



No. APP_34320/2025
UPC_CFI_495/2025

ORDER
of the President of the Court of First Instance
in the proceedings before the Local Division HAMBURG
pursuant to R. 323 RoP (language of the proceedings)
Issued on 08/09/2025

HEADNOTE:

- When deciding on an application to change the language of the proceedings to the language in which the patent was granted for reasons of fairness, all relevant circumstances must be considered. In the context of this overall assessment, due consideration must be given to the need for the adverse party to coordinate and communicate internally in view of their defence.

KEYWORDS:

Change of the language of the proceedings – Art. 49 (5) UPCA and R. 323 RoP

APPLICANT (DEFENDANT IN MAIN PROCEEDINGS):

HMD Global Oy

Bertel Jungin aukio 9 - 02600 - Espoo - FI

Represented by: Oliver Bäcker - Hogan Lovells International LLP

RESPONDENT (CLAIMANT IN MAIN PROCEEDINGS):

Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V.,

Hansastraße 27c - 80686 - München - DE

Represented by: Volkmar Henke - Bardehle Pagenberg Partnerschaft mbB

PATENT AT ISSUE: EP2609590

SUMMARY OF FACTS

By a statement of claim filed on 04 June 2025, Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V., brought an infringement action against the Applicant based on EP2609590 (No. ACT_26409/2025 UPC_CFI_495/2025).

By a generic procedural application dated 05 August 2025 (“the Application”), HMD Global Oy, referring to R. 323 RoP, requested that the language of the proceedings be changed from German to English. Pursuant to R. 323.1. RoP, the Application was forwarded to the President of the Court of First Instance of the UPC by email dated 7 August 2025. By an order dated 8 August 2025, the Claimant in the main action (No. ACT_26409/2025 UPC_CFI_495/2025) was subsequently invited in accordance with R. 323.2 RoP to indicate within 10 days its position on the admissibility of the request and on the use of the language in which the patent was granted, namely English, as language of the proceedings.

Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. submitted their written comments on 20 August 2025.

The panel of the LD Hamburg has been consulted in accordance with R. 323.3 RoP.

INDICATION OF THE PARTIES’ REQUESTS:

The Applicant requests that:

- The language of the proceedings be changed to the language in which the patent was granted, i.e. English.
- The order to change the language of the proceedings will not depend on any translation or interpreting arrangements.

Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. requests that the Court:

- Decide on the Application to change the language of the proceedings without oral hearings.
- Reject the Defendant’s Application.

- Should the request to change the language of the proceedings be granted, order that a translation of the pleadings and annexes already submitted is not required.

POINTS AT ISSUE:

HMD Global Oy states that the requested change is necessary pursuant to Article 49 (5) UPCA in conjunction with R. 323(1) RoP, for reasons of fairness and considering all relevant circumstances including the position of the parties – in particular the position of the Defendant – for the following reasons:

- The Court of Appeal (“CoA”) in its order dated 17 April 2024 (UPC_CoA_101/2024), specified the circumstances to be considered when changing the language of the proceedings, which should relate to the specific case and to the situation of the parties.
- In the present dispute, the evidence and annexes are predominantly submitted in English, the Defendant is based in a non-German speaking country and communicates with its legal representatives and technical experts exclusively in English, which was also the language used in prior exchanges between the parties.
- The current language of the proceedings is considerably detrimental to HMD Global Oy as its proper defence requires a significant amount of translation work, leading to costs and important delays.
- The requested change would instead not disadvantage the Claimant, which is active internationally.
- The position of the Defendant is decisive in the absence of any other indication.

The Applicant further contends that a translation of the existing written pleadings and other documents beyond those already available pursuant to R. 324 RoP is not required.

Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. states that the Application should in principle be dismissed for the following reasons:

- A change in the language of the proceedings cannot be made for sole reasons of convenience. Rather, it requires identifying grounds of fairness and weighing up all circumstances.
- The expenses incurred in the context of the dispute can reasonably be expected by the Defendant, describing itself as an international company actively present in 200 countries.
- The respective size of the parties is not relevant in the present case. Even though the Fraunhofer Society for the Promotion of Applied Research operates beyond German-speaking areas, the coordination of the proceedings is carried out

exclusively with the Fraunhofer Institute "IIS" headquartered in Erlangen, whose other entities are also located in Germany. It should also be noted that the association's main offices are in Munich.

- The choice of German as the language of the proceedings was deliberately by the Claimant considering the above.
- The Defendant has already submitted a request for an extension of the time limits with reference to the present Application. However, HMD Global Oy has sufficient resources to defend itself adequately in compliance with the RoP. The language of the proceedings doesn't affect the communication between German representatives.

The Claimant further indicates that should it be in the interest of a smooth conduct of the proceedings and deemed appropriate by the Court and the panel of the local division, they would not object to the requested change and agree that a translation of the pleadings and annexes already submitted are not necessary.

Further facts and arguments as raised by the parties will be addressed below if relevant for the outcome of this Order.

GROUNDINGS FOR THE ORDER:

1- Admissibility of the Application

It is first noted that the admissibility of the Application is not disputed in the present case.

