



Appeal n°:  
UPC\_CoA\_904/2025  
and  
UPC\_CoA\_905/2025

**ORDER**  
**of the Court of Appeal of the Unified Patent Court**  
**concerning a Preliminary objection (R.19 RoP)**  
**issued on 16 March 2026**

HEADNOTES

- (i) The decision to deal with the Preliminary objection in the main proceedings may be taken either by the judge-rapporteur, as laid down in R. 20.2 RoP, or by the panel if the judge-rapporteur has decided to refer the matter to the panel to decide.
- (ii) This follows from the first part of R. 102.1 RoP, according to which the judge-rapporteur may refer any matter to the panel for decision. Although this provision is provided for under Chapter 2 (R. 101 to 110 RoP) of the Rules of Procedure on the interim procedure, it shall apply mutatis mutandis to the written procedure where the judge-rapporteur, after his assignment to the case by the presiding judge pursuant to R. 18 RoP, is likewise tasked with the management of the case, including case management decisions or orders relating to a Preliminary objection.
- (iii) This is further confirmed by R. 331 RoP on the responsibility for case management which provides that (R. 331.1 RoP) during the written procedure and the interim procedure, case management shall be the responsibility of the judge-rapporteur subject to Rules 102 and 333 and that (R. 331.2 RoP) the judge-rapporteur may refer a proposed order to the panel. Case management includes, *inter alia*, deciding the order in which issues are to be decided and ordering that issues or matters are to be heard together (R. 334(e) and (i) RoP).

KEYWORDS

Competence of the Court, Preliminary objection; UPCA Art. 32, R. 19 and 20 RoP.

APPELLANTS (DEFENDANTS IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

1) **Vivo Mobile Communication Co., Ltd.**, No. 1, Vivo Road, Chang'an Town, 523866 Dongguan City, China

2) **Vivo Tech GmbH**, Speditionstrasse 21, 40221 Düsseldorf, Germany

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(hereinafter jointly “**VIVO**”)

represented by Dr Georg Rauh, attorney-at-law, Vossius & Partner Patentanwälte Rechtsanwälte mbB

RESPONDENT (CLAIMANT IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

**Sun Patent Trust**, Madison Avenue, 35th Floor, 10022 New York, United States of America

(hereinafter “**SUN PATENT**”)

represented by

- Caroline Levesque, attorney-at-law, and other representatives of HOYNG ROKH MONEGIER (in UPC\_CoA\_904/2025),
- Sabine Agé, attorney-at-law, and other representatives of HOYNG ROKH MONEGIER (in UPC\_CoA\_905/2025)

PATENTS AT ISSUE

EP 3 407 524 (in UPC\_CoA\_904/2025)

EP 3 852 468 (in UPC\_CoA\_905/2025)

DECIDING JUDGES

Panel 1a

Klaus Grabinski, presiding judge and President of the Court of Appeal

Emmanuel Gougé, legally qualified judge and judge-rapporteur

Peter Blok, legally qualified judge

LANGUAGE OF THE PROCEEDINGS

English

IMPUGNED ORDERS OF THE COURT OF FIRST INSTANCE

- In appeal proceedings CoA\_904/2025:

Order of the Court of First Instance of the Unified Patent Court, Paris Local Division, dated 30 October 2025, on a Preliminary objection (R. 19 RoP)

Reference numbers: UPC\_CFI\_362/2025; ACT\_18934/2025

- In appeal proceedings CoA\_905/2025:

Order of the Court of First Instance of the Unified Patent Court, Paris Local Division, dated 30 October 2025, on a Preliminary objection (R. 19 RoP)  
Reference numbers: UPC\_CFI\_361/2025; ACT\_18933/2025

