



UPC_CFI_169/2024 Procedural Order of the Court of First Instance of the Unified Patent Court delivered on 17/03/2025

HEADNOTES

1. According to Art. 31 UPCA in conjunction with Brussels-Ia-Regulation the UPC has international jurisdiction where the courts of a Contracting Member State would have jurisdiction under the Brussels-Ia-Regulation.
2. According to Art. 71b (2) Brussels-Ia-Regulation in conjunction with Art. 7(2) Brussels-Ia-Regulation the UPC has international jurisdiction, regardless of the Defendant's place of residence, for all patent infringements committed in a UPC Member State.

KEYWORDS

Art. 31 UPCA, Art. 71b (2) Brussels-Ia-Regulation, Art. 7(2) Brussels-Ia-Regulation, International Jurisdiction, Rule 19 RoP, Preliminary Objection

CLAIMANT

- 1) **Daedalus Prime LLC**
(Claimant) - 75 South Riverside, unit B/C, Croton-on-Hudson - 10520 - New York - US
Represented by
Dr. Marc Grunwald

DEFENDANTS

- 1) **Xiaomi Communications Co., Ltd.**
(Defendant) - # 019, 9th Floor, Building 6, Yard 33 Xierqi Middle Road, Haidian District - 100085 - Beijing (Peking) - China
Represented by Prof. Dr. Tilman Müller-Stoy
Statement of claim served on 09/09/2024
- 2) **Xiaomi Inc.**
(Defendant) - No.006, floor 6, Building 6, Yard 33, Middle Xierqi Road, Haidian District, Beijing (Peking) 100085, China
Represented by Jan Boesing
Statement of claim served on 13/08/2024
- 3) **Xiaomi Technology Netherlands B.V.**
(Defendant) - Prinses Beatrixlaan 582 - 2595BM - The Hague (Den Haag) - DE
Represented by Prof. Dr. Tilman Müller-Stoy
Statement of claim served on 26/04/2024

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| 4) | Xiaomi Technology Germany GmbH
(Defendant) - Niederkasseler Lohweg 175 - 40547 -
Düsseldorf - DE | Represented by Prof. Dr.
Tilman Müller-Stoy
Statement of claim served on
26/04/2024 |
| 5) | MediaTek Inc. (Headquarters)
(Defendant) - No.1, Dusing Rd. 1, Hsinchu Science
Park – 30078 - Hsinchu - TW | Represented by Dr. Moritz
Meckel
Statement of claim served on
15/11/2024 |

APPLICANT

- | | | |
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| 5) | MediaTek Inc. (Headquarters)
(Defendant) - No.1, Dusing Rd. 1, Hsinchu Science
Park – 30078 - Hsinchu - TW | Represented by Dr. Moritz
Meckel |
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PATENT AT ISSUE

<i>Patent no.</i>	<i>Proprietor/s</i>
EP2792100	Daedalus Prime LLC

DECIDING JUDGE

Judge-rapporteur	Dr. Schilling
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SUBJECT

Preliminary Objection according to R. 19 RoP

SHORT SUMMARY OF THE STATEMENT OF CLAIM

Claimant is seeking an injunction against Defendants 1) to 5) for offering, placing on the market, using, or importing or possessing/storing for the aforementioned purposes a system-on-a-chip apparatus for secure communications over a network comprising the features of claim 1 of the patent in suit EP 2 792 100 in the territories of the Federal Republic of Germany, the French Republic and the Kingdom of the Netherlands. The application of the patent in suit EP 2 792 100 was filed on 15 December 2011 and granted on 29 July 2020. It has been validated with effect in the UPC Member States Germany, France and the Netherlands.

Claimant's action is directed against Defendants' 1) – 4)'s Xiaomi smartphones that have, e.g. an 8000 series or 9000 series Dimensity processor from Defendant 5) (attacked embodiments).

Claimant sees Defendant 5) being liable for the alleged patent infringement based on the assertion that Defendant 5) provides the processors for the attacked embodiments. Claimant argues that Defendant 5) would be liable together with Xiaomi for offering and marketing the infringing smartphones in Germany as a joint perpetrator. Complicity required a joint commission, i.e. a conscious and intentional cooperation in putting the asserted claim into practice. It asserts that there have been concrete indications of onward supply to the Member States of the UPC, leading to joint and several liability. It considers at the very latest Claimant's letter of inquiry (exhibit PS 2)

and its complaint filed with the District Court Düsseldorf (4b O 16/24) having made Defendant 5) aware of the fact that its processors were making their way into the German market as components of certain Xiaomi smartphones. In addition, the distribution of the smartphones in Germany has to be seen as deliberately intended by Defendant 5) as this significantly promoted its own sales.

