



**Munich local division  
UPC\_CFI\_9/2024**

**Procedural order  
of the Court of First Instance of the Unified Patent Court  
local division Munich  
issued on 30 August 2024**

PLAINTIFF

**Huawei Technologies Co. Ltd**

represented by: Dr Tobias J. Hessel (Clifford Chance).

DEFENDANT

- 1) Netgear Germany GmbH**
- 2) Netgear Inc.**
- 3) Netgear International Limited**

represented by: Dr Stephan Dorn (Freshfields).

PATENT IN SUIT

European patent no. 3 611 989.

JUDICIAL BODY/CHAMBER

Panel 1 of the Munich local division.

PARTICIPATING JUDGES

This Order was issued by presiding judge Dr Matthias Zigann as judge-rapporteur.

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LANGUAGE OF THE PROCEEDINGS

German.

OBJECT

Action for infringement - Rule 105.5 RoP.

PRESENTATION OF THE FACTS

The applicant, based in Shenzhen, China, was founded in 1987 and is a leading global provider of information and communication technology, infrastructure and intelligent devices. It has approximately 197,000 employees worldwide and operates in over 170 countries and regions. The applicant is an active member of more than 600 standardisation organisations, industry alliances and open source communities, where it works with others to develop mainstream standards and technically advance the industry. The applicant invests over 10% of its turnover in research and development each year. In the last ten years, it has invested a total of more than 977 billion RMB (approx. 129 billion euros) in research and development. This puts the applicant in second place worldwide among companies with the most investment in research and development, as shown in "The 2021 EU Industrial R&D Investment Scoreboard"

(<https://iri.jrc.ec.europa.eu/sites/default/files/contenttype/scoreboard/2021-12/EU%20RD%20Scoreboard%202021%20FINAL%20online.pdf>). The applicant has also been one of the companies with the most patent applications worldwide for years.

Defendant 1) is a company based in the USA that manufactures and sells network products for private and business use. It describes itself as "a leading global provider of Wi-Fi solutions". With the introduction of the new Wi-Fi 6 standard, the defendant 1) offers a variety of products (including routers, modems, mesh systems, switches, repeaters, etc.), especially for private users, which it prominently advertises for the use of Wi-Fi 6 (see: <https://www.netgear.com/de/home/discover/wifi6/>). On its website, the defendant emphasises that

1) the benefits that Wi-Fi 6 brings to their products and explicitly promotes these benefits of Wi-Fi 6 as "the biggest Wi-Fi revolution ever".

Defendant 2) is a subsidiary of defendant 1) with its registered office in Munich, through which the German business, including distribution, is handled.

Defendant 3) is also a subsidiary of defendant 1) based in Ireland, which operates the online shop for the German business.

The plaintiff is the sole proprietor of the European patent EP 3 611 989 B1 (hereinafter referred to as the patent in suit; Annexes K2-5 and K11), which was granted, inter alia, with effect in the Federal Republic of Germany. The patent in suit is also in force with identical claims in the following member states of the UPCA: Belgium, Denmark, Italy, Finland, France and Sweden. The patent in suit claims the priority of CN 201510555654 of 1 September 2015 and is based on a European patent application of 31 August 2016. The notice of grant of the patent in suit was published by the European Patent Office on 26 May 2021.

The plaintiff is suing the defendants for infringement of the patent in suit by manufacturing and distributing devices that use the Wi-Fi 6 standard, inter alia for injunctive relief. The patent in suit was declared to the standardisation organisation IEEE as standard-essential for the Wi-Fi 6 standard (802.11ax standard). The defendants are defending themselves with three (identical) nullity counterclaims and with arguments of

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Non-infringement and exhaustion in relation to devices with Qualcomm modem chips (KE # 234 et seq.). Furthermore, the defendants raise the antitrust objection (KE # 436 et seq.) and a contractual (Annex FBD12-24; KE # 248 et seq.) compulsory licence objection.

The plaintiff defends the patent in suit with six auxiliary requests (Annex K25).

As far as can be seen, the following documents were submitted in the actions for annulment:

Patent in suit	K2-5 and K11
Characteristic classifications	K12 FBD11
UrAnspr	which in English language of the original claims of the patent in suit
UrAnm	in Chinese language drafted divisional application
UrAnmÜ	English translation of the original application as filed with the EPO by the then applicant
CT-PE2-ÜP	Translation by the defendant of the UrAnm
TrunkNote WO 2017/036402 A1	English translation of the parent applicationCN, as filed with the EPO by the then applicant
StammAnmCN WO 2017/036402 A1	parent application drafted in Chinese (published as publication WO 2017/036402 A1)
PrioNm	in Chinese language drafted priority application CN 2015/10555654
PrioNotification	English translation of the PrioAnm, as filed with the EPO by the then applicant
PrioAnmÜ-SP (duplicate)	English translation of the defendants of the PrioAnm
K42	Translation of the plaintiff from StammAnmCN, UrAnm, PrioAnm
D1a - Novelty	IEEE Submission 802.11-16/0039r1
D1b - Novelty	IEEE Submission 802.11-15/1304r1
D2	IEEE Submission 802.11-15/0805r2
D3	IEEE Submission 802.11-15/0344r2

