

UPC_CFI_494/2025 and 495/2025
Procedural order
of the Court of First Instance of the Unified Patent Court,
delivered on: 19/12/2025

CLAIMANT

**Fraunhofer-Gesellschaft zur Förderung der
angewandten Forschung e.V.,**
(Claimant) - Hansastraße 27c - 80686 -
München - DE

Represented by: Dr. Volkmar Henke

DEFENDANT

HMD Global Oy
(Defendant) - Bertel Jungin aukio 9 - 02600 -
Espoo - FI

Represented by: Oliver Bäcker

PATENT IN SUIT

<i>Patent nr.</i>	<i>Proprietor</i>
EP 2 380 167	Fraunhofer-Gesellschaft zur Förderung der angewandten Forschung e.V.,
EP 2 609 590	

LANGUAGE:

English, since 08. September 2025

DECIDING JUDGE

Judge-rapporteur Dr. Schilling

SUBJECT OF THE APPLICATION:

Request to produce evidence, R. 190 RoP

SHORT SUMMARY OF FACTS:

1. The Defendant requests the disclosure of licensing agreements cited by the Claimant in its Statement of Claim or in pre-trial negotiations.
2. The Defendant is of the opinion that the Claimant has an obligation under EU antitrust law to behave transparently in the license negotiations. This includes the obligation to present –

at least – the relevant license agreements relating to the MPEG-4/AAC standard, which are currently in place.

3. According to the Defendants this includes the bilateral license agreement with [...], which the Claimant mentioned in its letter dated 22 October 2018 (exhibit BP 6d, p. 16, clause 5). The Defendant is of the opinion that the fact that [...] has already obtained a license under Claimant's patent portfolio – and thus also under the Patent-in-Suit – would result in an exhaustion of the asserted claims as this comprises the consent that the mobile devices equipped with this third parties' operating system – as in particular the attacked embodiments in the case at hand – can be put on the market.
4. The Defendant refers to the fact that the Claimant mentioned vis-à-vis the Defendant in its initial letter dated 22 December 2017 that it had already concluded five bilateral license agreements, all of which (allegedly) conformed to a sample license agreement attached to the letter (presented by the Claimant as exhibit BP 6a, p. 3, para. 15), which the Defendant disputed. The Claimant had relied on these agreements with the Defendant's competitors as the benchmark for determining the presence or absence of discrimination. The Defendant argues that the disclosure is necessary for the assessment as to whether the license conditions invoked by the Claimant can be regarded as FRAND or whether they are evidently unFRAND and unacceptable due to discrimination against the Defendant.
5. Additionally, in the case at hand, the Claimant demands royalties for the period from 2017 onwards, hence for substantial periods in which the five bilateral license agreements were undisputedly still in force. The Defendant argues that at least for these royalties, the bilateral license agreements previously in force must serve as the primary FRAND benchmark as it would clearly be unFRAND if the Claimant could now demand higher royalty rates for the past years than it would have been allowed to demand while the bilateral license agreements were still in force.
6. The Claimant agreed to have the AAC Patent License Agreement ("Agreement") concluded between [...] and Claimant, which is according to the Claimant its only bilateral AAC patent license agreement currently in force, to the present proceedings. As [...] has rejected Claimant's request and pointed to a provision in the Agreement pursuant to which disclosure of the same may only be provided under a confidentiality rule, the Claimant argues that it is therefore necessary that the Court orders the submission of the Agreement by Claimant, to allow Claimant to overcome the contractual confidentiality obligation.
7. The Claimant challenged the request to produce copies of the five license agreements concluded with third parties referred to by Claimant in their initial letter to Defendant dated December 22, 2017. The Claimant argues that these license agreements are no longer in force. Thus, these license agreements are of no significance for assessing whether there is unfair discrimination within the meaning of antitrust law, as they have no impact on the competitive position of competitors.
8. The Claimant announced that it will submit a redacted copy of the AAC Patent License Agreement concluded between [...] and Via in connection with Claimant's Reply to the Statement of Defense. The Claimant is of the opinion that neither this nor the bilateral agreement between the Claimant and [...] lead to exhaustion of Claimant's rights vis-à-vis Defendant.
9. By orders of 7 and 17 November 2025 information in the Claimant's response were classified as confidential pursuant to R.262A RoP.

10. The judge-rapporteur conducted a video-conference with the parties' representatives regarding the present application on Tuesday, 16 December 2025. Reference to its contents will be made in the following.

