



UPC_CFI_54/2023
Order for proceedings
of the Court of First Instance of the Unified Patent Court issued on
4 June 2024

PARTIES

- 1) **Avago Technologies International Sales Pte. Limited** Represented by Florian Schmidt-Bogatzky
(claimant and counter-defendant) - 1 Yishun Avenue 7 - 768923 - Singapore - SG

- 2) **Tesla Germany GmbH** Represented by Dr Marcus Grosch
(Defendant and Counterclaimant) - Ludwig-Prandtl-Straße 27-29 - 12526 Berlin – DE

- 3) **Tesla Manufacturing Brandenburg SE** Represented by Dr Marcus Grosch
(Defendant and Counterclaimant) - Tesla Str. 1 - 15537 Grünheide (Mark) - DE

PRESIDING JUDGE

Rapporteur (Judge-rapporteur) MOTIONS OF

THE PARTIES

The defendants filed a further application under Rule 190.1 EPG-VerfO on 15 May 2024, requesting that the plaintiff be ordered to submit the following documents:

1. *The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. referred to in the power of attorney submitted as Annex EIP 11. to authorise the [...] to grant the authority to [...] on behalf of Avago Technologies General IP (Singapore) Pte. Ltd.*

2. *The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. referred to in the Power of Attorney submitted as Exhibit EIP 11 authorising the transfer of the patent in suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd.*

3. *The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. referred to in the Power of Attorney submitted as Annex EIP 12 authorising the transfer of the patent in suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd. resolution of the Board of Directors" of [...] to*

Authorisation of [...] to grant power of attorney to [...] to act on behalf of [...] Corporation.

4. *The resolution of the Board of Directors of [...] referred to in the power of attorney submitted as Annex EIP 12 authorising the transfer of the patent in suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd.*

The defendants argued that the resolution passed by the governing bodies of the companies in the plaintiff's group of companies was an internal matter to which the defendants had no access. The powers of attorney submitted (Annexes EIP 11 and EIP 12) referred to that the signatory [...] to further sub-authorisation was allegedly authorised by the Board of Directors. There are doubts as to whether the powers of attorney submitted as Annexes EIP 11 and EIP 12 were validly granted.

They have asserted that there are also reasonable doubts as to whether [...] acted on behalf of Avago Technologies General IP (Singapore) Pte. Ltd. and [...] within the scope of the power of representation allegedly granted to him by the powers of attorney submitted as Annexes EIP 11 and EIP 12. The powers of attorney expressly stipulate that authorisation of the respective transfer by the Board of Directors is a prerequisite for effective action with power of representation. There was no indication in the powers of attorney that such authorisation had been granted by the Board of Directors with regard to the transfer of the disputed patent.

By order of 21 May 2024, the plaintiff was given the opportunity to comment. The plaintiff opposed the application.

The plaintiff asserts that the defendants are no longer concerned, as they were initially, with the admissibility of the self-dealing transaction, but rather with the internal decision-making process at the management level. There is no doubt that such a decision-making process took place. At most, motions 1 and 3 concerning the authorisation of [...] could have something to do with the matter at hand.
issue at hand.

It further considers that the request for the submission of resolutions of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. and [...] clearly does not constitute "plausible evidence" as expressly required by R. 190.1 VerfO. There are no connecting facts to suggest that the relevant resolutions of the plaintiff's group of companies were not taken or were not taken effectively. This is because the companies involved [...] and Avago belonged (and belong) to the same group of companies. The transfer of the patent in suit (and the other patents involved in the transaction at the time) has also been "lived" on a daily basis for many years. Furthermore, this could at most concern the transferring, former patent owner [...]. Avago General IP, as the "recipient" of the patent transfer, is not affected and, according to the documents, nothing needs to be "authorised by the Board".

REASONS FOR THE ORDER

1.

According to Rule 190.1 VerfO, the court may, upon a reasoned request by the party that has designated the evidence, order the opposing party or the third party to produce such evidence if a party has submitted all reasonably available and plausible evidence to substantiate its claims and has

Justification of these claims Evidence has been identified that is in the possession of the opposing party or a third party.

The defendants disputed the plaintiff's standing to sue and objected to the lack of effective authorisation of the persons acting, in particular on the grounds of an impermissible self-dealing transaction. This application is a follow-up application following receipt of the powers of attorney submitted by the plaintiff in Annexes EIP 11 and 12. The defendants had already requested the submission of the following documents in their statement of defence and in a separate application dated 15 April 2024:

1. The power of attorney referred to in the expert opinions of [...] dated 17 May 2018 (Annex EIP 9) and [...] ("Advice on Validity of Assignment of Patents") dated 16 May 2018 (Annex EIP 10), according to which Avago Technologies General IP (Singapore) Pte. Ltd. grants several persons the authority to act on its behalf in certain legal transactions ("Power of Attorney"), signed by [...] as its "Chief Financial Officer" on 17 October 2016.