DATE OF THE ORAL HEARING

9 March 2026

FACTS AND REQUESTS OF THE PARTIES

*The first instance proceedings*

1. On 18 April 2025 SUN PATENT brought two infringement actions against VIVO before the Court of First Instance, Paris Local Division (hereafter “Paris LD”) (ACT\_18933/2025 UPC\_CFI\_361/2025 and ACT\_18934/2025 UPC\_CFI\_362/2025), seeking inter alia a determination of the terms of a fair, reasonable and non-discriminatory (hereafter “FRAND”) licence between the parties in the field of 4G+ technologies, as follows:
  - A. As the principal claim,
    - I. [INFRINGEMENT] to hold that the Claimant has demonstrated that the Defendants infringe [the specific claims of the patent at issue] by offering, importing, exporting, using, placing on the market, in France and Germany, 4G+ compatible mobile phones and devices including but not limited to [...];
    - II. [FRAND TERMS] To find that the terms on which the Claimant is willing to license [the patent at issue], as set out in HRM Exhibit No. 9.4 are FRAND. Alternatively, where the Court determines that adjustments are required to the terms on which the Claimant proposes to license [the patent at issue], in order to bring these terms into the FRAND range, to find those (adjusted) terms to be FRAND.
    - III. In the event that the Defendants and each of them do not enter into a licence on such terms as the Court determines to be FRAND within a specified time period to be directed by the Court:
      1. [INJUNCTION] subject to a penalty to be determined by the Court for each case of infringement, an injunction to restrain the Defendants and each of them (whether acting by their directors, officers, employees, agents or otherwise howsoever) from infringing [the patent at issue] (Article 63 UPCA) in the Contracting Member State in which European Patent No. [...] has effect [...].
      2. [DESTRUCTION] [...].
2. VIVO filed a Preliminary objection pursuant to R. 19 RoP in each CFI proceedings and objected to the jurisdiction of the UPC, arguing in summary that an independent claim for determination of a FRAND rate lodged by the Claimant does not fall under the exclusive competence of the UPC as listed under Art. 32(1) UPCA, as well as under the competence of the Paris LD under Art. 33(1) UPCA.
3. The panel of the Paris LD rejected the PO “entirely [...], specifying that the admissibility of claim A.II in the Statement of claim as regards Art. 32.1 UPCA shall be dealt with in the main proceedings” and granted leave to appeal. It considered inter alia, concerning the competence of the UPC under Art. 32 (1) UPCA in relation to the FRAND claims, that the main issue is the infringement of an essential patent, whereas the question of the FRAND offer is only incidental or dependent on the main issue and that SUN PATENT anticipated this

incident and made it a condition of its application for an injunction against infringement (impugned orders of 30 October 2025, p.5, para 5 and 6).

4. With their Statements of defence (hereafter “SoD”), VIVO filed a FRAND defence, arguing inter alia that the FRAND objection is applicable, based on EU competition law as well as contractually on the ETSI IPR Policy (SoD of 28 November 2025, para 134 ff).

#### *The appeal*

5. VIVO lodged an appeal against the impugned orders, requesting the Court of Appeal to reverse the orders insofar as the Paris LD has deferred the decision regarding admissibility of claim A.II. of the Statement of claim (hereafter “SoC”) to a decision in the main proceedings and insofar as the objection regarding admissibility of claim A.III. of the SoC has been rejected, and to dismiss claims A.II and A. III of the SoC as inadmissible for lack of competence of the UPC according to Art. 32 UPCA and R. 19.1 (a) RoP.
6. VIVO argue in summary that the Paris LD was wrong in exercising its discretion and by deferring the jurisdictional question instead of deciding it in accordance with R. 20.1 RoP: only the judge-rapporteur - not the panel - may defer the Preliminary objection to the main proceedings pursuant to R. 20.2 RoP, and the Paris LD mischaracterised principal claim A.II, which is not incidental to infringement but a separate and independent request for a binding res judicata declaration of FRAND licence terms for which the UPC lacks jurisdiction.
7. VIVO also requested to stay the main proceedings or, alternatively, to extend the terms for filing the SoD, which was rejected by the Court of Appeal (CoA Order of 27 November 2025).
8. SUN PATENT requests the Court of Appeal to dismiss the appeal.
9. It refers inter alia to R. 102.1. RoP according to which the judge-rapporteur may refer any matter to the panel for decision, and the panel may of its own motion review any decision or order of the judge-rapporteur or the conduct of the interim procedure and argues that deferring the jurisdiction issue to the main proceedings ensures procedural efficiency and cost-effectiveness in according to Art. 41(3) UPCA. It further argues that SUN PATENT is not asserting an independent FRAND rate determination claim, that no relief is sought in subsection A.II of its claim but rather that SUN PATENT’s action is an action for infringement for which relief is sought in claim A and that the claim for an injunction in claim A.III is conditioned upon a preliminary step made necessary by contractual and European competition law that the Court rules on whether SUN PATENT’s license offer is FRAND (claim A.II).

#### GROUNDS

10. The appeal is admissible but is unfounded and shall be dismissed for the following reasons.

#### *Deferral ordered by the panel*

11. The Court of First Instance has discretion to either decide on the Preliminary objection as soon as practicable after claimant has provided its written comments or had the opportunity to do so, as provided for in

R. 19.5 RoP, or decide to deal with the Preliminary objection in the main proceedings (see CoA order of 18 Sept. 2024, UPC\_CoA\_265/2024, APL\_30169/2024, Volkswagen AG/Network System Technologies, para 23).

