



File reference:  
UPC\_CoA\_520/2024  
App\_57474/2024  
APL\_51079/2024

**Procedural order**  
**of the Court of Appeal of the Unified Patent Court concerning an**  
**application pursuant to R. 36 RoP**  
**issued on 01 November 2024**

DEFENDANT AND APPELLANT

**Scandit AG**, Hardturmstrasse 181, 8005 Zurich, Switzerland (hereinafter referred to as "**Scandit**"), represented by Dr. Johannes Bukow and Tonio Allendorf, attorneys at law, Quinn Emanuel Urquhart & Sullivan, LLP

APPLICANT AND RESPONDENT

**Hand Held Products, Inc**, 855 S Mint Street, Charlotte, NC 28202, USA (hereinafter referred to as "**Hand Held Products**"), represented by Dr. Tobias Wuttke, attorney, Bardehle Pagenberg, Partnerschaft mbB Patentanwälte Rechtsanwälte,

PATENT IN DISPUTE

EP 3 866 051

DECIDING JUDGE

Emmanuel Gougé, Judge-Rapporteur

LANGUAGE OF THE PROCEEDINGS

German

CONTESTED ORDER OF THE COURT OF FIRST INSTANCE

- Order of the Court of First Instance of the Unified Patent Court, Munich Local Division, dated 27 August 2024
- File reference: ORD\_46277/2024, ACT\_9216/2024, UPC\_CFI\_74/2024

#### SUMMARY OF FACTS

1. On 27 August 2024, the Court of First Instance, Munich Local Division, issued a preliminary injunction against the defendant (Scandit) due to indirect infringement of claims 1 and 10 of the patent in dispute and rejected the Applicant's request (Hand Held Products) for provisional measures in the remainder and the requests of both parties to order the other party to pay the costs.
2. Scandit appealed the contested order and filed its notice of appeal on 11 September 2024.
3. Hand Held Products filed its response to the appeal on 02 October 2024.
4. On 21 October 2024, Scandit applied for leave to file a reply to the response to the appeal pursuant to R. 36 of the Rules of Procedure (RoP).
5. Following a procedural order dated 24 October 2024, Hand Held Products submitted its written statement on 28 October 2024.

#### INDICATION OF THE PARTIES' REQUESTS

6. In support of its request to be allowed to file a reply, Scandit repeats its arguments already set out in the grounds of appeal, according to which the contested decision is based on an incorrect interpretation of features 1.7 to 1.9 of claim 1 of the patent by reference to an "*augmented reality*".
7. Scandit is of the opinion that, when Hand Held Products referred to these features by reference to an "*augmented reality*" in its response to appeal, it was referring for the first time to the description in paragraph [0063] of the patent in dispute, which now requires a detailed analysis by Scandit.
8. In addition, Scandit argues that the reply is necessary in order to present further prior art which, in view of the short time limit for filing the grounds of appeal in the preliminary injunction proceedings, was still unknown to it at the time of filing the grounds of appeal and therefore could not be introduced together with the grounds of appeal.
9. Hand Held Products requests that Scandit's application be rejected.
10. Hand Held Products submits that, in accordance with the principles of acceleration and efficiency of the proceedings and the "front-loaded nature" of the proceedings before the UPC, the number of written pleadings must remain limited unless the applicant has submitted valid reasons for the admission of further written pleadings pursuant to R. 36 RoP.

11. The reference to paragraph [0063] of the patent merely serves to emphasize the interpretation given by the Court of First Instance in its decision on a detailed aspect relating to feature 1.8 of claim 1 of the patent, and the question of augmented reality had already been dealt with in Hand Held Products' statement of claim filed on 21 February 2024.
12. Scandit also failed to substantiate the need to submit further prior art.

#### GROUNDS FOR THE ORDER

13. The application to be allowed to submit a reply to Hand Held Products' response to the appeal is admissible, but not well-founded.
14. According to the Rules of Procedure (Part 4, "*Procedures before the Court of Appeal*"), the written phase before the Court of Appeal is limited for the appellant to the submission of a statement of grounds of appeal and for the respondent to the submission of a statement of response.
15. This limitation corresponds to the purpose of the appeal procedure, which is to review the contested decision or order of the Court of First Instance on the basis of requests, facts, evidence and legal arguments submitted by the parties in the proceedings before the Court of First Instance, R. 222.1 and .2 RoP, while requests, facts, evidence and legal arguments not submitted by the parties in the proceedings before the Court of First Instance may be disregarded, unless the Court of Appeal exercises its discretion otherwise, taking into account in particular the criteria set out in R. 222.2 (a)-(c) RoP.
16. Accordingly, it is provided that the statement of grounds of appeal shall state which parts of the decision or order are appealed against, the grounds for setting aside the decision or order appealed against and the facts and evidence on which the appeal is based in accordance with R. 222 and 226 RoP, and that the response to the appeal shall contain a response to the statement of grounds of appeal, according to R. 236.1 (d) RoP.
17. Additional grounds of appeal which are not submitted within the time limit for the statement of grounds of appeal provided for in R. 224.2 RoP are not admissible, according to R. 233.3 RoP.
18. It follows that no further exchange of written pleadings is provided for in the Rules of Procedure of the UPC unless a cross-appeal has been lodged pursuant to R. 237 and 238 RoP.

19. However, the court may, in accordance with R. 36 RoP, allow the exchange of further written pleadings at the reasoned request of a party, in particular if this is required by the principles of due process, such as in particular the principles of fairness, equity and efficiency and the right to be heard.
20. According to the case law of the Court of Appeal, R. 36 RoP can also be applied mutatis mutandis in appeal proceedings (Court of Appeal, 17 June 2024, UPC\_COA\_222/2024, APL\_25928/2024, App\_34219/2024).
21. In the present case, Scandit has not sufficiently demonstrated that the application of these principles requires that a reply be permitted in the appeal proceedings. Scandit had the opportunity to comment in the grounds of appeal on the court's interpretation of features 1.7. to 1.9. of patent claim 1 in the contested order in terms of "augmented reality". The fact that Hand Held Products defended the court's interpretation in the response to the appeal with reference to paragraph [0063] does not justify allowing the filing of a reply. Scandit has not substantiated why Hand Held Products' reference to this one paragraph of the patent description requires a new in-depth discussion and is not merely a selective aspect of the overall interpretation of features 1.7 to 1.9 of patent claim 1. Scandit will have the opportunity to address this aspect at the oral hearing.
22. Nor can Scandit be allowed to submit further prior art on appeal. In particular, it has not justified that the further prior art which it wishes to submit for the first time in the appeal proceedings could not reasonably have been submitted in the proceedings before the Court of First Instance, as provided for in R. 222.2(a) RoP.

PROCEDURAL ORDER

The application to file a reply to the appeal response is rejected.

This order will be issued on 01 November 2024.

EMMANUEL  
LUCIEN, RENÉ  
GOUGÉ

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Emmanuel Gougé, Judge-Rapporteur