



Procedural order
of the Court of First Instance of the Unified Patent Court local
division Düsseldorf
issued on 22 April 2024
concerning EP 3 926 698 B1

GUIDELINES:

1. If an action for revocation is successful, the patent in dispute is declared invalid with retroactive effect. As a result, even a simple licensee loses its preferential position compared to non-licensees. He can therefore join the legal dispute on the plaintiff's side and attempt to prevent such a declaration of invalidity.
2. If a local division has decided to hear both the infringement action and the nullity counterclaim, it will decide on both the infringement issue and the legal status on the basis of a uniform interpretation. In such a constellation, the licence holder can not only join the nullity counterclaim in isolation, but also the entire legal dispute.

KEYWORDS:

Intervention; admissibility of intervention; action for infringement; action for annulment; legal interest; isolated intervention; licensee; simple licence; simple licensee

PLAINTIFF AND COUNTER-DEFENDANT:

Seoul Viosys Co, Ltd, legally represented by its authorised representatives Chung- Hoon Lee and Young Ju Lee, 65-16, Sandan-ro 163 beon-gil, Danwon-gu, Ansan-si, Gyeonggi-do, 15429, Republic of Korea,

represented by: Attorney Dr Bolko Ehlgen, Attorney Dr Julia Schönbohm, Linklaters LLP, Taunusanlage 8, 60329 Frankfurt am Main, Germany,

supported by: Patent attorney Dr Dipl.-Phys. Olaf Isfort, law firm Schneiders & Behrendt, Huestraße 23, 44787 Bochum,

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rs.com STREITHELFERIN:

Seoul Semiconductor Co., Ltd., legally represented by its authorised representatives and CEOs Chung-Hoon Lee and Myeong-gi Hong, Building 0: 97-11, Sandan-ro 163 beon-gil, Danwon-gu, Ansan-si, Gyeonggi-do, 15429, Republic of Korea

represented by: Attorney Dr Bolko Ehlgen, Attorney Dr Julia Schönbohm, Linklaters LLP, Taunusanlage 8, 60329 Frankfurt am Main, Germany,

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DEFENDANT TO 1):

expert e-Commerce GmbH, legally represented by its managing directors Dr Stefan Müller and Michael Grandin, Bayernstraße 4, 30855 Langenhagen,

represented by: Attorney Dr Dirk Jestaedt, law firm Krieger Mes & Graf von der Groeben Part mbB, Bennigsen-Platz 1, 40474 Düsseldorf,

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with the participation of: Patent attorney Bernhard Ganahl, HGF Europe LLP, Neumarkter Strasse 18, 81673 Munich,

DEFENDANT TO 2) AND RESPONDENT:

expert klein GmbH, legally represented by its managing directors Jens Oerter and Thomas Jacob, Jägerstraße 32, 57299 Burbach,

represented by: Attorney Dr Dirk Jestaedt, law firm Krieger Mes & Graf von der Groeben Part mbB, Bennigsen-Platz 1, 40474 Düsseldorf,

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with the participation of: Patent attorney Bernhard Ganahl, HGF Europe LLP, Neumarkter Straße 18, 81673 Munich.

STREITPATENT:

European Patent No. 3 926 698 B1

ADJUDICATING BODY/CHAMBER:

Judges of the Düsseldorf local division:

This Order was issued by presiding judge Thomas as judge-rapporteur. LANGUAGE OF THE PROCEEDINGS:

German

SUBJECT: R. 313 et seq. RoP - Order regarding the motion to intervene filed by Seoul Semiconductor Co., Ltd.

BRIEF DESCRIPTION OF THE FACTS:

The plaintiff is the registered proprietor of the European patent EP 3 926 698 B1 (hereinafter: patent in suit). It has granted the intervener, which is its parent company, a non-exclusive licence to the patent in suit, including all national parts, with effect from 4 January 2023. The licence is in force. With regard to the details of the licence agreement, reference is made to Annexes SH 1 / SH 1a.

As the licensee of the patent in dispute, the intervener itself manufactures products falling within the scope of protection of the patent in dispute and distributes them within the scope of the Agreement on a Unified Patent Court (UPCA). In addition, the intervener also exercises its licence to use the patent in suit indirectly through its wholly-owned subsidiary, Seoul Semiconductor Europe GmbH, Frankfurter Str. 80 - 82, 65760 Eschborn. This is a wholly-owned sales company of the intervener.

In an action filed on 12 October 2023 (ACT_579244/2023), the plaintiff filed a claim against the defendants for infringement of the patent in dispute. On 22 December 2023, the intervener filed an application to intervene in relation to this infringement action (App_598403/2023). After the defendant 2) filed a counterclaim for revocation on 23 January 2024 (CC_3580/2024), the intervener extended its application to intervene to this counterclaim in a document dated 28 February 2024.

By Order of 31 January 2024 (ORD_3923/2024), the Düsseldorf local division decided to hear both the action and the nullity counterclaim (Art. 33(3)(a) UPCA).

APPLICATIONS BY THE PARTIES:

The intervener claims that the Court should

the accession to the infringement proceedings with
the action number 579244/2023 (UPC_CFI_363/2023) on
the side of the plaintiff in order to defend the plaintiff in the infringement proceedings
described in the application of

12 October 2023 in relation to EP 3 926 698 (requests A. and C.), and to intervene in the invalidity counterclaim with action number CC_3580/2024 to assist the applicant in defending EP 3 926 698.

The plaintiff agreed with the intervener's submissions. The defendants apply,

reject the application for leave to intervene filed by Seoul Semiconductor Co.

