



Local Chamber
Mannheim

UPC_CFI_247/2025
Order
of the Court of First Instance of the Unified Patent Court issued
on 16 September 2025
related to App_33294/2025

PLAINTIFF

Huawei Technologies Co. Ltd.

with registered office at the administrative building of Huawei Technologies Co. Ltd, Bantian,
Longgang District Shenzhen, 518129, P.R. China

Represented by: Matthias Meyer, Bird & Bird LLP, Carl-Theodor-Str. 6, 40213 Düsseldorf,
Germany

DEFENDANT

1. MediaTek, Inc.

Hsinchu Science Park No. 1, Dusing 1st Road - 30074 - Hsinchu - TW

2. MediaTek Germany GmbH

(Applicant) Kesselstraße 5-7 - 40221 - Düsseldorf - DE

Defendant 2. represented by: Dr Moritz Meckel, Henderson, Farabow, Garrett & Dunner, LLP

PATENT-IN-SUIT: EP 3 567 731

APPEALING BODY: Local Chamber Mannheim

DECISION-MAKING JUDGE: Legally qualified judge Sender as rapporteur

ACTION: Statement of defense; application pursuant to Rule 190 of the Rules of Procedure.

FACTS OF THE CASE:

Defendant 2) requests the production of licence agreements cited by Plaintiff [...], including the production of licence agreements with (further) licensees of Plaintiff named by Defendant 2).

The Plaintiff opposes the application of the defendant 2) in so far as two further licence agreements are to be submitted in addition to the licence agreements mentioned on pages 2 and 3 of its statement of 15 August 2025 (= item I of the Plaintiff's application). These further licence agreements relate exclusively to network infrastructure products and not to mobile devices. They were therefore *a priori* not suitable settlement agreements. It was not possible for the Plaintiff to provide the defendant with details of the content of the licence agreements out of court, as these contained strict confidentiality obligations. The disclosure of this strictly confidential information requires the consent of the respective contracting parties, which was not granted after a corresponding request (Exhibit K-NT22 (confidential)), which is why a court submission order is now necessary.

With regard to the further submissions and motions of the parties, reference is made to the exchanged written submissions of 20 July 2025 (motion of the defendant to 2) and 15 August 2025 (statement of the Plaintiff) together with Exhibits.

REASONS FOR THE DECISION:

The defendant's application is partially justified.

With the exception of the licence agreements with [...], the Plaintiff must submit the licence agreements mentioned by it on pages 2 and 3 of its statement of position of 15 August 2025 with its reply to the statement of defence in the infringement proceedings. In doing so, it is permitted to redact the parts that it does not wish to use for its factual submission or its legal argumentation.

I. Insofar as the Plaintiff agrees to the submission of the licence agreements specified by it in detail and has in the meantime - as it has documented to the court - unsuccessfully sought consent for submission from its respective contractual partners, the discretion granted in R. 190 VerfO was to be exercised here at the stage reached in the proceedings to order the submission. For the principles applicable in this regard, reference is made to the decision of the Local Chamber Mannheim of 30 April 2024, UPC_CFI_223/2023, Panasonic v. Xiaomi et al. The rapporteur understands the Plaintiff's submission under marginal no. 5 of its statement of 15 August 2025 to mean that the licence agreements to be submitted cover all [...] contracts mentioned, even if two contracts with a conclusion date [...] are mentioned there, which have not found a date-related correspondence in the Plaintiff's listing in its statement of 15 August 2025.

II. In contrast, the submission of the licence agreements with [...] was not to be ordered (at least at present).

1. The Court of First Instance has discretionary powers when deciding on an application for an order to produce evidence pursuant to R. 190 of the Rules of Procedure. The discretionary power also includes the judge-rapporteur's decision on the chronological order in which questions are to be decided in accordance with R. 334(e) of the Rules of Procedure. The assessment of an application for an order to produce evidence may also depend on the stage of the proceedings. A

Such a request may be considered not to meet the criteria of necessity, relevance and proportionality at a certain stage of the proceedings, but may be considered to meet those criteria at a later stage (see Court of Appeal, order of 24 September 2024, UPC_CoA 298-300/2024, Oppo et al v. Panasonic).

