



**Local Division Munich
UPC_CFI_153/2024**

**Procedural Order
of the Court of First Instance of the Unified Patent Court
Local Division Munich
issued on 12 August 2024**

HEADNOTES

Acting as a representative of a party in a particular proceeding in accordance with Rule 8.1 and .2 RoP requires that the lawyer has the authority from the party to act as counsel on behalf of the latter. The authority to act as counsel is subject of Civil law.

According to Rule 285.1 RoP a representative is deemed to be acting under such authority as long as his representative powers are not challenged.

Neither the CMS nor any other software establishes the status of representative. The CMS does not exclude any person as a representative because this person is not named in the CMS for a particular proceeding.

KEYWORDS

Representative, extension of time periods

CLAIMANT (RESPONDENT)

NEC Corporation, represented by its President and Chief Executive Officer Mr. Takayuki Morita, 7-1 Shiba 5-chome Minato-ku, 108-8001 Tokyo, Japan,

represented by:

Rechtsanwalt Dr. Müller der Kanzlei Bardehle
Pagenberg Partnership mbB, Bohnenstraße 4,
20457 Hamburg

DEFENDANT (APPLICANT)

1. **TCL Deutschland GmbH & Co. KG**, represented by the general partner TCL Deutschland Verwaltungs GmbH, which in turn is represented by its managing directors, Am Seestern 4, 40547 Düsseldorf,
2. **TCL Industrial Holdings Co., Ltd.**, represented by its directors, 22/F, TCL Technology Building, 17 Huifeng 3rd Road, Huizhou, Guangdong, China,
3. **TCT Mobile Germany GmbH**, represented by its managing directors, Am Seestern 4, 40547 Düsseldorf, Germany,
4. **TCT Mobile Europe SAS**, represented by its directors, 55 Avenue des Champs Pierreux, 92000 Nanterre, France,
5. **TCL Communication Technology Holdings Ltd.**, represented by its directors, 5/F, Building 22E, Science Park East Avenue, Hong Kong Science Park, Shatin, Hong Kong, SAR, China,
6. **TCL Operations Polska Sp. Z.o.o.**, represented by its managing directors, ul. A. Mickiewicza 31/41 96-300 Żyrardow, Poland,
7. **TCL Overseas Marketing Ltd.**, represented by its directors, 13/F TCL Tower Tai Chung Road Tsuen Wan, New Territories, Hong Kong, SAR, China,

Defendants 1) and 3)-6) represented by:

Rechtsanwalt Dr. Nack, Noerr, Noerr
Partnerschaftsgesellschaft mbB, Brienner Str. 28,
80333 Munich

PATENT AT ISSUE

European patent n° EP 2 863 637.

PANEL/DIVISION

Panel 2 of the Local Division Munich

DECIDING JUDGE/S

This order has been issued by the presiding judge Ulrike Voß, the legally qualified judge Daniel Voß and the legally qualified judge Andras Kupecz

SUMMARY OF FACTS

The Claimant is suing the Defendants for patent infringement. Its Statement of Claim was served on Defendants 1), 3), 4) and 6) (hereinafter: "the Defendants") on 13 and 18 April 2024.

On 17 May 2024, the Claimant requested the Court to order the replacement of Exhibit BP 6 as filed with the Statement of Claim by Exhibit BP 6-corrected as submitted with its request. The reason for this was that the Statement of Claim had referred to the HEVC standard ITU-T H.265 (hereinafter: HEVC standard) and stated that this document would have been submitted as Exhibit BP 6. However, by mistake the AVC standard was submitted as Exhibit BP 6. The request for replacement of the Exhibit was digitally signed by Ms. Emily Rohde.

In their comments, the Defendants requested the Court to dismiss the Claimant's request and to set the Statement of Defence filing deadlines – at that time ending on 13 July 2024 – to 9 August 2024. In their opinion, the erroneous submission of Exhibit BP 6 should result in the extension of the deadline for lodging the Statement of Defence in accordance with the decision of the Court of Appeal, dated 13 October 2023 (UPC_CoA_320/2023, APL_572929/2023, GRUR 2023, 1761). In addition, the Defendants argued the Claimant's request had not been properly filed as only Mr Tilman Müller was appointed as the representative for the Claimant in the UPC Case Management System (hereinafter: CMS).