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D4	US 2014/0 307 612 A1
D5 - Novelty	EP 3 318 030 B1
EPD1	IEEE Submission 802.11-15/0132r7
EPD2 - inventive step with D2/D3/D4	IEEE Submission 802.11-15/0873r0
EPD3	IEEE Submission 802.11-15/0821r2

### Further proceedings between the parties

On 2 March 2022, the plaintiff filed two infringement actions against the defendants 1) and 2) before the Düsseldorf Regional Court. The action under action number 4c O 9/22 relating to EP 3 143 741 B1 was dismissed by the Düsseldorf Regional Court in a judgement dated 11 May 2023 (Annex FBD 5), whereby the plaintiff has already appealed against this judgement to the Düsseldorf Higher Regional Court (case no. I-2 U 63/23; the date for the appeal hearing is 27 March 2025). The proceedings pending under case number 4c O 8/22 relating to EP 3 337 077 have been suspended until a decision has been reached on the nullity proceedings pending before the Federal Patent Court against the patent in suit there (Annex FBD6).

The nullity proceedings against EP 3 143 741 B1 are pending before the Federal Patent Court under case no. 2 Ni 20/22 (EP), and those against EP 3 337 077 under case no. 2 Ni 22/22 (EP).

Netgear Switzerland GmbH has filed a nullity action against the patent in suit before the Federal Patent Court (Ref. 4 Ni 33/23 (EP)).

In proceedings 4c O 8/22 before the Düsseldorf Regional Court, the defendant 1) submitted test files relating to the product "Nighthawk RAX200" with a Broadcom modem chip and the product "Orbi WiFi 6 router AX6000" with a Qualcomm modem chip (Reply # 46) (Annex K24), which were intended to prove the non-infringement of an asserted patent of the plaintiff in the proceedings there.

In the present proceedings, the plaintiff argues that it examined the files submitted by the defendant in the Düsseldorf proceedings for the functionality relevant here in accordance with the patent in suit (statement of claim # 153 et seq.). The plaintiff is of the opinion that the patent infringement can be proven not only on the basis of the standard, but also on the basis of this test data.

### Course of the present proceedings

The plaintiff filed the present action on 2 July 2023. It was served on the defendants on 14, 15 and 28 August 2023.

The defendants filed an objection on 7 September 2023 (App\_570172/2023). On 30 October 2023, the judge-rapporteur informed the parties pursuant to Rule 20.2 RoP that the objection was to be dealt with in the main proceedings. The defendants opposed this with Rule 333 applications and an (allowed) appeal, which were decided by the judge-rapporteur and, following the decision of the Court of Appeal of 21 March 2024 (APL\_595643/2023), by the Chamber as follows: Orders of 11 December 2023 (App\_586381/2023), 23 January 2024 (App\_595631/2023) and dated 8 April 2024 (App\_595611/2023):

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- 1. The ruling of the presiding judge Matthias Zigann as judge-rapporteur pursuant to Rule 20.2 RoP of 30/10/2023 that the defendant's objection of 07/09/2023 is to be dealt with in the main proceedings is confirmed by the panel.*
- 2. In all other respects, the defendants' applications are dismissed insofar as they have not been settled.*
- 3. The appeal is not authorised.*

The extension of the action to include claims from patent EP 3 678 321 of 23 November 2023 was admitted by the Board on 11 December 2023 (App\_587438/2023; App\_595631/2023). The subject matter of the admitted extension was separated on 24 January 2024 (ORD\_593105/2023). The new file number is ACT\_18917/2024 UPC\_CFI\_168/2024. The defendants' appeals against this were unsuccessful (APL\_4881/2024 UPC\_CoA\_36/2024; APL\_5395/2024 UPC\_CoA\_44/2024).

By Order of 9 February 2024 (ORD\_2858/2024), the Board decided, on the unanimous application of all parties, that the Munich local division would hear both the infringement action and the three nullity counterclaims.

Order of 9 February 2024 was issued by the judge-rapporteur (ORD\_2866/2024):

- 1. The language of the proceedings remains German.*
- 2. The oral hearing and the interim hearing as well as the oral hearing will nevertheless be held in English.*
- 3. The party representatives are requested to provide the court with their working translations into English of the documents already submitted and those still to be submitted, if this has not already been done, by uploading them to the CMS within two working days. In this respect, an upload option will be provided within the present workflow.*

A separate hearing was held by video conference on 19 February 2024. This was ordered by the judge-rapporteur (App\_6074/2024; reasons ORD\_8868/2024):

- 1. The video conference of 19/02/2024 is to be regarded as a separate hearing pursuant to Rule 334.d RoP.*
- 2. The recording of this separate hearing will be made available to the parties or their representatives at the premises of the Munich local division upon application (Rule 106 analogue RoP).*
- 3. The right to schedule an interim hearing is reserved (Rule 35.b RoP).*
- 4. The combined electronic filing of the defence to the infringement action, the defence to the revocation counterclaims and the auxiliary requests for amendment of the patent in the workstream of the infringement action on 29/01/2024 was effective and triggered the start of the time limit for the defendants under Rule 32.1 RoP on the same day.*