2. In view of this, the submission was not to be ordered in this respect.

So far, no sufficient evidence has been submitted or is otherwise apparent that the Plaintiff has other - perhaps even more suitable - settlement licence agreements that the parties could use sensibly on their way to concluding a FRAND licence, especially since it is primarily the Plaintiff's own decision whether and, if so, which and how many settlement licence agreements it submits in the proceedings in order to counter a possible FRAND defense by the Defendant and to characterise its conduct as compliant with EU antitrust law. Procedural consequences could only be drawn if, for example, it should turn out in proceedings that an SEP holder deliberately did not bring contracts suitable as settlement licences into the negotiations and proceedings in order to enforce excessive licences by exploiting its monopoly position (see LK Mannheim, order of 16 May 2024, UPC_CFI_216/2023, Panasonic v. Oppo et al).

III. In addition, the request in connection with the defendant's request for submission under 2) to order the Plaintiff to submit the licence agreements together with *"all amendments and supplements to the licence agreements, any ancillary agreements and other agreements relating to the aforementioned agreements"* is too extensive and must therefore also be dismissed.

The proper classification of the Plaintiff's offer as FRAND-compliant or FRAND-incompatible appears possible even without knowledge of these circumstances on the basis of the contracts now to be brought into the proceedings, because this allows the *status quo* of the Plaintiff's portfolio at the time the settlement licence agreements were concluded to be compared with the current portfolio and thus to assess whether any relevant changes may have occurred (see LK Mannheim, order of 16 May 2024, UPC_CFI_216/2023, Panasonic v. Oppo et al). In addition, it is also the Plaintiff's risk in this respect to submit and explain suitable settlement licence agreements in order to characterise its conduct as compliant with EU antitrust law.

IV. For the latter reason, the Plaintiff is also permitted to redact parts of the licence agreements to be submitted which it does not wish to use for its legal argumentation or its actual submission.

V. In view of the further proceedings, it is appropriate and reasonable for the Plaintiff to submit the contracts to be presented in connection with its statements in the reply. The legitimate interests of defendant 2) are not adversely affected by this because it can sufficiently address the Plaintiff's submissions within the deadline for the rejoinder.

VI. (Further) orders pursuant to R. 262A VerfO will be issued in connection with the submission of the aforementioned contracts with the reply on the basis of corresponding requests, which are to be expected anyway in view of the further statements in the reply on the FRAND issue. There is also no fear of loss of secret information as a result of this, since according to the procedure now established in the CFI, the unedited versions of the respective briefs will only be released after a preliminary confidentiality order has been issued that offers sufficient protection.

ORDER:

1. The submission of the following licence agreements with the reply to be filed in due time in the infringement proceedings is ordered:

- Licence agreement between the Plaintiff and [...];
- Licence agreement between the Plaintiff and [...];
- Licence agreement between the Plaintiff and [...];
- Licence agreement between the Plaintiff and [...];
- Licence agreement between [...] and [...];
- Licence agreement between the Plaintiff and [...];
- Licence agreement between the Plaintiff and [...].

Passages may be redacted insofar as the Plaintiff does not refer to these passages for its factual allegations and legal arguments.

2. The further claims are rejected.
3. It is pointed out that the court may take it into account if this submission order is not complied with (R. 190.7 VerfO accordingly).
4. It is further pointed out that the court may disregard procedural steps, facts, evidence or arguments if these have not been undertaken or provided by the party within the time limit set by the court (R. 9.2 VerfO).

Issued in Mannheim on 16 September 2025 Name

and signature

**Tobias
sender** Digitally signed by
Tobias Sender
Date: 2025.09.16
07:11:29 +02'00'

Sender

Legally qualified judge

Notice of appeal (Art. 73(2)(a), 59 UPCA, R. 190, R. 220.1(c), 224.1(b) RP): The party adversely affected by this decision may lodge an appeal within 15 days of its notification.