

**EIP**

# Adding a patent to existing proceedings

## **Huawei Technologies Co., Ltd v Netgear Inc & Ors (UPC\_CFI\_9/2023)**

**Order[1] of Court of Appeal on 11 March 2024 (UPC\_CoA\_44/2024); Appeal against ORD\_593106/2024 of the CFI panel dated 18 January 2024 [2] following ORD\_593105/2023 and ORD\_587438/2023 of the Judge-Rapporteur dated 11 December 2023[3]**

Huawei sued Netgear in the Munich Local Division on 1 June 2023 for infringement of EP 3611989. On 23 November 2023 Huawei made a request under Rule 263 RoP to add a further patent, EP 3678321, to the proceedings. Huawei explained that because of limitation proceedings before the EPO which did not conclude until 20 October 2023 it was not able to include EP3678321 in the original claim. The alleged acts of infringement were the same for both patents. The Judge-Rapporteur allowed the request on 11 December 2023.

He further stated that the court is “obliged to grant the defendant largely the same opportunities for defence ... as in the case of a new, further action. This can be done by granting or extending time limits for comments.” But he did not set a specific date for the defence.

The Judge-Rapporteur separately considered whether the proceedings should be separated pursuant to Rule 302.1 of RoP and ordered that they should.

Netgear sought review under Rule 333 of the decision to add EP 3678321. The panel rejected the review but stated that Netgear must be granted the same deadline to file its defence as it would have had if the action had been brought separately, but no longer. The time period for filing the defence began on 11 December 2023, the date on which the decision was made by the Judge-Rapporteur to admit the patent to the proceedings.

Permission to appeal was granted.

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## **Decision**

The Court of Appeal heard the appeal as a panel of three with no technical judge(s).

The Court of Appeal considered Rule 263.2(b) as to whether adding the patent would “unreasonably hinder the other party in the conduct of its action”. Due process required that the defendant would have the same time limit to respond to the new patent as it would have had if a new action had been brought. The time limit is not set by the RoP and should be included in the order.

The Court of Appeal noted that the Court of First Instance had granted three months for filing the defence but ruled that the time period should start from the date of the judgment of the review panel, 18 January 2024, rather than from the date of the judgment of the Judge-Rapporteur, 11 December 2023. This was because there was a lack of clarity in the order made by the Judge-Rapporteur as to the starting date of the time limit for the statement of defence. The time limit would therefore end on 18 April 2024.

## **Comment**

Netgear had also raised three other procedural appeal points which it dropped during the hearing in return for Huawei’s consent to the time for the defence ending on 18 April 2024. This may have contributed to the Court of Appeal’s final ruling that the time limit should run to 18 April 2024.

The overall effect of Netgear’s application for review and appeal was to provide it with a little under five months from filing of the new claim to lodge its defence compared with the usual three months from service set by Rule 23. Huawei on the other hand, by adding the claim to existing proceedings rather than filing a new one, had saved any potential delay arising from the formal procedures for effecting service on the defendant.

[1] <https://www.unified-patent-court.org/en/node/647> and <https://www.unified-patent-court.org/en/node/649>

[2] <https://www.unified-patent-court.org/en/node/552>

[3] <https://www.unified-patent-court.org/en/node/512> and <https://www.unified-patent-court.org/en/node/512>