The Claimant requested to reject the Defendants' request for deadline extension.

On 13 July 2024 the Panel 2 of the Local Division Munich by its judge-rapporteur Daniel Voß issued the following order:

1. Exhibit BP 6 as filed with the Statement of Claim is replaced with Exhibit BP 6-corrected as filed with the Request of 17 May 2024.
2. The Statement of Defence filing deadlines of Defendants 1), 3), 4) and 6) are set to 19 July 2024.

The Court stated according to the Claimants comments on the Defendants' request Ms. Emily Rohde was part of the legal team on the Claimant's side and therefore authorised to represent the Claimant and to file the request for replacement of Exhibit BP 6 on its behalf. With regard to the request for deadline extension, the Court held that the present case concerned a

different matter than the decision of the Court of Appeal cited by the Defendants. The circumstances argued against an extension of the deadline. However, with regard to the erroneous submission of Exhibit BP 6 and the uncertainty about the outcome of the Defendants' request due to the change in the Court's panel and the late decision on this request, a slight deadline extension was granted.

The Defendants request for a panel review of the order issued by the judge-rapporteur on 13 July 2024. They are of the opinion the order is legally erroneous. They maintain their view that the request for replacement of Exhibit BP 6 cannot be considered properly submitted because it was not made by the authorised representative of the Claimant. Ms. Rohde is part of the legal team of the Claimant's representative, Mr. Müller, but not the representative of the Claimant. The latter could only be the lawyer who is listed in the UPC CMS, in this case Mr. Müller, who is – in addition – the only representative named in the Statement of Claim.

Furthermore, the extension of the Statement of Defence filing deadline only until 19 July 2024 deprives the Defendants of a substantial part of their term. According to the case law of the Court of Appeal and similar cases of the Court of First Instance the deadline should have been extended by the time the Exhibit BP 6 was submitted later, to ensure fairness and equity in the proceedings. A defendant must be allowed a full three-month time period to respond on the Statement of Claim including all of its exhibits that must be submitted at the same time. If the Court allows the supplementation of exhibits, it must also extend the defendant's time limit accordingly. The number, the relevance or the defendant's knowledge of the exhibits are not grounds for not granting the full deadline extension. Asking the defendant to obtain an exhibit referred to in the Statement of Claim in another way would violate the burden of submission and burden of proof rules and cannot be a reason for the denial of a deadline extension. Nor can the expiry of the Preliminary Objection submission time period be taken into account in favor of the Claimant when considering the extension of the deadline. Against this background, the discretion regarding to the request for deadline extension was exercised incorrectly.

The Claimant considers the Order issued by the judge-rapporteur on 13 July 2024 to be correct. The Defendants' request for a revised order does not contain new facts or new legal arguments. The term "representative" in R. 8.2 RoP must not be interpreted in a strictly literal sense. The UPCA and the RoP do not contain a limitation to "the" one representative that is listed in the CMS. Even the CMS itself and its functionality "My Legal Team" offer the possibility to work on one case under the responsibility of the authorised representative of the party. In addition, more than one registered representative can be member of a legal team and all registered representatives can formally lodge a document on the CMS. Ms. Rohde is such a qualified representative.

Insofar as the Defendants again request an extension of the Statement of Defence filing deadline, this request is inadmissible due to a lack of any legitimate legal interest in the requested decision. The Defendants have already lodged a Statement of Defence on 19 July 2024, i.e. within the extended deadline. A retroactive extension is not necessary, especially since the Defendants do not explain why a supplementary Statement of Defence is needed. However, the Order issued by the judge-rapporteur is also correct on the merits. It is in line with the case law of the Court of Appeal and the judge-rapporteur exercised his discretion correctly.

