



Paris Local Division

UPC_CFI_358/2023
Procedural order
of the Court of First Instance of the Unified Patent Jurisdiction, handed
down on *02/08/2024*
concerning *R.191 RdP*

APPLICANT

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

Represented by
Grégoire
DESROUSSEAUX

DEFENDER

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

Represented by Henri BOURGEOIS

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

JUDGE WHO RULES

Chairman and Judge-Rapporteur **Camille Lignieres**

LANGUAGE OF PROCEDURE: French

ORDER

FACTS and PROCEDURE

HEWLETT-PACKARD DEVELOPEMNT COMPANY, L.P (hereinafter "HP") brought an infringement action against LAMA FRANCE (hereinafter "LAMA") before this Division on 11 October 2023 on the basis of patents EP2089230 and EP1737669.

LAMA submitted a statement of defence and a counterclaim for revocation of the patents in question.

HP then applied to amend these patents.

A final reply pursuant to R. 32.3 RdP is expected from LAMA by 16 August 2024.

It was at this stage of the written proceedings before this division that HP submitted to the judge-rapporteur an application for disclosure dated 15 July 2024 on the basis of R.191 RoP, asking the JUB to order LAMA to pay a fine of EUR 10,000 per day of delay from the date of service of the disclosure order:

- Primarily, to communicate the identity of any third parties or partners of LAMA FRANCE or its subsidiaries, involved in the production and distribution of the disputed products (article 67.1.a and c) AJUB), the corresponding invoices, even redacted, in order to confirm the identity of the designated third parties;
- In the alternative, if French law were to apply, to communicate the identity of any third parties or partners of LAMA FRANCE or its subsidiaries, outside France, involved in the production and distribution of the disputed products (article 67.1.a) and c) AJUB), the corresponding invoices, even redacted, in order to confirm the identity of the designated third parties;
- In the alternative, if the French liability regime were to apply for acts of infringement defined according to the AJUB, to communicate the identity of any third parties or partners of LAMA FRANCE or its subsidiaries, outside the countries Austria, Belgium, Denmark, France, Germany, Italy, the Netherlands, Portugal and Sweden, involved in the production and distribution of the disputed products (article 67.1.a) and c) AJUB), the corresponding invoices, even redacted, in order to confirm the identity of the designated third parties.

HP clarifies that it agrees that confidential invoice information may be redacted or that it will not object to confidentiality measures under Rule 262A of the RoP being adopted.

Following a preliminary order of the judge-rapporteur of 25 July 2024, LAMA submitted its written observations in response on 31 July 2024, opposing the request as inadmissible because infringement had not yet been established against it, untimely and unjustified in view of the facts of the case. In the alternative, LAMA proposes to limit the communication of information to certain invoices as set out on page 14 of its written observations, subject to confidentiality as provided for by R.262 A RdP, and without penalty.

REASONS

The legal framework

-Rule 191 RoP - Application for a Disclosure Order :

"The Court may, at the reasoned request of a party, order the other party or any third party to disclose information under the control of that other party or third party, as specified in Article 67 of the Agreement, or other information reasonably necessary to support the claims of that party. Rule 190(1), second sentence, (5) and (6) shall apply *mutatis mutandis*.

-Article 67 AJUB - Power to order disclosure of information :

" 1. The Court may, in response to a justified and proportionate request from the claimant and in accordance with the Rules of Procedure, order an infringer to inform the claimant of :

a) the origin and distribution channels of the contested products or processes;"

Admissibility of the application

Contrary to what LAMA claims, a request for disclosure of information on the basis of R.191 RoP is admissible in the course of proceedings, even before the existence of an offence has been established, if this is necessary for the investigation of the case at that stage of the proceedings.

The Court recalls that the Local Division of the JUB in Düsseldorf has already recognised this in the following terms: "In principle, Rule 191 of the RoP concerns information in the course of proceedings in order to oblige the parties to provide information concerning the submissions to be made (see Tilmann/Plassmann/ Ahrens, Rule 191 para. Ahrens, Rule 191 para. 1 - referring to the discovery procedure). However, the wording of the second sentence does not preclude ordering disclosure of the aforementioned information in the final decision." (UPC_CFI_7/2023 (LD Düsseldorf), decision of 3 July 2024).

The same position was adopted by this Local Division in its order of 31 July (UPC_CFI_ 425/2023, LD Paris). The Court considers that Rule 191 of the RoP can be invoked at various stages of the proceedings, in order to order the parties to communicate information during the handling of the case or at the stage of the final decision. In addition, the Court notes that it is appropriate to apply the same reasoning in relation to the right to information provided for in Directive 2004/48/EC on enforcement within the EU (Art. 8), which allows such a request to be made at any stage of the proceedings.

For these reasons, HP's application is admissible.

On the "reasoned request

The question is whether the information requested by the applicant is reasonably necessary to protect the interests of that party, in accordance with Art. 67(1) AJUB and Rule 191 of the RoP.

