



Order
of the Court of First Instance of the Unified Patent Court
in the main proceedings concerning European patent 3 024 163 issued on:
04/07/2024

Date of receipt of the application: 31/07/2023

Xiaomi Inc.

(Defendant) - No.006, Floor 6, Building 6, Yard 33,
Xierqi Middle Road, Haidian District - 100085 - Beijing
- CN

Statement of claim served on
10/09/2023

Beijing Xiaomi Mobile Software Co. Ltd.

(Defendant) - No.018, Floor 8, Building 6, Yard 33 Xierqi
Middle Road, Haidian District - 100085 - Beijing - CN

Statement of claim served on
10/09/2023

Xiaomi Technology Germany GmbH

(defendant) - Niederkasseler Lohweg 175 - 40547 -
Düsseldorf - DE

Statement of claim served on
08/09/2023

Xiaomi Technology France S.A.S

(defendant) - 93 rue Nationale Immeuble Australia -
92100 - Boulogne-Billancourt - FR

Statement of claim served on
08/09/2023

Xiaomi Technology Italy S.R.L

(defendant) - Viale Edoardo Jenner 53 - 20158 - Milano
- IT

Statement of claim served on
19/09/2023

Xiaomi Technology Netherlands B.V.

(defendant) - Prinses Beatrixlaan 582 - 2595BM - The
Hague - NL

Statement of claim served on
10/09/2023

Xiaomi H.K. Limited

(Defendant) - Suite 3209, 32/F, Tower 5, The Gateway,
Harbour City, 15 Canton Road, Tsim Sha Tsui, Kowloon
- 999077 - Hong Kong - HK

Statement of claim served on
10/09/2023

Xiaomi Communications Co., Ltd.
(Defendant) - No.019, Floor 9, Building 6, Yard 33,
Xierqi Middle Road, Haidian District - 100085 - Beijing
- CN

Statement of claim served on
08/09/2023

Odiporo GmbH
(defendant) - Formerweg 9 - 47877 - Willich - DE

Statement of claim served on
10/09/2023

Shamrock Mobile GmbH
(defendant) - Siemensring 44H - 47877 - Willich - DE

Statement of claim served on
10/09/2023

APPLICANT

1) **Panasonic Holdings Corporation** Represented by:
1006, Oaza Kadoma, Kadoma-shi - 571- Jonas Block
8501 - Osaka - JP

APPELLANT

1) **Xiaomi Inc.** Represented by:
No.006, Floor 6, Building 6, Yard 33, Henrik Lehment
Xierqi Middle Road, Haidian District -
100085 - Beijing - CN

2) **Beijing Xiaomi Mobile Software Co. Ltd.** Represented by:
No.018, Floor 8, Building 6, Yard 33 Xierqi Henrik Lehment
Middle Road, Haidian District - 100085 -
Beijing - CN

3) **Xiaomi Technology Germany GmbH** Represented by:
Niederkasseler Lohweg 175 - 40547 - Henrik Lehment
Düsseldorf - DE

4) **Xiaomi Technology France S.A.S** Represented by:
93 rue Nationale Immeuble Australia - Henrik Lehment
92100 - Boulogne-Billancourt - FR

- | | | |
|-----|--|-----------------------------------|
| 5) | Xiaomi Technology Italy S.R.L Viale Edoardo Jenner 53 - 20158 - Milan - IT | Represented by: Henrik Lehment |
| 6) | Xiaomi Technology Netherlands B.V. Prinses Beatrixlaan 582 - 2595BM - The Hague - NL | Represented by: Henrik Lehment |
| 7) | Xiaomi H.K. Limited Suite 3209, 32/F, Tower 5, The Gateway, Harbour City, 15 Canton Road, Tsim Sha Tsui, Kowloon - 999077 - Hong Kong - HK | Represented by: Henrik Lehment |
| 8) | Xiaomi Communications Co, Ltd. No.019, Floor 9, Building 6, Yard 33, Xierqi Middle Road, Haidian District - 100085 - Beijing - CN | Represented by: Henrik Lehment |
| 9) | Odiporo GmbH Formerweg 9 - 47877 - Willich - DE | Represented by: Henrik Lehment |
| 10) | Shamrock Mobile GmbH Siemensring 44H - 47877 - Willich - DE | Represented by: Henrik Lehment |