REQUEST

The Defendants request

that the Panel review the case managing order made by Judge Rapporteur Mr. Daniel Voß on 13 July and make the following revised case management order

1. Plaintiff's request to replace Exhibit 6 as filed with Exhibit BP 6-corrected is dismissed.
2. Defendants' 1, 3, 4 and 6 time period for lodging the Statement of Defense is extended to 9 August 2024,
3. in the alternative to request 1, in the event that the requested review is not provided before 19 July 2024:
 - a) Defendants' 1, 3, 4 and 6 time period for lodging the Statement of Defense is retroactively extended to 9 August 2024
 - b) Defendants 1, 3, 4 and 6 are allowed to lodge a supplementary Statement of Defense brief by 9 August 2024,
4. in the alternative, if the Panel does not make a revised case management order according to request 1 and request 2 or request 3:

the present order may be appealed by Defendants 1, 3, 4 and 6 at the Court of Appeal with the leave of the Court of First Instance within 15 days of service of the Court of First Instance's decision to that effect.

The Claimant requests

that the Defendants' request to revise the case management order as of 13 July 2024 as well as Defendants' request for leave for appeal are rejected in their entirety.

GROUND FOR THE ORDER

The Defendants' request for a review of the Order of the judge-rapporteur by the panel is admissible but unfounded.

I.

The Defendants' request for a panel review is admissible.

Subject of the request is a case management order of the judge-rapporteur, R. 333.1 RoP. The request has been filed in due form and time in accordance with R. 333.1 and .2 RoP. These provisions do not require new reasons to be presented. It is permitted to refer exclusively to facts and legal arguments that already formed the basis of the order to be revised. Since the panel reviews both the lawfulness and the expediency of the contested order (Tilman/Plassmann, Unified Patent Protection in Europe, 2018, RoP, R.333 mn. 11), an application under R. 333 RoP is not limited to new facts or new arguments.

II.

The Defendants' requests to dismiss the Claimant's request for replacement of Exhibit BP 6 and to extend the time period for lodging the Statement of Defence are not successful.

It can be left open which point in time is decisive for the review of an order of the judge-rapporteur - that of the order to be reviewed or that of the decision of the panel. It can also be left open, whether the applicant of an application for panel review may file amended requests. The Order issued by the judge-rapporteur on 13 July 2024 is in any case lawful and appropriate.

1.

The Judge Rapporteur's Order dated 13 July 2024 to replace Exhibit BP 6 with Exhibit BP 6-corrected is lawful (No. 1 of the Order).

The Defendants solely argue that the Claimant's request for replacement of Exhibits and the corrected Exhibit were not submitted by the representative of the Claimant in accordance with the UPCA and the RoP.

Ms. Rohde, however, has acted as a representative of the Claimant pursuant to R. 8.2 RoP.

This provision stipulates that where the RoP provide that a party performs any act, that act shall be performed by or upon the representative for the time being of the party. The term "representative" refers to R. 8.1 RoP pursuant to which a party shall be represented in accordance with Art. 48 UPCA unless otherwise provided by the RoP. Art. 48 (1) UPCA requires that parties shall be represented by lawyers authorised to practise before a court of a Contracting Member State. In addition to these requirements Art. 48 (1) UPCA and R. 8.1 RoP implicitly presuppose that the lawyer has the authority from his client to act as counsel on behalf of the latter. Under such authority to act as counsel, he is authorised to conduct proceedings on behalf of the party represented (Tilman/Plassmann, United Patent Protection in Europe, 2018, UPCA, Art. 48 mn. 2). This follows from R. 285.1 RoP according to which a representative who claims to be representing a party shall be accepted as such; however, the Court may order the representative to produce written authority if his representative powers are challenged. The authority to act as counsel is subject to Civil Law.

According to these principles, there is no doubt that Ms. Rohde has acted as representative of the Claimant within the meaning of Art. 48 (1) UPCA and R. 8.1 RoP when submitting the request for replacement of Exhibits and the Exhibit itself.

Ms. Rhode is a lawyer and authorised to practise before a court of a Contracting Member State pursuant to Art. 48 (1) UPCA. The Defendants do not contest this. A dispute would also be implausible. Ms. Rhode is a registered UPC representative, and R. 286 (1) RoP requires that a representative pursuant to Art. 48 (1) UPCA shall lodge at the registry a certificate that she is a lawyer authorised to practise before a court of a member state. Therefore, Ms. Rohde's registration as UPC representative is an indication for her status of lawyer.

