



Local Division Munich
UPC_CFI_65/2024
ACT_8064/2024

Order
of the Court of First Instance of the Unified Patent Court
Local Division Munich
issued on 25 August 2025

LEITSATZ

Rule 19.1 (a) RoP does not mean that the Defendant of an infringement action may raise any objection in the context of an application to opt out and the withdrawal of an opt-out in order to argue that the withdrawal is invalid and a previously declared opt-out is valid.

The withdrawal of an opt-out is at least effective if the requirements of Rule 5.3 and 5.7 RoP are met (in the case of more than one applicant or patent proprietor also Rule 5.1 RoP), the withdrawal is entered in the register and the requirements of Rule 5.8 RoP are not met. If this is the case, the resulting effectiveness of the withdrawal of the opt-out is binding for the Court and the parties. In particular, where a UPC representative is acting in accordance with Rule 5.3 (b) (i) RoP, a written mandate, a power of attorney or any other power or representation is not a necessary condition for the effectiveness of the withdrawal of an opt-out and the lack of such power of representation cannot be invoked with a Preliminary objection.

CLAIMANT

Network System Technologies LLC, legally represented by its Chief Executive Officer (CEO) Warren Hurwitz, 533 Congress Street, Portland, ME 04101, United States of America,

represented by:

Attorney-at-law Dr. Thomas Gniadek, Simmons & Simmons LLP; Thierschplatz 6, 80538 Munich.

DEFENDANTS

3. **Qualcomm Incorporated**, legally represented by its Chief Executive Officer (CEO) Cristiano Amon, 5775 Morehouse Drive, San Diego, CA 92121, United States of America,
4. **Qualcomm Technologies, Inc.**, legally represented by its Chief Executive Officer (CEO) Cristiano Amon, 5775 Morehouse Drive, San Diego, CA 92121, United States of America,
5. **Qualcomm Germany GmbH**, legally represented by its Chief Executive Officer (CEO) Hamid-Reza Nazeman, Anzinger Straße 13, 81671 Munich, Germany,

represented by: Attorney-at-law Johannes Heselberger,
Bardehle Pagenberg Partnerschaft mbB,
Prinzregentenplatz 7, 81075 Munich.

PATENT AT ISSUE

European Patent n° EP 1 552 399

PANEL/DIVISION

Panel 2 of the Local Division Munich

DECIDING JUDGE/S

This order has been issued by the judge-rapporteur Dr. Daniel Voß

LANGUAGE OF THE PROCEEDINGS

English

SUBJECT-MATTER OF THE PROCEEDINGS

Patent infringement – Application pursuant to Rule 19.1 RoP

SUMMARY OF FACTS

- 1 The Claimant is suing the Defendants 3) to 5) (hereinafter: Defendants) for alleged patent infringement.
- 2 Patent-in-suit is the European Patent EP 1 552 399. It was filed on 7 October 2003, claiming priority of 8 October 2002. The mention of the grant of the patent-in-suit was published on 26 September 2007. The patent term expired on 7 October 2023.

- 3 On 25 May 2023, a patent attorney at Maiwald GmbH, the registered patent representative for the German part of the patent-in-suit, lodged the opt-out for the patent-in-suit. On 20 December 2023, Ms Xingye Huang of the law firm Simmons & Simmons LLP filed an application to withdraw the opt-out. At this time, neither Ms Huang nor Simmons & Simmons LLC were the proprietors of the patent-in-suit or the registered representatives for any national part of the patent-in-suit. The automatically generated “Acknowledgement of withdrawal of an Opt-out” document has been provided as Exhibit P 8.
- 4 The Statement of Claim was posted between 19 and 21 March 2025 as a registered letter with acknowledgment of receipt and was served on each of the Defendants at the postal address of Defendant 5) on 22 March 2024. The Defendants lodged a Preliminary objection on 25 April 2024.

REQUESTS

- 5 Defendants request that

the infringement action against the Defendants 3) to 5) is dismissed as inadmissible (Rule 19.1 RoP).

- 6 Claimant requests that

the Preliminary objection based on Rule 19.1 (a) RoP concerning the jurisdiction and competence of the Court and the objection that an opt-out applies to the patent-in-suit are dismissed.

