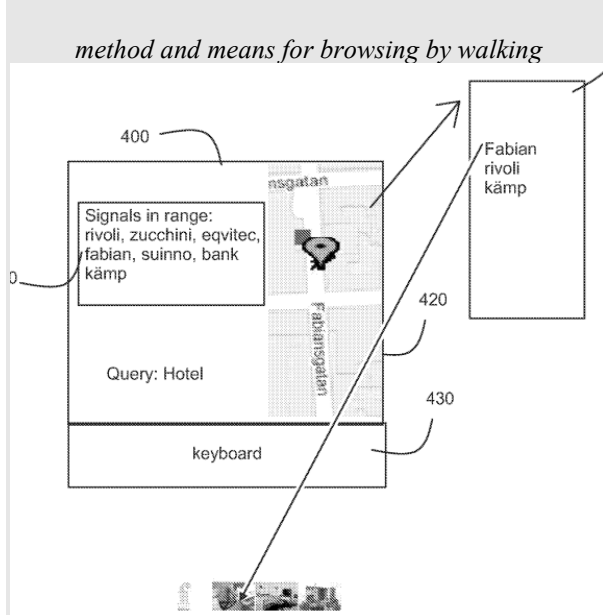


UPC Court of Appeal, 21 August 2024, Microsoft v Suinno



PATENT LAW – PROCEDURAL LAW

Inadmissible request for discretionary review by the Court of Appeal of an order rejecting – without leave to appeal – the ‘R.361 RoP request’ to declare the revocation action as manifestly inadmissible (Rule 361 RoP)

- **Leave to appeal as provided for in Rule 220.2 RoP was required because the provision of Rule 363(2) RoP that a “decision [...] pursuant to Rules [...] 361 [...] is a final decision within the meaning of Rule 220.1(a)” (for which leave to appeal is not required) only concerns orders granting a ‘R.361 RoP request’.**
- **An order denying a R.361 RoP request is a case management order as meant in R.333.1 RoP that cannot be directly appealed but can only be reviewed by the panel.**

The notion of ‘case management decision or order’ is a broad concept that calls for a broad interpretation. All case management orders and decisions, notably those mentioned in R.334 RoP, can be subject of review under R.333 RoP (Court of Appeal, order of 21 March 2024, UPC_CoA_486/2023 APL 595643/2023, para 35). According to R.334(h) RoP, to dismiss a claim summarily if it has no prospect of succeeding is the use of case management powers. A fortiori this includes the rejection of a R.361 RoP request.

Source: [Unified Patent Court](#)

**UPC Court of Appeal,
21 August 2024**

(Rombach)

UPC_CoA_454/2024

APL 44552/2024

ORDER

of the Court of Appeal of the Unified Patent Court

issued on 21 August 2024

concerning an application for a discretionary review by the Court of Appeal under [Rule 220.3 RoP](#)

HEADNOTES:

1. An appeal against an order denying the request to reject an action as manifestly bound to fail according to [R.361 RoP](#) is admissible under the requirements of [R.220.2](#) and [R.220.3 RoP](#).
2. Such order is a case management order. As such it can only be the subject-matter of an appeal if it has been issued by a panel.

APPLICANT, APPELLANT AND DEFENDANT IN THE MAIN PROCEEDINGS BEFORE THE CFI

Microsoft Corporation, Washington, US
represented by Prof. Tilmann Müller-Stoy and Nadine Westermeyer, attorneys at law, Bardehle Pagenberg, Partnerschaft mbB Patentanwälte Rechtsanwälte

RESPONDENT AND CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE CFI

Suinno Mobile & AI Technologies Licensing Oy, Helsinki, Finland

represented by Mikko Kalervo Väänänen, European Patent Attorney

PATENT IN SUIT

[EP 2 671 173](#)

LANGUAGE OF THE CASE

English

DECIDING JUDGE

This order was issued by Patricia Rombach, standing judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

□ [Central Division Paris](#)

□ [Date: 2 July 2024](#)

□ [App 28103/2024, UPC CFI 164/2024; ORD 33379/2024](#)