Defendants also do not challenge Mrs. Rohde's authority to act as counsel. They merely object that only the lawyer listed in the UPC CMS, Mr. Müller, can be the representative of a party. However, neither the CMS nor any other software establishes the status of representative. In particular, the CMS does not exclude any person as a representative simply because this person is not named in the CMS for a particular case. The same applies to the Statement of Claim. The Claimant is not obliged to list all representatives in his brief. It is also possible to appoint additional representatives after the Statement of Claim has been submitted.

2.

The Panel also holds that the extension of time period until 19 July 2024 ordered by the judge-rapporteur is lawful and appropriate (No. 2 of the Order).

a)

The Defendants' original and current requests to extend the Statement of Defence filing deadline are admissible. They cannot be rejected on the grounds the Defendants have no legitimate legal interest in an extension of their deadline any more. This interest persists even if the Defendants have already filed a Statement of Defence within the deadline extended by the judge-rapporteur's order only until 19 July 2024. The Defendants cannot be obliged to comment now on all possible contents of a supplementary submission in order to substantiate their request for an extension of the deadline. It is not ruled out that the Defendants will later gain information and insights that are currently unknown.

b)

However, there is no need to extend the time limit for lodging the Statement of Defence beyond 19 July 2024 as already ordered by the judge-rapporteur.

Pursuant to R. 9.3 RoP the Court may extend, even retrospectively, a time period referred to in the RoP or imposed by the Court. This provision has to be applied and interpreted in accordance with Art. 41 (3), 42 and 52 (1) UPCA on the basis of the principles of proportionality, flexibility, fairness and equity (see Recital 2 of the RoP). In particular, flexibility shall be ensured by applying all procedural rules in a flexible and balanced manner with the required level of discretion for the judges to organise the proceedings in the most efficient and cost effective manner (Recital 4) and fairness and equity shall be ensured by having regard to the legitimate interests of all parties (Recital 5).

According to these principles, the time limit for the Statement of Defence cannot always be automatically extended by the period for which one or more exhibits to which the Statement of Claim refers were filed later, regardless of how many exhibits are involved and why they were originally not submitted together with the Statement of Claim or submitted incorrectly.

Such a schematic approach would not do justice to the individual case. Nothing else follows from the principles established by the Court of Appeal in the order of 13 October 2023 (UPC_CoA_320/2023, APL_572929/2023, GRUR 2023, 1761). The headnotes already state: “Failing any specific circumstances of an individual case which calls for another term ..., the extensions of the terms mentioned in Rules 19.1 and 23 RoP shall compensate for and thus be equal to the period during which the Annexes have not been available contrary to R. 13.2 RoP.” (Underlining by the Court).

In the present case, the facts of the case at hand differ significantly from the facts on which the order of the Court of Appeal is based. In the latter case, the exhibits referred to in the Statement of Claim were not served on the Defendants together with the Statement of Claim. They were also not uploaded to the CMS together with the Statement of Claim. This was a deliberate decision by the Claimant. The Registry had even pointed out the absence of the exhibits in accordance with R. 16.3 RoP.

In the present case, all of the exhibits referred to in the Statement of Claim were available to the Defendants in the CMS at the time of service, with the exception of the HEVC standard, Exhibit BP 6, for which the AVC standard was uploaded by mistake.

R. 13.2 RoP is intended to allow the defendant to respond to the entire submission contained in the statement of claim and all exhibits to which the claimant refers in support of its claim. This provision ensures that the principles of fairness and equity, which must be ensured by taking into account the legitimate interests of both parties, are sufficiently observed (CoA, Order of 13.10.2023, UPC_CoA_320/2023, APL_57292/2023, GRUR 2023, 1761). However, it must be taken into account that all but one exhibits were fully available to the Defendants. Nor can it be disregarded that the missing HEVC standard were partly cited in the Statement of Claim and that the HEVC standard is both publicly available and known to the Defendants. Against this background, it is not apparent that the Defendants would not be able to adequately defend themselves against the action.

Taking these circumstances into account, it does not shift the burden of proof and burden of submission. In this respect, it should be noted that the HEVC standard was not completely withheld from the Defendants. The correct Exhibit BP 6-corrected was available to the Defendants from 17 May 2024. They had around two months within the extended deadline to also consider this exhibit for their Statement of Defence. It is neither submitted nor otherwise apparent that this was not possible for the Defendants.