PATENT IN DISPUTE

| <i>Patent no.</i> | <i>Owner</i> |
|-------------------|--------------------------------|
| EP3024163 | Panasonic Holdings Corporation |

DECIDING JUDGES

COMPOSITION OF THE PANEL (PANEL 1) - COMPLETE COMPOSITION

| | |
|---|---------------------------|
| Presiding judge and judge-rapporteur | Matthias Zigann |
| Legally qualified judge | Tobias Pichlmaier |
| Legally qualified judge | András Kupecz |
| Technically qualified judge | Kerstin Roselinger |

This Order was issued by presiding judge Matthias Zigann as judge-rapporteur. LANGUAGE OF THE

PROCEEDINGS: German

SUBJECT MATTER OF THE CASE:

Patent infringement;
here: Application for secrecy protection

APPLICATIONS BY THE PARTIES

The applicant seeks an Order for the protection of secrets for the Reply pursuant to Rule 262A of the Rules of Procedure:

I. according to R. 262A VerfO

1. the following information is to be classified as confidential, so that the provisions of R. 262A of the Code of Civil Procedure apply, namely information on the licence negotiations which preceded and are still ongoing in this litigation, as well as internal considerations and calculations, namely in particular

- the grey shaded versions*
- the "KAP FRAND attachments" labelled as "strictly confidential"*

Such information pursuant to Section I.1. is contained in the Reply; insofar as we refer to this information in subsequent documents, we will label it accordingly.

2. Order the defendants to provide the information in section I.1 only to

- to the authorised representatives, their assistants (including experts and their team members) and not to disclose them to third parties, and*
- this information may not be used outside of this procedure,*

unless they can prove that they have lawfully obtained knowledge of the information to be treated as confidential outside the present proceedings and are complying with any restrictions associated with this other acquisition of knowledge, in particular such restrictions arising from contractual confidentiality agreements.

3. Order that after the final termination of the proceedings, each party and the

the persons named in Section I.2 releases or destroys the confidential information in accordance with Section I.1;

4. to make the Order subject to a proportionate penalty payment of at least EUR 100,000.00 for each case of non-compliance;

5. to oblige the parties and the persons named in Section I.2 to treat the confidential information pursuant to Section I.1 as strictly confidential beyond the proceedings and to use the confidential information exclusively for the purposes of these proceedings;

Alternatively, in the event that the panel does not grant the applications under I in full, we request that

II. the information and/or the documents submitted which are the subject of the above applications under point I shall not be deemed to have been filed and may not be used in the proceedings by the opposing party and the court unless the applicant expressly declares within 14 days of receipt of the final decision that the information and/or the documents submitted shall nevertheless be deemed to have been filed.

On 09/05/2024, the judge-rapporteur provisionally granted secrecy protection as requested and invited the defendants to comment on the application.

The defendants claim:

1. Point I.2, first indent of the provisionally ordered confidentiality regulation to be amended as follows:

- the authorised representatives in the present proceedings (ACT_545619/2023) and in the parallel proceedings between the plaintiff and the respective defendants in the proceedings before before the Regional Court Munich I (Ref. 21 O 9854/23, 21 O 9855/23, 21 O 9856/23 and 21 O 9429/23), before the Regional Court Mannheim (Ref. 14 O 67/23, 14 O 90/23, 14 O 91/23 and 14 O 92/23), before the Munich local division of the Unified Patent Court (ACT_545562/2023 and ACT_546092/2023), the Mannheim local division of the Unified Patent Court (ACT_245615/2023, ACT_545817/2023 and ACT_545606/2023) and before the High Court of Justice of England & Wales (case number HP-2023-000025), their auxiliaries (including experts and their team members) and may not disclose them to third parties

2. to delete point I.3 of the provisionally ordered confidentiality regulation or - in the alternative as follows:

"3. order that, after the final termination of the proceedings, each party and the persons referred to in para.