PRELIMINARY OBJECTION DEFENDANT 5)

Defendant 5) filed a preliminary objection according to R. 19.1 (a) RoP on 16 December, 2024.

Defendant 5) points out that it is not domiciled in a Member State of the UPC. It is of the opinion that Claimant did not substantiate why the UPC would have international jurisdiction in relation to Defendant 5) on the basis of Article 31 UPCA. Claimant had not even asserted any activity of Defendant 5) pertaining to the attacked Xiaomi smartphones which would directly touch any of the UPC territories in dispute. In particular, Claimant did not assert that Defendant 5) ever imported, made, offered, sold placed on the market, used, or stored any attacked Xiaomi smartphones in Germany, France or the Netherlands by himself.

It criticizes that Claimant's line of argumentation was relying on legal theories known to German national law, but not to the UPCA or its related statutes.

Even the Local Division Düsseldorf in its order dated 18 October 2023 did not rule that the German case law or the principle of "*Mittäterschaft*" would apply in front of the UPC. Rather, the Court left the question of applicability open as it was not relevant for the case. Also, the Court of Appeal's order dated 3 September 2024 does not provide any basis to assume the UPC would have jurisdiction and competence to hear the present case either. In that case the Defendants themselves had committed the allegedly patent infringing acts (world-wide supply of video files and media player software for streaming via the internet), which did directly touch the territories of UPC member states. Therefore, the Court of Appeal did not have to (and did not) consider "*Mittäterschaft*"-type legal theories, which are at issue in the present case at hand.

Defendants 5) request:

- I. the Preliminary Objection be allowed;
- II. the infringement action (ACT_19012/2024) against the Defendant 5) be dismissed for lack of jurisdiction and competence of the Unified Patent Court according to Rule 19.1(a) RoP;
- III. the Court determines that Claimant bears all legal costs and other expenses incurred by the Defendant 5) in the present proceedings.

Claimant requests

- I. The Preliminary objection filed by Defendant 5) according to R. 19 (1) RoP dated December 16, 2024 is dismissed.
- II. Defendant 5) bears the costs of the Preliminary objection proceedings.

In the alternative

The Preliminary objection is to be dealt with in the main proceedings.

With its response 20 December 2024 Claimant argues that the UPC has international jurisdiction with regards to Defendant 5). Two main criteria are relevant for the territorial competence of the divisions of the Court, namely the domicile of a defendant and/or the place of the infringement. These criteria provide elements of geographical connection with the UPC Contracting Member

State where the respective local division is located. If any, i.e. one, of these two criteria is established, the respective local division is competent to hear the case.

In particular, the UPC has international jurisdiction in respect of an infringement action where the patent in suit relied on by Claimant has effect in at least one Contracting Member State and the damage may occur in that particular Contracting Member State. In the case at hand, the patent in suit is a European patent with effect in Germany, France and the Netherlands and Claimant considers to have substantiated infringement inter alia by referring to the infringing smartphones equipped with chips manufactured by Defendant 5) (see Statement of Claim, marg. no 133 et seqq.). In the present case, the infringing processors were embedded in Xiaomi's smartphones and brought to the EU market (see Statement of claim, marg. no. 134 et seq.) and are offered and sold in various UPC Contracting Member States. Thus, damages inter alia in Germany would arise for Claimant through customers obtaining Xiaomi smartphones including processors of Defendant 5) within the territory of the Contracting Member States (i.e., Germany and other countries) where the patent in suit has effect.

It further argues that the identification of the place where the harmful event occurred or may occur within the meaning of Art. 7(2) Brussels Regulation would not depend on criteria which do not appear in this provision and which are specific to the examination of the merits, such as the conditions for establishing infringement within the meaning of Art. 25, 26 UPCA. A conclusive argumentation relating to the prerequisites of Art. 25, 26 UPCA would only be required for granting the claims in the infringement proceedings on the merits, but not decisive for the establishment of jurisdiction under the UPC regime.

GROUND FOR THE ORDER

The admissible preliminary objection is to be rejected. The UPC has international jurisdiction over the dispute as a whole and the Hamburg Local Division is competent to hear the infringement action brought by the Claimant against all Defendants. Whether or not Defendant 5) – if the Court would in the end find an infringement of the patent in suit (and the patent in suit valid) – can be deemed liable is a question of the merits of the case, which is not subject to the determination of jurisdiction and competence.

1.