The Claimant cannot be reproached of not having provided the Defendants with the BP 6-corrected attachment earlier. It was not aware that it had mistakenly uploaded a different exhibit to the CMS. Instead, in accordance with the principles of fairness, the Defendants would have been expected to point out the mistake to the Claimant as soon as they became aware of it. Since the Defendants raised a Preliminary objection, it must be assumed that they dealt with the Statement of Claim within the time period for the Preliminary objection. It is therefore also not objectionable if the judge-rapporteur's order refers to the fact that the Defendants did not draw attention to the erroneously submitted exhibit within this period.

Defendants do not claim that they did not notice that an incorrect exhibit was uploaded with the Statement of Claim. Instead, the Defendants intended to bring up the contradictions between the contents of Exhibit BP 6 and the infringement read in the Statement of Claim in their Statement of Defence. They consider that such contradictions pertain to the material question whether infringement is conclusively alleged by Claimant. The Panel does not agree with this. If the Claimant has obviously mistakenly submitted an Exhibit other than the one referred to in the Statement of Claim, this is not a question of the conclusive allegation of patent infringement. In this respect, the Statement of Claim is decisive and the party who notices the submission of an incorrect exhibit is obliged to point out this error immediately or correct it. Otherwise, it would be in the defendant's power to extend the time limit for filing a Statement of Defence by a further three months if it only pointed out an incorrect exhibit for the first time at the end of the (not yet extended) time period, although it would have been able to do so much earlier. The parties have a general duty to support the proceedings (see recital 7 RoP) and it cannot be to the defendants' advantage that they did not comply with this duty.

Balancing the mutual interests of the parties also requires taking into account the interest in an efficient and expeditious conduct of the proceedings. In this respect, the Panel shares the opinion of the judge-rapporteur that the possibility of extending the time limits for written submissions laid down in the RoP in accordance with R. 9.3 RoP should only be used with caution and only in justified exceptional cases (CoA, order of 13.10.2023, UPC_CoA 320/2023 APL_572929/2023, GRUR 2023, 1761; LD Düsseldorf, Order of 20.01.2024, UPC_CFI_363/2023 APP_2249/2024, GRUR-RS 2024, 5106; order of 19.01.2024, UPC_CFI_475/2023 APP_1714/2024; LD Hamburg, order of 22.08.2023, UPC_CFI_54/2023).

For the aforementioned grounds, there was no reason to deviate from these principles in the present case and to extend the deadline for filing a Statement of Defence until 9 August 2024. Nor does anything else follow from the other orders of the Munich Local Division, submitted by the Defendants as Exhibits D11 and D11a. These are not binding on the Panel 2 and refer solely to the decision of the Court of Appeal (CoA, order of 13.10.2023, UPC_CoA 320/2023 APL_572929/2023, GRUR 2023, 1761), which the Panel does not consider to be pertinent.

Therefore, the extension of time period until 19 July 2024 ordered by the judge-rapporteur remains in place. Nor is there any reason to extend the time limit for filing a Statement of Defence in accordance with the other requests and auxiliary requests (No. 2 and 3 of the Defendants' Application dated 18 July 2024).

3.

Leave for appeal is not granted. Even if there are parallel proceedings that were treated differently by another panel, this order is an individual decision. Further harmonisation of the case law by the Court of Appeal is not required in this respect. As stated, there is no deviation from the precedent of the Court of Appeal cited.

ORDER

1. The judge-rapporteur's Order of 13 July 2024 is upheld.
2. The Defendants' further requests of 18 July 2024 are dismissed in their entirety.

DETAILS OF THE ORDER

Order no. ORD_42985/2024 in ACTION NUMBER:	ACT_16417/2024
UPC number:	UPC_CFI_153/2024
Action type:	Infringement Action
Related proceeding no. Application No.:	42443/2024
Application Type:	APPLICATION_ROP_333

NAMES AND SIGNATURES

Presiding Judge U. Voß

Legally qualified judge Dr. D. Voß

Legally qualified judge Kupecz