2- Merits of the Application

According to Art. 49 (1) UPCA, the language of the proceedings before a local division must be an official language of its hosting Member State or alternately the other language designated pursuant to Art. 49 (2). It is further provided by R. 323 RoP that "1. If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(5) of the Agreement (...) [t]he President, having consulted [the other parties and] the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements".

Regarding the criteria that may be considered to decide on the Application, Art. 49 (5) UPCA specifies that “(...) the President of the Court of First Instance may, on grounds of fairness and taking into account all relevant circumstances, including the position of parties, in particular the position of the defendant, decide on the use of the language in which the patent was granted as language of proceedings (...)”.

By an order dated 17 April 2024, the UPC Court of Appeal (hereinafter “CoA”) ruled that when deciding on a request to change the language of the proceedings to the language of the patent for reasons of fairness, all relevant circumstances must be taken into account. These circumstances should primarily relate to the specific case, such as the language most commonly used in the relevant technology, and to the position of the parties, including their nationality, domicile, respective size, and how they could be affected by the requested change (UPC_CoA_101/2024, Apl_12116/2024, para. 22-25). It was furthermore stated that the internal working language of the parties, the possibility of internal coordination and of support on technical issues are relevant circumstances, while other proceedings pending before a national court, which do not relate to the dispute, are in themselves of less relevance (UPC_CoA_354/2024, Apl 38948/2024, Order dated 18 September 2024, para. 26-27).

In the event that the result of the balancing of interests is the same in the context of this overall assessment, the CoA found that the emphasis placed “in particular” on the position of the defendant under Art. 49 (5) UPCA is justified by the flexibility afforded to the claimant which frequently has the choice of where to file its action – since any local or regional division in which an infringement is threatened or taking place is competent – and can generally choose the most convenient timeframe to draft its Statement of Claim, while the defendant is directly bound by strict deadlines. The position of the defendant(s) is consequently the decisive factor if both parties are in a comparable situation.

In the same decision, the CoA also held that *“for a claimant, having had the choice of language of the patent, with the ensuing possibility that the claimant/patentee may have to conduct legal proceedings in that language, as a general rule and absent specific relevant circumstances pointing in another direction, the language of the patent as the language of the proceedings cannot be considered to be unfair in respect of the claimant”* (para. 34).

According to the abovementioned caselaw, addressing the issue of fairness involves considering the language of the patent and the language commonly used in the technology in question, alongside all circumstances identified as being relevant in the requested assessment of the respective interests of the parties with a particular consideration for the Defendant(s).

In the present case, the fact that the language most used in the technology in question – relating to audio processing and audio decoding – is English is not disputed and evidenced by the list of annexes submitted.

The Claimant mainly submits that its geographical scope of activities – focused on Germany although extended to non-German speaking countries – as well as its internal organization, represent valid reasons to choose German as the language of the proceedings. It is further argued that the status of the Defendant, operating worldwide, means that HMD Global Oy is sufficiently equipped to be sued in a language other than English.

It is true that a multinational company with substantial legal department is supposed to have adequate resources to deal with and coordinate international disputes in different languages (UPC_CoA_101/2024 APL 12116/2024, para. 24). However, due consideration must also be given to the need for such entities to coordinate and communicate internally in view of their defence. This strategic coordination is necessarily affected if the proceedings are not conducted in their usual working language (UPC_CoA_354/2024_APL_38948/2024, para. 26). For a Finnish company, being sued in German involves significant time constraints and translation work, which is to be weighed with the consequences borne by the Claimant. Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V. is a research Institute active in Germany and abroad. Given this context, they regularly need to communicate in English in their daily work and continuing the proceedings in this language doesn't involve considerable efforts compared to those incurred by HMD Global Oy having to prepare its defence in German.

These circumstances shall be considered in combination with the general principles identified by the CoA and previously mentioned, according to which:

- being sued in the language in which the patent was granted shall be expected – and consequently, is not unfair – from the Claimant's side, unless specific aspects of the case call for another solution.
- the position of the Defendant shall prevail in the overall assessment and balancing of the respective interests if both parties are in a comparable situation.

Finally, as rightly recalled by the Claimant, the requested change should not affect the course of the proceedings nor cause any delays. As HMD Global Oy filed the present Application timely before its Statement of Defense, it can be implemented at an early stage (CoA_101/2024 – APL_12116 – order dated 17 April 2024 – para. 25).

It follows from the above that the Application must be granted without additional interpretation and translation arrangements pursuant to R. 324 RoP, which are not required in the present situation according to both parties.

ON THESE GROUNDS

- 1- The language of the proceedings shall be changed to the language in which the patent was granted, namely English.
- 2- The present order shall not be conditional on other specific translation or interpretation arrangements.
- 3- An appeal may be brought against the present order within 15 calendar days of its notification pursuant to Art. 73. 2 (a) UPCA and R.220 (c) RoP.

INSTRUCTIONS TO THE PARTIES AND TO THE REGISTRY

The next step requires the Applicant to file the Statement of Defence within the time period prescribed by the Rules of Procedure.

ORDER

Issued on 8 September 2025

NAME AND SIGNATURE

Florence Butin
President of the UPC Court of First Instance