In this respect, the court issued interim secrecy orders and granted an opportunity to comment on the details of the secrecy order. In addition, the defendants were given access to the unedited versions of the last version of the documents referred to by the plaintiff as "Replies" - partly via release by the law firm in the CMS, partly outside the CMS due to technical problems with the CMS or misapplications whose origin could not yet be clarified. According to their submission, the defendants and their legal representatives received access to the unedited final versions for the first time on 12 July 2024 in proceedings UPC_CFI_219/2023 and in the parallel proceedings UPC_CFI_218/2023 and UPC_CFI_223/2023 on 15 and 16 July 2024, respectively, not limited to the purpose of commenting on the application for secrecy protection.

The Reply on the technical aspects of the case as well as the defence to the revocation counterclaim and the statements on the application to amend the patent do not contain any redactions. The plaintiff's applications for protection of secrecy did not relate to the submission on the technical aspects on the infringement and validity side.

The defendants are of the opinion that they are entitled to the full two-month period for a reply from 12 July 2024 in order to safeguard their right to be heard, which is why the deadline should be extended at least until 12 September 2024 as requested. The plaintiff opposed the extension of the deadline. The judge-rapporteur extended the deadline, which had previously expired on 14 August 2024, until 28 August 2024, rejecting the further application.

The defendants oppose this with their application for review pursuant to R. 333 RoP, repeating and expanding on their arguments. The plaintiff continues to oppose an extension of the deadline.

The defendants in all three parallel proceedings are unanimous in their request:

1. to have the judge-rapporteur's Order of 25 July 2024 reviewed by the entire panel (Rule 333.1 RoP UPC),

in the alternative

2. allow the appeal against that decision of the panel on the application for an extension of time; and
3. to set the defendants an additional deadline of 12 September 2024 to supplement their Reply to the plaintiff's "Reply Part II - non-technical part".

REASONS FOR THE DECISION

The admissible application is unsuccessful on the merits. The panel exercises the power to order the extension of the time limit in the same way as the judge-rapporteur.

1. The panel initially shares the judge-rapporteur's view that, in the case of confidentiality protection pursuant to R. 262A RoP, a time limit for commenting on the content does not begin to run only from the time at which the natural persons entitled to access the opposing party called to comment and their authorised representatives have received access to an unedited version of the document containing the confidential information for the purpose of commenting on the content (aA Munich Local Division, Order of 4 July 2024, UPC_CFI_220/2023). Rather, the delay in receipt must be taken into account by means of an appropriate extension of the deadline (see Düsseldorf local division, Order of 4 April 2024, UPC_CFI_355/2023; Court of Appeal, Order of 13 October 2023, UPC_CoA_320/2023 on the extension of the deadline for filing a statement of defence in the event of late submission of the annexes to the statement of claim).

2. The judge-rapporteur there has already set out the relevant considerations for the rejection of the further request for an extension of the time limit in the Order of 13 June 2024 in proceedings 219/2023 (ORD_35648/2024) concerning an earlier extension of the time limit. The panel agrees with this.

Accordingly, it is not necessary in the present case, even taking into account the further submissions, to extend the time limit for Reply to the Reply "Part II - non-technical part" to such an extent that the defendant is entitled to the full Reply period of two months from the date from which the natural persons authorised to access the last unedited version of the Reply "Part II - non-technical part" and the defendant's legal representatives have access to the last unedited version of the Reply "Part II - non-technical part", from the date on which the natural persons authorised to access the Reply "Part II - non-technical part" on behalf of the defendant under the secrecy protection orders and the defendant's legal representatives have access to the last unedited version of the Reply "Part II - non-technical part" for the purpose of commenting on its content. It is true that the extension of the deadline must in principle compensate for and thus correspond to the period in which the party concerned does not have full access to the material in dispute for legal defence or prosecution on the merits (see Court of Appeal, Order of 13 October 2023, UPC_CoA_320/2023 on the extension of the time limit for filing a statement of defence in the event of late submission of the annexes to the statement of claim; Düsseldorf local division, Order of 4 April 2024, UPC_CFI_355/2023). In this case, the plaintiff as the opposing party also bears the burden of proof for such circumstances that justify a deviation from the principle. However, a transfer of these principles to the case in dispute does not justify an extension of the time limit beyond the scope granted. It can therefore be left open whether these principles also apply if, as in the case in dispute, a submission of settlement licences and unredacted submissions in this regard only takes place after the party itself has issued submission orders, or whether in such a situation, as the plaintiff believes, the statutory deadlines for written submissions do not apply from the outset, but instead only a deadline originally set by the court applies, which is to be set separately for the opposing party's comments on the settlement licences and the submissions made in this regard.

