



LISBON – LOCAL DIVISION
UPC_CFI_317/2024
ACT 35572/2024

ORDER

of the Court of First Instance of the Unified Patent Court

issued on **23 August 2024**

APPLICANT IN PRELIMINARY INJUNCTION PROCEEDINGS:

TELEFONAKTIEBOLAGET LM ERICSSON

represented by Mr. Wim Maas
Mr. Eelco Bergsma
Mr. Manuel Durães Rocha

DEFENDANTS IN PRELIMINARY INJUNCTION PROCEEDINGS:

1. ASUSTEK COMPUTER INC
2. ARVATO NETHERLANDS B.V.
3. DIGITAL RIVER IRELAND LTD.

all represented by Mr. Alex Wilson
Mr. Ari Laakkonen
Mr. Adam Rimmer
Ms. Sara Nazaré
Ms. Joana Piriquito Santos

PATENT AT ISSUE:

EUROPEAN PATENT NO EP 2 819 131 B1

PANEL:

Presiding judge and
Judge-rapporteur: Rute Lopes
Legally qualified judge: Sam Granata
Legally qualified judge: Petri Rinkinen

DECIDING JUDGE:

This order was issued by Judge Rute Lopes acting as judge-rapporteur.

SUMMARY OF FACTS AND ORDER SOUGHT BY THE PARTIES

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By generic application of 15 August 2024 (related proceedings App_47284/2024), Applicant Ericsson requested leave to amend its claim unconditionally so that the Court:

(a) grants a preliminary injunction for direct infringement of the Patent by prohibiting the Defendants ASUSTek and Digital River Ireland, individually and jointly, from infringing the Patent in any way, with immediate effect after service of the order to be rendered in this matter, in particular by offering and/or selling infringing products (such as laptops and notebooks) that contain either the Intel Wi-Fi 6E AX211 Module (“AX2011”) or the Intel Wi-Fi 6 AX201 Module (“AX2101”), hereafter referred to as the “Infringing Products” (Articles 623(1) and 25(a) UPCA);

or in the discretion of the Court, in the alternative,

grants a preliminary injunction for infringement of the Patent by prohibiting ASUSTek and Digital River Ireland, individually and jointly, from infringing the Patent with immediate effect after service of the order to be rendered in this matter, by offering and/or selling infringing products (such as laptops and notebooks) that contain either the Intel Wi-Fi 6E AX211 Module (“AX211”) or the Intel Wi-Fi 6 AX201 Module (“AX201”), hereafter referred to as the “Infringing Products” (Articles 62(1) and 25(a) UPCA);

(b) prohibits Arvato with immediate effect after service of the order to be rendered in this matter, to render storing, shipping and/or repairing services to ASUSTek and/or Digital River Ireland in relation to ASUS branded products that contain the AX201 and AX211 modules. (Article 62(1) UPCA);

c) orders the Defendants ASUSTek and Digital River Ireland to provide counsel for Ericsson, within four (4) weeks after service of the order rendered in this matter, with a written statement, substantiated with appropriate documentation of:

(i) the origin and distribution channels of the Infringing Products including the full names and addresses of the legal entities that are involved in the manufacture of and trade in these systems;

(ii) the quantities marketed and sold, as well as the price obtained for the Infringing Products in the Contracting Member States in which the Patent is in force and the total turnover and net profit made in selling the Infringing Products; and

(iii) the identity of any third party involved in the sale, marketing and / or distribution of the Infringing Products in the Contracting Member States in which the Patent is in force (including the full names and addresses of the

legal entities that are involved), (Article 62(1) and 67 UPCA; and Rule 211 RoP);

(d) orders the Defendants to deliver up to a bailiff appointed by Ericsson, at their own expense, or alternatively orders the seizure, of any Infringing Products in stock and / or otherwise held, owned or in the direct or indirect possession of the Defendants in the Contracting Member States in which the Patent is in force, within one (1) week after service of the order to be rendered in this matter, and to provide counsel for Ericsson with proper evidence of the full and timely compliance with this order within ten (10) days after the delivery up to the bailiff or seizure (Article 62(3) UPCA; Rule 211(1) RoP);

(e) orders the Defendants to comply with the orders under 8(a) – 8(d) above, subject to a recurring penalty payment of up to EUR 250,000.00 or another amount as the Court may order, to the Court for each violation of, or non-compliance with, the order(s), plus up to EUR 100,000.00 for each day, or part of a day counting as an entire day, that the violation or non-compliance continues, or another amount as determined by this Court in the proper administration of justice (Article 62(2) UPCA; Rule 354(3) RoP);

(f) appends an order for the enforcement to its decision, while declaring that the order is immediately enforceable (Article 82(1) UPCA);

(g) orders the Defendants to jointly and severally bear reasonable and proportionate legal costs and other expenses incurred by Ericsson in these proceedings and orders, insofar such costs are to be determined in separate proceedings for the determination of such costs, that the Defendants pay to Ericsson by means of an interim award of costs of the sum of EUR 11,000 or another amount as the Court may order (Article 69 UPCA; Rule 118(5) and Rule 150(2) 211(1)(d) RoP).