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5. *The parties may submit the following documents until the conclusion of the written procedure:*

- a. *Defendant: 02/04/2024*
- b. *Applicant:02/05/2024*
- c. *Defendant: 03/06/2024*

*In this document, they may also address topics that have been raised today in addition to those addressed in the Rules of Procedure, provided that they do so immediately in the earliest document available to them.*

6. *The written procedure ends on 03/06/2024.*

7. *The hearing date of 18/06/2024 (additional day 19/06/2024), 9.00 a.m., local division Munich, Denisstr. 3, room 212, is confirmed. The language of the hearing will be English.*

8. *The value of the infringement action is set at € 1 million. The value of the three actions for annulment is set at € 1 million. The value of the proceedings is set at € 2 million.*

9. *In all other respects, the defendants' applications of 02/02/2024 and 19/02/2024 are dismissed.*

By Order of 17 May 2024 (App\_26587/2024), the date for the oral hearing was postponed to 30-31 October 2024 at the defendant's application.

By Order dated 27 May 2024 (App\_31099/2024), the date of the interim date was set for 29 August 2024.

As far as can be seen, the following main documents and relevant additional documents of the parties have been submitted so far:

Party	Content and date	Workflow	Translation of
K	Statement of claim dated 2 July 2023 K1-K21	ACT_459771/2023	ORD_2866/2024
B	Objection from 23 September 2023	App_570172/2023	ORD_2866/2024
K	Defence to objection dated 18 September 2023	App_570172/2023	ORD_2866/2024
B	Opinion (objection) dated 27 September 2023	App_570172/2023	ORD_2866/2024
K	Statement (objection)	App_570172/2023	ORD_2866/2024

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	From 2 October 2023		
B	Statement of defence From 17 November 2024 FBD 1-FBD30 D1-D4 EPD1-EPD3 PrioAnm PrioAnmUE SPS StammAnm UrAnm UrAnmUE UrAnspr	ACT_459771/2023	ORD_2866/2024
B	Action for annulment (NWK) from 17 November 2023 FBD 1-FBD30 D1-D4 EPD1-EPD3 PrioAnm PrioAnmUE SPS StammAnm UrAnm UrAnmUE UrAnspr	CC_586627/2023 CC_588071/2023 CC_588080/2023	ORD_2866/2024
K	Reply From 29 January 2024 K25-K32	ACT_459771/2023	ORD_2866/2024
K	Defence to NWK From 21. February 2024 K25-K32	CC_586627/2023 CC_588071/2023 CC_588080/2023	ORD_2866/2024
K	Application to amend the patent (ÄA) K25-K32 from 21 February 2024	App_9267/2024 App_9262/2024 App_9258/2024	ORD_2866/2024
B	Application for submission of evidence From 23 February 2024	App_9728/2024	App_9728/2024

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	FBD41-44		
B	Duplicate From 2 April 2024 D5 FBD41-FBD47 PCT-PE2-UEP PrioAnmUE-SP StammAnmCN	ACT_459771/2023	
B	Reply to NWK dated 2 April 2024 D5 FBD41-FBD47 PCT-PE2-UEP PrioAnmUE-SP StammAnmCN	CC_586627/2023 CC_588071/2023 CC_588080/2023	
B	Defence to ÄA of 2 April 2024 D5 FBD41-FBD47 PCT-PE2-UEP PrioAnmUE-SP StammAnmCN	App_9267/2024 App_9262/2024 App_9258/2024	
K	Statement on application for submission of evidence From 14. April 2024 K33-35	App_9728/2024	App_9728/2024
K	Submission against itself From 23 April 2024 K36	App_22295/2024	App_22295/2024
B	Application for the taking of evidence and submission of evidence From 25 April 2024 FBD48-50	App_22455/2024	App_22455/2024
K	Submission against itself From 29 April 2024 CC 01	App_23552/2024	App_23552/2024



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B	Defence to motion for reference against itself From 29 April 2024	App_22295/2024	
K	Submission against itself From 7 May 2024	App_25868/2024	App_25868/2024
K	Template licence agreement from 7 May 2024 K48, 67	App_22295/2024	App_22295/2024
K	Licence agreement template dated 8.5.2024 K68-69	App_9728/2024	App_9728/2024
K	Opinion on the submission against itself dated 10 May 2024	App_25868/2024	App_25868/2024
B	Opinion on the submission against itself dated 14 May 2024 FBD51	App_25868/2024	
K	Opinion on the submission against itself dated 10 May 2024 K70	App_23552/2024	App_23552/2024
B	Opinion on the submission against itself dated 14 May 2024	App_23552/2024	
K	Duplicate on NWK from 1 May 2024 K38- K42	CC_586627/2023 CC_588071/2023 CC_588080/2023	CC_586627/2023
K	Reply to AA From 1 May 2024 K38-K42	App_9267/2024 App_9262/2024 App_9258/2024	App_9267/2024