In the event of a dispute, it must be taken into account that the two-month period under R. 29 (d) RoP applies in total to the Reply to the Reply in the infringement dispute and the Reply to the statement of defence to the nullity counterclaim. This extension of one month compared to infringement proceedings without a revocation counterclaim takes account of the fact that the

examination of questions of both infringement and legal validity takes more time on the one hand and, on the other hand, cannot normally be carried out separately from each other.

can. The plaintiff's submissions on the technical aspects of infringement and validity in its Reply and defence to the action for annulment of

22 March 2024 do not contain any redactions. Rather, these statements were immediately accessible to the defendant. As a result of deadline extensions, the defendants had between three and four months, and thus significantly more than two months, depending on the proceedings, to submit their defence, which could be made independently of the redacted confidential information in the Reply "Part II - non-technical part".

Against this background, it is neither necessary nor justified to grant the defendants the full deadline of two months from receipt of the unedited last version of the Reply "Part II - non-technical part" solely for the outstanding duplicate on the FRAND aspects. Rather, the extension of the deadline granted in this respect until 28 August 2024 is sufficient. Between 12 and 15/16 July 2024 and 28 August 2024, the defendants have almost seven and more than six weeks, respectively, without having to additionally prepare the complete duplicate in the infringement proceedings and the Reply in the nullity counterclaim proceedings during this period. In the UPC_CFI_219/2023 and 223/2024 proceedings, the duplicates on the technical aspects of the infringement proceedings and the defences in the nullity counterclaim were already submitted before 12 July 2024, in the UPC_CFI_218/2023 proceedings on 22 July 2024, i.e. only 10 days after 12 July 2024. By 12 July 2024, however, the defendants in the latter proceedings had more than three and a half months since the Reply and the plaintiff's defence to the action for annulment to deal solely with the technical aspects of the dispute. In doing so, they had to seriously expect and take into account in their time planning that the unedited version of the Reply "Part II - non-technical part" would be available before the expiry of the time limit granted in this respect on 22 July 2024 and that they would have to deal with it as a matter of priority from that date, if necessary. This means that, viewed in the light of day, the defendants in all three parallel proceedings have almost seven weeks just to prepare the duplicates of Reply "Part II - non-technical part". This is more than the period of one month that would have been available to respond to the infringement action with regard to the infringement issue and the FRAND objection if there had been no revocation counterclaim.

Even in such a situation, it may be necessary, depending on the circumstances of the individual case, to extend the deadline for the rejoinder on the non-technical aspects to such an extent that two full months remain for this alone. However, the defendants do not provide sufficient circumstances as to why they would not be able to evaluate the content of the Reply "Part II - non-technical part" and the duplicate thereto by 28 August 2024. The defendants are naturally aware of the course of the licence negotiations. The FRAND dispute between the parties is already known in part to the relevant natural persons on the defendants' side, although possibly not yet with regard to the evaluation of the settlement licence agreements carried out in the Reply here, as the defendants admit. However, the defendants' natural persons involved were already aware of the relevant three settlement licence agreements from other national legal disputes before 12 July 2024. This means that the effort required to analyse the licensed portfolio patents and the licensed standards does not have to be repeated. The fact that external experts for the

unpacking of licence agreements does not in itself justify the extent of the requested extension of time. Since the defendants had to expect this, they were already able to organise the use of external experts for the period after receipt of the unedited versions of the Reply. The defendants' own analyses for the evaluation of the licensed standards and portfolio patents from parallel national proceedings are not subject to confidentiality in the absence of any evidence to the contrary. It is therefore not apparent why experts would have to re-evaluate the licensed standards and portfolio patents. It must also be taken into account that, due to the parallel national proceedings, the defendants do not have to deal with the aspects of Reply "Part II - non-technical part" without prior knowledge and experience, even with regard to the analysis of licence agreements.

