



Paris Local Division

UPC_CFI_358/2023
Order
of the Court of First Instance of the Unified Patent Jurisdiction, handed
down on 19/12/2024

APPLICANT

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

Represented by Henri BOURGEOIS

DEFENDER

HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P
10300 Energy Drive, Spring, Harris County, TX, 77389,
USA - 77389 - Harris County - US

Represented by Grégoire
DESROUSSEAUX

PATENT IN SUIT

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

COMPOSITION OF THE CHAMBER -

Chairman and Judge-Rapporteur Camille **Lignieres Legally qualified judge**
Peter Tochtermann Legally qualified judge
Carine Gillet Legally qualified judge

Stefanie Philipps Technically qualified judge

LANGUAGE OF PROCEDURE: French

LAMA FRANCE (hereinafter "LAMA") has filed applications dated 13 December 2024 in response to the application filed by HEWLETT-PACKARD DEVELOPMENT COMPANY (hereinafter "HEWLETT").

"HPDC") on 21 November 2024 (Application No. 66323/2024) for enforcement of the decision on the merits handed down on 13 November 2024 (hereinafter "the Decision"). LAMA seeks a stay of execution of the Decision during the appeal period, in the alternative, the establishment of a circle of confidentiality restricted solely to counsel for the parties for the execution of the communication of information as referred to in IV of the operative part of the Decision, and in the infinitely alternative, to grant a guarantee of two million Euros paid for its benefit by HPDC if the restricted circle of confidentiality is not granted.

By preliminary order of the presiding judge issued on 16 December 2024, HPDC's opinion was sought on LAMA's applications (Order No. ORD_66525/2024 in ACTION No.: ACT_578697/2023);

HPDC filed its written comments via CMS on 18 December 2024. HPDC submits that the application for a stay of execution is a matter exclusively for the Court of Appeal. HPDC therefore requests that the Presiding Judge or the Paris Local Division declare that the court of first instance lacks jurisdiction to rule on this application. It adds that, in any event, LAMA FRANCE's claim is neither justified nor well-founded and must be dismissed.

HPDC also asked the Court to reject LAMA FRANCE's application for a confidentiality club restricted to representatives of the parties.

-Primarily, HPDC does not object to the following information being communicated in a confidentiality club composed of the representatives and one natural person for each party:

- the purchase and resale invoices to the wholesalers concerned during the period not covered by the statute of limitations relating to the types of counterfeit cartridges; however, in order to allow the practical implementation of a verification of the execution of the prohibition and recall measure, the names of the wholesalers and other customers of LAMA relating to the cartridges concerned by the decision may be freely communicated to HPDC ;

- accounting information relating to the import, purchase or sale of counterfeit cartridges during the period not covered by the statute of limitations.

On the other hand, with regard to the identity of the manufacturers and/or suppliers of the infringing cartridges, HPDC is requesting full access to this information due to the absence of any justification for the confidential nature of this information.

Lastly, on the subsidiary warranty claim, HPDC asks the Court to declare LAMA FRANCE's warranty claim inadmissible, arguing that :

- LAMA FRANCE's request being late in relation to the "*front loaded*" nature of the proceedings before the Court of First Instance, the parties being required to make their application in good time,

- and rule 118.8 does not in any event allow the Court of First Instance to add a guarantee after a decision has already been given.

In the alternative, HPDC seeks rejection of this warranty claim, on the grounds that the claim is neither justified nor proportionate in light of the arguments put forward by LAMA France, in that the alleged serious consequences have not been demonstrated and that it is not justified that the warranty would be intended to compensate for the damage in the event of a breach of confidentiality.

LAMA, invited in the preliminary order to take a position on the question of the jurisdiction of the Court of First Instance with regard to its application for a stay of execution, argued that the combination of Rules 223-4 (on the stay of execution during the appeal proceedings) and 345-5 RoP (on the duty judge of first instance in cases of extreme urgency) during the transitional period in the appeal period and before the appeal is lodged, would give the Court of First Instance jurisdiction to stay execution.

1) On the application for a stay of execution :

Only the Court of Appeal has the power to suspend the execution of a decision (Article 74 AJUB and R. 223 RdP) and to date no appeal has been lodged against the decision on the merits.