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K	Statement on the application for the taking of evidence and submission of evidence  From 30 May 2024  K71-82	App_22455/2024	App_22455/2024
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K	Statement interim hearing From 5 June 2024	App_31099/2024	App_31099/2024
B	Statement interim hearing From 6 June 2024	App_31099/2024	
B	Duplicate of AA of 3 July 2024 Extract from EPO case law FBD51	App_9267/2024 App_9262/2024 App_9258/2024	App_9267/2024
K	Template licence agreement dated 23 July 2024 K83	App_23552/2024	App_23552/2024
K	Template licence agreement dated 23 July 2024 K84	App_25868/2024	App_25868/2024
K	Licence agreement template dated 25 July 2024 K85-86	App_22455/2024	App_22455/2024
B	Application R 185 and 201 From 14 August 2024	App_47068/2024	
B	Submission of licence agreement Application for unredacted submission by applicant dated 19 August 2024 FBD51-54	App_22455/2024	

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The negotiation history presents itself according to according to the plaintiff as follows (contents subject to confidentiality):

[redacted]

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The following key documents were presented as part of the presentation of the negotiation history):

Injury information Appendix K15

Offer of the plaintiff dated 25 June 2022 K 16, K 17

E-mail correspondence K20, K28, FBD7; FDP45, FDB 51 Counteroffer from the defendant dated 1 May 2023 K 21

Plaintiff's second offer (1st offer revised) dated 25 June 2023 K29 Plaintiff's third offer (2nd offer revised) dated 10 April 2024 K43

As part of the presentation of the non-discriminatory nature of the plaintiff's offer, the following licence agreements have been submitted to date (contents subject to confidentiality):

<b>Presenting party</b>	<b>Licence holder [redacted]</b>	<b>Plant number</b>
K		K18, K19
K		K18, K19
K		K48, K67, K70, FBD52 (K17)
K		K49
K		K50
K		K51
K		K52
K		K52?
K		K53
K		K54
K		K55
K		K56
K		K58
K		K59
K		K60, FBD52, 53 (K17)
K		K61
K		K62

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K		K63, FDB50
K		K64
K		K68, K69
K		K70
K		K72
K		K73
K		K74
K		K75
K		K76
K		K77
K		K78
K		K79
K		K80
K		K81
K		K82, FDB 49
K		K83
K		K84, FBD51
K		K85
K		K86
K		K43 Part 1 p. 2

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In anticipation of the interim date, the parties have submitted the following applications:

The applicant claims that the Court

should: APP\_31099/2024 of 5 June

2024

- 1. In addition to the topic of the final consolidation of the submissions and confidentiality applications already mentioned by the local division, it would be useful for the preparation for the oral hearing on 30/31 October 2024 if the local division could name the points of contention that are currently essential for the decision-making process, in particular whether certain points addressed by the judge-rapporteur in the hearing on 19 February 2024 have been resolved and whether certain other points require further discussion.*
- 2. It would also be helpful to know whether, in the view of the local division, further submissions or the submission of further evidence on certain aspects appears necessary (R 104 (e) RoP) so that these can be submitted before the main hearing. In particular, from the applicant's point of view - following the judge-rapporteur's indication at the hearing on 19 February 2024 - no expert evidence is required for the questions of technical understanding of the patent in suit. The same applies to the questions concerning the infringement of the patent in suit or the realisation of the patent-compliant teaching in the asserted standard, since, from the plaintiff's point of view, the points of dispute between the parties are reduced to the question of the correct interpretation of the patent in suit when viewed in the light of day.*
- 3. With regard to the judge-rapporteur's indication at the hearing of 19 February 2024 that an interpretation of the asserted claims must be made uniformly for the examination of the infringement and the existence of the right, the applicant, in particular in its triplicate of 1 May 2024 once again comprehensively explained its understanding of the meaning of the claims and at the same time clarified that this correct understanding applies uniformly to all questions of infringement and the legal status of the patent in suit. From the plaintiff's point of view, the issue raised by the local division should thus have been comprehensively addressed.*
- 4. Furthermore, a classification of the submitted licence agreements with regard to their respective relevance as comparable licence agreements should be helpful. Establishing criteria according to which the local division considers a contract to be relevant as a settlement licence agreement for determining FRAND conformity and according to which the local division will view the submitted contracts would also enable a focused discussion of the extensive material at the oral hearing.*
- 5. Furthermore, according to the plaintiff's understanding, a decision by the panel ordered by the Court of Appeal on the timing of the decision on the defendant's objection regarding the effectiveness of the plaintiff's withdrawal from the opt-out is still pending. The postponement of the oral hearing to the end of October would now leave time to take up such an issue at the interim hearing, provided that the local division has not already decided on this beforehand.*
- 6. Due to the regular errors in the CMS in these proceedings, we also propose a complete synchronisation of the proceedings overview in the CMS. This will ensure that all parties to the proceedings (including the local division) have full knowledge of all workstreams and all documents submitted.*
- 7. With regard to the concordance list suggested by the local division at the hearing of 19 February 2024 for a uniform translation into English of central - in particular technical - terms*

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*of these proceedings, the plaintiff intends to discuss this with the defendants.*



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*to be agreed before the interim hearing and then made available to the local division. This could also be discussed at the interim hearing if necessary.*