- 2 The Applicant grounded its request on the circumstance that Defendant Arvato acts as an intermediary, and to avoid unnecessary discussions or potential enforcement issues, claims regarding this Defendant should be limited to its intermediary position. The Applicant also stated that the factual basis for this amendment is the same as for the initial claims.
- 3 The Applicant also corrected its erroneous references to Article 63 UPCA (which should have been references to Article 62 UPCA) and the reference to Rule 118(5) and 150(2) RoP (which should have been a reference to Rule 211(1)(d) RoP); and the erroneous defined Modules in par. 1.1(a) of the Application, where it's written "*WiFi 6E AX 211 Module ("AX201")*" or *WiFi 6 AX201 Module ("AX211")*", should be "*WiFi 6E AX 211 Module ("AX211")*" or *WiFi 6 AX201 Module ("AX201")*".
- 4 Due to the impossibility to file a reply in the same generic application (App_47284/2024), the Defendants replied to the Applicant in this generic application, requesting that the Court gives leave to the Applicant to change its claim as requested.

GROUNDS FOR THE ORDER

- 5 The leave for a change of claim is granted as the requested amendments limit the original claims.
- 6 According to R. 263.3 RoP leave to limit a claim unconditionally in an action shall always be granted.
- 7 In this particular case, Defendants did not oppose to the amendments and agreed that they limit the scope of the original claims.
- 8 And the Court agrees that the unconditional request limits the scope of the initial claims regarding Defendant Arvato. In its Application for preliminary injunction, Ericsson requested the Court to grant a general injunction against all Defendants according to R. 25(a) and 62(1) UPCA, and now, the Applicant requests that Defendant Arvato should no longer be considered to be infringing according to Art. 25(a) UPCA, but regarded as an intermediary according to Art. 62(1) UPCA, whose services are used by the other Defendants to infringe the Patent.

ORDER

1. The Court allows the amendment as requested by the Applicant to unconditionally limit its initial claim.
2. The request of the Applicant is now as follows (amendments underlined and corrections of erroneous references inserted):

The Applicant requests that the Court:

(a) grants a preliminary injunction for direct infringement of the Patent by prohibiting the Defendants ASUSTek and Digital River Ireland, individually and jointly, from infringing the Patent in any way, with immediate effect after service of the order to be rendered in this matter, in particular by offering and/or selling infringing products (such as laptops and notebooks) that contain either the Intel Wi-Fi 6E AX211 Module (“**AX211**”) or the Intel Wi-Fi 6 AX201 Module (“**AX201**”), hereafter referred to as the “**Infringing Products**” (Articles 62 (1) and 25(a) UPCA);

or in the discretion of the Court, in the alternative,

grants a preliminary injunction for infringement of the Patent by prohibiting ASUSTek and Digital River Ireland, individually and jointly, from infringing the Patent with immediate effect after service of the order to be rendered in this matter, by offering and/or selling infringing products (such as laptops and notebooks) that contain either the Intel Wi-Fi 6E AX211 Module (“**AX211**”) or the Intel Wi-Fi 6 AX201 Module (“**AX201**”), hereafter referred to as the “**Infringing Products**” (Articles 62(1) and 25(a) UPCA);

(b) prohibits Arvato with immediate effect after service of the order to be rendered in this matter, to render storing, shipping and/or repairing services to ASUSTek and/or Digital River Ireland in relation to ASUS branded products that contain the AX201 and AX211 modules. (Article 62(1) UPCA);

(c) orders the Defendants ASUSTek and Digital River Ireland to provide counsel for Ericsson, within four (4) weeks after service of the order rendered in this matter, with a written statement, substantiated with appropriate documentation of:

(i) the origin and distribution channels of the Infringing Products including the full names and addresses of the legal entities that are involved in the manufacture of and trade in these systems;

(ii) the quantities marketed and sold, as well as the price obtained for the Infringing Products in the Contracting Member States in which the Patent is in force and the total turnover and net profit made in selling the Infringing Products; and

(iii) the identity of any third party involved in the sale, marketing and / or distribution of the Infringing Products in the Contracting Member States in which the Patent is in force (including the full names and addresses of the legal entities that are involved), (Article 62(1) and 67 UPCA; and Rule 211 RoP);

(d) orders the Defendants to deliver up to a bailiff appointed by Ericsson, at their own expense, or alternatively orders the seizure, of any Infringing Products in stock and / or otherwise held, owned or in the direct or indirect possession of the Defendants in the Contracting Member States in which the Patent is in force, within one (1) week after service of the order to be rendered in this matter, and to provide counsel for Ericsson with proper evidence of the full and timely compliance with this order within ten (10) days after the delivery up to the bailiff or seizure (Article 62(3) UPCA; Rule 211(1) RoP);

(e) orders the Defendants to comply with the orders under 8(a) – 8(d) above, subject to a recurring penalty payment of up to EUR 250,000.00 or another amount as the Court may order, to the Court for each violation of, or non-compliance with, the order(s), plus up to EUR 100,000.00 for each day, or part of a day counting as an entire day, that the violation or non-compliance continues, or another amount as determined by this Court in the proper administration of justice (Article 62(2) UPCA; Rule 354(3) RoP);

(f) appends an order for the enforcement to its decision, while declaring that the order is immediately enforceable (Article 82(1) UPCA);

(g) orders the Defendants to jointly and severally bear reasonable and proportionate legal costs and other expenses incurred by Ericsson in these proceedings and orders, insofar such costs are to be determined in separate proceedings for the determination of such costs, that the Defendants pay to

Ericsson by means of an interim award of costs of the sum of EUR 11,000 or another amount as the Court may order (Article 69 UPCA; Rule 118(5) and Rule 150(2) 211(1)(d) RoP).

ORDER DETAILS

Order no. 48428/2024 in related Generic Applications: 48229/2024 and 47284/2024

UPC number: UPC_CFI_317/2024

Application Type: Application for provisional measures