It is true that, as in the case of the subsequent submission of annexes to the statement of claim, the plaintiff may bear the burden of proof that an undiminished time limit for filing is exceptionally not necessary. In the case in dispute, however, the deadline for the duplicate was already extended to a considerable extent. In this situation, it is incumbent on the defendants to show circumstances from their sphere that justify a deadline of two months for the Reply "Part II - non-technical part" alone and that are known only to them.

The fact that the plaintiff in a parallel national legal dispute may claim a period of nine months for the evaluation of primarily its own licence agreements cannot replace a concrete and sufficient explanation as to why the time available to the defendant in the present proceedings is not sufficient for a Reply to the Reply "Part II - non-technical part". Apart from this, it is not apparent how the pending time-consuming evaluation that the plaintiff may currently be carrying out for the other proceedings should have found full receipt in the Reply in the proceedings here.

The judge-rapporteur rightly points out in the Order of 13 June 2024 regarding an earlier extension of time. June 2024 concerning an earlier extension of time in proceedings UPC_CFI_219/2023, the rapporteur also rightly points out that, when assessing that extension of time, account had to be taken of the fact that the defendants had already been aware, when applying for the previous extension of time, that a submission order had been issued by the plaintiff against itself with regard to two settlement licence agreements and that the actual submission and presentation in this regard was therefore to be seriously expected, and that they had nevertheless only applied for an extension of time until 19 June 2024 within the framework of this previous extension of time and had apparently considered this extension to be sufficient. June 2024 and apparently considered this to be sufficient. Even if this is no longer decisive, this also speaks - at least without further concrete explanation as to why the defendants have now come to a fundamentally different assessment of the period of time required from their point of view to deal with the (now three instead of two) settlement licence agreements - against the scope of the extension of time requested in the present case.

In proceedings CFI_UPCI_219/2023, a further extension of the deadline would also jeopardise the hearing date. In the event of a further extension of the deadline, the panel, including the technically qualified judge, would no longer have adequate time to prepare.

Should this be relevant, the panel further agrees with the judge-rapporteur to the extent that an extension of the time limit is possible solely with regard to the aspects of the FRAND objection and is not contrary to R. 29 (d) RoP (see Order of 13 June 2024, CFI_UPCI_219/2023). In particular, these non-technical aspects are independent of the technical aspects of the infringement and validity issue and do not require a uniform time limit.

3. The further application, in the alternative to the request for review, to set an additional deadline of 12 September 2024 to supplement the plaintiff's "Reply Part II - non-technical part", must also not be granted for the reasons given.

The panel can decide on this application as intended by the defendants. The power to decide follows as an annex to the power to review, because setting a deadline for supplementing the duplicate at least partially remedies the defendant's request on the merits. Apart from this, the court can also amend and revoke any of its procedural Orders of its own motion outside of review proceedings (see R. 335 RoP). There are no indications that the ruling body would have to wait until the procedural stage of the oral hearing to do so. Such a requirement would also contradict the principle of efficient conduct of proceedings. The setting of a deadline for a supplement to the duplicate is in fact an amendment to the final Order for the last extension of the duplicate deadline.

4. The appeal is not authorised.

With this Order, the panel does not deviate from the cited orders of the Court of Appeal and the Düsseldorf local division. According to these Orders, the extension of the time limit does not have to guarantee the full time limit without exception. Accordingly, after weighing up the circumstances of the individual case, the panel comes to the conclusion that the extension granted is sufficient.

Although the panel takes a different view than the Munich local division in the Order of 4 July 2024 with regard to the start of the running of time limits, the Munich local division deviates from the cited Order of the Düsseldorf local division and the principles established by the Court of Appeal in the cited Order for the case of subsequent submission of annexes to the application. This does not give rise to any reason to allow the appeal for the present Order.

ORDER

1. The defendant's application of 9 August 2024 for review by the panel of the judge-rapporteur's Order pursuant to R. 262A RoP of 25 July 2024 is dismissed.
2. The defendants' application of 9 August 2024 to set them an additional deadline of 12 September 2024 to supplement their Reply to the plaintiff's "Reply Part II - non-technical part" is rejected.

NAMES AND SIGNATURES

Issued in Mannheim on 9 September 2024

Peter Michael

Dr Tochtermann

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Prof Dr Peter Tochtermann
Presiding judge

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