POINTS AT ISSUE

- 7 The Defendants base their Preliminary objection on lack of jurisdiction of the Court due to an opt-out of the patent-in-suit from the competence of the Court according to Rule 19.1 (a) RoP.
- 8 The Defendants are of the opinion that the opt-out regarding the patent-in-suit was not effectively withdrawn. Since the opt-out lodged on 25 May 2023 remains valid, the national courts have exclusive jurisdiction over the patent-in-suit. The withdrawal of the opt-out was invalid because neither Ms Huang nor Simmons & Simmons LLC were the proprietors of the patent-in-suit or the representatives for any national part of it, who are entered in the national patent registers. The Defendants contest that Ms Huang had the proper power of representation for lodging the application to withdraw the opt-out on behalf of the proprietor of the patent-in-suit and that the withdrawal was effective with regard to all other formal requirements of a withdrawal of an opt-out.

- 9 The Defendants argue that the Claimant has not alleged, let alone proved that UPC representative Ms Huang was actually authorised by the Claimant to withdraw the opt-out; the Claimant seems to remain deliberately silent on this matter in its reply to the Preliminary objection. The Defendants classify Rule 5.3 (b) (i) RoP as a provision that contains formal requirements, but no substantive requirements for an effective withdrawal of an opt-out including the power of authorization of the UPC Representative who has filed the withdrawal of the opt-out. Since the Claimant has not even stated that Ms Huang was actually authorised by the Claimant to file the withdrawal it cannot rely on Rule 285 RoP which is only relevant for the burden of proof. Alternatively, the Defendants ask the Court to issue an order according to Rule 285.1 RoP.
- 10 The Defendants also take the view that the Claimant has not even stated and/or proven that the formal requirements under Rule 5.3 (b) (i) RoP have been fulfilled. The automatically generated Acknowledgement of withdrawal does not confirm that the withdrawal complies with the legal requirements and is for informational purposes only. Moreover, Rule 5.3 (b) (i) RoP does require that the representative was “appointed by the applicant or the proprietor.” Since the Defendants expressly dispute that such appointment was made for the withdrawal of the opt-out, Claimant’s statements in its reply to the Preliminary objection miss the point, because they completely ignore the requirement in Rule 5.3 (b) (i) RoP and that, in proceedings before the UPC, such appointment must at least be stated and – if disputed by the Defendant – also proven by the Claimant.
- 11 The Defendants also consider proof of authority to lodge the application to withdraw the opt-out on behalf of the proprietor to be highly relevant because the withdrawal of an opt-out has significant substantive legal effect for the patent proprietor. The legal systems of all UPC member states require a power of representation for such actions. According to the Defendants, the requirement of proper authorisation for an application to withdraw an opt-out can also be inferred from Rule 5A RoP
- 12 The Claimant considers that Rule 5.3 and .7 RoP lay down the legal requirements for withdrawing an opt-out and that Ms Huang has fulfilled all these requirements by using the official UPC form for lodging a withdrawal of an opt-out. In particular, Ms Huang is an acknowledged and registered UPC representative according to Art. 48 UPCA. Such a UPC representative is not required to state or show a power of representation or similar. The Claimant assumes the legal requirements for the withdrawal of the opt-out have been met because after Ms Huang signed and lodged the application, the Registry issued an “Acknowledgment of Withdrawal of Opt-out” document regarding the patent-in-suit. When a UPC representative lodges the application for an opt-out or its withdrawal, neither proof of ownership of the patent nor a written mandate or power of attorney is required for an opt-out or its withdrawal to be effective. A UPC representative holds a unique position of trust. He is not only a party’s representative, but also a trusted member of the judiciary. Thus, a UPC representative acting for a party in the course of UPC proceedings is not required to produce a written mandate or a power of attorney. Nothing can be inferred from Rule 5A RoP in this context because this Rule provides for a separate procedure for setting aside an unauthorised

application to opt out or an unauthorised withdrawal of an opt-out. It does not address the question of whether a UPC representative must submit a written mandate.

GROUNDING FOR THE ORDER

- 13 The Preliminary objection is admissible, but unfounded.

