



Düsseldorf Local Division
UPC_CFI_336/2024
UPC_CFI_605/2024

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 14 April 2025
concerning EP 3 065 184 B1

Claimant:

Maxeon Solar Pte. Ltd., represented by its CEO, 8 Marina Boulevard #05-02, Marina Bay Financial Centre, 018981 Singapur

Represented by: Attorney-at-law Christian Harmsen, Attorney-at-law Dr Bastian Selck, Bird & Bird LLP, Carl-Theodor-Straße 6, 40213 Düsseldorf, Germany

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Defendants:

1. **Aiko Energy Germany GmbH**, represented by its CEOs Dr Christian Frank Peter und Haojie Lu, Niederkasseler Lohweg 18, 40547 Düsseldorf, Germany
2. **Solarlab Aiko Europe GmbH**, Dr Christian Frank Peter, Berliner Allee 29, 79110 Freiburg im Breisgau, Germany
3. **Memodo GmbH**, represented by its CEOs Enrico Brandmeier, Daniel Schmitt und Tobias Wenleder, Eichenstraße 11 a-d, 85445 Oberding, Germany
4. **Aiko Energy Netherlands B.V.**, represented by its CEO, Schiphol Boulevard 201 – 1118 BG - Schipol, the Netherlands
5. **Libra Energy B.V.**, represented by its CEO Bram van Duijn, Eendrachtsstraat 199, 1951 AX Velsen-Noord, the Netherlands

6. **VDH Solar Groothandel B.V.**, represented by its CEO, Finlandlaan 1, 2391 PV, Hazerswoude-dorp, the Netherlands
7. **PowerDeal SRL**, represented by its CEO, Rue du Fond des Fourches 41, 4041 Herstal, Belgium
8. **Coenergia Srl a Socio Unico**, represented by its CEO, Foro Buonaparte 55, 20121 Milan, Italy

Defendants 1., 2. and 4. represented by:

Attorney-at-law Gertjan Kuipers, Attorney-at-law Hendrik Jan Ridderinkhof and other Representatives before the UPC of Hogan Lovells International LLP, Strawinskyiaan 4129, 1077 ZX Amsterdam, the Netherlands

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Patent Attorney Dr Andreas Schmid, Patent Attorney Cedrik Rohr and other Representatives before the UPC of Hogan Lovells International LLP, Karl-Scharnagl-Ring 5, 80539 Munich, Germany

Defendants 3. and 5. to 8. represented by:

Attorney-at-law Dr Constantin Kurtz, Attorney-at-law Dr Stefan Eck, Attorney-at-law Maximilian Reif, Klaka Rechtsanwälte Partnerschaft mbB, Delpstraße 4, 81679 Munich, Germany

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PATENT IN SUIT:

EUROPEAN PATENT NO. 3 065 184 B1

PANEL/DIVISION:

Panel of the Düsseldorf Local Division

DECIDING JUDGES:

This order was issued by Presiding Judge Thomas acting as judge-rapporteur, the legally qualified Judge Dr Thom, the legally qualified judge Zhilova and the technically qualified judge Dr Schmidt.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT: R. 158 RoP – Request for security of legal costs

SUMMARY OF FACTS AND STATEMENT OF FORMS OF ORDER SOUGHT BY THE PARTIES:

1. The Defendants 1., 2. and 4. have lodged a request for security of legal costs.
2. They put forward that the Claimant is not in the financial position to bear its legal costs and other expenses in case the action is dismissed. According to the published financial results, the Claimant's parent company, Maxeon Solar Technologies, Ltd., has been incurring significant losses in the fiscal year 2023 and for the first and second quarter of fiscal year 2024. To support its immediate liquidity needs and its continuing operations the parent company requires additional capital via a debt investment and equity investment, both subject to regulatory approvals. In addition, according to a statement on its website, the law firm Pomerantz LLP has filed a class-action lawsuit against Maxeon Solar Technologies, concerning the question of whether “Maxeon and certain officers and/or directors have engaged in securities fraud or other unlawful business practices”. The Defendants are not aware of any details of these proceedings, but they fear that the class-action lawsuit could have a further material adverse effect on the financial condition of the Maxeon group and, therefore, the Claimant.
3. Further, the Defendants 1., 2. and 4. state that regardless of the worrying financial situation of the Maxeon group, enforcing a potential cost decision would be particularly difficult because the Claimant is based in Singapore and thus outside the European Union.
4. The Defendants 1., 2. and 4. base the requested security amount on the value of dispute set by the Claimant at EUR 1,000,000, and the ceiling for reimbursable representation costs of EUR 112,000 set by the Administrative Committee of the UPC. In view of the costs associated with the realisation of the security, the Defendants 1., 2. and 4. also deem appropriate to add a 10% premium to this amount.
5. Based on the foregoing, the Defendants 1., 2. and 4. request that the Claimant is ordered to provide adequate security in the amount at least of EUR 123.200 for the costs incurred and to be incurred by them in the proceedings and for other expenses. They leave the decision to the Court's discretion as to the type of security and the deadline to be provided.
6. According to the Claimant, the request is unfounded.
7. The Claimant argues that there is no indication to doubt its solvency. The Claimant has made substantial progress in its capital raising and debt restructuring initiatives. All of the Claimant's debt comprises convertible bonds, and its losses and the debt have been significantly reduced. Even this debt does not mature until January 2028.
8. As regards the alleged uncertainties and particular procedural difficulties caused by the enforcement of a decision on costs, the Claimant points out that Art. 69(4) UPCA and Rule

