Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

No. APP_26610/2024
UPC_CFI_99/2024

ORDER
of the President of the Court of First Instance
in the proceedings before the Local Division DÜSSELDORF
pursuant to R. 323 RoP (language of the proceedings)
issued on 18/06/2024

APPLICANTS (DEFENDANTS IN THE MAIN PROCEEDINGS):

1- **Apple Retail Germany B.V. & Co. KG**
Maximilianstraße 54 - 80538 - München
Germany

2- **Apple Distribution International Ltd.**
Hollyhill Industrial Estate, Hollyhill - T23 YK84 - Cork
Ireland

3- **Apple GmbH**
Prinzregentenplatz 7 - 81675 - Munich
Germany

4- **Apple Retail France EURL**
3-5 rue Saint Georges - 75009 – Paris
France

5- **Apple Inc.**
One Apple Park Way - CA 95014 - Cupertino
US

Represented by: Tilman Müller-Stoy (Bardehle Pagenberg)

RESPONDENT (CLAIMANT IN THE MAIN PROCEEDINGS):

Ona Patents SL
Carrer de Calàbria 149 En. 1 - 08015 – Barcelona
Spain

Represented by: Christof Augenstein (Kather Augenstein)

PATENT AT ISSUE:
Patent n° EP 2263098.

SUMMARY OF FACTS - SUBJECT - MATTER OF THE PROCEEDINGS:

By a Statement of Claim filed on 14 March 2024, Ona Patents SL. brought an infringement action against Apple Retail Germany B.V. & Co. KG, Apple Distribution International Ltd., Apple GmbH, Apple Retail France EURL and Apple Inc. (hereinafter collectively referred to as "Apple") based on EP 2263098 entitled *"Positioning of mobile objects based on mutually transmitted signals"* before the Local Division Düsseldorf.

By an application dated 10 May 2024, the abovementioned defendants, referring to R. 323 RoP, requested that the language of proceedings be changed from German to English (hereinafter the "Application"). The Application was forwarded by the Judge-rapporteur to the President of the Court of First Instance of the UPC pursuant to R. 323.1. RoP.

By an order dated 14 May 2024, the Claimant in the main action (No. ACT_11910/2024 UPC_CFI_99/2024) was therefore invited, in accordance with R. 323.2 RoP, to state within 10 days 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.

Ona Patents SL has submitted its written comments on the Application on 24 May 2024.

The panel of the LD Düsseldorf has been consulted according to R. 323.3 RoP.

REQUESTS OF THE PARTIES:

Apple requests the language of the proceedings be determined to be the language of the patent in suit EP 2 263 098, namely English (Rule 323.1 RoP).

Ona Patents SL requests the court to reject the Application to change the language of the proceedings.

POINTS AT ISSUE:

In support of the request, Apple states that Ona Patents has not responded to the defendant's proposal for an amicable solution pursuant to R. 321 RoP without any comprehensible justification and that the Application – being necessary for an adequate legal defence – shall be granted for the following reasons:

- As part of the assessment to be made pursuant to Art.49(5) UPCA, the positions of the parties must be taken into account, *"in particular the position of the defendant";*
- According to UPC_CoA_101/2024_order of 17 April 2024, certain circumstances are relevant while others are not to be considered, and should the respective interests be equivalent, the wording of Art. 49 (5) UCPA states that the position of the Defendant is decisive;
- The Application is admissible, pursuant to R. 323.1 RoP the filing of a unilateral request to change the language before the expiry of the time-limit imposed for lodging the Statement of Defence promotes the efficient conduct of proceedings;
- Applying the standards provided by the abovementioned case law, the requested change is imperative in the present situation as being efficient and justified by the principle of fairness, with regard to the language used in the relevant technology, the documents of prior art, the exhibits submitted, the corporate language of the Defendants, the working language of Ona Patents SL. and the domicile of most of the parties;
- The inconvenience incurred if the language remains German would be more important for Apple due to the tight lime-limits to organize its defence, which are further shortened by translation requirements;
- The requested change would not delay the proceedings.

Ona Patents states that the Application must be rejected for the following reasons:

- It is primarily inadmissible pursuant to R. 4.1 RoP because it was erroneously filed using a R.9 RoP *"generic procedural application"* in the Case Management System (hereinafter "CMS") while a dedicated workflow is provided under the designation *"Application by a single party to use the language in which the patent was granted as language of the proceedings";*
- Apple fails to substantiate any violation of the requirements of fairness and expediency due to the current language in which the action was filed. The Claimant is a medium-sized start-up company and got prepared to conduct the proceedings in German;
- The circumstances addressed by the Court of Appeal (UPC_CoA_101/2024 ApL_12116/2024, order of 17 April 2024, para. 21 seq.) are merely an exemplary list of relevant factors in the context of a case-by-case approach, and should the cited criteria be applied, the language initially chosen would be retained as the parties are already involved in parallel national proceedings dealing with similar technical issues. Apple is the largest listed company in the world and protection of smaller entities is a central concern of the legislator, the Respondent has its own IP litigation department sized for conducting patent disputes in German while Ona Patents SL is a Spanish start-up founded in 2023. The majority of the defendant's registered office is not in an English-speaking country;
- The Claimant can choose the language in which he wants to file its action and the change pursuant to R. 323.1 RoP in conjunction with Art. Art. 49(5) UPCA is a systematic exception to this principle for reasons of fairness;
- The choice of the language of the patent cannot bind the plaintiff, as at the time of the application the language regime of the UPC was not foreseeable and it was not the choice of the legislator to standardize the language of the patent as language of the proceedings;
- The defendant does not present any relevant circumstances that could justify the requested change, and fails to specify how its right to a fair trial could be violated if the proceedings were continued in German.