SUMMARY OF THE FACTS

1. The claimant in the main proceedings (hereafter referred to as Suinno) is asserting a claim against the defendant in the main proceedings (hereafter referred to as Microsoft) for infringement of European patent [2 671 173](#). Microsoft has filed an application pursuant to [R.361 RoP](#) (App_28103/2024) to reject (I) claimant’s application pursuant [R.262A RoP](#) of April 9, 2024 (App_19084/2024, hereafter also referred to as ‘[the R.361-R.262A RoP request](#)’) and (II) Suinno’s infringement action (ACT 18406/2024, hereafter also referred to as ‘[the R.361 RoP-action request](#)’) as manifestly inadmissible.

2. By [order issued on 26 June 2024 \(‘concerning the application RoP 262A No. App 19084/2024’, ORD 27206/2024\)](#) the judge-rapporteur ordered that the access to agreements A & B is restricted to Microsoft’s attorneys and Microsoft’s directors who have a legitimate need to access these agreements for the purposes of the current proceedings.

3. By [order issued on 2 July 2024 \(ORD 33379/2024, hereafter referred to as ‘the impugned order’\)](#) the judge-rapporteur rejected the request to declare ‘the revocation action’ (insertion of ‘revocation’ obviously

accidentally) manifestly inadmissible. Leave to appeal was not granted.

4. On 17 July 2024 Microsoft filed a request for panel review of the [impugned order](#) pursuant to [R.333 RoP](#) (App_42138/2024) to the Court of First Instance. The panel has not yet decided.

PARTIES' REQUESTS

5. On 1 August 2024 Microsoft lodged a request for discretionary review, requesting:

I. The Order pursuant to [R.361 RoP](#) made by the judge-rapporteur and issued on [July 2, 2024](#) concerning the Application No. App_28130/2024 lodged in the infringement proceedings UPC_CFI_164/2024 is reviewed by the Court of Appeal ([R.220.3 RoP](#)).

II. The Order pursuant to [R.361 RoP](#) made by the judge-rapporteur concerning the Application No. App_28130/2024 lodged in the infringement proceedings UPC_CFI-164/2024 is set aside and

1. Claimant's Application pursuant to [R.262A RoP](#) of April 9, 2024 (App_19084/2024, as corrected in the statement dated on 20 August 2024) is rejected as being manifestly inadmissible ([R.361 RoP](#)); and

2. Claimant's action (ACT_18406/2024) is rejected as being manifestly inadmissible ([R.361 RoP](#)).

III. In the alternative:

The following question is referred to the CJEU for preliminary ruling:

“In order to comply and be compatible with Union law, shall the requirement of independence of representatives before the Unified Patent Court, as set out in Article 48.5 of the Agreement on a Unified Patent Court and in Article 2.4.1 of the Code of Conduct for Representatives before the Unified Patent Court, be interpreted as meaning that a legal person cannot be validly represented before the Unified Patent Court by a person who is at the same time its managing director and main shareholder?”

6. Suinno requests that the request be dismissed.

PARTIES' SUBMISSIONS

7. Microsoft argues, as far as relevant here, as follows.

8. [R.363.2 RoP](#) is not applicable in the present case. First according to the title, [R.363 RoP](#) relates to “Orders dismissing manifestly inadmissible claims”. Therefore [R.363 RoP](#) only concerns situations in which the court orders that the action is declared manifestly inadmissible. It does not cover situations like the present, where an application to order manifest inadmissibility is rejected. This is also in line with the wording of [R.361 RoP](#). Further support can be found in the Table of Court Fees; a fixed fee of EUR 11.000 is only appropriate if the matter in dispute has been decided as a whole and the action has been dismissed.

9. [R.363.2 RoP](#) refers to the “Court of First Instance”, which is, in legal literature available to date, considered as meaning the whole panel rather than the judge-rapporteur. Assuming this to be correct [R.220.1\(a\) RoP](#) is not applicable here as the order under review was taken and issued by the judge-rapporteur.

