



No. APP\_43992/2024, APP\_43996/2024,  
APP\_43998/2024, APP\_44003/2024,  
APP\_44010/2024, APP\_44130/2024/2024

**UPC\_CFI\_336/2024**

**ORDER**  
**of the President of the Court of First Instance**  
**in the proceedings before the Local Division Düsseldorf**  
pursuant to R. 323 RoP (language of the proceedings)  
issued on 23/08/2024

HEADNOTES:

- 1- A submission, although lodged in English, shall be declared admissible if it was not returned by the Registry as provided for by the RoP, which does not envisage any other consequence in such situation. In accordance with R. 7.1 RoP, it is for the Court to decide on a case-by-case basis whether an application pursuant to R. 323 lodged in a different language is to be rejected.
- 2- When deciding on a request to change the language of the proceedings to the language in which the patent was granted, all relevant circumstances relating to the case and to the position of the parties must be taken into account. If the balance of interests is equal – such as when both parties are international companies with significant internal resources – the position of the defendant is the decisive factor. In contrast to the language skills of the representatives of the parties, the ability for the managing directors or their equivalents on both sides to understand the language of the proceedings is a relevant consideration.

KEYWORDS:

- Change of the language of the proceedings

APPLICANTS (DEFENDANTS IN MAIN PROCEEDINGS):

**1. Aiko Energy Germany GmbH**

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**2. Solarlab Aiko Europe GmbH**

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**Represented by:** Gertjan Kuipers – Hogan Lovells

**3. Memodo GmbH**

Eichenstraße 11 a-d - 85445 – Oberding - DE

**4. Libra Energy B.V.**

Eendrachtsstraat 199 - 1951 - Velsen-Noord - NL

**5. VDH Solar Groothandel B.V.**

Finlandlaan 1 - 2391 - Hazerswoudedorp - NL

**6. PowerDeal SRL**

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**7. Coenergia Srl a Socio Unico**

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**Represented by:** Constantin Kurtz – Klaka

**RESPONDENT (CLAIMANT IN MAIN PROCEEDINGS):**

**Maxeon Solar Pte. Ltd.**

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**Represented by:** Christian Harmsen – Bird&Bird

**OTHER PARTY (DEFENDANT IN MAIN PROCEEDINGS):**

**Aiko Energy Netherlands B.V.**

Hofplein 20 - 3032 - Rotterdam - NL

**Represented by:** Gertjan Kuipers – Hogan Lovells

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**PATENT AT ISSUE:** EP3065184

## **SUMMARY OF FACTS**

By a statement of claim filed on 19 June 2024, Maxeon Solar brought an infringement action against Aiko Energy Germany GmbH, Solarlab Aiko Europe GmbH, Memodo GmbH, Libra Energy B.V., VDH Solar Groothandel B.V., PowerDeal SRL, Coenergia Srl a Socio Unico and Aiko Energy Netherlands B.V., based on EP3065184 entitled “Trench process and structure for back side contact solar cells with polysilicon doped regions” before the Local division Düsseldorf.

By generic procedural applications dated 29 and 30 July 2024, the first seven abovementioned defendants in the main proceedings requested pursuant to R. 323 RoP, that the language of proceedings be changed from German to English (hereinafter the “Application”).

The Application was forwarded by the judge-rapporteur to the President of the Court of First Instance of the UPC, pursuant to R. 323.1. RoP, by email dated 30 July 2024.

By an order dated 7 August 2024, the claimant in the main proceedings (No. ACT\_36426/2024 UPC\_CFI\_336/2024) and the other Defendant Aiko Energy Netherlands B.V. were therefore invited, in accordance with R. 323.2 RoP, to state their position within 10 days regarding the admissibility of the Application and the use of the language in which the patent was granted (English) as language of the proceedings.

Aiko Energy Netherlands B.V. and Maxeon Solar submitted their written comments on the Application on 8 and 19 August 2024, respectively.

The panel of the LD Düsseldorf has been consulted in accordance with R. 323.3 RoP.