In its application, LAMA's main request is to communicate: "the identity of any third parties or partners of LAMA FRANCE or its subsidiaries, involved in the production and distribution of the disputed products (Article 67.1.(a) and (c) AJUB), the corresponding invoices, even redacted, in order to confirm the identity of the designated third parties".

LAMA maintains that HP's request for this information reverses the burden of proof.

The Court recalls that a request for information under R. 191 of the RoP must be sufficiently justified and proportionate to be granted.

In the present case, HP wishes, in the context of its infringement action against LAMA, to demonstrate that the latter is responsible for acts of infringement of its two patents. The question therefore arises as to whether LAMA is a manufacturer, importer and/or supplier of the allegedly infringing products in accordance with Article 25 AJUB.

The HP request itself is therefore justified. However, it is also necessary to examine whether this request is sufficiently justified and proportionate to be granted.

In this case, LAMA disputes that it is a manufacturer and importer of the products it offers to professionals.

With regard to manufacturing, at this stage of the proceedings, the only element that would make it possible to say that Lama had a role in the manufacture of the allegedly infringing products would be its own references on its website in the screen capture produced in the report of the investigation drawn up at HP's request (exhibit 49 HP): "*Lama France has been remanufacturing inkjet and laser cartridges since 1996 for various brands.*"

However, the chartered accountant's certificate clearly states that LAMA's only activity is trading, and that it has no "own production". (exhibit 49 LAMA)

In addition, LAMA clarified the role of its two subsidiaries in its written reply of 31 July 2024 by producing extracts from the Kbis of each of them.

With regard to imports, there is evidence in the file to suggest that products proposed by LAMA and allegedly infringed by HP are the subject of parallel imports into the EU market from Asia or South America. Accordingly, at this stage of the proceedings, the Court considers it necessary and proportionate to grant the request for disclosure in terms more limited than those requested by HP and more in line with the subsidiary reply made by LAMA in its observations of 31 July 2024 (page 14), namely the disclosure of :

-Invoices relating to the allegedly counterfeit cartridges, which are the subject of the dispute, and which were imported by LAMA FRANCE outside the territory of the European Union, mentioning the country of importation outside the territory of the European Union and redacting the data relating to the identification of the suppliers (such as in particular the commercial name, the address of the registered office, the identification numbers of the company, the name of the legal representative of the company).

As HP has already indicated that it is not opposed in principle to confidentiality measures relating to the information concerned, the communication of these invoices will be subject to the confidentiality measures provided for in R. 262A of the RoP, limiting access to the information to :

- a natural person for LAMA,

- an individual for HP,
- the representatives of the parties to the present proceedings before the JUB.

This injunction will not be accompanied by a penalty payment at this stage.

In order not to affect the timetable of the written procedure, the deadline for communicating these elements will be 14 days from the notification of this order on 2 August 2024. The information must be produced by 16 August 2024 (the date by which LAMA must submit its last set of pleadings in relation to HP's request for amendment of its patents in issue under R.32.3 RoP), and HP's written observations are only expected on this point by 29 August 2024.

The Judge-Rapporteur informs the parties that the written procedure will be closed on 30 August 2024 in accordance with R.35 RdP.

The status conference will be held on 6 September 2024.

FOR THESE REASONS

The Judge-Rapporteur orders LAMA France to provide the following information by 16 August 2024:

- Invoices relating to the allegedly counterfeit cartridges, which are the subject of the dispute, and which were imported by LAMA FRANCE outside the territory of the European Union, mentioning the country of importation outside the territory of the European Union and redacting the data relating to the identification of the suppliers (such as in particular the commercial name, the address of the registered office, the identification numbers of the company, the name of the legal representative of the company);
- Communication of these invoices is subject to the confidentiality measures provided for in R. 262A of the RoP, limiting access to the information to :
 - a natural person for the company LAMA FRANCE, whose name and position must be communicated by the latter before 16 August 2024,
 - a natural person for the HEWLETT-PACKARD DEVELOPMENT COMPANY, whose name and position must be provided by the latter before 16 August 2024,
- the representatives of the parties to these proceedings.
- Declares that written observations from HEWLETT-PACKARD DEVELOPPEMNT COMPANY are expected only on this point by 29 August 2024 at the latest;
- Informs the parties that the written procedure will be closed on 30 August 2024 in accordance with R.35 RdP ;
- The status conference will be held on 6 September 2024;
- this order may be reviewed at the request of a party in accordance with R. 333 RdP.

Rendered in Paris on 2 August 2024.

The Judge-Rapporteur, Camille Lignières.

 Date :
2024.08.02
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DETAILS OF THE ORDER

Order n° ORD_43600/2024 in ACTION N° ACT_578697/2023 UPC n° :
UPC_CFI_358/2023

Type of action: Infringement action

Related procedure application no.: 41706/2024

Type of application: Application for an order for the provision of information (Rule 191 of the Rules of Procedure)