Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Reference no.:
UPC_CoA_570/2024
APL_53968/2024

Order
of the Court of Appeal of the Unified Patent Court
issued on 15 October 2024
concerning an application for a discretionary review (Rule 220.3 RoP)

HEADNOTES

The inadmissibility requirement under R. 361 RoP must be reserved for clear-cut cases and should not result in a full exchange of arguments and evidence, as is clear from the use of the words "manifestly inadmissible".

KEYWORDS

Action manifestly bound to fail.

APPLICANT AND DEFENDANT IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE

Microsoft Corporation, Washington, US (hereinafter "**Microsoft**")
represented by Prof. Tilmann Müller-Stoy and Nadine Westermeyer, attorneys at law, Bardehle Pagenberg, Partnerschaft mbB Patentanwälte Rechtsanwälte

RESPONDENT AND CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE

Suinno Mobile & AI Technologies Licensing Oy, Helsinki, Finland (hereinafter "**Suinno**")
represented by Mikko Kalervo Väänänen, European Patent Attorney

PATENT IN SUIT

EP 2 671 173

LANGUAGE OF THE PROCEEDINGS

English

DECIDING JUDGE

Emmanuel Gougé, Legally qualified judge and Standing judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- □ Order of the Court of First Instance of the Unified Patent Court, Central division Paris, dated 16 September 2024
- □ Reference numbers: App_ 42138/2024
  ORD_43015/2024
  ACT_18406/2024
  UPC_CFI_164/2024

SUMMARY OF THE FACTS

1. This application for discretionary review relates to an application under R. 361 RoP filed by Microsoft with the Paris Central Division on 22 May 2024, requesting that Suinno's infringement action and R. 262A RoP application be rejected as being manifestly inadmissible, as a result of an alleged lack of independence of Suinno's representative.

2. By an order issued on 02 July 2024 (ORD_33379/2024), the judge-rapporteur dismissed Microsoft application to declare the infringement action manifestly inadmissible. Leave to appeal was not granted.

3. Following an application for a panel review filed by Microsoft on 17 July 2024 under R.333 RoP, the Paris Central Division, considering that the requirement of manifest inadmissibility under R.361 RoP was not met, rejected said application and refused to grant leave to appeal (ORD_43015/2024, 16 September 2024, hereafter the "impugned order").

4. On 01 August 2024 Microsoft lodged a request for discretionary review (R. 220.3 RoP) of the order issued by the judge-rapporteur (ORD_33379/2024), which was held inadmissible by the Standing judge of the Court of appeal in an order dated 21 August 2024 (APL_44552/2024).

5. On 01 October 2024 Microsoft lodged a request for discretionary review of the impugned order with the Court of Appeal (APL_53968/2024).

6. In the same infringement action (UPC_CFI_164/2024), the Paris Central Division (Panel 2) issued a second order (ORD_41174/2024) on the same day as the impugned order, following an application for panel review under R. 333 RoP filed by Microsoft. The Central Division ruled on the R. 262A application on confidentiality as well as the issue of independence of Suinno's representative and granted leave to appeal. An appeal has been filed by Suinno against said order pursuant R. 220.2 RoP and is currently pending with the Court of appeal.

PARTY REQUESTS

7. Microsoft requests to set aside the impugned order and to reject the Claimant's infringement action as being manifestly inadmissible in accordance with R.361 RoP. In the alternative, Microsoft requests the Court of Appeal to refer questions to the CJEU for a preliminary ruling regarding the interpretation of the requirement of independence of a party's representative under the Agreement on a Unified Patent Court ("UPCA").

PARTY SUBMISSIONS

8. Microsoft argues, as far as relevant here, as follows.

9. According to Art. 48 (5) UPCA, R. 8.1 and R. 290.2 RoP, and Art. 2.4.1 of the Code of Conduct for Representatives who appear before the Unified Patent Court, a representative before the UPC shall act as independent counsellor.

10. In the absence of further specifications of the principle of independence in the aforementioned provisions, and in accordance with the primacy of Union law, said principle should be assessed by reference to the conception of the lawyer's role in the EU legal order in which, according to relevant case law of the CJEU, the requirement of independence means the absence of any employment relationship between the lawyer and his client as well as the absence of any financial dependence or of any extensive administrative and financial powers of the representative within the represented party.

11. Furthermore, the language under Art. 48(5) UPCA concerning the requirement of independence applicable to UPC representatives is phrased in the same way as the Statute of the CJEU, on which the case law of the CJEU is based.

12. In light of the aforementioned, considering that he is also the Managing Director and main shareholder of Suinno, enjoying extensive administrative and financial powers within said company, Suinno's representative cannot be considered as independent for the purpose of a valid representation of that party in the proceedings.

13. The impugned order, when deciding that the alleged lack of independence by the claimant's representative does not appear to be "manifest" and, therefore, could not lead to an assessment of manifest inadmissibility of the action, so that the requirement set under R. 361 RoP is not met, is contradicted by the ruling of the same panel 2 of the Paris Central Division in its above cited order ORD_41174/2024 in which it held that the (same) representative cannot be considered as independent for the purpose of a valid representation of his client in the current proceedings.

14. The lack of independence of Suinno's representative, and the inadmissibility due to a lack of independence of the representative is clear without any need for a more in-depth analysis and thus manifest pursuant to R. 361 RoP.

REASONS

15. The request for discretionary review must be dismissed.

16. According to R. 361 RoP ("actions manifestly bound to fail"), "where it is clear that the Court has no jurisdiction to take cognisance of an action or of certain of the claims therein or where the action or defence is, in whole or in part, manifestly inadmissible or manifestly lacking any foundation in law, the Court may, after giving the parties an opportunity to be heard, give a decision by way of order."

17. The requirement under R. 361 RoP must be reserved for clear-cut cases. It should not result in a full exchange of arguments and evidence, as is clear from the use of the words 'manifestly inadmissible', and should not require further in-depth analysis, as rightly pointed out in the impugned order.

18. Microsoft has failed to demonstrate that a review of the impugned order on the requirement set under R. 361 RoP is necessary to ensure a consistent application and interpretation of the RoP or any other objective of the discretionary review procedure. Microsoft's position that the impugned order is incorrect and does not provide a correct interpretation of Art 48(5) UPCA, R. 8.1 and R. 290.2 RoP, and Art. 2.4.1 of the Code of Conduct for Representatives who appear before the Unified Patent Court, is not sufficient for the Court to grant Microsoft's application, in particular as the issue of

independence of a UPC representative is also the subject matter of a R. 220.2 RoP appeal currently pending, during which both Microsoft and Suinno have the opportunity to address it thoroughly.

19. There is no contradiction between the impugned order, which had to apply the higher standard of manifest inadmissibility, and the confidentiality order (ORD_41174/2024) which addressed the issue of independence of Suinno's representative outside the very specific legal framework of R. 361 RoP.

ORDER

The request for discretionary review is dismissed.

This order is issued on 15 October 2024.

EMMANUEL, LUCIEN, RENÉ GOUGÉ

Digitally signed by EMMANUEL, LUCIEN, RENÉ GOUGÉ
Date: 2024.10.15 15:44:05 +02'00'

Emmanuel Gougé
Standing judge