## **INDICATION OF THE PARTIES’ REQUESTS:**

Memodo GmbH, Libra Energy B.V., VDH Solar Groothandel B.V., Power Deal SRL, Coenergia Srl a Socio Unico, Aiko Energy Germany GmbH, Solarlab Aiko Europe GmbH and Aiko Energy Netherlands B.V. (referring to the grounds indicated by the Applicants):

- request the Court to order the language of the proceedings to be changed to the language in which the patent at issue has been granted, namely English;
- do not request a translation of the existing pleadings and other documents pursuant to Rule 324 RoP.

Maxeon Solar Pte. Ltd requests the Court to dismiss the Application to change the language of the proceedings.

A German version of the Application is provided as an exhibit for each statement.

**POINTS AT ISSUE:**

It is stated that the Application must be granted for the following reasons:

- Prior attempts to reach an amicable solution were unsuccessful and ultimately rejected by Maxeon Solar without providing further justification;
- The Application although lodged before the Statement of Defense, is admissible;
- The balance of interests in the present case clearly favours the Defendants;
- English is the language commonly used in the relevant field of technology, as confirmed by the Claimant's request to be exempted from the obligation to provide German translations of the exhibits;
- With respect to the intended counterclaim for revocation of the patent at issue, most of the prior art documents cited in previous validity proceedings before a national court concerning the parent application are in English;
- Only three of the eight Defendants are based in Germany, while the parent company of the AIKO Group, the manufacturer of the accused products, is based in China, meaning that communication and coordination among the Defendants will occur in English;
- Being sued before the UPC in a language that the defendant does not master poses a significant disadvantage, which is not mitigated by the assistance of representatives fluent in German. Conversely the requested change would not be a burden for Maxeon Solar, which is based in Singapore and whose working language within its corporate structure is most probably English;
- Changing the language would not delay the proceedings, but would instead enhance efficiency and reduce translation costs;
- Other proceedings related to the parent application of the patent at issue are pending in the Netherlands and in Germany, where the technical evidence submitted as well as the prior art are predominantly in English;
- Finally, considering the respective size of the parties involved, changing the language of the proceedings would have no detrimental impact on the Claimant.

Maxeon Solar Pte. Ltd objects to the Application for the following reasons:

- The Applicants have lodged their submissions in English, which is not the language of the proceedings, and the German version provided as Annex 1 – labelled as “exhibits” – cannot be considered a valid “procedural pleading”. The Application is therefore inadmissible pursuant to R. 7.1 RoP;
- The Claimant chose German as the language of proceedings when initiating the action before the Düsseldorf Local Division;
- Defendants 1) - 3), with their registered office in Germany, conduct regular business in the country and are legally required to handle disputes and administrative matters before German courts;
- English is not an official language in the Netherlands whereas German (including dialects), is widely spoken in many parts of the country; in addition, Belgium – where one of the Defendants has its registered offices – has three official languages including German, which is also recognised as regional official language in some parts of Italy;
- The language skills of managing directors are irrelevant, as it is a variable factor. Moreover, the CofA has clarified that representatives’ teams typically operate in multilingual environments;
- German is being used in other legal disputes involving the same parties. Additionally, the Claimant is also conducting preliminary injunction proceedings in Dutch against three Defendants before the national court in The Hague;
- As regards the relative sizes of the parties, the Aiko Group – likely conducting proceedings for all defendants – is the third-largest supplier of solar modules in 2022;
- Recent job postings by Defendants based in Germany have sought German-speaking candidates;
- It was not the decision of the legislator to standardize the language of the patent as the language of the proceedings;
- The Applicants have not presented any relevant circumstances to justify the requested amendment and have failed to explain how their right to a fair trial could be compromised if the proceedings continue in German.

Further facts and arguments raised by the parties will be addressed below if deemed relevant to the outcome of this order.

## **GROUNDINGS FOR THE ORDER:**

### **1- Admissibility of the Application**

Maxeon Solar initially states that the Application should have been submitted in the language of the main proceedings and that translations provided as “exhibits” cannot be regarded as valid pleadings.