158.1 RoP do not distinguish between parties domiciled inside or outside the EU. The domicile of a party could not be taken into account, either directly or indirectly, by reference to unspecified assumptions about possible difficulties in enforcing a decision on costs.

9. Additionally, the Claimant considers the required security to be too high, pointing out that the amount in dispute addresses the action against all eight defendants. However, the requested security is only for the Defendants 1., 2. and 4., i.e. 3/8 of the amount in dispute. In view of this, based on the Table of ceilings of recoverable costs, the Claimant would consider a security in the amount of EUR 56,000 plus further expenses, i.e. EUR 60,000, to be appropriate.

INDICATION OF THE PARTIES' REQUESTS:

10. The Defendants 1., 2. and 4. request

to order the Claimant, within a period to be determined by the Court at its discretion, to provide security in the amount of at least EUR 123,200 for the costs of the legal dispute and the other costs incurred by Defendants 1., 2. and 4. and/or arising costs with the Claimant may have to bear, by way of bank guarantee, deposit or other appropriate means of security.

11. The Claimant requests

to dismiss the request for security according to Rule 158 RoP.

GROUNDINGS OF THE ORDER:

13. The Defendants' 1., 2. and 4. request is admissible and for the most part well founded. However, the Court has set the amount of security lower than requested.

A. Legal framework

14. The Court has the discretion to order a security for legal costs and other expenses. In accordance with the case law of the UPC (see CoA, order of 17 September 2024 in case UPC_CoA_217/2024, Audi v. NST), the Court, when exercising its discretion under Art. 69(4) UPCA and Rule 158 RoP, must determine, in the light of the facts and arguments brought forward by the parties, whether the financial position of the claimant gives rise to a legitimate and real concern that a possible order for costs may not be recoverable and/or the likelihood that a possible order for costs by the UPC may not, or in an unduly burdensome way, be enforceable. Proof of only one of the two conditions is sufficient for the imposition of a security for costs. The burden of substantiation and proof why an order for security for costs is appropriate in a particular case is on the Defendant making such a request, but that – once the reasons and facts in the request have been presented in a credible manner – it is up to the Claimant to challenge these reasons and facts and in a substantiated manner, especially since that party will normally have knowledge and evidence of its financial situation. It is for the Claimant to argue that and why a security order would unduly interfere with its right to an effective remedy (see also CoA, Order of 29 November 2024 in case UPC_CoA_548/2024, Arke v. SodaStream).

B. Necessity of providing security

15. Applying the above principles to the case at hand, the Defendants' interests in obtaining a security outweigh the interests of the Claimant in view of the facts and arguments brought forward by the parties, also when special care is taken to protect the Claimant's procedural rights.
16. The Defendants have argued in a substantiated manner that the Claimant, as part of the Maxeon Group, is in a very difficult financial situation. The Claimant has not provided any convincing evidence to substantiate its financial situation and, in particular, its ability to bear the possible costs of the proceedings. In its statement, the Claimant confirms that the solar market is currently difficult (for everyone in this market), in particular in view of the various infringing activities affecting its business. Taking into account the timeframe within which the current proceedings are expected to be concluded and a decision on costs to be made, in particular in the event of an appeal to the Court of Appeal, the maturity of the debt investment in 2028 and the unpredictability of the already difficult solar energy market further justify the risk that the Claimant will not have the financial resources to pay the successful party's costs. Therefore, the Claimant must provide adequate security for the legal and other costs of the Defendants.