*8. The same applies to the agreement between the parties on the recoverable costs suggested in the hearing of 19 February 2024. In this respect, too, the plaintiff will endeavour to find a settlement with the defendants in a timely manner, which will also be communicated to the local division prior to the interim hearing.*

*9. Finally, it would be helpful to note in the interim hearing how the local division intends to conduct and structure the main hearing, in particular (i) whether the division will introduce the merits of the case and dispute and provide procedural guidance, (ii) how much time the division will allocate to discussing infringement, legal merits and FRAND in each case, and (iii) whether there will be any limits on the length of the parties' pleadings.*

The defendants claim:

in APP\_31099/2024 of 6 June 2024

*1. Firstly, we would like to suggest discussing the plaintiff's obligation to submit (unredacted) licence agreements and other information required for the evaluation, such as sales figures and average sales prices of the products covered by the licence agreement. In the defendant's view, the plaintiff has so far only inadequately fulfilled this obligation. In particular, the question of the usefulness of the licence agreements submitted to date as a benchmark must be addressed in this context if this information is not available. A benefit for the defendant with regard to those licencees who, as direct competitors of the defendant, also manufacture WLAN routers and access points (in particular HONOR, XIAOMI, Oppo, Nokia, Samsung), is also not yet apparent from the submission of the contracts.*

*2. As a further point, we would like to suggest that the Board identifies the main issues of the proceedings pursuant to Rule 104(a) RoP UPC and also identifies which relevant facts are in dispute. In this respect, it would be particularly helpful to be informed of the Chamber's assessment of the evidence offered by the defendant to date. If the underlying evidentiary issues are deemed to be relevant to the decision, the interim hearing should be used to submit the corresponding motions for evidence and order the taking of evidence. Specifically, these are*

*a) Gathering of evidence through court expert opinions:*

*(aa) on technical issues of standard implementation (statement of defence of 17 November 2023, paras. 196, 197, 222, 225; rejoinder of 2 April 2024, para. 34), in particular in this regard,*

*(1) whether the order of assignment of resource allocations and RUs for which no user scheduling information subfield exists is reversed in IEEE 802.11ax compared to the order claimed in the patent in suit (statement of defence of 17 November 2023, para. 222);*

*(2) whether the allocation indices of Table 27-26 of the IEEE 802.11ax standard referred to by the applicant contribute user scheduling information sub-fields to the respective user fields of HE-SIG-B channels 1 and 2, which would exclude the realisation of features 1.6 and 1.7 in this respect;*

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- (3) *the importance of the scheduling software for the operation of the challenged embodiments and for the allocation of RUs (statement of defence of 17 November 2023, margin no. 196, 197); and*
- (4) *how the technical teaching of the patent in suit is to be understood with regard to the physical principles of signal transmission (duplicate of 2 April 2024, para. 34);*
- (bb) *on the content and significance of the test data for the question of patent infringement (duplicate of 2 April 2024, para. 40); and*
- (cc) *on US law and New York State law on the content of the plaintiff's obligations under the LOA to IEEE SA (Statement of Defence of 17 November 2023, paras. 285, 334, 336);*
- b) *Taking of evidence by hearing witnesses from employees of Netgear Inc. (Statement of defence of 17 November 2023, paras. 198, 199, 200, 491 et seq.):*
- (aa) *The defendant's inability to influence the functioning of the modem chips (statement of defence of 17 November 2023, paras. 198, 199, 200); and*
- (bb) *On the defendant's internal financial data with regard to any enforcement security to be ordered (Statement of Defence of 17 November 2023, para. 491 f.); and*
- c) *Taking of evidence by Order to submit (unredacted) licence agreements of the plaintiff (Statement of defence of 17 November 2023, paras. 408, 334, 336; also duplicate of 2 April 2024, para. 408), if not already done.*
3. *There is also a dispute between the parties about the correct translation of the documents submitted as PrioAnmÜ-SP and UrAnmÜ as annexes to the counterclaim for a declaration of nullity (see triplicate of 1 May 2024, para. 75 et seq.; duplicate of 2 April 2024, para. 139 et seq.). As the parties use contradictory translations of the documents and base their respective arguments on them, we suggest that translations of the documents be prepared by a court-appointed and sworn translator.*
4. *Furthermore, it would be helpful to discuss the fundamental importance that the Board attaches to the question of exhaustion under Art. 29 UPCA for the present proceedings and the further fate of the action for a declaratory judgement (UPC\_CFI\_152/2024) directed thereto. As already stated several times, the defendants already consider the exhaustion issue to be relevant for a decision in the present proceedings, but as a precautionary measure they have also brought an action for a declaratory judgement directed to this issue, which is also pending before this Chamber. It is appropriate to deal with this declaratory action at the same time due to the close factual connection. However, it is also recognisably desired by the parties, as both parties have so far also commented on the declaratory action in the pleadings cycle of these infringement proceedings.*
5. *With regard to the agreement between the parties on a concordance list and on the recoverable costs suggested by the local division at the oral hearing on 19 February 2024, the defendants will endeavour to reach an agreement with the plaintiff in a timely manner.*
6. *In addition, we agree with the plaintiff's request from its statement of 5 June 2024 to show the course and structure of the oral hearing on 30/31 October 2024.*