Pursuant to R. 7.1 RoP titled “language of written pleadings and written evidence” - “[w]ritten pleadings and other documents, including written evidence, shall be lodged in the language of the proceedings unless the Court or these Rules otherwise provide” and according to R. 14.4 “[t]he Registrar shall return any pleading lodged in a language other than the language of proceedings”.

In the present case, although the disputed submissions were lodged in English, they were not returned by the Registry as foreseen by the RoP, which does not prescribe any other consequence for this specific situation. According to R. 7.1 RoP, it is within the Court’s discretion to decide on a case-by-case basis whether an application lodged in a different language under R. 323 RoP should be rejected (UPC CFI 373/2023 – LD Düsseldorf – Order of 16/01/2024). Given that translations were provided alongside the English version, there is no further compelling reason to reject the submissions at this stage.

The Applications shall thus be declared admissible.

### **2- Merits of the Application**

According to Art. 49(1) UPCA, the language of the proceedings before a local division must be an official language of its host Member State, or alternatively, the other language designated pursuant to Art. 49 (2). It is further provided by R. 323 RoP that “1. *If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(5) of the Agreement (...) [t]he President, having consulted [the other parties and] the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements*”.

Regarding the criteria that may be considered in deciding on the Application, Art. 49 (5) UPCA specifies that “(...) *the President of the Court of First Instance may, on grounds of fairness and taking into account all relevant circumstances, including the position of parties, in particular the position of the defendant, decide on the use of the language in which the patent was*

*granted as language of proceedings. In this case the President of the Court of First Instance shall assess the need for specific translation and interpretation arrangements”.*

It has furthermore been stated that Art. 49 (5) UPCA must be interpreted to mean that the decision on whether or not to change the language of the proceedings to the language in which the patent was granted must be based on a consideration of the respective interests at stake, without the requirement that it constitute a disproportionate disadvantage (UPC CFI 225/2023 LD The Hague, order of 18 October 2023, UPC CFI 373/2023 LD Düsseldorf, order of 16 January 2024, UPC CFI 410/2023 LD Mannheim, order of 15 April 2024).

By an order dated 17 April 2024, the UPC Court of Appeal (hereinafter “CofA”) ruled that when deciding on a request to change the language of the proceedings to the language of the patent for reasons of fairness, all relevant circumstances must be taken into account. These circumstances should primarily relate to the specifics of the case, such as the language most commonly used in the relevant field of technology, as well as the position of the parties, including their nationality, domicile, respective size, and how they might be affected by the requested change (UPC\_CofA\_101/2024, Apl\_12116/2024, para. 22-25).

In the event that the balancing of interests yields an equal result in the context of this overall assessment, the CofA found that the emphasis placed “in particular” on the position of the defendant under Art. 49 (5) UPCA is justified by the flexibility afforded to the claimant which frequently has the choice of where to file its action – since any local or regional division in which an infringement is actually threatened or occurring is competent – and can generally choose the most convenient timeframe to draft its Statement of Claim, while the defendant is in contrast typically bound by strict deadlines.

Based on the above, it follows that the position of the defendant (s) is the decisive factor if both parties are in a comparable situation.

In the same decision, the CofA also held that “for a claimant, having had the choice of language of the patent, with the ensuing possibility that the claimant/patentee may have to conduct legal proceedings in that language, as a general rule and absent specific relevant circumstances pointing in another direction, the language of the patent as the language of the proceedings cannot be considered to be unfair in respect of the claimant” (para. 34).

In the present case, it is not disputed that English is the commonly used language in the relevant field of technology, relating to solar cells and in particular their fabrication and structures. This is particularly evident in the prior art cited in the patent at issue and is acknowledged in the Statement of Claim which supports the requested exemption from

translating exhibits which are provided in English, given the specialized literature and terminology involved.

Regarding the situation of the Defendants, three entities – two from the Chinese Aiko Group, identified as the manufacturers of the products in question, and Memodo – have their registered offices in Germany. Three others are based in the Netherlands with the remaining Defendants based in Belgium and Italy, respectively. In this context, as correctly noted by the Applicants, it is reasonable to assume that the technical expertise needed to address the dispute will primarily be provided in English.