The international jurisdiction of the UPC is governed by Art. 31 UPCA. According to Art. 31 UPCA the international jurisdiction of the Court shall be established in accordance with Regulation (EU) No 1215/2012 (Brussels-Ia-Regulation) or, where applicable, on the basis of the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Lugano Convention).

a)

According to Article 71a (1) Brussels-Ia-Regulation for the purposes of the Regulation, a Court common to several Member States as specified in paragraph 2 shall be deemed to be a Court of a Member State when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of this Regulation. Based on the case-law of the UPC Court of Appeal (Court of Appeal, 03.09.2024 – CoA_188/2024, APL_21943/2024) the UPC is a common Court within the meaning of Art. 71a (1) of the Brussels-Ia-Regulation, as explicitly mentioned in Art. 71a (2) (a) Brussels-Ia-Regulation. Therefore, the UPC has jurisdiction where the courts of a Contracting Member State would have jurisdiction under the Brussels-Ia-Regulation in an action within the meaning of Art. 32 (1) UPCA, Art. 71b (1) and (2) Brussels-Ia-Regulation.

b)

The UPC's jurisdiction as a common Court within the meaning of Art. 71a Brussels-Ia-Regulation is defined in Art. 71b Brussels-Ia-Regulation as follows:

Article 71b

The jurisdiction of a common court shall be determined as follows:

(1) a common court shall have jurisdiction where, under this Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument;

(2) where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, Chapter II shall apply as appropriate regardless of the defendant's domicile.

Application may be made to a common court for provisional, including protective, measures even if the courts of a third State have jurisdiction as to the substance of the matter;

(3) where a common court has jurisdiction over a defendant under point 2 in a dispute relating to an infringement of a European patent giving rise to damage within the Union, that court may also exercise jurisdiction in relation to damage arising outside the Union from such an infringement.

Such jurisdiction may only be established if property belonging to the defendant is located in any Member State party to the instrument establishing the common court and the dispute has a sufficient connection with any such Member State.

According to Art. 71b (1) Brussels-Ia-Regulation, the UPC as a 'common court' of several EU Member States (Art. 71a) has jurisdiction in patent matters (within the meaning of the UPCA) if a court of an EU Member State that is a party to the UPCA would be competent (if the UPC did not exist) under the rules of jurisdiction of the Brussels-Ia-Regulation (Bopp/Kircher EurPatentprozess-HdB/Bopp/Krumm, 3rd ed. 2025, Section 8, para. 11).

More importantly, Art. 71b (2) Brussels-Ia-Regulation supplements the basic rule under Art. 7 Brussels-Ia-Regulation where a Defendant is not domiciled in an EU member state by opening jurisdiction according to Art. 7 Brussels-Ia-Regulation *regardless of the defendant's domicile*. The UPC thus has international jurisdiction, regardless of the Defendant's place of residence, for all patent infringements committed in a UPC member state (see. Bopp/Kircher EurPatentprozess-HdB/Bopp/Krumm, 3rd ed. 2025, Section 8, para. 12; comp. Tilmann/Plassmann/Grabinski/W. Tilmann, 1st ed. 2024, UPCA, Art. 31 para. 22a). This is notwithstanding the fact that the Defendant is domiciled in a third country and a Court of a member state in such a constellation could in principle only base its international jurisdiction on its national law in accordance with Article 6. The only requirement is that the place of infringement or action is in a member state that is a party to the UPCA (see Geimer/Schütze Int. Private Law/E. Peiffer/M. Peiffer, 67th supplement June 2024, VO (EG) 1215/2012 Art. 71b para. 6).

2.

Based on this frame set of jurisdictional provisions the UPC has international jurisdiction with respect to Defendant 5) in the present case.

a)

The Court of Appeals ordered that in the light of the case-law, Art. 7 (2) in conjunction with Art. 71b (1) Brussels-Ia- Regulation must be interpreted as meaning that the UPC has international jurisdiction in respect of an infringement action where the European patent relied on by the claimant has effect in at least one Contracting Member State and the alleged damage may occur in that particular Contracting Member State. As the UPC as a common Court has jurisdiction *regardless of the defendant's domicile* for all patent infringements committed in a UPC member state (Art. 71b (2) in conjunction with Art. 7 sub (2) Brussels-Ia-Regulation) it comes down to the point that international jurisdiction is given in that Contracting Member State *where the harmful event occurred or may occur*, within the meaning of Art. 7 sub (2) Brussels-Ia- Regulation. The expression 'place where the harmful event occurred or may occur' in Art. 7(2) of the Regulation is intended to cover both the place where the damage occurred and the place of the event giving rise to it, so that the defendant may be sued, at the option of the applicant, in the courts for either of those places (Court of Appeal, 03.09.2024 – CoA_188/2024, APL_21943/2024). Art 7 sub (2) Brussels-Ia-Regulation covers "matters relating to tort, delict or quasi-delict", which includes alleged patent infringements (see LD Hamburg, 18.12.2024 - UPC_CFI_525/2024, ACT_51510/2024, App_58871/2024).

