



Order
of the Court of First Instance of the Unified Patent Court in
the main proceedings concerning European patents 3
611 989 and 3 678 321
issued on 18/01/2024

Guiding principles:

1. On the admissibility of extending the action to include claims from a further patent in suit after the conclusion of limitation proceedings.
2. The defendants must be granted the same pleading deadlines for the defence in response to an extension of the action as would have been granted if the action had been filed as a separate action, but no longer. The (non-extended) time limit for filing a defence begins to run in relation to the subject matter of an extension of the action when the extension of the action is admitted.

Keywords:

Rule 333; review by the panel; extension of the action; further patent in suit; limitation proceedings; possibility of separation; time limit for filing a defence

Applicant

- 1) **NETGEAR Germany GmbH**
(defendant in the main proceedings) - Konrad-Zuse-Platz 1
- 81829 - Munich - DE
represented by
Stephan Dorn

- 2) **Netgear Inc.**
(defendant in the main proceedings) - 350 E Plumeria Dr -
95134 - San Jose - US
represented by
Stephan Dorn

- 3) **Netgear International Limited**
(defendant in the main proceedings) - First Floor Building
3, University Technology Centre, Curraheen Road -
T12K516 - Cork - IE
represented by
Stephan Dorn

Defendant

- 1) **Huawei Technologies Co. Ltd**
(Plaintiff in the main proceedings) -
Bantian Huawei Base Longgang District
Shenzhen - 518129 - Shenzhen - CN
represented by
Tobias J. Hessel

Patents in suit

<i>Patent no.</i>	Owner
EP3611989	Huawei Technologies Co. Ltd
EP3678321	Huawei Technologies Co. Ltd

COMPOSITION OF THE PANEL

Presiding judge and Judge-rapporteur	Matthias Zigann
Legally qualified judge	Tobias Pichlmaier
legally qualified judge	Edger Brinkman
technically qualified judge	Patrice Vidon

This Order was issued by the full panel of judges.

LANGUAGE OF THE PROCEEDINGS

German

SUBJECT OF THE PROCEEDINGS

Patent infringement

Here: Application under Rule 333.1 RP for review of the judge-rapporteur's Order of 11/12/2023 under Rule 263 RP to allow the extension of the action to include claims from European Patent 3 678 321.

APPLICATIONS

The applicants (defendants in the main proceedings) apply,

- 1. reject the applicant's application for admission of the extension of the action of 23 November 2023.*
- 2. in the alternative, to allow the appeal.*

The defendant (plaintiff in the main proceedings) requests the court to

to extend the pending action pursuant to Rule 263.1 RP by the applications specified below based on the further patent in suit EP 3 678 321.

FACTS OF THE CASE

The plaintiff is suing the defendants for infringement of European patents 3 611 989 and 3 678 321. She initially filed an action on 01/06/2023 based solely on European patent 3 611 989. In a document dated 23/11/2023, she requested that the action be extended to include claims from European patent 3 678 321.

The plaintiff submits that, due to limitation proceedings before the European Patent Office concerning European patent 3 611 989, which took place in the period from 13/04/2023 to 20/10/2023, it was prevented from asserting claims based on this patent in the action of 01/06/2023. The extension of the action was directed against the same acts of infringement relating to the WiFi6 functionality of the infringing forms. The extension is therefore procedurally economical. The defendants would not be unreasonably disadvantaged by the authorisation. If it had also based the action on European patent 3 611 989 at the same time, it would have run the risk, irrespective of the patent claim asserted, that the defendants would attack the existence of the patent as granted in its entirety with nullity counterclaims, although the patent proprietor no longer wishes to maintain the patent as granted anyway.

