



**Munich local division  
UPC\_CFI\_221/2024**

**Procedural order  
of the Court of First Instance of the Unified Patent Court  
local division Munich  
issued on 2 September 2024**

APPLICANT (APPLICANT)

**Panasonic Holdings Corporation**

represented by: Sören Dahm (Kather Augenstein).

DEFENDANTS (RESPONDENTS)

- 1) Guangdong OPPO Mobile Telecommunications Corp. Ltd.**
- 2) OROPE Germany GmbH**

represented by: Tobias Hessel (Clifford Chance).

PATENT IN SUIT

European Patent No. 3 024 163

JUDICIAL BODY/CHAMBER

Panel 1 of the Munich local division

PARTICIPATING JUDGES

This Order was issued by presiding judge Dr Matthias Zigann, legally qualified judge András Kupecz, legally qualified judge Tobias Pichlmaier and technically qualified judge Kerstin Roselinger.

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LANGUAGE OF THE PROCEEDINGS

German

OBJECT

Action for infringement - Rule 305 RoP

BRIEF PRESENTATION OF THE FACTS

The lawsuit against defendants 1 and 2 was filed on 4 August 2023. The main hearing is scheduled for the end of January 2025.

As a marketing agent, defendant 2 performs support services, such as market and target group analyses, search engine optimisation, social media marketing and entire marketing campaigns in accordance with the service agreements concluded with Guangdong Oppo Mobile Telecommunications Corp. Ltd. and OTECH Germany GmbH, and also provides administrative services. In 2020, the company handled the smartphone sales business for its sister company OTECH Germany GmbH on a transitional basis. This line of business was taken over by OTECH Germany GmbH in August 2020.

In June 2023, OTECH Germany GmbH was convicted of patent infringement by the Mannheim Regional Court. This was reported in the blog "FOSS PATENTS" on 7 June 2023.

The 2020/2021 annual report of defendant 2, in which the business circumstances described above were presented, was published on 4 August 2024 and has been available online since then. The plaintiffs' representatives accessed it online on 18 February 2024.

On 15 March 2024, the plaintiff extended a patent infringement action pending before the Regional Court of Munich I to include defendant 3.

On 5 June 2024, the plaintiff in the present proceedings applied for consent to extend the action to OTECH Germany GmbH.

The defendants 1 and 2 were heard. They oppose the admission of the extension of the action. They consider this to be inadmissible and inappropriate. The plaintiff could and should have sued OTECH Germany GmbH directly, but in any case it could have filed the application for admission of the extension of the action much earlier. Alternatively, the time limits should be adjusted. OTECH Germany GmbH should be granted the same deadlines as any other defendant. The deadline of the end of 2025 could therefore not be met.

The plaintiff argues that the legal representatives of the defendant OTECH Germany GmbH simply relied on the submissions of the other defendants before the Munich I Regional Court. The position of the (identical) representatives here is therefore not comprehensible.

Moreover, the plaintiff was not aware of the activities of OTECH Germany GmbH before the action was filed. It was only through the annual financial statements that the plaintiff became aware of the fact that the defendants had largely transferred the sales activities of the defendant 2) to OTECH Germany GmbH.

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OTECH Germany GmbH and the Mannheim Regional Court presumably condemned OTECH Germany GmbH for this reason. The blog article on FOSS PATENTS did not explain why the Regional Court of Mannheim had assumed that OTECH Germany GmbH had passive legitimacy. The plaintiff was not aware of the reasons for the judgement. These have not yet been published by Beck or Wolters Kluwer. It was therefore not possible for the plaintiff to include OTECH Germany GmbH in the action.

