



Local Division Munich

UPC_CFI_508/2023
ACT_597609/2023
App_64018/2024

Order **of the Court of First Instance of the Unified Patent Court** **Local Division Munich** **issued on December 9th 2024**

Headnotes:

1. Rule 275.1 RoP also applies if a foreign authority refuses formal service according to the Hague Service Convention seriously and definitively. A serious refusal of service is also given if a request for service is not processed for more than six months without any apparent reason.
2. To be considered as an alternative method of service (Rule 275.1 RoP), the method must be factually and legally possible.
3. According to Rule 275.2 RoP, an unsuccessful attempt to serve documents by means of Rule 274.1 a) (ii) RoP usually is not acceptable as good service. Only if an attempt of service under Rule 274 RoP has failed and service by an alternative method or at an alternative place is neither possible nor reasonable, the court may order that an unsuccessful attempt of service under Rule 274 RoP is good service.

APPLICANT

air up group GmbH, Friedenstraße 22a, 81671 Munich, Germany

represented by: Jan Boesing

DEFENDANT

Guangzhou Aiyun Yanwu Technology Co., Ltd., A09-3, No.9, Chentian
Dashigang S.Road, Huangshi Street, Baiyun District, Guangshou, China

PATENT AT ISSUE

EP 3 655 341

PANEL/DIVISION

Panel 1 of the Local Division Munich

DECIDING JUDGE/S

This order has been issued by the judge-rapporteur Tobias Pichlmaier

LANGUAGE OF THE PROCEEDINGS

English

SUBJECT-MATTER OF THE PROCEEDINGS

Application for preliminary measures; service

SUMMARY OF FACTS

The proceedings concern an application for preliminary measures. The defendant is domiciled in China. The applicant has not requested for an ex-parte proceeding. Therefore, the service of the application at the defendant's domicile was arranged.

The **history of service** is as follows:

- 27/12/2023 Applicant files application for interim measures and pays court fees
- 04/01/2024 Court's registry starts preparations for the formal service of the application in China according to Article 5 (1) of the Hague Service Convention
- 02/02/2024 In order to speed up the service, Applicant at the suggestion of the Court's registry by email asks Mr Andy Long whether informal service of the application by email would be accepted on a voluntary basis (Article 5 (2) of the Hague Service Convention); due to the pre-litigation correspondence with Mr Andy Long this approach was promising; the email remains unanswered
- 21/02/2024 In order to speed up the service, Court's registry asks Mr Andy Long by email to indicate whether service of the application by email is accepted on a voluntary basis; also this email remains unanswered
- 07/03/2024 Court's registry requests for the required copies and translations for formal service in China
- 02/05/2024 Submission of the required copies and translations by the applicant after there were considerable difficulties in having all the documents translated in a short time
- 24/05/2024 Posting of the service documents by registry requiring the defendant to lodge an Objection to the Application for provisional measures within a time limit of two weeks from the service of the documents
- 11/06/2024 Receipt of the service documents by the competent authority in China according to the tracking number

- 04/07/2024 Court's registry sends an inquiry to the competent Chinese authority regarding the status of service; no answer from the Chinese authority received
- 11/07/2024 Court's registry informs Applicant about the date of service of the application to the Chinese authorities (11/06/2024).
- 23/10/2024 Court's registry sends another inquiry to the competent Chinese authority regarding the status of service
- 24/10/2024 Request from the competent Chinese authority to send the service documents for these proceedings again by email
- 08/11/2024 Court's registry sends the service documents combined with another request for further feedback on the status of service
- 18/11/2024 Information from the competent Chinese authority that the service documents have been submitted to the Supreme Court for further process

REQUEST

Applicant requests the court to find

- I. The steps already taken to bring the request for preliminary injunction in the proceedings ACT_597609/2023 to the attention of Defendant constitute good service pursuant to R. 275.2 RoP. Service shall be deemed effective as of the date of this order.
- II. The order according to item I. is published on the Court's website with the names of the parties and the file number, so that the order can be found under the decisions published on the website.

GROUNDS FOR THE ORDER

1. Service requirements

Where an application is made under Article 62 UPCA, it is necessary to serve the application to the defendant to give him the possibility to lodge an objection to the application for provisional measures within a time limit to be specified. The requirement of service arises from Rule 209.1, 270.2 RoP and Article 32 (1) (c) UPCA.

Service of the application may only be waived if the Court orders provisional measures without the defendant having been heard (Rule 212.1 RoP); no such application has been made in the present case.

2. Attempt of service in accordance with Rule 274.1 RoP

If the defendant is domiciled in China, an application for preliminary measures is to be served according to the Hague Service Convention (Rule 274.1 (a) (ii) RoP).

According to Article 5 of the Hague Service Convention, both formal and informal service is possible. In the case of informal service, the service documents may also be served by electronic means, for example by email, provided that the law in the receiving state does not object to such a form of service. China allows service by electronic means such as email with the consent of the recipient (UPC_CoA_69/2024). Both formal and voluntary informal service are admissible methods under the Hague Service Convention and thus fall under Rule 274.1 RoP.

Since this is an application for preliminary measures, Court's registry initially tried to effect informal service according to Article 5 (2) of the Hague Service Convention in order to expedite the service.

Subsequently, Court's Registry arranged formal service in accordance with Article 5 (1) of the Hague Service Convention by transmitting the service documents to the competent Chinese authority on 24 May 2024. According to the tracking number, the service documents were received by the competent

authority in China on 11 June 2024. In the correspondence conducted with the Chinese authority, the latter never claimed that the documents had not arrived.

3. Failure of service in accordance with Rule 274.1 RoP

In the present case, neither an informal nor a formal service in accordance with Rule 274.1 (a) (ii) RoP and Article 5 of the Hague Service Convention could be effected: Consent to an informal service could not be obtained, the formal service has not yet been effected.