THE PARTIES' REQUESTS:

The Defendant requests the Court to order that,

- I. the Claimant must produce electronic and unredacted copies of the five license agreements concluded with third parties the Claimant referred to in its letter to the Defendant dated 22 December 2017 (exhibit BP 6a), concerning the Claimant's MPEG-4/AAC patent portfolio;
- II. the Claimant must produce an electronic and unredacted copy of the license agreement concluded with [...] the Claimant referred to in its letter to the Defendant dated 22 October 2018 (exhibit BP 6d), concerning the Claimant's MPEG-4/AAC patent portfolio;
- III. the Claimant must produce an electronic and unredacted copy of the license agreement concluded with [...] the Claimant referred to in its email to the Defendant dated 2 October 2025 (exhibit HL-FRAND 6a), concerning the Claimant's MPEG-4/AAC patent portfolio.

The Claimant requests the Court to order,

- I. Defendant's requests under item I. and item II. are rejected.
- II. Claimant is ordered to submit a copy of the AAC Patent License Agreement concluded between [...] and Claimant referred to in Claimant's email to Defendant dated October 2, 2025, subject to that the document is classified as confidential information pursuant to a confidentiality order as outlined under item III. – VIII. below.
- III. The copy of the AAC Patent License Agreement concluded between [...] and Claimant is classified as confidential pursuant to R.262A RoP, meaning that the entire agreement must be treated as strictly confidential and must not be used or disclosed outside the present legal dispute, even after its termination.
- IV. It is ordered that access to the information classified as confidential under item I. above shall be limited, on the part of the Defendant, to the following persons:
 1. Defendant's representatives appointed in the present proceedings including their assistants and team members,
 2. the following natural persons of the Defendant
 - [REDACTED], Head of IP and Litigation,
 - [REDACTED], General Counsel,
 - [REDACTED], Assistant Legal Counsel,
 - [REDACTED], Associate General Counsel;
 3. the following natural persons of Condico IP Oy:
[REDACTED]

[REDACTED]

V. It is ordered that the persons authorized to access the confidential information pursuant to Request IV. must treat the confidential information confidential and must not use or disclose it outside of the present proceedings or to a person who is not authorized to access the confidential information pursuant to Request IV.

VI. It is ordered that the obligation to maintain confidentiality pursuant to Section V. shall continue to apply even after the conclusion of the judicial proceedings, unless the disputed information becomes known to persons from circles that ordinarily have access to such information or becomes readily accessible by other means.

VII. It is ordered that the obligation to maintain secrecy pursuant to Requests III-VI. shall continue to apply after the present proceedings have been concluded.

VIII. Prior to making orders, the judgment or any other official communication publicly available, any information contained therein that relates to the information classified as requiring confidentiality under Section III. shall be redacted.

GROUND FOR THE ORDER

I.

11. The CoA granted that the possibility to order production of evidence pursuant to R.190 RoP is open for a request by a defendant, such as in the present case, to produce (counter)-evidence. The further wording of R.190.1 RoP indicates that it is open to the parties on both sides to request an order to produce evidence. This can be seen from the use of the neutral terms “a party” and “the other party”, as the purpose of this provision and Art. 59 UPCA is to ensure that the party who has the burden of proof will have access to the tools for carrying this burden (comp. Court of Appeal, order of 24 September 2024, UPC_CoA 298-300/2024, Oppo et al v. Panasonic, mn. 32 ff.).
12. A FRAND defence leads to conflicting interests, where, as in the present case, the alleged infringer seeks to obtain evidence to support its FRAND defence. The patent holder, on the other hand, has an interest in maintaining its business secrets (and the business secrets of third parties) and not to be overburdened by procedural obligations, that may delay the proceedings UPC_CoA 298-300/2024, Oppo et al v. Panasonic, mn. 43).
13. According to the CoA in the cited decision, the Court of First Instance has discretionary powers when deciding on an application for an order to produce evidence pursuant to R. 190 RoP. The discretionary power also includes the judge-rapporteur's decision on the chronological order in which questions are to be decided in accordance with R. 334(e) RoP. The assessment of an application for an order to produce evidence may also depend on the stage of the proceedings. Such a request may be considered not to meet the criteria of necessity, relevance and proportionality at a certain stage of the proceedings, but may be considered to meet those criteria at a later stage (LD Mannheim, order of 16 September 2025, UPC_CFI_247/2025).

II.

14. Based on these requirements, the Defendant's request is currently justified in part, only

1.