A

- 14 The Preliminary objection is admissible because it was lodged in due form and within the time limit specified in Rule 19.1-3 RoP.
- 15 The Preliminary objection was lodged on 25 April 2024, i.e. within one month of service of the Statement of claim in accordance with Rule 19.1 RoP. This is because, in the present case, the Statement of claim is deemed to have been served on the Defendants on the tenth day following posting, i.e. between 25 and 30 March 2024, in accordance with Rule 271.6 (b) RoP.

B

- 16 The Preliminary objection is unfounded. The Unified Patent Court (hereinafter: the Court) has competence in respect of the present action based on the patent-in-suit pursuant to Art. 32 (1) (a) UPCA in conjunction with Art. 2 (b) UPCA. The patent-in-suit is not opted out from the exclusive competence of the Court, as the opt-out applied for on 25 March 2023 was effectively withdrawn on 20 December 2023 in accordance with Art. 83 (4) UPCA.

I.

- 17 Pursuant to Rule 19.1 (a) RoP, the Defendant may lodge a Preliminary objection concerning the jurisdiction and competence of the Court, including any objection that an opt-out pursuant to Rule 5 RoP applies to the patent that is the subject of the proceedings.
- 18 However, this provision does not mean that the Defendant may raise any objection in the context of an application to opt out and the withdrawal of an opt-out in order to argue that the withdrawal is invalid and a previously declared opt-out is valid.

1.

- 19 It can be left open whether, in accordance with Art. 83 (3) and (4) UPCA the effectiveness of an opt-out or its withdrawal is established solely by the entry of the opt-out or the entry of its withdrawal in the register which is the case here, and whether this entry is binding on the Court and the parties. Even if one follows the broader view that the Rules of Procedure (hereinafter: the Rules) lay down further conditions for the effectiveness of an opt-out or its withdrawal which can be objected to by the parties and reviewed by the Court, these conditions are limited to those required by Rule 5 RoP. In particular, where a UPC representative is acting in accordance with Rule 5.3 (b) (i) RoP, a written mandate or power of attorney is not a necessary condition for the effectiveness of an opt-out or its withdrawal.

20 Pursuant to Rule 5.7 RoP, the withdrawal of an opt-out shall be regarded as effective from the date of entry in the register. Paragraphs 1 (a) and 5 shall apply *mutatis mutandis*. According to the broader view, these provisions must be interpreted as meaning that, in order to be effective, a withdrawal of an opt-out must satisfy the conditions laid down in Rule 5. This is because Rule 5.5 RoP, to which Rule 5.7 RoP refers, provides that the opt-out which meets the requirements laid down in that Rule – i.e. in Rule 5 RoP – shall be regarded as effective from the date of entry in the register. In the case at hand it can be left open whether the phrase “which meets the requirements laid down in this Rule” in Rule 5.5 RoP establishes a substantive legal requirement for the Court to also examine the conditions laid down in Rule 5.3 if objected by a Defendant in a Preliminary objection or whether examination of Rule 5.8 RoP and the entry in the register are sufficient for an effective withdrawal. In the end, the withdrawal of an opt-out is at least effective if the requirements of Rule 5.3 and 5.7 RoP are met (in the case of more than one applicant or patent proprietor also Rule 5.1 RoP), the withdrawal is entered in the register and the requirements of Rule 5.8 RoP are not met. If this is the case, the resulting effectiveness of the withdrawal of the opt-out is binding for the Court and the parties. There are no other requirements that the Defendant could contest in a Preliminary objection and that the Court had to examine.

2.

21 In this regard, it must be taken into account that the Agreement of a Unified Patent Court (hereinafter: the Agreement) and the Rules contain coordinated and stringent provisions governing the application to opt out, its requirements, the tasks of the registry, the entry of an opt-out in the register and its effects and related legal remedies. The same applies to an application to withdraw an opt-out. The procedure for opting out or withdrawing the opt-out is not a contradictory procedure, but a unilateral one. It is the owner of the patent who may choose, by means of an opt-out or its withdrawal, to which jurisdiction he wishes to submit his patent. A future Defendant of an infringement action or the Claimant of a revocation action must accept this choice. This argues in favour of restricting objections to an opt-out or its withdrawal in a Preliminary objection.

