



UPC_CFI_743/2025
Local Division Munich

ORDER
of the President of the Court of First Instance
in the proceedings before the Local Division MUNICH
pursuant to R. 323 RoP (language of the proceedings)

Issued on 29/10/2025

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 taken into account. Internal working language of the parties and their possibility of internal coordination and support are relevant considerations.
- arguments referring to the conditions in which the final decision may be enforced are of less relevance in the overall assessment, as they relate to the outcome of the trial and not to the respective situation of the parties during the proceedings.

KEYWORDS:

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

APPLICANTS (DEFENDANTS IN THE MAIN PROCEEDINGS):

1- Skechers USA Deutschland GmbH

Waldstraße 66, 63128 Dietzenbach - Germany

2- Skechers S.a.r.l

Alte Steinhauserstrasse 14, 6330 Cham (Kanton Zug), Switzerland

3- Skechers U.S.A., Inc.

228 Manhattan Beach Blv., Manhattan Beach, California, 90266, USA

4- Skechers EDC SPRL

Avenue du Parc Industriel 159, 4041 Herstal, Belgium

5- Skechers USA Italia Srl

Via Energy Park 6, 20871 Vimercate (MB), Italy

6- Skechers USA France SAS

Immeuble Bercy Crystal, 14 rue Gerty Archimède, 75012 Paris, France

Represented by: Timothy Whitfield & Peter Damerell (Powell Gilbert (Europe) LLP), Martin Bicker & Anthony Albutt (D Young & Co LLP), Axel Verhauwen, Michael Bergermann & Julia Vogtmeier (Krieger Mes Part mbB).

RESPONDENT (CLAIMANT IN THE MAIN PROCEEDINGS):

FAST IP, LLC

1172 West 700 North, Suite 200, Lindon UT 84042, USA

Represented by: Bernd Allekotte, Julia Traumann, Jens C. Koch & Sebastian Flach (Grünecker PartG mbB).

PATENT AT ISSUE: EP4003084

SUMMARY OF FACTS

By a statement of claim filed on 13 August 2025, FAST IP LLC brought an infringement action against the Applicants (hereinafter collectively referred to as “Skechers” or “the Defendants” in reference to their role in the main proceedings) based on EP4003084 titled “*Rapid-entry foot wear having a stabilizer and an elastic element*”.

By a procedural application dated 26 September 2025 the Defendants, referring to R. 323 RoP, requested that the language of the proceedings be changed from German to English (hereinafter “the Application”). The Claimant in the main action was subsequently invited, in accordance with R. 323.2 RoP, to state its position on the admissibility of the Application and on the use of the language in which the patent was granted, namely English, as language of the proceedings.

FAST IP, LLC submitted their written comments on 17 October 2025.

The Application was forwarded to the President of the UPC Court of First Instance pursuant to R. 323.1. RoP.

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

INDICATION OF THE PARTIES’ REQUESTS:

The Applicants request that:

1. The language of the proceedings be the language in which the patent was granted, namely English.
2. The German annexes be translated at the Claimant’s expense pursuant to R. 324 RoP.

FAST IP LLC requests that the Court dismiss the Application.

POINTS AT ISSUE:

The Applicants state that the change of the language of the proceedings to the language in which the patent was granted is justified in the present case for the following reasons:

- The language of the patent cannot be considered unfair towards the Claimant in the absence of specific circumstances indicating otherwise.
- All defendants are part of the Skechers group based in California, and only one out of its subsidiaries involved in the dispute has registered offices in Germany. English is the internal language within the company, as to communication with legal and technical consultants, advising and management. The current language of the proceedings would therefore entail considerable additional work, time and expenses with the related risk of delays. In contrast, neither party would recourse to translations if the

language of the proceedings was changed to English. Furthermore, FAST IP submitted annexes in this language while requesting to be waived from translations.

- Regarding the circumstances of the case, eleven of the twelve documents referenced by the patent are in English as is the prior art mentioned in the description. This evidences that English is the common language in the relevant technical field, which also argues in favor of the requested change.
- The present Application was preceded by exchanges between the parties seeking an amicable agreement and filed at an early stage before the time limit for lodging the Statement of Defence. There will consequently be no delays in the overall course of the proceedings.
- The Claimant did not invoke relevant circumstances justifying their choice to file their action in German, while the language skills of the representatives are not relevant considerations.
- As previously emphasized by the CoA, the position of the defendant(s) is the decisive factor when weighing up the interests involved.
- With respect to the consequences of the change pursuant to R. 324 RoP, the Defendants offer to rely on their certified translation of the Statement of Claim while the annexes submitted in German should be translated at the Claimant's expenses.

