



Local Division Munich  
UPC\_CFI\_54/2024

**Preliminary Order**  
**of the Court of First Instance of the Unified Patent Court**  
**delivered on *12 November 2024***

**Claimant**

- 1) **Headwater Research LLC**  
(Main proceeding party - Claimant) - 110 North  
College Ave., Suite 1116 - 75702 - Tyler, Texas - US

Represented by Dr. Thomas Adam (Peterreins Schley)

**Defendants**

- 1) **Samsung Electronics GmbH**  
Am Kronberger Hang 6 - 65824 - Schwalbach – DE
- 2) **Samsung Electronics GmbH**  
Am Kronberger Hang 6 - 65824 - Schwalbach – DE
- 3) **Samsung Electronics Co. Ltd.**  
129, Samsung-ro - 16677 - Yeongtong-gu, Suwon-si, Gyeonggi-do - KR

1) - 3) Represented by Denise Benz (Allen Overy Shearman Sterling)

**Third party**

- 1) **Qualcomm Inc.**  
5775 Morehouse Drive, San Diego, California, CA 92121, USA  
c/o CSC - LAWYERS INCORPORATING SERVICE, 2710 Gateway Oaks Drive,  
Sacramento, CA, USA

Represented by Dr. Jan Bösing (Bardehle Pagenberg)

**PATENT AT ISSUE**

<i>Patent no.</i>	<i>Proprietor/s</i>
<b>EP2391947</b>	Headwater Research LLC, Headwater Research LLC

**DECIDING JUDGE**

**COMPOSITION OF PANEL (1) – FULL PANEL**

Presiding judge and Judge-rapporteur	<b>Matthias Zigann</b>
Legally qualified judge	<b>Tobias Pichlmaier</b>
Legally qualified judge	<b>Andras Kupecz</b>
Technically qualified judge	<b>Erice Augarde</b>

This order was made by Presiding Judge Matthias Zigann, acting as Judge-rapporteur.

**LANGUAGE OF PROCEEDINGS:** English

**SUBJECT-MATTER OF THE PROCEEDINGS**

R. 190 request.

**STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES**

Defendants' requests:

In App\_40276/2024 against Qualcomm Inc.:

*I. to order Respondent*

*1. pursuant to Art. 59 (1) UPCA, R. 190 RoP, to produce a copy of the patent assignment agreement of December 18, 2006 between [REDACTED] and Qualcomm Inc in electronic form;*

2. to produce the evidence according to 1. within seven working days;
3. pursuant to Art. 82 (4) UPCA to pay a severe penalty payment to be determined within the discretion of the Court for each case of violation of the order;

II. In addition, pursuant to R. 262.2, we request to classify the patent assignment agreement in I.1. as well as its content as confidential;

III. In the event that this submission is discussed at the interim hearing and/or the oral hearing, we request

1. to exclude the public for this part of the interim hearing and/or oral proceedings in accordance with Art. 45 UPCA, R. 115 RoP as far as information subject to confidentiality pursuant to Section II is discussed;

2. to oblige persons present at the interim hearing and/or oral proceedings, including the party representatives, their authorized representatives and the patent attorneys appointed to participate in the legal dispute, to keep confidential from third parties any facts relating to the statements referred to in Section II or which come to their knowledge for the first time at the interim hearing and/or oral proceedings, and to use them only for the purpose of conducting the proceedings in the present proceedings;

IV. We request to exclude the public for part of the pronouncement of the grounds for the judgement, as far as information subject to confidentiality pursuant to Section II is discussed;

V. We request to exclude the information subject to confidentiality pursuant to Section II from inspection by third parties (Art. 58 UPCA, R. 262.1 b), 262.2 RoP);

VI. We request to redact all confidential information according to Section II prior to the publication of the reasons of any judgement or other announcements (R. 262.1 a), 262.2 RoP).

In App\_40272/2024; App\_40273/2024, App\_40275/2024 against the Claimant:

I. to order Respondent

1. pursuant to Art. 59 (1) UPCA, R. 190 RoP, to produce a copy of the patent assignment agreement of December 18, 2006 between [REDACTED] and Qualcomm Inc in electronic form;

2. to produce the evidence according to 1. within seven working days;

3. pursuant to R. 190.4 lit (b) RoP, in case that the evidence is not produced in accordance with the order of the Court, that such failure be taken into account when deciding on the issue in question and that the content of the agreement according to 1. as alleged by Applicants in the main proceedings (including the Counterclaim for revocation) shall be treated as correct;

4. pursuant to Art. 82 (4) UPCA to pay a severe penalty payment to be determined within the discretion of the Court for each case of violation of the order;