15. With regard to the AAC Patent License Agreement (“Agreement”) concluded between [...] and Claimant, which is according to the Claimant its only bilateral AAC patent license agreement currently in force, Defendant’s request can be granted as the Claimant gave its consent subject to a confidentiality declaration by the Court. It has to be noted that the Claimant did in fact try to achieve the other parties’ approval, which was rejected by [...]. Passages may be redacted insofar as the Claimant does not refer to these passages for its factual allegations and legal arguments.
- 2.
16. With respect to the bilateral agreement between Claimant and [...], the Defendant’s request is not at a stage where it can be granted. The Defendant argues with an exhaustion of rights due to a licensing agreement with a third party, independent from its FRAND-defence. As the defendant is relying on a derived position of rights from [...], it is the defendant’s obligation to contact the party from which it believes it can derive a legal position. As long as the defendant has not used their own means to obtain the desired evidence, the claimant is not in a position to be forced to provide this evidence. At present, therefore, the defendant is not in a position where it is difficult to obtain evidence, which would justify an order under Rule 190 RoP.
17. However, as discussed in the video conference relating to the R. 190-request, the Claimant could support the Defendant’s efforts by declaring its approval of the the release of the contract, in advance. The Claimant’s representatives confirmed that they will discuss with its client whether this could be possible.
- 3.
18. When it comes to the five bilateral license agreements, which have all expired, Defendant’s request is not at a stage to be granted, neither. While it might be true, that at some point it could be of relevance whether the Claimant’s initial offer in the year 2017 was non-discriminatory in light of the five, then active agreements, it has to be seen that the requested injunctive relief is directed into the future and thus be assessed under the current licensing regime of the Claimant (and the pool it is participating in), not a past one.
19. Furthermore, it has to be weighed by the Court, that even though the question of non-discrimination was raised by the Defendant, the main line of defence in this respect is based on calculating the license fee from the pool license, claimant’s share of the pool’s patents, the number of expired patents, an administration fee and a volume discount. These criteria could in a first step be compared to the bilateral license agreements and their calculations the Defendant had in place with other members of the same pool in the past, before entering into a discrimination discussion.
20. As far as the Defendant criticizes that the conditions the Claimant currently offers have remained unchanged since 2017, the judge-rapporteur does not see that the Defendant is currently limited in its defence against the requested injunctive relief without the expired agreements, at least not at the present stage of the proceedings.
21. While terminated agreements might play a role in the assessment of the entitlement to claim damages from the time of 2013 onward, it must be noted, firstly, that the Claimant is only seeking a declaratory judgement with regard to damages. Secondly, it must be noted that the Claimant has already disclosed one of them in a redacted version in Exhibit BP 6a. This evidence contained a declaration that the other agreements are “substantially similar to the redacted version of a signed PLA”. As the discussion in the video conference conducted showed that the Defendant is especially uncertain whether the substantial similarity also covers the Pricing Table, the Claimant could short-cut this question by giving an explanation

whether the Pricing Tables are similar or even identical, to avoid a possible R. 190-order in the future.

ORDER

I. Defendant's requests under item I. and item II. are currently not justified.

II. Claimant is ordered to submit a copy of the AAC Patent License Agreement concluded between [...] and Claimant referred to in Claimant's email to Defendant dated October 2, 2025, subject to that the document is classified as confidential information pursuant to a confidentiality order as outlined under item III. – VIII. below.

III. The copy of the AAC Patent License Agreement concluded between [...] and Claimant is classified as confidential pursuant to R.262A RoP, meaning that the entire agreement must be treated as strictly confidential and must not be used or disclosed outside the present legal dispute, even after its termination.

IV. It is ordered that access to the information classified as confidential under item I. above shall be limited, on the part of the Defendant, to the following persons:

1. Defendant's representatives appointed in the present proceedings including their assistants and team members,

2. the following natural persons of the Defendant

- [REDACTED], Head of IP and Litigation,
- [REDACTED], General Counsel,
- [REDACTED], Assistant Legal Counsel,
- [REDACTED], Associate General Counsel;

3. the following natural persons of Condico IP Oy:

[REDACTED]
[REDACTED]

V. It is ordered that the persons authorized to access the confidential information pursuant to Request IV. must treat the confidential information confidential and must not use or disclose it outside of the present proceedings or to a person who is not authorized to access the confidential information pursuant to Request IV.

VI. It is ordered that the obligation to maintain confidentiality pursuant to Section V. shall continue to apply even after the conclusion of the judicial proceedings, unless the disputed information becomes known to persons from circles that ordinarily have access to such information or becomes readily accessible by other means.

VII. It is ordered that the obligation to maintain secrecy pursuant to Requests III-VI. shall continue to apply after the present proceedings have been concluded.

VIII. Prior to making orders, the judgment or any other official communication publicly available, any information contained therein that relates to the information classified as requiring confidentiality under Section III. shall be redacted.

NOTICE OF APPEAL (ART. 73(2)(A), 59 UPCA, R. 190, R. 220.1(c), 224.1(b) RoP):

The party adversely affected by this decision may lodge an appeal within 15 days of its notification

ISSUED IN HAMBURG, 19 DECEMBER 2025

Judge-rapporteur