C. Amount of security

17. With regard to the amount of security considered appropriate, the Claimant correctly refers to the Guidelines for the Determination of Court Fees and the Ceiling for Recoverable Costs adopted by the Administrative Committee of the UPC on 24 April 2023. Pursuant to Art. 1 (2) and (3) of these Guidelines, the ceilings on recoverable costs apply to the costs of representation at each instance of the proceedings, irrespective of the number of parties. It follows that, regardless to the number of parties, only one ceiling is to be set, which is to be calculated on the basis of the value in dispute. Based on the value in dispute of EUR 1,000,000 for both the infringement action and the counterclaim for revocation and therefore 2,000,000 in total, the ceiling is EUR 200,000. The fact that the Defendants are partly represented by different law firms is no more relevant in this regard than the fact that they are connected to each other to different degrees.
18. As for the division of this ceiling between the Defendants, the ceiling is not automatically to be divided by the number of parties liable to pay costs, with the consequence that the Defendants 1., 2. and 4. would receive 3/8 in the case at hand. The purpose of the ceiling on recoverable representation costs is to prevent unjustified recovery of costs both in cases where one party has several representatives and in cases where one representative represents several parties. In the latter case, it is assumed that the several parties with a common representative are economically close or belong to the same economic group and/or do not have a conflict of interests. This is also the case for Defendants 1., 2. and 4., which the Claimant accuses of being the main infringers of the patent. Defendants 3. and 5. to 8. not only have a different representative, but their relationship to each other as well as their relationship to Defendants 1., 2. and 4. is disputed. In view of this, it is justified to distribute the ceiling equally among the groups of Defendants in the present case. Therefore, each group of the Defendants (Group 1: Defendants 1., 2. and 4.; Group 2: Defendants 3. and 5. to 8.) is entitled to EUR 100,000 of the ceiling.
19. However, when determining the amount of security, the Court must consider the fact that this amount is a ceiling and therefore a safeguard against undue cost recovery (see Decision

of the Administrative Committee of 24 April 2023 on the Scale of Recoverable cost ceilings, D - AC/10/24042023_E, Preamble, recital 1). As for the costs for representation, according to R. 152 RoP, these are only reimbursable if they are reasonable and proportionate (R. 152.1 RoP). This aspect must be considered when determining the security.

20. In exercising its discretion, the Court has also to take into account that an order to provide security can, depending on the circumstances, limit the Claimant's right to an effective remedy and to a fair hearing as guaranteed under Union law, including Art. 47 of the Charter and the Enforcement Directive (UPC_CFI_239/2023 (LD The Hague), Order of 13 February 2024, Arkyne v. Plant-e Knowledge). This must be avoided. Therefore, the Defendants' interest in security on the one hand and the Claimant's interest in the effective enforcement of its patent rights must always be balanced.
21. Based on these principles and considering the submissions of the parties, the Court finds it fair, reasonable and proportionate to order the Claimant to provide a security to the amount of EUR 100,000 in form of a deposit on the UPC account dedicated for security deposits or by a bank guarantee provided by a bank licensed in the European Union. Due to the division of the ceiling between the groups of Defendants, it is to be expected that the costs of Defendants 1., 2. and 4. will exhaust that part of the ceiling which is attributable to them. In view of this, these Defendants have a corresponding interest in security. It is not apparent that the imposition of such a security would unreasonably hinder the Claimant in the enforcement of its patent. The Claimant may choose which form of security it prefers to provide.

D. Time period for providing security

22. As to the time period, the Claimant has to provide security within six weeks of the date of service of the present order. This period is deemed sufficiently long for the Claimant to make the necessary arrangements.

E. Granting of leave to appeal

23. Leave to appeal is granted with a view to ensuring a consistent application and interpretation of the Rules of Procedure (Preamble RoP, no. 8).

ORDER:

For these grounds, having heard the parties on all aspects of relevance for the following order, the Court

- orders the Claimant to provide security for legal costs and other expenses to the Defendants 1., 2. and 4. in the amount of EUR 100.000 (one hundred thousand euros) either by way of deposit on the UPC account dedicated for security deposits, alternatively by way of bank guarantee issued by a bank licensed in the European Union to be chosen by the Claimant within six weeks from the date of service of this order;
- grants leave to appeal.

INFORMATION UPON SPECIFYING THE TIME LIMIT

Pursuant to Rule 158.4 RoP, the Claimant is informed that if it fails to provide the aforementioned security within the time stated a decision by default may be given, in accordance with Rule 355 RoP.

DETAILS OF THE ORDER:

App_48223/2024 under main file references ACT_36426/2024, CC_57043/2024 and CC_57310/2024

UPC number: UPC_CFI_336/2024 and UPC_CFI_605/2024

Type of procedure: Infringement action and counterclaim for revocation

Issued in Düsseldorf on 14 April 2025

NAMES UND SIGNATURES

Presiding Judge Thomas	
Legally Qualified Judge Dr Thom	
Legally Qualified Judge Zhilova	
Technically qualified Judge Schmidt	