The defendants are of the opinion that the existence of the requirements of Rule 263 VerfO has already not been sufficiently demonstrated. In the limitation proceedings, only the features of sub-claim 6 (relating to the method claim) and the identical sub-claim 14 (relating to the device claim) were included in the original main claims 1, 2, 9 and 10. These claims are now the new claims 1 to 4 of B3 of EP 321, and all other claims have been deleted. However, no new features had been added to the claims. Consequently, the applicant could have filed an action against the now limited version as early as 01/06/2023. It was easily possible to base the allegation of infringement on the original main claims and original sub-claims 6 and 14 of EP 321. A subsequent limitation of the asserted claims in order to adapt them to the outcome of the limitation proceedings pending before the European Patent Office would also have been possible without further ado under Rule 263.3 RP. The plaintiff's sole purpose in making the application was to avoid the re-serving of a statement of claim on the defendants. Furthermore, the defendants would be unreasonably hindered in their conduct of the proceedings by the extension of the action.

The judge-rapporteur made the following Order on 11/12/2023:

- 1. The application of the petitioner (plaintiff in the main proceedings) of 23/11/2023 for leave to extend the action pursuant to Rule 263.1 RP to include the claims specified in the document of 23/11/2023 based on the further patent in suit EP 3 678 321 is granted.*
- 2. Following the extension of the claim, the amount in dispute is set at a total of € 2 million, of which € 1 million is attributable to the subject matter of the extension of the claim.*

He explained the reasons for this:

The application for leave to amend the complaint is admissible and well-founded.

Pursuant to Rule 263.1 of the Rules of Procedure, a party may apply to the court at any time during the proceedings for the admission of an amendment or addition to the claim, including a counterclaim. The application must state the reasons why the amendment or addition was not already contained in the original document. Subject to paragraph 3, leave shall be refused if, having regard to all the circumstances, the party seeking leave to amend is unable to satisfy the court that (a) the amendment in question could not have been made earlier with due diligence and (b) the amendment does not unreasonably prejudice the other party in the conduct of the proceedings.

The application was admissible. The applicant has made submissions on all elements of the offence.

The requirements for refusal of authorisation are not met.

The court is convinced that the amendment in question could not have been made earlier with due diligence. The limitation proceedings ran until 20/10/2023 and the application to amend the complaint was filed on 23/11/2023. The delay can be explained by the need for legal preparation. A diligent plaintiff was also not required to file an action during the ongoing limitation proceedings. Irrespective of the fact that the courts of some EPC states do not permit the assertion of a limited patent claim before the conclusion of limitation proceedings and that it remains to be clarified what the situation is at the Unified Patent Court, the plaintiff would have been forced, in the event of such a procedure, depending on the outcome of the limitation proceedings, to adapt the action to the events in the limitation proceedings by way of an amendment to the action. The necessity of one amendment to the action would therefore be replaced by the necessity of another amendment to the action. The rejection of the authorisation would therefore bring no benefit in terms of procedural economy.

The court is also convinced that the amendment does not unreasonably hinder the other party in its conduct of the proceedings. A certain degree of obstruction does not preclude admission under the law. Furthermore, in the event that both patents are jointly managed within the same infringement proceedings, the court is obliged to grant the defendant largely the same defence options in relation to the second patent as in the case of a new, further action. This can be achieved by granting or extending

comment periods. If the subject matter of the extension of the action is separated, this would even be simplified.

The parties will be heard in a separate workflow on the question of whether the subject matter of the extension of the claim can or should be separated.

The applicants (defendants in the main proceedings) filed a petition for review pursuant to Rule 333.1 VerFO by document dated 22/12/2023. The defendant (plaintiff in the main proceedings) commented on this in a document dated 04/01/2024.

REASONS

The application is admissible (I.), but unfounded (II.).

The judge-rapporteur's Order of 11/12/2023 is therefore confirmed by the court.

I. The application is admissible.

The application of 22/12/2023 was filed within the time limit under Rule 333.2 of the Rules of Procedure and the fee was paid. The applicant had the opportunity to comment in accordance with Rule 333.2 of the Rules of Procedure, which it did in a document dated 04/01/2024.

The order of the judge-rapporteur in the written procedure to allow an extension of the action is an order falling within the scope of Rule 333.1 of the Rules of Procedure.