The timing of the application for admission of the extension of the action also does not argue against admitting the extension of the action for reasons of procedural economy. Admission of the extension of the action would prevent the parties from exchanging the same arguments in further proceedings. The timing is not important. Moreover, the timing chosen did not disadvantage the defendants, as a comparison with the parallel proceedings before the Munich Regional Court also shows. In order to minimise the expense of the extension of the action, in particular on the part of the Regional Court of Munich I, the plaintiff had asked the legal representative of the defendants 1) and 2) whether the plaintiff could name them as authorised representatives in the extension of the action before the Regional Court of Munich I in order to simplify service. The legal representative of defendants 1) and 2) answered in the affirmative, so that the extension of the action could be carried out without the need for new service. After the plaintiff had successfully extended the action before the Munich Regional Court, the plaintiff had also decided to extend the action before the Munich local division. In order to enable service via the CMS, the plaintiff had again contacted the legal representative of the defendants 1) and 2).

2) whether the latter was also authorised to accept service of process before the Munich local division. It was only after repeated enquiries that the plaintiff on

On 17 May 2024, the plaintiff received the reply that the legal representative of the defendants 1) and 2) was not representing OTECH Germany GmbH before the Munich local division at that time ("At this stage"). At the same time, the plaintiff contacted the Munich local division to find out how a subjective extension of the claim could be made via the CMS, because it was known that the workflow for the subjective extension of the claim was not operational. The court confirmed that the subjective extension of the action pursuant to R. 306.1 lit a) RoP was not fully implemented in the CMS at that time. The plaintiff then asked in a further email whether this technical problem could be solved with a new claim, which would then be combined with the existing claim after it had been filed. The court confirmed this possibility in principle, but provided that the actions were filed at the same time.

must be "ripe". In addition, the court had suggested that the parties agree on a shortened time limit so that the actions could be heard in one hearing. In view of the fact that the legal representative of defendants 1) and 2) had informed the plaintiff in the meantime that he was not authorised to extend the action, such a solution was not possible. The plaintiff had therefore been forced to use the incompletely implemented workflow in the CMS. However, this showed that the plaintiff had endeavoured to process the extension of the action for all parties with as little additional effort as possible. Coordination with the opposing party and the court regarding the inadequacy of the CMS took time, so that the plaintiff later extended the action compared to the proceedings before the Munich Regional Court. However, this could not be held against her.

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### APPLICATIONS BY THE PARTIES

The applicant claims that the Court should:

*"extend the present legal dispute to the defendant 3) and make the applications under I. to IX. inclusive from the statement of claim dated 31 July 2023 also with regard to the defendant 3).*

The defendants 1 and 2 apply:

*Rejection of the application and, in the alternative, adjustment of the time limits.*

### REASONS FOR THE ORDER

The court exercises the discretion granted to it in Rule 305 RoP not to allow the extension of the action.

#### 1. Legal situation

- a. Pursuant to Rule 305 RoP, the court may, on application by a party, order that a person (a) be added as a party, (b) be removed as a party, (c) be substituted for another party. The court shall invite the other parties to the proceedings to comment on the application as soon as possible after it has been served. If the court orders a person to become a party or to withdraw as a party, it may make appropriate orders in respect of that party as to the payment of court fees and costs.
- b. Pursuant to Rule 306 RoP, if the court orders that a party be added, removed or replaced by another party pursuant to Rule 305.1 RoP, the court shall issue orders regulating the effects on the conduct of the proceedings. The court also determines the extent to which a new party is bound by the previous status of the proceedings.
- c. A comparison with the provision in Rule 263 RoP on the objective amendment of the action, in particular on the extension of the action, shows that in Rule 305 RoP the aspect of the delay in filing the application has not been explicitly elevated to an element of the offence that precludes a positive decision. However, this does not mean that this aspect does not play a role. Rather, the provision grants the court broad discretion to allow an extension of the claim despite any delay in filing the application due to other considerations, such as procedural economy. However, it must always be borne in mind that the entire Rules of Procedure are characterised by the need to ensure that all parties are afforded a speedy procedure and a fair hearing.

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2. The application for permission to extend the subjective claim must be deemed to have been filed out of time.

The plaintiff has not denied that it was already aware in June 2023 that OTECH Germany GmbH had been convicted of patent infringement by the Mannheim Regional Court on the basis of the notification to FOSS PATENTS dated 7 June 2023. It did not state when exactly it had received the reasons for the judgement. In any case, however, it could and should have taken the knowledge of this judgement as an opportunity to make further enquiries, especially since it had already made a claim against the defendants 1 and 2 before the local division for patent infringement. Had it done so, it would have been able to retrieve the annual report, which has been available online since 4 August 2023, at an earlier date than 18 February 2024 and accordingly file the application for permission to extend the action much earlier than 5 June 2024.

