



UPC_CoA_543/2024
APL_52760/2024
UPC_CoA_544/2024
APL_52761/2024
UPC_CoA_545/2024
APL_52763/2024

ORDER
of the Court of Appeal of the Unified Patent Court issued on
30 September 2024
concerning an application for discretionary review by the
Court of Appeal under Rule 220.3 RoP

APPELLANTS (AND DEFENDANTS IN THE MAIN PROCEEDINGS BEFORE THE CFI)

1. **Xiaomi Technology Germany GmbH**, Düsseldorf, Germany
2. **Xiaomi Technology France S.A.S**, Boulogne-Billancourt, France
3. **Xiaomi Technology Italy S.R.L**, Milan, Italy
4. **Xiaomi Technology Netherlands B.V.**, The Hague, Netherlands
5. **Odiporo GmbH**, Willich, Germany
6. **Shamrock Mobile GmbH**, Willich, Germany

all represented by: Fabian Schubach, attorney-at-law and Kilian Seidel, attorney-at-law
(Freshfields Bruckhaus Deringer, Munich, Germany)

all hereinafter also referred to as 'Xiaomi'

APPELLANT (AND PLAINTIFF IN THE MAIN PROCEEDINGS BEFORE THE CFI)

Panasonic Holdings Corporation, Osaka, Japan

represented by: Christopher Weber, Attorney at Law
(Kather Augenstein Rechtsanwälte, Düsseldorf, Germany) Hereinafter

also referred to as 'Panasonic'.

PATENTS IN DISPUTE

EP 3096315
EP 2568724
EP2207270

DECIDING JUDGE

This Order was issued by Rian Kalden, Permanent Judge.

CONTESTED ORDERS OF THE COURT OF FIRST INSTANCE

- Date : 10 August 2024 (ORD_47198/2024; ORD_47201/2024; ORD_47199/2024)
- Action numbers of the Court of First Instance, Mannheim local division: UPC_CFI_218/2023, ACT_545606/2023, App_45838/2024; UPC_CFI_219/2023, ACT_545615/2023, App_45837/2024; UPC_CFI_223/2023, ACT_545817/2023, App_45833/2024

LANGUAGE OF THE PROCEEDINGS

German

BRIEF PRESENTATION OF THE FACTS

1. Three proceedings for alleged infringement of three patents are pending between the parties before the Mannheim local division of the Unified Patent Court (UPC_CFI_218/2023 - ACT_545606/2023, UPC_CFI_219/2023 - ACT_545615/2023, UPC_CFI_223/2023 - ACT_545817/2023), whereby each of the defendants also filed a counterclaim for a declaration of invalidity of the respective patent in suit (instead of many, e.g. CC_594296/2023, CC_591342/2023, CC_594274/2023).
2. At issue in the present case is the expiry or the necessary extension of the defendant's time limit under R. 29(d) RoP to Reply to the defence to the counterclaim, Duplicate Reply to the defence to the application and Reply to an application to amend the patent (hereinafter the "Duplicate").
3. Xiaomi bring forward:
 - a. The plaintiff's time limit under R. 29(d) RoP to file a defence to the counterclaim for a declaration of invalidity together with a Reply to the statement of defence and (if applicable) an application to amend the patent (hereinafter the "Reply") expired on 22 March 2024. Within this period, the plaintiff provided both the court and the defendants with a partially redacted version of its Reply alone. As had become apparent in the meantime following the submission of the unredacted version, the redacted passages concerned the non-technical points of dispute in the proceedings, in particular the plaintiff's third-party licence agreements, which the plaintiff claimed it could not deal with without a court order to produce them.
 - b. In response to the plaintiff's requests for production of 22 March, 15 April and 15 May 2024, the judge-rapporteur issued Orders of 30 April and 17 May 2024 for the plaintiff to produce the third-party licence agreements concerned. The plaintiff submitted the completely unredacted version of the Reply to the Mannheim local division for the first time on 31 May 2024, together with confidentiality requests to restrict the defendant's access pursuant to R. 262A RoP.
 - c. In response to these applications by the plaintiff, the judge-rapporteur initially issued provisional confidentiality orders allowing the defendant's representatives and one other person on the defendant's side access to the unredacted version of the Reply solely for the purpose of commenting on the confidentiality measures. A substantive

The defendants and their legal representatives were not permitted to analyse the confidential parts of the Reply on this basis.