Pursuant to Rule 333.1 of the Rules of Procedure, all procedural decisions or Orders of the Case management decisions or orders made by the judge-rapporteur or the presiding judge"; French version: "Les décisions ou ordonnances relatives au traitement des affaires rendues par le juge-rapporteur ou le président") are reviewable by the panel upon reasoned application. The authorisation of an extension of the action shapes the course of the proceedings and is therefore procedural.

According to Rule 220.2 of the Rules of Procedure, the party complained against may either raise the objection in the appeal against the final decision or raise it while the proceedings are still pending. However, the judge-rapporteur's decision must first be reviewed by the panel in accordance with Rule 333 of the Rules of Procedure before the Court of Appeal makes a decision in accordance with Rules 220.2. and .3 of the Rules of Procedure (Rule 333.5 of the Rules of Procedure).

This procedure is intended to give the adjudicating body the opportunity to remedy the complaint itself and thus avoid a superfluous appeal.

II. The application is unfounded.

The panel first refers to the judge-rapporteur's reasoning reproduced above and adopts it as its own.

With regard to the further submissions of the parties, it should be added that the assessment of the admissibility of the extension of the action is based solely on Rule 263 of the Brussels Convention and not on national law.

The plaintiff could not reasonably be expected to assert the limited claims earlier before the conclusion of the limitation proceedings, also due to the risk of a further counterclaim for a declaration of invalidity of the second patent. As a separate means of attack, the counterclaim is not limited to a version of the claim that may have been asserted in the infringement proceedings. The defendants could therefore have easily attacked the legal validity of EP 3 678 321 in its originally granted version with a counterclaim, although this will no longer be relevant at all. As no decisions of the Unified Patent Court on the admissibility of such nullity counterclaims and the cost consequences exist, the patent proprietor did not have to take such a risk. It was allowed to await the outcome of the limitation proceedings.

The defendants must be granted the same time limits for their defence in the present proceedings or in the context of separate proceedings as would have been granted if the action had been filed as a separate action, but no longer. This means that the non-extended time limit for filing a defence in relation to the subject matter of the extension of the action began to run on 11/12/2023 when the extension of the action was admitted. The defendants will be informed in which workflow the statement of defence is to be submitted.

The appeal is admissible because the question of the assertion of further property rights extending the claim is of significance beyond the individual case.

ORDER

1. The judge-rapporteur's Order of 11/12/2023 (App_587438/2023) is confirmed by the panel.
2. The time limit for filing a statement of defence in relation to the subject matter of the extension of the action began on 11/12/2023 and will end (without extension) on 11/03/2024.
3. The appeal is authorised.

Dr Zigann Presiding judge and judge-rapporteur	Matthias ZIGANN  Digitally signed by Matthias ZIGANN Date: 2024.01.18 12:21:49 +01'00'
Pichlmaier legally qualified judge	Tobias Günther Pichlmaier  Digitally signed by Tobias Günther Pichlmaier Date: 2024.01.18 13:28:10 +01'00'
Brinkman legally qualified judge	Edger Frank BRINKMAN  Digitally signed by Edger Frank BRINKMAN Date: 2024.01.22 20:52:15 +01'00'
Vidon technically qualified judge	Patrice, Emmanuel, Pierre, Marie Vidon  Signature numérique de Patrice, Emmanuel, Pierre, Marie Vidon Date : 2024.01.22 15:54:04 +01'00'

ORDER DETAILS

UPC number:	UPC_CFI_9/2023
Action number of the infringement action:	ACT_459771/2023
Action number of the counterclaims:	CC_588071/2023;CC_588080/2023
Action number of the Order under review:	App_587438/2023
Subject of the Order under review:	263 Action
number of this Order:	App_595631/2023
Subject of this Order:	R 333

INFORMATION ABOUT THE APPOINTMENT

This Order may be appealed against either

- an appeal against the final decision of the Court of First Instance on the substance of the case may be lodged by any party who has been unsuccessful in whole or in part in its applications, or
- After the appeal has been admitted by the Court of First Instance, an appeal may be lodged within 15 days of service of the decision by any party whose applications were unsuccessful in whole or in part (Art. 73(2)(b) UPCA, R. 220.2, 224.1(b) RP).