According to Article 15 of the Hague Service Convention each Contracting State shall be free to declare that the judge may give judgment even if no certificate of service or delivery has been received, if all the following conditions are fulfilled:

- a) the document was transmitted by one of the methods provided for in this Convention,
- b) a period of time of not less than six months, considered adequate by the judge in the particular case, has elapsed since the date of the transmission of the document,
- c) no certificate of any kind has been received, even though every reasonable effort has been made to obtain it through the competent authorities of the State addressed.

On this basis, the following can be stated here:

- a. Court's Registry transmitted the service documents to the competent Chinese authority on 24 May 2024. The service documents were received by the relevant authority in China.

However, according to the Hague Service Convention, it is not the *receipt* of the documents that is decisive for the period specified in Article 15 (2) b), but their *transmission*. Consequently, for the purposes of Article 15 (2) of the Hague Service Convention, it is not important whether the defendant actually received the document and thus had an effective opportunity to take note of the contents of the document (HCCH, Practical Handbook on the Operation of the Service Convention, 2016, para. 315).

Until today, no certificate according to Article 6 of the Hague Service Convention has been received from the competent Chinese authority.

- b. The Court has to realise that more than six months have elapsed since the date of the transmission of the documents to the competent Chinese authority.
- c. The Court considers it adequate to give a judgment in the present case after the expiry of six months since the date of the transmission of the documents. This is justified in this case for two reasons:
 - (1.) The subject matter of the proceedings is a request for preliminary measures. This is therefore an urgent matter. The Hague Service Convention itself provides in Article 15 (3) that the court is not prevented by Article 15 from ordering preliminary measures in urgent cases.
 - (2.) Due to the known handling of requests for formal service by the competent Chinese authority, it is not to be expected that the request for service will be successful if further delay occurs. It is not only the experience of European national courts (e.g. Higher Regional Court Munich, GRUR-RR 2020, 511), but also of the Unified Patent Court (LD Mannheim, UPC_CFI_332/2024), that requests for service from the Chinese authority in many cases are either not forwarded at all or objected to and returned.
- d. Every reasonable effort has been made to obtain a proof of delivery through the competent Chinese authorities. Twice an inquiry to the respective Chinese authority was sent regarding the status of service.

4. Alternative attempt of service under Rule 275.1 RoP

If service in accordance with Rules 270-274 RoP is unsuccessful, an attempt must be made, if possible, to effect service by an alternative method or at an alternative place (Rule 275.1 RoP). Rule 275.1 RoP also applies if the foreign authority refuses service seriously and definitively (divergent: LD Mannheim, UPC_CFI_332/2024). A serious refusal of service can also be assumed if a

request for service is not processed for more than six months without any apparent reason.

The Rules of Procedure do not provide for an exception to the requirement of alternative service (Rule 275.1 RoP). Such an exception would also not be in line with the apparent intention of the provisions on service to exhaust all available options to give the defendant the opportunity to take note of the application and to defend himself (correctly LD Mannheim UPC_CFI_219/2023). In view of this, it seems inappropriate to penalise the defendant by not making further service attempts if the foreign authority refuses service in violation of the Hague Service Convention.

However, a prerequisite for further service attempts is that such attempts are possible at all. To be considered as an alternative method of service (Rule 275.1 RoP), the method must be factually and legally possible. An attempt of alternative service can only be dispensed with if there is no legally and factually possible alternative for service.

- a. **Service by an alternative method** is not possible in the present case.

Both the applicant and the court have tried unsuccessfully to effect service of the application both formally and informally.

No other admissible alternative means of service are apparent; in particular, China has opposed to send judicial documents directly to persons in China by postal channels (Article 10 (a) of the Hague Service Convention; see UPC_CoA_69/2024).

Attention is drawn to Rule 275.4 RoP in this context, which does not allow the order of an alternative method of service that is incompatible with the law of the state in which service is to be effected. The Court is neither aware nor can it reasonably be expected to find out whether further service methods such as service by public notice (a method that is provided for example by German national law, but not by the RoP) is compatible with Chinese law.

- b. **Service at another place** is also not possible. No other place is known where the application could be served.
- c. Further delay caused by service by an alternative method or at an alternative place would also be unreasonable in view of the fact that these are proceedings for preliminary measures. The present case shows that the urgency of a provisional measure is difficult to reconcile with the long duration of service abroad.

5. **Confirmation of good service**

Under Rule 275.2, it may be ordered that steps already taken to communicate the statement of claim to the defendant *by an alternative method or at an alternative place* constitute good service. According to the clear wording of Rule 275.2 RoP (“...steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place...”), only an (unsuccessful) attempt to serve the document *by an alternative method or at an alternative place* may be approved as good service. By contrast, an unsuccessful attempt to serve documents by means of Rule 274.1 a) (ii) RoP usually is not acceptable as good service under Rule 275.2 RoP.

In the view taken here, Rule 275.2 RoP contains an unintended gap: If an attempt of service under Rule 274 RoP has failed and service by an alternative method or at an alternative place is neither possible nor reasonable, the court may order that also an unsuccessful attempt of service under Rule 274 RoP shall constitute good service.

ORDER

1. The steps already taken to bring the request for preliminary injunction in the proceedings ACT_597609/2023 to the attention of Defendant constitute good service pursuant to Rule 275.2 RoP.
2. Service shall be deemed effective as of the date of this order (Rule 275.3 (b) RoP).
3. The Objection to the application for provisional measures is to file within fourteen days (Rule 275.3 (c) RoP).
4. The registry shall publish this order (including the names of the parties and the file number) on the Court's website.

Tobias Pichlmaier
Judge-rapporteur