FAST IP LLC contends that the Application should be dismissed for the following reasons:

- They deliberately selected German as an official language of the division – which is an option offered to the Claimant – to ensure that discussions on technical and legal questions will be as precise and nuanced as possible.
- There are no reasons for fairness within the meaning of Article 49(5) UPCA that would justify the requested change, even taking into account all relevant circumstances as the language of the patent as such is not sufficient.
- The factual aspects of the case are closely connected to the German market, which is of practical relevance while considering the possible enforcement of the decision.
- Any translation costs incurred cannot be a relevant factor for an international and globally active company which is accustomed to conducting patent disputes before foreign courts with the involvement of legal teams composed of representatives from different law firms.
- Two members of the panel who will hear the case and the majority of the representatives involved are native German speakers.
- In contrast, written submissions can easily be made available into any language by translation tools.

- The UPC is designed as a multilingual system where there is no primacy of the English language even if the trend may be moving in that direction. The Claimant's choice has legal basis and does not require any further justification, especially since a US company made a conscious decision to use another language than English.

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- 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_CofA_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).

Considering the abovementioned provisions and relating consistent caselaw, the request made by the Defendants shall be granted for the following reasons.

- Legal framework provided for by Art. 49 (5) and R. 321 to 324 RoP:

As rightly recalled by FAST IP, the Claimant has the option to select one of the official languages of the Division concerned as a general rule. This right can be limited for reasons of fairness that need to be substantiated by the Applicants. The disputed point here is whether all circumstances invoked by the Defendants involve such a fairness issue and create an unbalanced situation beyond any inconvenience normally borne by the parties engaging in international patent litigation. This assessment shall be made with regard to all factors identified by the CoA, as summarised notably in its decision dated 18 September 2024 (UPC_CoA_354/2024 – APL_38948/2024).

- Circumstances related to the case and the position of the parties:

The field of technology in question relates to human necessities and more specifically to characteristic features of footwear. The references cited by the patent are almost all US documents. It is therefore expected that further exhibits provided in support of further discussions will be originally in English.

While the relevance of the language used in discussing both validity and scope of the protection conferred by the patent is an important factor for the reasons mentioned by the

CoA, it has to be weighed alongside the respective situation of the parties with a particular consideration to the Defendants who belong to the US Skechers group of entities having its parent company registered in California. All subsidiaries involved in the dispute – except from Skechers USA Deutschland GmbH – are headquartered in countries that have various official languages (other than German), which means that they necessarily use English for their daily business and internal communication including legal and technical support in the context of the present action. The importance of this internal coordination for an efficient preparation of the defence – especially in the context of strict time limits and UPC procedural requirements – has been acknowledged by the CoA in its decisions dated 17 April. 2024 (UPC_CoA_101/2024_APL_12116/2024) and 18 September 2024 (UPC_CoA_354/2024 APL38948/202).

- Balance of respective interests:

In response to these arguments, FAST IP puts forward that the importance of the German market in the present case justifies facilitating the possible enforcement of the upcoming decision in this geographical scope in practice, referring to all formal translation requirements and additional subsequent hurdles. However, the conditions in which the final decision may be enforced in the territory where the alleged infringement occurred are of less relevance in the overall assessment, as they relate to the outcome of the trial – which cannot be anticipated – and not to the respective situation of the parties during the proceedings (No. APP_28457/2025 - UPC_CFI_448/2025 - Order dated 3 July 2025 – LD Munich).

The native language of the judges composing the panel and of the representatives cannot either be validly invoked. The language regime of the UPC indeed entails that cases can be managed and heard in English with all divisions irrespective of their composition. This multilingual framework is reflected by the representatives and law firms involved, which are adequately equipped to prepare written submissions and oral phases in any official language either chosen by the Claimant or alternately, being determined by the patent in question.

Against this background, none of the circumstances invoked by the Claimant – enforcement processes, language skills of the Court and all contributing teams – justify deviating from the general principle established by the case law as summarized above, according to which the defendant's position shall prevail in the assessment of all interests at stake in order to balance the advantage enjoyed by the patent holder who is aware of the predictable legal consequences attached to their choice to be granted or to acquire a patent in a given language.

Finally, with regard to the conditions under which the present Application has been filed ahead of the time limit imposed to submit the Statement of Defence, the requested change will not affect the course of the proceedings nor cause any delays as it can be implemented at an early stage (CoA_101/2024 – APL_12116 – order dated 17 April 2024 – para. 25).

The Application shall consequently be granted.

2- Consequences of the change in the course of the proceedings (R. 324. RoP):

According to R. 323.3 and 324 RoP, the Applicants shall specify whether existing pleadings and other documents should be translated and at whose expense. The subsequent order may therefore be conditional on specific translation or interpretation arrangements.

In the present case, as both parties are assisted by teams of representatives possessing skills in either English and German, it appears reasonable and cost-efficient to limit the translation to the existing written pleadings – namely the Statement of Claim, which is already available in English – and leave to the judge-rapporteur to decide otherwise should it be appropriate at a later stage for the annexes currently submitted in German.

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 Applicants to file the Statement of Defence within the time period prescribed by the Rules of Procedure.

ORDER

Issued on 29 October 2025

NAME AND SIGNATURE

Florence Butin
President of the UPC Court of First Instance