2. The power of attorney referred to in the expert opinions of [...] dated 17 May 2018 (Annex EIP 9) and [...] ("Advice on Validity of Assignment of Patents") dated 16 May 2018 (Exhibit EIP 10), according to which the [...] Corporation grants several persons the authority to act on its behalf in certain legal transactions ("Power of Attorney"), signed by its "Secretary" on 17 October 2016.

The plaintiff voluntarily complied with this request.

Object of present applications is to the authorisation of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. and the Board of Directors of [...]. A further subject matter is the submission of the respective resolutions of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. and the Board of Directors of [...] Corporation authorising the transfer of the patent in suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd.

2.

The application was granted with regard to claims 1, 3 and 4, but otherwise rejected.

a) In principle, the legal standing to assert ancillary claims under European patents is based on substantive entitlement. The entry in the patent register therefore has considerable indicative value for assessing who is the substantive owner of the patent (see Federal Court of Justice, judgment of 7 May 2013 - X ZR 69/11, GRUR 2013, 713, para. 57 et seq.

- milling method). On the basis of the EPC, nothing else applies. According to Rule 8.5 of the Rules of Procedure,

(a) [...] with regard to the proprietor of the European patent, the person who is entitled under the law of the Member State for which the European patent was granted to be registered as the proprietor of the patent shall be deemed to be the proprietor of the patent, regardless of whether that person is actually registered in the patent register of the Member State concerned (hereinafter referred to as the "national patent register"), and

(b)[..]

(c) For the purposes of paragraph 5, there shall be a rebuttable presumption that the person identified in the respective national patent register and in the European patent register maintained by the European Patent Office is entitled to be registered as the proprietor or applicant.

The Chamber must therefore proceed on the basis of a rebuttable presumption. The CoA has already applied this principle to patents with unitary effect and assumed that, on the basis of their corresponding entry in the Register for Unitary Patent Protection, these persons are to be treated as proprietors of the patent in question, Rule 8.4 RPC. As such, they are entitled to request the ordering of appropriate measures, Art. 47(1) EPGÜ (UPC_CoA 335/2023, order of 26 February 2024, p. 24).

b) Although the defendants have not provided any concrete evidence of the absence or inaccuracy of the authorisation of [...] in favour of [...]

. However, since the defendants have no insight whatsoever into the internal decision-making process within the plaintiff's company and group, they must be granted access to the resolutions referred to in the proceedings by the registered owner of the property rights, i.e. the plaintiff, for review. In addition, as the plaintiff also concedes, there is a connection between motions 1 and 3 concerning the authorisation of [...] and the present issue of self-dealing. This justifies a corresponding

c)

With regard to application 2, however, the requirements of Rule 190.1 VerfO have not been demonstrated. This is because the power of attorney submitted by the plaintiff as Annex EIP 11 merely states that authorisation by the board of directors is required for the *transfer of rights*, but not for the acquisition of rights. In this respect, the plaintiff is right to point out that the phrase "authorised by the Board" referred to by the defendants expressly refers only to "(i) Patent IP owned by the Company". If, on the other hand, Avago General IP is the recipient of a patent transfer, this provision does not apply, so that there are no indications of authorisation by the Management Board.

d)

With regard to claim 4, however, the requirements of Rule 190.1 VerfO are met. This is because the power of attorney submitted as Annex EIP 12 also shows that authorisation by the Executive Board is required for the *transfer of rights*. In this respect, the transfer of IP rights requires authorisation by the Executive Board of [...], the absence of which the defendant cannot verify or provide evidence of without having seen it.

ORDER

The plaintiff is ordered to submit the following documents **within one week**:

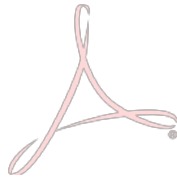
1. The resolution of the Board of Directors of Avago Technologies General IP (Singapore) Pte. Ltd. referred to in the power of attorney submitted as Annex EIP 11 authorising [...] to grant authority to [...] on behalf of Avago Technologies General IP (Singapore) Pte. Ltd.

2. ...

3. The resolution of the Board of Directors of [...] referred to in the power of attorney submitted as Annex EIP 12 authorising [...] to grant authority to [...] to act on behalf of [...].
4. The resolution of the Board of Directors of [...] referred to in the Power of Attorney submitted as Annex EIP 12 authorising the transfer of the patent in suit from [...] to Avago Technologies General IP (Singapore) Pte. Ltd.
5. The further application is dismissed.

DETAILS OF THE ORDER:

Order No. ORD_28831/2024 in App 27608/2024
Case number: ACT_463258/2023
UPC number: UPC_CFI_54/2023
Type of proceeding: Application for an order to produce evidence (Rule 190 of
the Rules of Procedure) ISSUED IN HAMBURG ON 4 JUNE 2024



Dr Schilling
Rapporteur