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in APP 47068/2024 dated 14 August 2024

1. *appoint a court expert pursuant to Rule 185 RoP UPC to take evidence on the content and significance of the test data submitted in the meantime by the applicant with its Reply (see Reply of 17 November 2023, paras. 226 to 232 and Reply of 2 April 2024, para. 40); in particular on the fact that*

a) *in the exemplary analysed package 300 of the test data "RAX200\_5G\_CH153\_80MHz\_MIMO-ON.pcap" according to Annex K24, the first resource allocation index in the first HE-SIG-B content channel 1, the index 200, and the first RA in the second HE-SIG-B content channel 2, the index 114,*

b) *in the exemplary analysed packet 300, the first resource allocation index in the first HE-SIG-B content channel 1, which shows the index 200, which contributes user scheduling subfields to the user field according to the standard specification IEEE 802.11ax;*

c) *all available test data according to Appendix K24 does not contain any packages that show a different assignment of resource allocation index to HESIG-B Content Channel, if the resource allocation index indicates that the resource allocation does not contribute a user scheduling subfield to the user field.*

2. *Appoint a forensic expert under Rule 201 RoP EPG to determine, by conducting his own measurements using a representative sample of the defendant's challenged embodiments, that none of the challenged embodiments generates and transmits packets with HE-SIG-B field having an order different from the order of resource allocation indices according to said packet 300 of the present test data;*

3. *appoint a court expert under Rule 185 RoP UPC to take evidence on the content of the plaintiff's obligations under the LOA to IEEE-SA and the fact that the defendants are beneficiaries of the Huawei LOA (cf.*

*Statement of defence of 17 November 2023, paras. 283 to 336), in particular that*

a) *the defendant is the beneficiary of the LOA,*

b) *the issuance of an LOA constitutes an independent, legally enforceable guarantee promise by the declaring party to the beneficiaries,*

c) *the submission of the LOA creates the obligation to make an offer to the defendant on RAND terms,*

d) *the submission of the LOA establishes the obligation to prove that the RAND offer is non-discriminatory.*

e) *the indication of the LOA establishes the obligation to refrain from enforcing a patent infringement in court before the standard user has submitted a demonstrably RAND-compliant offer, in particular a demonstrably non-discriminatory offer.*

4. *to appoint a court expert pursuant to Rule 185 RoP UPC to provide evidence on the accuracy of the translation in the Annex PrioAnmÜ-SP and/or to translate the Annexes PrioAnm, StammAnmCN, UrAnm into English (see rejoinder of 2 April 2024, paras 135 to 167 and quadruplicate of 3 July 2024, paras 254 to 262)*

*in the alternative, if the court does not make an order pursuant to Rule 185 RoP UPC,*

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*5. to notify the defendants accordingly so that they can, if necessary, provide corresponding (party) expert opinions in accordance with R. 181.1 RoP EPG.*

in APP\_22455/2024 of 19 August 2024

- 1. the plaintiff the submission of an unredacted version of the licence agreement with [redacted] (K62),*
- 2. the plaintiff the submission of an unredacted version of the licence agreement with [redacted] (K61),*
- 3. the applicant the submission of an unredacted version of the licence agreement between the [redacted] and [redacted] (K64),*
- 4. the plaintiff the submission of an unredacted version of the licence agreement with [redacted] (K82),*
- 5. to impose a severe penalty payment, the amount of which is at the discretion of the court, in the event of non-compliance with the production order.*

The defendants argue in response to application APP\_22455/2024 of 19 August 2024 that the plaintiff voluntarily submitted the licence agreements referred to in the previous applications, but did not submit them unredacted. Therefore, an evaluation of these contracts with regard to the RAND conformity of the plaintiff's offers to the defendant is impossible, although they are relevant to the plaintiff's licensing practice. [redacted] and [redacted] are manufacturers of Wi-Fi access points and distribute them worldwide. [redacted] sells motor vehicles with Wi-Fi AP functionality. The plaintiff's denial regarding the products that these companies manufacture and distribute is irrelevant; these are obvious facts. The licence agreements according to applications 1, 2 and 4 did not contain an express licence to the Wi-Fi 6 patents at issue here. However, these agreements contained standstill agreements and/or non-challenge agreements which also covered the plaintiff's Wi-Fi 6 patents. According to the plaintiff's own submission, standstill agreements and non-challenge agreements are contractual components subject to remuneration, so that the remuneration agreement contained in these contracts - so far redacted - is directly relevant for the evaluation of the Wi-Fi-6 patents and the offers to the defendants. The licence agreement between [redacted] and [redacted] was also only submitted in redacted form, although it is relevant for the plaintiff's licensing practice because it grants a licence to the Wi-Fi-6 patents relevant here. Because of the redactions, it was impossible for the defendant to analyse this contract with regard to the RAND conformity of the plaintiff's offers to the defendant.