It should be noted that rule 118.8 RoP does not give the court of first instance any power to suspend enforcement in this case.

The time limits for performance were set out in the operative part of the Decision.

Contrary to what LAMA maintains, if R. 345 (5) RdP gives the judge of first instance the power to rule immediately in the case of extreme urgency, it is within the powers held by the Court of First Instance, which has no power to suspend a decision during the appeal period.

Consequently, the application for a stay of execution can only be rejected, as the court before which the claim is brought does not have the power to stay the execution of its decision on the merits.

2) On the subsidiary request for a circle of confidentiality limited to only representatives of the parties :

The Court finds that HPDC does not object to the principle of organising a confidentiality circle on the basis of Rule 262A RoP to protect the confidential information that will be communicated in the context of the execution of the communication of information ordered in the decision on the merits of 13 November 2024 (paragraphs 312 and 313 of the grounds and part IV of the operative part) concerning invoices and accounting elements.

The Tribunal considers that this request is legitimate because the documents to be disclosed are likely to contain information covered by business secrecy.

Rule 262A.6 RoP provides that "The number of persons referred to in paragraph 1 shall not be greater than is necessary to ensure respect for the rights of the parties to the proceedings to an effective remedy and to a fair trial; it shall include, at least, one person".

for each party and the lawyers or other representatives of the parties to the procedure.

It should be noted that the case law within the JUB has allowed this circle to be restricted to the representatives of the parties to the proceedings (by not including a private person representing each of the parties), only in the event of agreement between the parties on this point (LD Paris, 26 March 2024, UPC_CFI_397/2023; LD The Hague, 4 March 2024, UPC_CFI_239/2023).

In the present case, the Tribunal notes that there is no agreement on the composition of the confidentiality circle and considers that Rule 262A.6 RoP should therefore apply. There is therefore no need to modify the composition of the circle of confidentiality as constituted by the procedural order issued on 2 August 2024 (Order No. ORD_43600/2024 in ACTION No. ACT_578697/2023_UPC No.: UPC_CFI_358/2023).

Furthermore, only accounting information and invoices communicated by LAMA to HPDC will be concerned. Indeed, LAMA does not justify that information relating to manufacturers' and/or suppliers' networks must be kept confidential with regard to HPDC.

3) On the subsidiary request for a guarantee :

Rule 118.8 RoP provides in fine that: "The Court may make any provision or measure subject to the provision of security by the successful party for the benefit of the unsuccessful party, as determined by the Court in accordance with Rule 352".

The Court notes that LAMA had not requested the provision of a guarantee following HPDC's request for disclosure of information. Furthermore, the Court considers that the creation of a confidentiality circle in accordance with the provisions of R. 262A.6 RoP to protect the confidentiality of the confidential information to be communicated by LAMA is sufficient to protect the latter's interests. The fact that HPDC objects to the composition of a confidentiality circle restricted solely to counsel for the parties cannot justify the creation of a guarantee in favour of LAMA at this stage of the proceedings, and this request will therefore be rejected as unfounded.

In the light of the foregoing, the Court :

- Declares that it does not have the power to stay the execution of its decision on the merits of 13 November 2024;
- Orders that the confidential information relating to the invoices and accounts of LAMA France which will be communicated in the context of the execution of the communication of information ordered in the decision on the merits of 13 November 2024 (§ 312 and 313 of the grounds and part IV of the operative part) will be accessible only to the persons designated in the circle of confidentiality as constituted in the order of 2 August 2024 ;

- Rejects LAMA France's request for a guarantee on the basis of R. 118.8 and R. 352 RdP.
- Recalls that this order may be appealed in accordance with the provisions of R. 220.2 RdP.

Rendered in Paris on 19 December 2024.

Camille Lignieres, Presiding Judge

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Peter Tochtermann, legally qualified judge

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Stefanie Philipps, technically qualified judge

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DETAILS OF THE ORDER

Order n° ORD_66525/2024 in ACTION N°: ACT_578697/2023 UPC n° :
UPC_CFI_358/2023

Type of action: Infringement action

Related procedure no. Application no.: 66323/2024 Type of
application: Generic procedural application