22 Above all, only the persons named in Rule 5A.1 RoP are entitled to apply for the removal of an unauthorised application or an unauthorised withdrawal of an opt-out in accordance with Rule 5A RoP. It is incomprehensible why third parties as the Defendant of an infringement action should be entitled to raise objections to an opt-out or its withdrawal in its Preliminary objection, that it – due to lack of legal basis, particularly if the objections do not relate to the requirements set out in Rule 5 RoP – cannot raise outside the Preliminary objection, neither out of court nor in proceedings under Rule 5, 5A RoP. Conversely, if the third party is the Claimant of a revocation action, it has no possibility at all to assert the invalidity of the opt-out or its withdrawal. According to the Agreement and the Rules, the Defendant therefore has no right to take action against an unauthorised withdrawal of an opt-out. On the other hand, in cases such as the present one, the Claimant makes it rather clear by bringing an action before the UPC that it wishes to maintain the jurisdiction, even if the opt-out was withdrawn by an

unauthorised person. The filing of the action before the UPC has virtually the effect of approving the otherwise unauthorised withdrawal of the opt-out.

- 23 The Agreement and the Rules also do not provide for any legal consequences for the register if the Court finds, upon a Preliminary objection, that the withdrawal of an opt-out was not submitted by the patent proprietor or another authorised person. Although the withdrawal of the opt-out is considered invalid and the Preliminary objection is successful, the Register is not amended and gives the impression that the UPC has jurisdiction over this patent. This could result in an infringement action being dismissed by the Court as inadmissible due to an invalid withdrawal of the opt-out, but a third party could bring an admissible isolated revocation action before the Court if, for example, it is unaware of the invalidity of the withdrawal which is also not being invoked. Even if a third party was aware that the Court considers the withdrawal to be invalid, it cannot be expected to bring the revocation action directly before the various national courts in the expectation that they would all also affirm the invalidity of the withdrawal. In any case, there would be a risk of conflicting decisions which must be avoided.

3.

- 24 It follows from all of the above that the objections to the effectiveness of an opt-out or its withdrawal should be limited. Thus, the Defendant, who asserts the invalidity of a withdrawal of an opt-out in a Preliminary objection pursuant to Rule 19.1(a) RoP, can only object that the formal requirements of Rule 5.3 and 5.7 RoP have not been complied with, that the withdrawal has not been entered in the register or that the requirements of Rule 5.8 RoP are met.
- 25 In particular, a mandate, a power of representation or any other authority for a representative acting under Rule 5.3 (b) (i) RoP is not required for an effective opt-out or its withdrawal. Unlike paragraph (ii), Rule 5.3 (b) (i) RoP does not require a mandate or any other substantive legal authority to represent. Nor can such a condition be derived from the term “appointed” in paragraph (i). Rule 5.3 (b) RoP refers to the information that the representative or any other person lodging the application must provide, namely its name, postal address and electronic address. Paragraph (i) does not say anything about a mandate, a power of attorney or the like. This can only be found in paragraph (ii). The idea behind this is that a representative in accordance with Art. 48 UPCA is deemed to be duly authorised. He is entitled to take all actions before the Court whereby he is expected to act within the limits of his power of representation. If he does not have power or representation or exceeds it, the applicant or patent proprietor has the rights under Rule 5A RoP. However, as already mentioned, there is no reason to assume that the Defendant can invoke the lack of power or representation against the opt-out or its withdrawal in a Preliminary objection. The Rules of Procedure do not contain any provision from which it could be inferred that the Defendant could rely on the lack of power of representation.
- 26 Rule 5A RoP entitles only the applicant or the patent proprietor. Rule 285 RoP is also not applicable in this context. On the contrary, according to this provision, the existence of the power or representation of a UPC representative in accordance with Art. 48 UPCA is presumed. However, due to the unilateral nature of the procedure to opt out or to withdraw the

opt-out, there is no opposing party that could challenge the representative's power of representation under Rule 285.1 RoP. The Defendants have therefore raised their objection in the present infringement proceedings that Ms Huang was not duly authorised to withdraw the opt-out. However, these are different proceedings from the opt-out procedure, and Ms Huang is not a representative in the present proceedings.

- 27 Finally, nothing else can be inferred from the case law of the Court of Appeal. Its Order of 18 September 2024, which was issued in parallel infringement proceedings, does address the principles of statement, substantiation and proof in the context of Rule 285.1 RoP if the power of representation is challenged. But it does not answer the question of whether this power of representation is a necessary requirement for the effective withdrawal of an opt-out under Rule 5.3 (b) (i) RoP, the lack of which can be asserted by means of a Preliminary objection. The latter must be denied for the reasons stated above.