I.2 releases or destroys the confidential information pursuant to Section I.1, provided that the aforementioned information is in the possession of the respective party or person and the release or destruction does not conflict with statutory retention obligations for the party or the persons named in Section I.2;"

3. Item I.4 of the provisionally ordered confidentiality regulation be amended as follows:

"4. to make the Order subject to a proportionate penalty payment of at least EUR 100,000.00 for each culpable case of non-compliance;"

4. Section 1.5 of the provisionally ordered confidentiality regulation be amended as follows:

"5. to oblige the parties and the persons named under 1.2, first indent, to treat the confidential information under 1.1 as strictly confidential beyond the proceedings and to use the confidential information exclusively for the purposes of these proceedings;"

REASONS FOR THE ORDER

The Order of provisional protection of secrecy of 09/05/2024 is to be set aside to the extent requested by the defendants and confirmed in all other respects. The application must be dismissed to the extent of the cancellation.

1. In their statement of 21/05/2024, the defendants do not deny the need for protection of the information concerned by the application. The need for protection must therefore be assumed.

2. The defendants have raised the following formal objections:

a. It is possible to understand the term "authorised representative" in point 1.2 of the provisionally ordered confidentiality regulation in different ways. In this respect, a clarification to avoid misunderstandings would at least make sense.

This clarification is useful to avoid misunderstandings. The provisional Order should therefore be modified in this respect.

b. The Rules of Procedure do not provide any basis for the obligation to surrender and destroy (point 1.3 of the provisionally ordered confidentiality regulation). Furthermore, contrary to R. 262A.2 of the Rules of Procedure, the plaintiff has also not substantiated the requested obligation to surrender or destroy, so that this cannot be granted. In any case, it must be ensured that such an obligation does not conflict with conflicting legal obligations.

The Rules of Procedure do not provide any basis for the obligation to surrender and destroy. The provisional Order must therefore be cancelled in this respect.

c. Furthermore, the requested minimum amount for the threat of a penalty payment in accordance with section 1.4 of the provisionally ordered confidentiality regulation was neither sufficiently justified (contrary to R. 262A.2 VerfO) nor proportionate. There was no requirement of culpability.

For the reasons stated, the threat of a penalty payment should be amended to the effect that a penalty payment of up to € 100,000.00 can be imposed in the event of a culpable infringement. This sum was also set at this level in the German proceedings and was considered sufficient. The wording offers the possibility of penalising the smallest infringements with a lower amount. The culpability requirement is inherent to an offence, but on application

to be included.

d. Finally, the content of the obligation in point I.5 of the provisionally ordered confidentiality regulation with regard to the defendants is already contained in the second indent of point I.2 of the provisionally ordered confidentiality regulation, so that there is an unnecessary duplication of the Orders.

The duplication must be corrected.

3. It is pointed out that the court still does not have a completely unredacted version of the Reply. The Reply submitted as an "unredacted version" contains numerous redactions on pages 142-167. This approach is inadmissible (see Mannheim local division, Order of 13/06/2024; APP 35009/2024 and APP 35013/2024 in UPC CFI 219/2023).