Furthermore, while Aiko Energy Germany, Solarlab Aiko Europe and Memodo clearly use the official language of the location in which they operate and therefore must recruit employees including managing directors who speak German, as highlighted by Maxeon Solar, this does not necessarily apply to other Defendants based in the Netherlands, Belgium and Italy. Even if it were confirmed that German is used as a regional language in parts of these countries, this argument is not pertinent to the decision on the Application. The broader territorial scope of the companies' activities involved in the dispute means that their situation is not influenced by this regional language context.

Regarding the respective size of the parties, particularly in terms of corporate resources and logistic support, Maxeon Solar and Aiko appear comparable for the purpose of the Application, as both are international companies operating in multiple countries. In contrast, the other defendants are described by the Claimant as national wholesalers most probably relying on the Aiko group for their defence. The fact that the Aiko Group was cited as the third-largest supplier of solar modules in 2022 by the US Department of Energy does not undermine this assessment, as Maxeon Solar is itself a spin-off entity of the US company SunPower.

Another point addressed is the language skills of the directors and legal representatives of the companies involved. Contrary to the Respondent's assertion, this question is not irrelevant. Maxeon Solar refers to the abovementioned decision of the CofA, which ruled that "whether a representative has specific language skills is in general of no significance" in international disputes where multilingual and multi-disciplinary teams are involved. However, this cannot be extended to managing directors or similar positions within legal departments, who – as also noted by the CofA in the same decision – "must be able to fully understand what is submitted by a representative on its behalf" and by the other party (UPC\_CofA\_101/2024, Apl\_12116/2024, para. 23 and 26). It is therefore relevant to note that the main contact person for the legal representatives within the Aiko group does not speak German and that the Chief Legal & Sustainability Officer from Maxeon is an English speaker.



To summarize, it appears that changing the language of the proceedings would greatly facilitate the coordination among the Defendants – especially those that are not German entities – while not posing any detriment to the Claimant which operates and communicates in English.

As the balancing of interests in this case appears to be equal based on the above, without it being of particular relevance to address other parallel proceedings before national courts which are handled in German and Dutch, for the abovementioned reasons identified by the Court of Appeal (UPC\_CofA\_101/2024 Apl\_12116/2024, para. 28 - 30), the position of the Defendants is the decisive factor to be considered in the overall assessment. In addition, none of the circumstances raised by the parties in the context of the present Applications can be deemed “specific” grounds sufficient to deviate from the general rule that “the language of the patent as the language of the proceedings cannot be considered to be unfair in respect to the Claimant” (UPC\_CofA\_101/2024, Apl\_12116/2024, para. 34).

The Applications to change the language of the proceedings to the language of the patent must consequently be granted.

### **3- Consequence of changing the language during the proceedings**

According to R. 324 RoP, an application under R. 321.1 or 323.1 shall specify whether existing pleadings and other documents should be translated and at whose cost. If the parties cannot agree, the judge-rapporteur or the President of the Court of First Instance, as applicable, shall decide in accordance with R. 323.3 RoP, which states that the deciding judge “*may make the order conditional on specific translation or interpretation arrangements*”. In the absence of any specific request from the Defendants in this respect, it is assumed at this stage that no further interpretation or translation arrangements are required.

### **FOR THESE GROUNDS**

- 1- The application is granted and the language of the proceedings shall be changed from German to English.
- 2- The present order shall not be conditional on specific translation or interpretation arrangements.
- 3- An appeal may be brought against the present order within 15 calendar days of its notification to the Applicants pursuant to Art. 73. 2 (a) UPCA and R.220 (c) RoP.

**INSTRUCTIONS TO THE PARTIES AND TO THE REGISTRY:**

The next step is for the Applicants and other Defendant to file the Statement of Defence within the time period as set by the Judge-rapporteur.

ORDER

Issued on 23 August 2024

**NAME AND SIGNATURE**

**Florence Butin**  
**President of the UPC Court of First Instance**