II.

- 28 In the present case, Ms Huang has effectively withdrawn the opt-out of the patent-in-suit, which therefore falls within the jurisdiction of the UPC.

1.

- 29 It is undisputed that the withdrawal of the opt-out is entered into the register.

2.

- 30 The formal requirements for the withdrawal of the opt-out pursuant to Rule 5.7 RoP in conjunction with Rule 5.3 RoP have been met.
- 31 The Defendants only argue that Ms Huang who lodged the application to withdraw the opt-out, did not have proper power of representation for lodging the application on behalf of the proprietor of the patent-in-suit. However, in the present proceedings, Rule 5.3 (b) (i) RoP is applicable because the Claimant has stated that Ms Huang is an acknowledged and registered UPC representative according to Art. 48 UPCA. This has not been disputed by the Defendants. As discussed in detail above, the material power of representation is not a requirement for the effectiveness of the withdrawal of an opt-out under Rule 5.3 (b) (i) RoP, the lack of which could be asserted in a Preliminary objection.

However, even if one were to admit the objection that there is no material power of representation for an effective withdrawal from the opt-out, it would not succeed in this case. As the Claimant has already pointed out and the Court of Appeal has acknowledged in parallel cases, a UPC representative according to Art. 48 UPCA holds a position of trust and, as follows from R.285 RoP, acting for a party before the Unified Patent Court is not required to submit a written mandate or a power of attorney, unless the Court upon a challenge of the representative powers, explicitly orders a representative to produce a written authority (Court of Appeal, Order of 18 September 2024, UPC_CoA_2642024, APL_30168/2024 – NST/Audi). In the case at hand, submission of a written mandate or power of attorney is not necessary, since the Defendants have not brought any substantiated reasons why the actual existence of

a valid power of attorney should be called into question. The present case is no different from the case decided by the Court of Appeal. The defendant's submission is limited to the mere fact that representatives other than the UPC representative Ms Huang are registered in the EPO and national patent registers. That is, as the Court of Appeal already found (Order of 18 September 2024, UPC_CoA_2642024, APL_30168/2024 – NST/Audi), not sufficient.

- 32 As far as the Defendants have contested that the withdrawal of the opt-out was effective with regard to all other formal requirements of a withdrawal, their submissions are not sufficiently substantiated. The Claimant has stated that the legal requirements for the withdrawal of the opt-out have been met because after Ms Huang signed and lodged the application, the registry issued an “Acknowledgment of Withdrawal of Opt-out” document regarding the patent-in-suit, which proves that all formal requirements for the withdrawal have been met. The Defendants did not specify which specific requirement would not have been fulfilled.

3.

- 33 The Defendants do not assert that the requirements of Rule 5.8 RoP are met. Other objections have not been raised.

C

- 34 In accordance with Rule 20.1 RoP, the parties are informed that the proceedings will be continued in accordance with the Rules of Procedure as the preliminary objection is rejected. The parties have the opportunity to submit any outstanding pleadings in due time.
- 35 A decision on the costs is not necessary. The costs of the Preliminary objection will be addressed to the main proceedings.
- 36 Pursuant to Rule 21.1 RoP, an appeal against a decision of the Judge-rapporteur rejecting the preliminary objection may only be lodged in accordance with Rule 220.2 RoP. Accordingly, the appeal must be allowed by the Judge-rapporteur, who has discretionary power in this matter, taking into account recital 8. In the present case, the appeal is not to be allowed. The decision sets out additional arguments and reasons in part as to why the objections raised by the defendants are unsuccessful. However, this does not contradict the case law of the Court of Appeal, which leads to the same result.

ORDER

The Defendants 3) to 5)‘ Preliminary objection is rejected.

The proceedings will be continued.

Appeal is not allowed.

DETAILS OF THE ORDER

Order no. ORD_69426/2024 in ACTION NUMBER:

UPC number:

Action type:

Related proceeding no. Application No.:

Application Type:

ACT_8064/2024

UPC_CFI_65/2024

Infringement Action

22897/2024

Preliminary objection