*II. In addition, pursuant to R. 262.2 we request to classify the patent assignment agreement in 1 as well as its content as confidential;*

*III. In the event that this submission is discussed at the interim hearing and/or the oral hearing, we request*

*1. to exclude the public for this part of the interim hearing and/or oral proceedings in accordance with Art. 45 UPCA, R. 115 RoP as far as information subject to confidentiality pursuant to Section II is discussed;*

*2. to oblige persons present at the interim hearing and/or oral proceedings, including the party representatives, their authorized representatives and the patent attorneys appointed to participate in the legal dispute, to keep confidential from third parties any facts relating to the statements referred to in Section II or which come to their knowledge for the first time at the interim hearing and/or oral proceedings, and to use them only for the purpose of conducting the proceedings in the present proceedings;*

*IV. We request to exclude the public for part of the pronouncement of the grounds for the judgement, as far as information subject to confidentiality pursuant to Section II is discussed;*

*V. We request to exclude the information subject to confidentiality pursuant to Section II from inspection by third parties (Art. 58 UPCA, R. 262.1 b), 262.2 RoP);*

*VI. We request to redact all confidential information according to Section II prior to the publication of the reasons of any judgement or other announcements (R. 262.1 a), 262.2 RoP).*

Claimant requests:

*On behalf of the Respondent/Claimant we request that the Application for an order to produce evidence dated 5 July 2024 be dismissed.*

*As far as the request vis-à-vis Qualcomm is concerned, as things stand the PAA\_2006 is not suitable as evidence for Defendants' allegations and, irrespective of Qualcomm's readiness (under certain circumstances) to produce the document, could and should not be ordered to do so. Should the Court decide otherwise, auxiliary we request that [REDACTED] – who is not a party in these proceedings – be invited to comment or, auxiliary, Claimant be heard with regard to any confidentiality measures to be taken concerning the PAA\_2006 prior to filing.*

Qualcomm requests:

*Qualcomm appreciates the option provided by Rule 190 RoP to request the production of certain specifically identified documents from other parties as well as from third parties. Against this background, Qualcomm does not object to Defendants' request, but will comply with a corresponding order if issued by the Court. When producing the requested document, Qualcomm will file requests for protective orders in parallel.*

#### SUMMARY OF FACTS

Claimant has sued Defendants for infringement of EP 2 391 947.

Defendants seek the production of documents pursuant to R. 190 RoP to prove that plaintiff is not the (sole) proprietor of the invention claimed in the patent in suit. Defendants have reason to believe that Plaintiff is not a (sole) proprietor, and therefore Plaintiff is not entitled to commence infringement proceedings. Furthermore, the lack of (sole) proprietorship in the patent in suit results in the ground for invalidity according to Art. 138(1)(e) EPC, so that the patent in suit must be revoked.

#### GROUNDS FOR THE ORDER

As Qualcomm has stated that it does not oppose Defendants' request but will comply with a corresponding order if issued by the Court the production of a copy of the patent assignment agreement of December 18, 2006 between [REDACTED] and Qualcomm Inc in electronic form is to be ordered. A refusal in these circumstances would only be justified if the production of this document would not be useful at all in these proceedings. This is not the case. Although a US court has found that the Claimant has standing, that decision is not final and, even if it were final, it would not be binding on this Court. Confidentiality concerns can be addressed in the course of the production of the electronic copy, if such a request is made.

#### ORDER

1. Qualcomm is ordered to produce a copy of the patent assignment agreement of December 18, 2006 between [REDACTED] and Qualcomm Inc in electronic form within seven days.
2. Non-compliance to this order may result in a penalty payment ordered by this court of up to € 5000,00 per day of non-compliance.
3. Confidentiality issues will be addressed in response to a respective application in the course of the production of the document.

#### INSTRUCTIONS TO THE PARTIES

The parallel application App\_40275/2024 against the Claimant will be obsolete after the production of the document. Defendants are invited to withdraw this application and the two further parallel applications accordingly.

#### INFORMATION ABOUT REVIEW BY PANEL

Any party may request that this Order be referred to the panel for a review pursuant to R. 333 RoP. Pending review, the Order shall be effective (R. 102.2 RoP)

ORDER DETAILS

Order no. ORD\_49223/2024 in ACTION NUMBER: ACT\_7603/2024

UPC number: UPC\_CFI\_54/2024

Action type: Infringement Action

Related proceeding no. Application No.: 40276/2024

Application Type: Application for an Order to produce evidence (RoP190)

Dr. Zigann

Presiding Judge and Juge-rapporteur