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The interim meeting took place via video conference on 29 August 2024. The

following took part:

For the court:

- Presiding judge and judge-rapporteur Dr Matthias Zigann
- Legally qualified judge Edger Brinkman as observer
- Technically qualified judge Patrice Vidon as observer

In favour of the plaintiff:

- Huawei Inhouse
  - o [redacted]
  - o [redacted]
  - o [redacted]
  
- Clifford Chance
  - o Attorney Dr Tobias J. Hessel
  - o Attorney Thomas Misgaiski
  - o Attorney Dr Marie Gessat
  - o Lawyer Lea Prehn
  
- Bird & Bird
  - o Attorney Christian Harmsen
  - o Attorney Dr Matthias Meyer
  - o Attorney Dr Jörg Witting
  
- BDPE Patent Attorneys and Attorneys at Law
  - o PA Dr Friedrich Emmerling
  - o PA Lan Bi

For the defendant:

- Freshfields Bruckhaus Deringer PartG mbB
  - o RA Dr Frank-Erich Hufnagel
  - o Attorney Henning Gutheil
  - o Attorney Diana Baum
  - o Attorney Dr Stephan Dorn
  
- Samson and Partner Patent Attorneys
  - o PA Dr.-Ing. Cletus von Pichler

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## REASONS FOR THE ORDER

### I. Collection of evidence

1. At the hearing, the defendants clarified that only the applications dated 14 August 2024 were still current in this respect.
2. Based on the discussion at the hearing, it currently appears appropriate to take evidence with regard to the correct translation of the Chinese-language documents StammAnmCN, UrAnm and PrioAnm into English. In this respect, the parties have submitted translations that contradict each other. Admittedly, this aspect could be left open if, from the point of view of a person skilled in the art, the disclosure content would be the same even if one or the other translation were used as a basis, which the plaintiff submits. However, the Board is currently unable to make a statement on the interpretation and the disclosure content of the patent in suit and these three documents. This will only be possible following the oral hearing. In order to prepare these comprehensively, a (further) translation must be obtained from a court-appointed translator.

Since this translator should preferably have specialised knowledge in the field of the patent and, according to the unanimous submission of both parties, should prepare the translation with knowledge of the parties' dispute, only a patent attorney with knowledge of Chinese and English, i.e. an expert, appears to be suitable.

The parties have already agreed to find a suitable translator and to agree on one if possible. This should be finalised within a week.

3. The other suggestions to order expert evidence are not followed up.

### II. Submission of further documents

1. The defendant's application of 19 August 2024 (APP\_22455/2024) must be dismissed. This is because the court has already made a final decision in this respect by Order of 15 July 2024 (App\_22455/2024). The defendant's applications of 25 April 2024 (App\_22455/2024) to produce these same contracts were rejected because the plaintiff had already submitted these contracts in advance on 30 May 2024 in partially redacted form. At that time, the court considered the submission of partially redacted contracts to be sufficient and therefore rejected the defendant's application for (fully) unredacted submission. No application for review was received within the time limit of Rule 333.2 RoP. The period granted for comments did not include an extension of this period.
2. Insofar as the application should be understood as a suggestion to the court to order the complete submission ex officio, and this is how the defendants have responded today, there is currently no reason to do so.
3. The plaintiff is at liberty to voluntarily make a complete submission within the current deadline for its written pleadings.

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### III. Objection

The Chamber will decide on the appeal during the main hearing.

### IV. Objections to delays

At the hearing, it was elaborated that the plaintiff considers the arguments concerning further translation errors, lack of executability and the D5 citation, which were only submitted by the defendants at a later date, to have been submitted late, but that they are not relevant. There is therefore currently no need to rule on the issue of lateness.

With regard to the other translation errors, it only makes sense to commission a complete translation of all three documents.

### V. Non-technical defence

#### 1. Exhaustion of products with Qualcomm chips (K68)

The contract was only submitted by the plaintiff at a later date by order of the Chamber. The defendants therefore submitted detailed arguments on the interpretation of this contract for the first time in their document dated 3 July 2024 # 103 et seq. The plaintiff must be given the opportunity to respond to this upon application.

#### 2. LOA to IEEE dated 25 July 2019 (FBD13-14)

At the hearing, it was worked out that the declaration made on 25 July 2019 referred to the previous bylaws of the IEEE. The defendants argue that subsequent events have now given rise to a binding effect with regard to later bylaws. The plaintiff argues, among other things, that, irrespective of the applicable bylaws, the defendants' behaviour made it permissible to bring an infringement action.

In response to questions, the defendants stated that a licence to the patent in suit via SISVEL is "still under consideration".

There is therefore currently no reason to obtain an expert opinion on the LOA.

### 3. Antitrust compulsory licence objection

At the hearing, it was worked out that, from the plaintiff's point of view, the reference to the infringement of the patent in suit was to be found in Annex K15, which was submitted before the action was filed. The plaintiff will subsequently submit an appropriately labelled copy. Furthermore, the plaintiff has stated that a claim chart relating to another member of the patent family of the patent in suit was submitted before the action was filed. In this respect, too, the plaintiff will further specify this submission. The defendants have objected to the claim chart that there are significant deviations from the features of the patent in suit. With regard to the patent list according to K15, they objected that there were simply too many patent numbers listed therein. Neither of the two documents was therefore suitable as evidence of infringement.

In response to questions, the defendants stated that they had provided information and accounts based on generally available figures after the counter-offer had been rejected. No security had been provided. Taking a licence for the patent in suit via SISVEL is "still under consideration".