3. The circumstances of the present case do not require the extension of the claim to be admitted despite this delay.

Defendants 1 and 2 have filed a counterclaim for annulment. The written procedure will be concluded in September or October 2024. It is currently not known whether and by whom OTECH Germany GmbH will be represented by a lawyer. It is also not known whether it will exercise its right to file an independent action for annulment. If it does so, it would not be limited to what the defendants 1 and 2 have submitted so far with regard to the nullity attacks to be presented therein. Ordering a commitment to the previous state of proceedings pursuant to Rule 306.2 RoP would appear too far-reaching in this respect. In principle, anyone can challenge the invalidity of a granted patent with an action for revocation. However, if the extension of the action were authorised, OTECH Germany GmbH would be restricted to doing so in the context of a nullity counterclaim due to Art. 33(4) UPCA. Against this background, a further restriction to those invalidity attacks that the defendants 1 and 2 had already raised in the context of their invalidity counterclaim would not appear to be fair. In such a situation, however, the plaintiff as patent proprietor would then also have to be given the opportunity to defend itself against these new invalidity attacks, including with a further (auxiliary) application for amendment of the patent. Consequently, the written procedure could not be shortened, if at all, to such an extent that the planned date at the end of January 2025 could still be meaningfully prepared and carried out. Therefore, considerations of procedural economy do not require the late-filed application to be admitted.

Moreover, it cannot be inferred from the plaintiff's submission that it attaches greater importance to the objective of extending the action than to the objective of meeting the deadline at the end of 2025. On the contrary, it is known from parallel pending applications for a stay of proceedings and cancellation of the hearing dates with regard to parallel proceedings in the United Kingdom that the plaintiff is vehemently opposed to a stay and attaches great importance to maintaining the planned dates.

Another factor in the consideration is also that the disadvantages for the plaintiff are manageable. Finally, the plaintiff can file new, separate proceedings against OTECH Germany GmbH at any time. These new proceedings would be brought to a decision quickly within the (efficient) procedural framework of the UPC.

4. The appeal must be allowed because the questions arising here have not yet been clarified by the Court of Appeal.

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ORDER

1. The application is rejected.
2. The appeal is authorised.

ORDER DETAILS

Order No. ORD\_40296/2024 in PROCEDURE NUMBER: ACT\_545620/2023  
 UPC number: UPC\_CFI\_221/2023  
 Nature of the action: Action for infringement  
 No. of the related proceedings Application No.: 33757/2024  
 Type of application: Application for change of party

INFORMATION ON THE APPEAL IF IT IS AN ORDER UNDER ART. 73(2)(B) UPCA:

This Order may be appealed against either  
 - an appeal against the final decision of the Court of First Instance on the substance of the case may be lodged by any party who has been unsuccessful in whole or in part in its applications, or  
 - after the Court of First Instance has granted leave to appeal, an appeal may be lodged within 15 days of service of the decision by any party whose applications have been unsuccessful in whole or in part (Art. 73(2)(b) UPCA, R. 220.2, 224.1 (b) RoP).

Issued in Munich on 2 September 2024

Dr Zigann Presiding judge and judge-rapporteur	Matthias ZIGANN  Digitally signed by Matthias ZIGANN Date: 2024.09.02 10:34:51 +02'00'
Kupecz Legally qualified judge	András Ferenc Kupecz  Digitally signed by András Ferenc Kupecz Date: 2024.09.02 11:29:02 +02'00'
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Roselinger Technically qualified judge	Kerstin Roselinger  Digitally signed by Kerstin Roselinger Date: 2024.09.02 11:18:13 +02'00'
for the Deputy Chancellor	Anja Mittermeier  Digitally signed by Anja Mittermeier Date: 2024.09.02 13:54:39 +02'00'