12. The decision to deal with the Preliminary objection in the main proceedings may be taken either by the judge-rapporteur, as laid down in R. 20.2 RoP, or by the panel if the judge-rapporteur has decided to refer the matter to the panel to decide.
13. This follows from the first part of R. 102.1 RoP, according to which the judge-rapporteur may refer any matter to the panel for decision. Although this provision is provided for under Chapter 2 (R. 101 to 110 RoP) of the Rules of Procedure on the interim procedure, it shall apply mutatis mutandis to the written procedure where the judge-rapporteur, after his assignment to the case by the presiding judge pursuant to R. 18 RoP, is likewise tasked with the management of the case, including case management decisions or orders relating to a Preliminary objection.
14. This is further confirmed by R. 331 RoP on the responsibility for case management which provides that (R. 331.1 RoP) during the written procedure and the interim procedure, case management shall be the responsibility of the judge-rapporteur subject to Rules 102 and 333 and that (R. 331.2 RoP) the judge-rapporteur may refer a proposed order to the panel. Case management includes, *inter alia*, deciding the order in which issues are to be decided and ordering that issues or matters are to be heard together (R. 334(e) and (i) RoP). It follows, that the Court of First Instance's order that the admissibility of claim A.II will be dealt with in the main proceedings is a case management order that the judge-rapporteur was permitted to refer to the panel.
15. It follows that, contrary to VIVO's argument, there has been no legal error in that the panel – and not the judge-rapporteur - decided that the admissibility of claim A.II of the SoC shall be decided in the main proceedings.

*The discretion exercised by the panel*

16. The second aspect to be reviewed by this Court is whether the Paris LD, by deciding as it did, has overstepped the boundaries of its discretion and could not reasonably have come to its decision to defer the assessment of the admissibility of claim A.II of the SoC to the main proceedings.
17. Considering that the CFI has a margin of discretion to either decide on the Preliminary objection as soon as practicable or to deal with it in the main proceedings, the review by the Court of Appeal is limited. If, within this limited scope of review, it is established that the CFI erred in using its discretion, for example by misusing or exceeding its discretion, the order must be set aside.
18. The LD Paris has not misused or exceeded its margin of discretion in deciding to defer the decision on the admissibility of claim A.II of the SoC to the main proceedings. There are sound reasons of case management efficiency for the admissibility of claim A.II to be dealt with in the main proceedings.
19. The Paris LD rightly held, *inter alia*, that it follows from reading the contested operative part of the SoC, that SUN PATENT's main claim consists primarily of an infringement action, that SUN PATENT has merely anticipated the so-called "FRAND defence" that the defendant is raising against this type of infringement

action, that the main issue is the infringement of an essential patent, whereas the question of the FRAND offer is only incidental or dependent on the main issue (impugned orders, p.5, para 2 to 6). The Court of Appeal understands that the Paris LD thereby considered the possibility that it will not need to decide on the admissibility of claim A.II if the question of whether VIVO infringe the patent is answered in the negative in the main proceedings.

20. With its appeal, VIVO have failed to demonstrate that SUN PATENT's claim under part A.II of the operative part of the SoC amounts to an independent claim that will have to be decided upon even if the Court were to conclude that VIVO do not infringe the patent. The wording of claim A.III makes it clear that SUN PATENT requests an injunction in the event that VIVO do not enter into a licence on such terms as the Court determines to be FRAND. The FRAND determination as requested under A.II is therefore a necessary step to impose the injunction requested under A.III. If the Court were however to find that VIVO do not infringe the patent, it will not grant the injunction, and the FRAND determination will not be necessary.
21. This is further supported by the reasons developed in the SoC, under part C on "remedies sought by the Claimant" (SoC p. 76), in which the request for FRAND determination is unambiguously presented as a condition of the granting of remedies : "by its principal claim, the Claimant requests as a condition of the granting of remedies that the Court determines the terms of the FRAND licence that the Claimant is obliged to offer (C.I) and in the event that the Defendants are not willing to accept the licence terms determined by the Court to be FRAND then the Claimant seeks the remedies set forth in C.II" (SoC, para 250, first sentence).
22. In addition, as rightly pointed out by the Paris LD, all facts and arguments relevant to the determination of FRAND terms, whether admissible or not, will have to be debated by VIVO in any event in the context of their FRAND defence (impugned orders, p.5, para 7), which the Paris LD – in line with the expectations of the parties at the time – assumed would follow. It is even more so since VIVO have, with their SoD (see above para 4), meanwhile filed a FRAND defence which will anyway have to be dealt with in the main proceedings, whether or not claim A.II is admissible.

#### ORDER

The Court of Appeal rejects VIVO's appeals.

This order was issued on 16 March 2026.

Klaus Grabinski, presiding judge and President of the Court of Appeal

Emmanuel Gougé, legally qualified judge and judge-rapporteur

Peter Blok, legally qualified judge