## VI. Provision of security for enforcement

1. It was discussed at the hearing that, in the event of an Order for the provision of security, the choice between a cash deposit and a bank guarantee is at the discretion of the Chamber and that, due to possible difficulties in determining the suitability of the bank and details of the text of the guarantee deed, the Chamber has a preference in favour of an Order for the provision of security by means of a cash deposit. The plaintiff has emphasised that it prefers the provision of a bank guarantee and will seek preliminary clarification with the defendants regarding the details.
2. In response to a question, the defendant stated that the amount of security could be reduced by 65 per cent if devices with Qualcomm chips were not covered by the Orders to be enforced.

## VII. Preparation of the oral hearing

At the suggestion of the parties, the following must be settled:

1. An overview of the submitted documents, attachments, documents and translations with references (CMS workflow number, date) must be submitted, preferably coordinated with the other party.
2. Any missing translations of documents must be submitted subsequently.
3. English-language attachments do not need to be translated.
4. So-called "skeleton arguments", including references to the main documents (incl. CMS workflow number and date, also in relation to the translation) can be submitted.
5. Please let us know within the deadline whether a hybrid video conference is required.
6. The names of all participants should also be provided.



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#### VIII. Expiry of the oral hearing (30-31 October 2024)

The aim is to hear the case on one day only. The second day is for security purposes only.

The Chairman will introduce the case. Questions may be asked. After a break, the parties will then have the opportunity to take it in turns to make brief presentations on individual topics that are still of interest after the introduction. These presentations may be interrupted by further questions from the Chamber.

The employees of the law firm will provide break and meeting rooms for the parties.

#### IX. Parallel procedure

In respect to the parallel proceedings ACT\_18917/2024 UPC\_CFI\_168/2024 and ACT\_16294/2024 UPC\_CFI\_152/2024) were agreed as joint dates:

- 19 .1.2025 10.00 a.m., interim appointment as video conference
- 25 March 2025, 9.00 a.m., main date

Separate summonses will be issued in  
this respect.

#### ORDER

1. Both parties may submit documents containing the following until 27 September 2024:
  - a. List of documents, documents, annexes and translations into English in the proceedings, including references (workfl ow number; date), preferably agreed with the other party.
  - b. Any other (machine) translations.
  - c. "Skeleton Arguments.
  - d. Number of participants Negotiation
  - e. Would you like a video conference?
  - f. Details agreed with the other party regarding a bank guarantee as security by the plaintiff in the event of victory.
2. Until 27 September 2024, the plaintiff may also comment on the defendant's submission on exhaustion based on the Qualcomm contract and on where exactly the patent-in-suit appears in the documents submitted for the infringement notice. The claim chart relating to the other patent from the same patent family as the patent in suit must be submitted.
3. A court-appointed expert with knowledge of telecommunications technology (WiFi 6) and the Chinese and English languages is appointed in accordance with Rule 185 RoP EPC to translate the PrioAnm, StammAnmCN and UrAnm annexes into English. The expert shall take into account the respective submissions of the parties and justify his translation in the disputed points.
4. The parties are requested to nominate suitable persons by e-mail within one week, preferably to agree on a joint proposal. You are also requested to obtain an estimate of the costs and processing time from this person.

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5. In all other respects, the defendants' applications for the taking of evidence and the production of documents cited above are dismissed.
6. The written procedure will be closed on 27 September 2024.
7. The parties will be summoned to the oral hearing on 30 and 31 October 2024, both at 9.00 a.m., both at the Munich local division, Denisstr. 3 in Munich, Room 212 and Overflow Room 220b. The second day of the hearing will only take place if necessary. The hearing will be held in English.

#### INFORMATION ON THE REVIEW BY THE ADJUDICATING BODY

Each party may request a review of this Order by the adjudicating body in accordance with R. 333 RoP. The Order remains effective until it has been reviewed (R. 102.2 RoP).

#### INFORMATION ABOUT THE ORAL PROCEEDINGS IN COURT

The oral hearing is public unless the court decides to hold a hearing in camera, if necessary, in the interests of one of the parties or third parties or in the general interests of justice or public order (R. 115 RoP).

#### INFORMATION ABOUT THE SOUND RECORDING

An audio recording of the hearing is made. The recording is made available to the parties or their representatives after the hearing on the premises of the court (R. 115 RoP).

#### INFORMATION ON THE ABSENCE OR LATENESS OF A REPRESENTATIVE

Upon application, a default judgement may be issued against a party if a duly summoned party fails to appear at an oral hearing. (R. 355.1 (b) RoP).

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ORDER DETAILS

Order No. ORD\_49424/2024 in PROCEDURE NUMBER: ACT\_459771/2023

UPC number: UPC\_CFI\_9/2023

Nature of the action: Action for infringement


No. of the related proceedings Application No.:

31099/2024 Type of application:

Summons to the hearing

Signed in Munich on 30 August 2024

Matthias  
ZIGANN

 Digitally signed by Matthias  
ZIGANN  
Date: 2024.08.30 14:23:57  
+02'00'

Dr Zigann  
Presiding judge