FACTUAL AND LEGAL ISSUES:

In the opinion of the plaintiff and the intervener, the latter has a legal interest in the outcome of the proceedings due to its position as a licensee of the patent in dispute. As a licence holder, it manufactures products that make use of the technical teaching of the patent in dispute and markets them within the scope of the UPCA. There is therefore the possibility that the outcome of the proceedings will have a direct effect on the legal position of the intervener as the licensee. Like the applicant, the intervener is affected by the distribution of the products at issue. The intervener has an interest in supporting the plaintiff and patent holder in preventing a continuation of the infringement in order to enjoy the full legal benefits of the licence agreement itself.

Irrespective of this, the legal interest in intervening also follows from the fact that the local chamber decided in favour of a joint hearing of the infringement and nullity counterclaims. It was to be expected that the legal validity and infringement issues would overlap in terms of content, for example in the interpretation of the patent in dispute.

The defendant has objected to the intervener joining the infringement proceedings. It denies that the intervener has a *legal* interest in the outcome of the proceedings. The position as a (simple) licensee is not sufficient for such a legal interest. This does not even constitute an economic interest, which is in any case irrelevant for the admissibility of the intervention.

REASONS FOR THE ORDER:

The application to intervene is

admissible. 1.

According to R. 314.2 VerfO, such an application must be made before the conclusion of the written procedure. The intervener complied with this requirement. It filed its application before receipt of the statement of defence and extended it to the statement of defence after the action for annulment was filed.

2.

The intervener has a legal interest in the outcome of the proceedings, R. 313.1 VerfO.

a)

Such a legal interest exists if the intervener has a direct and present interest in the issuance of the Order or decision requested by the supported party. An interest merely relating to the grounds of the action is not sufficient.

interest. A distinction must be made between potential interveners who have a direct interest in the decision on the specific application of the supported party and those who can only demonstrate an indirect interest in the outcome of the legal dispute. If the position of the intervener is merely similar to that of one of the parties, this is not sufficient for a legal interest (UPC_CoA_404/2024, Order of 10 January 2024, App_584498/2023, para. 10).

b)

Based on these principles, the intervener has a direct and present interest in the outcome of the proceedings.

aa)

If the revocation counterclaim is successful, the patent in suit will be revoked with retroactive effect pursuant to Art. 65 (2) and (4) UPCA. As a result, the intervener as licensee loses its preferential position over non-licensees, which is also associated with a simple licence. It can therefore join the legal dispute on the plaintiff's side and attempt to prevent such a declaration of nullity (Bopp/Kircher/Lux, Handbuch Europäischer Patentprozess, 2nd ed., § 11 para. 30; Bopp/Kircher/Burrichter/Kirchhofer, loc. cit., § 14 para. 167).

bb)

Such an intervention is not only admissible in isolation in relation to the revocation counterclaim. If, as here, the local division has opted for a joint hearing of the infringement and revocation counterclaims (Art. 33 (3) (a) UPCA), it must decide on both the infringement and the legal validity on the basis of a uniform interpretation of the patent in dispute (UPC_CFI_16/2024 (LK Düsseldorf), Order of 15 April 2024). Infringement action and nullity counterclaim are therefore closely linked in terms of content. Any change in the interpretation and determination of the scope of protection can directly influence not only the answer to the infringement question, but also the assessment of the validity of the patent in dispute. Against this background, the intervener can only effectively pursue its interest in preventing the invalidation of the patent in suit if it joins not only the nullity action in isolation, but the legal dispute as a whole. The question of whether a simple licence entitles the intervener to join the infringement action in isolation therefore does not need to be decided in the present case.

3.

Pursuant to R. 315.1 (b) of the Rules of Procedure, the judge-rapporteur or the presiding judge must set a time limit within which the intervener may submit a statement in intervention. Point 3 of the Order takes this into account.

ORDER:

1. The intervener's application to intervene is admissible.
2. The parties to the proceedings are hereby informed of the admissibility of the application to intervene.
3. The intervener has the opportunity to submit a statement in intervention **by 6 May 2024**.
4. The plaintiff and the intervener are represented by the same authorised representatives. If neither of the parties or the intervener objects, the following rules shall therefore apply until further notice in order to simplify the proceedings and unless otherwise agreed in individual cases

Order the following additional orders:

- a. In the absence of any indication to the contrary from the plaintiff and/or the intervener in the further course of the proceedings, the local division assumes until further notice that the intervener waives service of documents filed electronically by the parties, so that service on the intervener is unnecessary. The same applies to all Orders and decisions of the court. Upon receipt by the plaintiff's authorised representatives, these are also deemed to have been received by the intervener.
- b. The intervener's documents must generally be submitted in paper form and served on the parties. However, the joint authorised representatives of the plaintiff and the intervener are free to waive such service. If they make use of this option, it is sufficient for the intervener to submit the relevant document in triplicate (1x for the paper file kept at the local division; 2x for service on the two defendants). Otherwise, the document in question must be submitted in quadruplicate.
- c. The Order made under point 4. b. does not apply to the third-party notice. This must be served on both parties and therefore also on the plaintiff, which is why it must be submitted in quadruplicate.

Issued in Düsseldorf on 22 April 2024 NAMES

AND SIGNATURES

Presiding judge Thomas

**Ronny
Thomas**  Digitally signed by Ronny
Thomas Date: 2024.04.22
07:56:37 +02'00'

ORDER DETAILS:

ORD_5343/2024 for the main file reference ACT_579244/2023

UPC number: UPC_CFI_363/2023

Type of proceedings: Action for infringement