In the present case, because the problem is being addressed by the Unified Patent Court for the first time, an exception must be made. However, the time limit for filing a duplicate is currently not running. The time limit for filing a Reply only runs from the date on which the defendants have been served with a fully unredacted Reply. This is because the defendants have a right to defend themselves comprehensively, uniformly and in full knowledge of all the plaintiff's submissions in the Reply and by exhausting the time limits provided for by the Rules of Procedure, without being forced to submit requests for extensions of time with an uncertain outcome. The defendants also have the right to respond uniformly to the Reply. If this were to be viewed differently, the redacted parts of the duplicate would have to be regarded as not having been submitted. A later submission could then be dealt with in accordance with Rule 9.2 of the Rules of Procedure.

The time limits for the counterclaim and the (alternative) amendment of the patent must be considered separately from this. These time limits are based on the defendant's decision to attack the legal validity of the patent with a counterclaim for revocation. This attack is legally independent of the compulsory licence objection under antitrust law. Redactions that clearly only concern statements on the compulsory licence objection under antitrust law therefore generally have no influence on this objection. Rule 29.d VerfO does not change this (see local division Mannheim, Order of 13/06/2024; APP 35009/2024 and APP 35013/2024 in UPC CFI 219/2023), because a

There is no contradiction between these time limits. After expiry of the time limit for filing a Reply to the Duplicate Reply to the Statement of Defence in the infringement dispute, no further exchange of documents is provided for by the Rules of Procedure in this respect, while further documents must be exchanged in relation to the application for amendment of the patent. The application for an extension of these time limits will be decided under App_33754/2024.

ORDER

1. The Order for Preliminary Protection of Secrets dated 09/05/2024 is set aside to the extent requested by the defendants and affirmed in all other respects. The application is dismissed to the extent of the cancellation.

2. The final Order on the protection of secrets is now consolidated as follows:

a. The following information is classified as confidential:

- the grey shaded versions in the Reply

- the "KAP FRAND attachments" labelled as "strictly confidential"

b. It is ordered that

- the defendants only provided the information under point 2.a to the authorised representatives in the present proceedings (ACT_545619/2023) and in the parallel proceedings between the plaintiff and the respective defendants in the proceedings before the Regional Court Munich I (ACT 21 O 9854/23, 21 O 9855/23, 21 O 9856/23 and 21 O 9429/23), before the Regional Court Mannheim (ACT 14 O 67/23, 14 O 90/23, 14 O 91/23 and 14 O 92/23), before the Munich local division of the Unified Patent Court (ACT_545562/2023 and ACT_546092/2023), the Mannheim local division of the Unified Patent Court (ACT_245615/2023, ACT_545817/2023 and ACT_545606/2023) and before the High Court of Justice of England & Wales (case number HP-2023-000025), their auxiliaries (including experts and their team members) and may not disclose it to third parties unless it can be proven that they have lawfully obtained knowledge of the classified information outside of the present proceedings and have acted within the scope of any other knowledge that may have been obtained. restrictions associated with this other acquisition of knowledge, in particular such restrictions arising from contractual confidentiality agreements.
- and that the defendants may not use this information outside these proceedings.

c. For each culpable breach of this confidentiality order, the imposition of a penalty payment of up to € 100,000.00 is threatened for each case of non-compliance.

3. The time limit for filing a Reply shall only run from the date on which the defendants have been served with a completely unredacted Reply. This does not affect the running of the time limits for filing the counterclaim for revocation and the (auxiliary) applications for amendment of the patent.

**Matthias
ZIGANN**

Digitally signed by
Matthias ZIGANN Date:
2024.07.04
13:48:37 +02'00'

Dr Zigann
Presiding judge and judge-rapporteur

ORDER DETAILS

| | |
|------------------------------|--|
| UPC number: | UPC_CFI_220/2023 |
| No. Action for infringement: | ACT_545619/2023 |
| No. Counterclaims: | CC_3450/2024;CC_3452/2024; CC_3455/2024; CC_3457/2024; CC_3458/2024; CC_3459/2024; CC_3460/2024; CC_3465/2024; CC_3470/2024; CC_3469/2024 |
| Application number: | App_21945/2024 |
| Type of application: | 262A (Reply) |