By generic procedural applications dated 14 June 2024 (App_35829/2024, App_35890/2024, App_35891/2024 and App_35892/2024), Apple requested the authorization to submit further comments referring to another decision rendered on 30 May 2024 (22744/2024 UPC_CFI_26/2024) and to the content of the response given by Ona Patents.

A decision to change the language of the proceedings requires weighing the respective interests of the parties in light of all relevant circumstances. In the context of this case-by-case assessment and with regard to the arguments and facts previously submitted, the reasoning and outcome of a recent order rendered on the same matter does not appear to be a sufficient reason for allowing additional observations – mainly relating to the situation of the Applicant – that are not foreseen by R. 323.2 RoP.

Further facts and arguments as raised by the parties will be addressed below if relevant to the outcome of this order.

GROUNDS FOR THE ORDER:

1- Admissibility of the Application

Ona Patents SL argues that the Application is inadmissible because it was submitted in the form of a R. 9 RoP *"generic procedural application"* in the case management system of the Court which provides a dedicated *"R. 323 workflow"* to be used for this purpose.

According to R. 4.1 RoP, *"written pleadings and other documents shall be signed and lodged at the Registry or relevant sub-registry in electronic form. Parties shall make use of the official forms available online. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt".*

Pursuant to R. 9 RoP – *"Powers of the Court" "1. The Court may, at any stage of the proceedings, of its own motion or on a reasoned request by a party, make a procedural order such as to order a party to take any step, answer any question or provide any clarification or evidence, within time periods to be specified".*

The R. 9 workflow allows the parties to submit their requests in the course of the proceedings, and the Court to take any decision relating to the management of the case. As does the *"R. 323 RoP"* entitled *"Application by a single party to use the language in which the patent was granted as language of the proceedings",* it provides the user with an electronic form, which is an *"official"* one within the meaning of the abovementioned R. 4.1. RoP.

The Application shall thus be declared admissible.

2- 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 (…) The 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. In this case the President of the Court of First Instance shall assess the need for specific translation and interpretation arrangements".*

It has furthermore been stated that Art. 49 (5) UPCA must be interpreted in such a way that the decision on whether or not to change the language of the proceedings to the language in which the patent was granted must be determined considering the respective interests at stake, without requiring it to constitute a disproportionate disadvantage (UPC CFI 225/2023 LD The Hague, order of 18 October 2023, UPC CFI 373/2023 LD Düsseldorf, order of 16 January 2024, UPC CFI 410/2023 LD Mannheim, order of 15 April 2024).

By an order dated 17 April 2024, to which both parties refer, the UPC Court of Appeal (hereinafter "CofA") 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, respectively (UPC_CofA_101/2024, Apl_12116/2024, para. 22-25).

In the event that the result of the balancing of interests is the same in the context of this overall assessment, the CofA found that the emphasis given *"in particular"* to 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 actually 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.

Based on the above, it follows that the position of the defendant (s) is the decisive factor if both parties are in a comparable situation.

In the same decision, the CofA 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).

In the present case, it is not disputed that English is the language commonly used in the relevant field of technology in question, as it is reflected by the prior art cited in the patent in suit and annexes submitted by the Claimant in the main proceedings without translation pursuant to R. 13.1 (q) RoP.

As the Claimant has its registered offices in Spain and English is obviously the corporate language of the Defendants, it can be inferred that English is the most convenient language for Apple and a "neutral" working language for Ona Patents whose website is only available in English, as highlighted by the Applicants.

The Apple group however, has organized itself to handle patents disputes in German notably by appointing an in-house German litigator, as mentioned by an article published in January 2023 (Exhibit 1 provided by the Respondent). It is more generally to be noted that due to its size and worldwide development, Apple has an extensive legal department with the necessary resources to handle and coordinate proceeding in various languages.

Moreover, two of the five entities involved in the present case are located in Germany.

Regarding Ona Patents which is a medium-size company founded in 2023, the choice to file its action in German is made in the context of parallel disputes between the same parties before the regional court of Munich involving, according to the claimant, technically comparable issues. Ona Patents also raises that its main contact person is able to discuss and approve its representative written submissions in German, being indeed fluent in this language.

It appears from these circumstances that Ona Patents had relevant reasons to file its infringement action in German although the language of the patent and relating technology

is English, namely the language skills of the contact person likely to follow-up the proceedings on its behalf, the location of the registered offices of two defendants and the existence of parallel proceedings handled in German with limited resources compared to those of Apple.

It results in substance from the above that the requested change would represent a significant drawback for the Claimant, while being in contrast a slight advantage in favor of the Defendants.

Consequently, the outcome of balancing of the respective interests of the parties with regard to all relevant circumstances of the case, leads the Court to reject the Application to change the language of the proceedings to the language in which the patent was granted.

FOR THESE GROUNDS

1- The Application to change the language of the proceedings to the language in which the patent at issue has been granted, is dismissed.
2- The present order shall not be conditional on specific translation or interpretation arrangements.
3- An appeal may be brought against the present order within 15 calendar days of its notification to the Applicants pursuant Art. 73. 2 (a) UPCA and R.220 (c) RoP.

INSTRUCTIONS TO THE PARTIES AND TO THE REGISTRY:

The next step is for the Applicants to file the Statement of Defence within the time period as set by the Judge-rapporteur.

ORDER
Issued on 18 June 2024

NAME AND SIGNATURE

Florence Butin
President of the UPC Court of First Instance

FLORENCE ANNE BUTIN

Signé numériquement par FLORENCE ANNE BUTIN
DN : cn=FLORENCE ANNE BUTIN, c=FR, email=florence.butin@unifiedpatentcourt.org
Date : 2024.06.18 19:25:22 +02'00'