b)

In the present case Claimant has sufficiently stated in its Statement of Claim that these criteria are present and that therefore the UPC has international jurisdiction in this case pursuant to Art. 7(2) in conjunction with Art. 71b (2) Brussels-Ia- Regulation with respect to Defendant 5).

aa)

Claimant relies on a European patent that has been validated with effect in the UPC Member States Federal Republic of Germany, the French Republic and the Kingdom of the Netherlands. It stated that the alleged damage may occur in these Contracting Member States, as the attacked embodiments – smartphones equipped with chips manufactured by Defendant 5) – were offered on these markets by Defendants 1) to 4). Therefore, the likelihood of a damage within the meaning of Art. 7 (2) Brussels-Ia- Regulation arises from the alleged marketing of the attacked embodiments within the territory of these Member States in which the European patent has effect, allegedly making use of the patented solution according to claim 1 of the patent in suit.

bb)

The issue whether the patent has been infringed and whether that infringement may be attributed to Defendant 5) falls within the scope of the examination of the substance of the action by the court having jurisdiction (Court of Appeal, Order of September 03, 2024, CoA_188/2024). Neither the identification of the place where the harmful event occurred nor a conclusive argumentation relating to the conditions of Art. 26 UPCA, which is required for granting the claims in the infringement action, are decisive for the establishment of jurisdiction pursuant to Art. 7 (2) Brussels-Ia-Regulation (Court of Appeal, Order of September 03, 2024, CoA_188/2024). Therefore, it is sufficient for establishing international jurisdiction of the UPC that the Claimant claims that Defendant 5) would be a joint perpetrator as it was aware of the fact and deliberately intended that its processors were making their way into the German market as components of certain Xiaomi smartphones, regardless whether or not these assertions are disputed by Defendant 5) or not.

cc)

Even if one were to consider [quod non] a limitation of Art. 71b (2) Brussels-Ia- Regulation in cases of multiple Defendants to constellations where the additional requirements of Art. 8 Brussels-Ia-

Regulation were met (comp. Tilmann/Plassmann/Grabinski/W. Tilmann, 1st ed. 2024, UPCA, Art. 31 Rn. 31a), the outcome would be the same.

Art. 8 (1) Brussels-Ia- Regulation requires where a Defendant is one of a number of Defendants, he or she can be sued *in the Courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings.*

Here, Defendant 4) is domiciled in Germany. The claims against all Defendants rely on the same patent and the same attacked embodiment – smartphones equipped with chips manufactured by Defendant 5) – making the claims closely connected within the meaning of Art. 8 (1) Brussels-Ia- Regulation. As Defendants 1) – 4) belong to the same Group (“Xiaomi”) and as Defendant 5) is undisputedly supplier to the Xiaomi-Group there has to be seen a commercial relationship within the meaning of Art. 33 (1) lit. b) UPCA, which is sufficient for the establishment of jurisdiction.

3.

The competence of the Hamburg Local Division, which is not explicitly contested, follows Art. 33 (1) lit. a UPCA. Claimant stated that the alleged damage may occur in particular in Germany, where the attacked embodiments were marketed. That Defendant 5) is not residing or based in Germany is not relevant for the scope of Art. 33 (1) lit. a UPCA (LD Hamburg, 18.12.2024 - UPC_CFI_525/2024, ACT_51510/2024, App_58871/2024). The place “where the actual or threatened infringement has occurred or may occur” as referred to in Art. 33 (1) (a) UPCA must be interpreted in the same way as the place “where the harmful event occurred or may occur” of Art. 7(2) Brussels-Ia- Regulation is interpreted in relation to alleged patent infringements (Court of Appeal, Order of September 03, 2024, CoA_188/2024).

4.

Rule 19 RoP does not offer an isolated cost decision for this type of application. The costs are part of the costs of the main proceeding.

5.

Leave to appeal has not been requested.

ORDER

The preliminary objection is dismissed.

INFORMATION ABOUT THE APPEAL

An order of the judge-rapporteur rejecting the Preliminary objection may only be appealed pursuant to Rule 220.2 RoP. According to this Rule the order may be either the subject of an appeal together with the appeal against the decision or may be appealed with the leave of the Court of First Instance within 15 days of service of the Court’s decision to that effect. In the event of a refusal of the Court of First Instance to grant leave within 15 days of the order of one of its panels a request for a discretionary review to the Court of Appeal may be made within 15 calendar days from the end of that period.

ORDER DETAILS

Order no. ORD_67603/2024 in ACTION NUMBER: ACT_19012/2024

UPC number: UPC_CFI_169/2024

Action type: Infringement Action

Related proceeding no. Application No.: 66363/2024

Application Type: Preliminary objection