

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 9 October 2024
concerning an application for a discretionary review (R.220.3 RoP)

HEADNOTE:

A party who wants to appeal an order in accordance with R.220.3 RoP must, unless leave to appeal has already been granted in the order, request the Court of First Instance to grant leave to appeal (R.220.2 RoP). Only if such a request has been denied is it possible to request a discretionary review.

APPLICANT AND CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE CFI

Suinno Mobile & AI Technologies Licensing Oy, Helsinki, Finland (hereinafter Suinno)
represented by Mikko Väänänen, European Patent Attorney

RESPONDENT AND DEFENDANT IN THE MAIN PROCEEDINGS BEFORE THE CFI

Microsoft Corporation, Washington, US (hereinafter Microsoft)
represented by Prof. Tilmann Müller-Stoy and Nadine Westermeyer, Attorneys at law (Bardehle Pagenberg)

PATENT IN SUIT

EP 2 671 173

LANGUAGE OF THE CASE

English

DECIDING JUDGE

This order was issued by Ingeborg Simonsson, Standing judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- Paris Central Division
- Date: 30 September 2024 (signed on 27 September 2024) and subsequent order of 1 October 2024 with notification pursuant to R.158.4 RoP
- App_ 42517/2024, UPC_CFI_164/2024; ORD_ 45914/2024

SUMMARY OF THE FACTS

1. By the impugned order of the Court of First Instance, the Paris Central Division granted Microsoft's request for security for costs, ordered Suinno to provide security for costs and, at the same time, declared a request for security for costs filed by Suinno inadmissible.
2. There was no indication in the order that an appeal may be lodged in accordance with Art.73 UPCA and R.220.2 RoP (see R.158.3 RoP).
3. On 1 October 2024, the judge-rapporteur informed Suinno that if it failed to provide adequate security within the time stated, a decision by default may be given, in accordance with R.355 RoP.
4. The standing judge has consulted the file of the proceedings of the Court of First Instance and concluded that Suinno has not requested the Paris Central Division to grant leave to appeal.
5. On 7 October 2024 Suinno lodged a request for discretionary review of the impugned order with the Court of Appeal.

PARTY REQUESTS

6. Suinno requests that leave to appeal be granted and that the order be annulled. Auxiliary, Suinno requests the Court of Appeal to revise the impugned order and the value of the case, if necessary, and provide a time limit for payment that is after both appeals in cases APL_53968/2024, UPC_CoA_570/2024 and APL_53716/2024, UPC_CoA_563/2024 have been decided. The security should then be set at EUR 56 000 or EUR 100 000.

PARTY SUBMISSIONS

7. Suinno argues, as far as relevant here, as follows.
8. Rule 158.3 RoP requires the impugned order to indicate that an appeal may be lodged in accordance with Art.73 UPCA and R220.2 RoP. The impugned order does not indicate this and should be annulled prima facie for this reason.
9. The impugned order has been issued too early since the value of the case has not been decided yet and the Court does not know whether the case is even admissible. Furthermore, the amount of security set by the Paris Central Division is too high.
10. The impugned order contradicts the UPCA and the intent of the Contracting Member States. No security for costs is warranted by the UPCA.

REASONS

11. The request for discretionary review is inadmissible.
12. A discretionary review by the Court of Appeal pursuant to R.220.3 RoP is only admissible, if leave to appeal against the impugned order is required (R.220.2 RoP) and the Court of First Instance refused to

grant leave within 15 days of the order (R.220.3 RoP) (see CoA order of the Standing judge on 21 August 2024, UPC_CoA_454/2024, APL_44552/2024, para 21).

13. As laid down in R.220.2 RoP, orders other than those referred to in R.220.1 RoP require leave to appeal if, as here, they are not subject of an appeal together with the appeal against the decision.
14. While it is clear from R.158.3 RoP that an order for security shall indicate that an appeal may be lodged in accordance with Art.73 UPCA and R.220.2 RoP, such an indication, when provided, does not mean that leave to appeal has been granted. The reference to Art.73 UPCA means, as far as is relevant here, that an appeal against an order of the Court of First Instance may be brought before the Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions together with the appeal against the (main) decision, or where the Court grants leave to appeal, within 15 days of the notification of the Court's decision to that effect (Art.73(2)(b)(i-ii) UPCA). The reference to R.220.2 RoP means that the order may either be subject of an appeal with the leave of the Court of First Instance, or in the event of a refusal of the Court of First Instance to grant leave to appeal, the Court of Appeal allows the request for a discretionary review (R.220.3 and R.220.4 RoP).
15. The decision on leave can already be given in the (impugned) order itself, or – if that is not the case – afterwards by a separate decision upon a request for leave, which decision must be issued within 15 days of the impugned order, cf R.220.3 RoP (see CoA order on 11 April 2024, UPC_CoA_79/2024, APL_9578/2024, paras 15 and 17).
16. There is no consequence stated in R.158 RoP if the Court of First Instance fails to provide the indication referring to Art. 73 UPCA and R.220.2 RoP as set out in R.158.3 RoP. Clearly, the consequence of such a failure cannot be that the unsuccessful party is deprived of its right to request leave to appeal. Neither can the absence be understood as an implied leave to appeal. Instead, the unsuccessful party can still ask the Court of First Instance to grant leave to appeal by a separate decision as set out in para 16 above.
17. It follows that the impugned order does not contain a decision granting leave to appeal. Indeed, if there had been such a decision, there would have been no need for Suinno to request the Court of Appeal for a discretionary review.
18. A party who wants to appeal an order in accordance with R.220.3 RoP must, unless leave to appeal has already been granted in the order, request the Court of First Instance to grant leave to appeal (R.220.2 RoP). Only if such a request has been denied is it possible to request a discretionary review.
19. As set out in paragraph 4 above, Suinno has not requested the Court of First Instance to grant leave to appeal. Suinno's request for discretionary review is by consequence inadmissible.

ORDER

The request for discretionary review is dismissed.

Issued on 9 October 2024

Ingeborg Simonsson
Standing Judge