- d. With their application of 11 June 2024, the defendants therefore requested an extension of the deadline for the rejoinder, initially until 6 August 2024, but explicitly reserved the right to extend the deadline further. By Order of 13 June 2024, the judge-rapporteur granted this application only in part and extended the deadline firstly only for the defence to the plaintiff's non-technical submission and secondly also extended this "partial deadline" only until 19 July 2024.
 - e. On 12 July 2024, the unredacted version of the Reply was then made available to the defendants for the first time for evaluation of the content on the basis of the judge-rapporteur's final confidentiality order.
 - f. Thereupon, by application of 19 July 2024, the defendants requested an extension of the time limit for the duplicate to a period of two months from 12 July 2024, i.e. until 12 September 2024, in order to ensure that they had the full time limit under R. 29(d) RoP. In response to this application, the judge-rapporteur extended the deadline for the duplicate in non-technical terms until 28 August 2024 by Order of 25 July 2024 (ORD_42727/2024, ORD_42728/2024, ORD_42730/2024), but otherwise (again) rejected the defendant's request for an extension of the deadline.
 - g. The defendants challenged this partial rejection with an application dated 9 August 2024 for review by the panel pursuant to R. 333 RoP UPC
 - h. By Order of 9 September 2024, the panel rejected the defendant's application for review pursuant to R. 333 RoP and thus confirmed the judge-rapporteur's partial rejection of the defendant's application for an extension of time. At the same time, the panel did not allow the appeal.
 - i. The appeal should be allowed in order to clarify an inconsistent view by the various local divisions of the Unified Patent Court and to ensure consistent application of the Rules of Procedure by the Unified Patent Court. Thus, the Mannheim local division consistently and also most recently in the context of the Order of 9 September 2024 complained of here assumes that the defendant's duplicate period already begins to run with the filing of the redacted version of the plaintiff's Reply. Insofar as initially redacted submissions are only submitted later and together with requests for confidentiality pursuant to R. 262A RoP, the Mannheim local division generally responds by extending this duplicate deadline, which is already running. In contrast, the local divisions of Hamburg and Munich, for example, assume that the time limit under R. 29(d) RoP only begins to run after the unredacted version has been submitted and the final confidentiality order under R. 262A RoP has been issued, so that the defendants automatically have the full duplicate period available for the evaluation of the unredacted Reply.
 - j. The appeal should also be allowed because it is based on an incorrect weighting of the principle of the right to be heard.
4. Apply for Xiaomi:
1. review the decision of the panel not to allow the appeal against the panel's Order of 9 September 2024 (R. 220.3 RoP UPC);
 2. to allow the appeal (R. 220.4 RoP UPC);

3. Review and set aside the Order of the panel of 9 September 2024 (ORD_47198/2024, ORD_47199/2024, ORD_47201/2024) to the extent that it partially rejected the defendant's application for an extension of time;
4. to retroactively extend the defendant's time limit for filing a reply pursuant to R. 29(d) RoP UPC until at least two weeks after the Court of Appeal's decision on the appeal.

REASONS FOR THE DECISION

1. The period by which a court extends a deadline in a particular case is at the discretion of the court.
2. It is not apparent and Xiaomi have not sufficiently substantiated that the Mannheim local division misinterpreted the Rules of Procedure or exceeded its discretionary powers with the contested decision, in particular also taking into account Xiaomi's right to be heard.
3. There is no urgent need to grant the application on other grounds, also in view of the stage of the proceedings before the Court of First Instance.

ORDER

The application for a discretionary review is rejected (R.220.4 RoP).

Issued on 30 September 2024

Rian Kalden
Date:
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Rian Kalden, Permanent Judge