10. Applicant is aware of the order of this Court issued on January 11, 2024, according to which “[a]s a general principle, unless provided otherwise, a case management decision or order made by the judge-rapporteur or the presiding judge can only be appealed if such decision or order has first been reviewed by the panel pursuant to [R.333.1](#)”. However it is not clear from the law and case-law available to date whether the present order is to be considered a case management order which could be the subject of an application for panel review pursuant to [R.333 RoP](#).

11. The [impugned order of 2 July 2024](#) does not deal with the [R.361-R.262A RoP](#) request (although this request was included in Microsoft's application pursuant to [R.361 RoP](#) of 22 May 2024) nor does – insofar correctly so, as this request was not the subject matter of this application and workflow – the [order of 26 June 2024 \(ORD_27206/2024\)](#) concerning Suinno's [R.262A RoP](#) request.

12. Accordingly, by ignoring the [R.361-R.262A RoP](#) request, the Court of First Instance only incompletely dealt with and decided Microsoft's application pursuant to [R.361 RoP](#), so that the impugned [order of 2 July 2024](#) is also subject to review by the CoA in this respect and the CoA is also called upon to review, to lift this order and to decide also on Microsoft's [R.361-R.262A RoP](#) request. This is not affected by the fact that the time limit of [R.220.3 RoP](#) is not met with respect to the [order of 26 June 2024](#), as this order only relates to Suinno's application pursuant to [R.262A RoP](#) and not to Microsoft's [R.361-R.262A RoP](#) request, which is the subject matter of a separate workflow and should have been dealt with separately in the impugned [order of 2 July 2024](#).

13. Suinno argues, as far as relevant here, as follows.

14. The [R.220.3 RoP](#) time limit expired 26th July 2024 and therefore the request is inadmissible.

REASONS:

I. Request for discretionary review regarding 'the [R.361-R.262A RoP](#) request'

15. The Request for discretionary review regarding the [R.361-R.262A RoP](#) request is inadmissible.

16. The [impugned order](#) only rejected the request to declare the 'revocation action' manifestly inadmissible, which clearly means that the judge-rapporteur only rejected 'the [R.361 RoP](#) action request' as inadmissible. This is confirmed by the fact that the summary of facts and parties' requests as well as the grounds of the order deal only with Suinno's action or Statement of claim.

17. This is also supported by the fact that in the [order issued on 26 June 2024 \(ORD_27206/2024\)](#) the judge-rapporteur granted the request of 9 April 2024 and ordered 'pursuant to [Article 58 UPCA](#) and [R.262A RoP](#)' that the access to Agreements A&B is restricted to Microsoft attorneys and Microsoft directors who have a legitimate need to access these Agreements for the purpose of the current proceedings. The grounds for the order addresses Microsoft's objection of inadmissibility of the request, based on the grounds of a violation of [R.290.2 RoP](#) in relation to the non-compliance with the Code of Conduct by Suinno's representative.

18. Contrary to Microsoft's view, the fact that the [order of 2 July 2024](#) does not address the [R.361-R.262A RoP](#) application does not mean that the order is incomplete and that the rejection of this application is also the subject of the request for discretionary review. The [R.361-R.262A RoP](#) application was (implicitly) decided in the [order](#) on the [R.262A RoP](#) application of [26 June 2024](#).

19. It is not necessary to decide whether the present request for discretionary review shall be interpreted as also referring to the [order issued on 26 June 2024](#). This is because the present request would not meet the time limit in [R.220.3 RoP](#).

II. Request for discretionary review regarding 'the R.361 RoP-action request'

20. Also the request for discretionary review regarding 'the [R.361 RoP](#)-action request' is inadmissible.

21. A discretionary review by the Court of Appeal pursuant to [R.220.3 RoP](#) is only admissible, if leave to appeal against the impugned order is required ([R.220.2 RoP \(1\)](#)) and the Court of First Instance refused to grant leave within 15 days of the order ([R.220.3 RoP \(2\)](#)). In case of an order made solely by the judge-rapporteur or the presiding judge, it also depends on whether it may be appealed directly (3). Unless otherwise provided, [R.220.3 RoP](#) provides for the grant of leave to appeal by the standing judge only if the subject-matter of the appeal, in case leave is granted, is an order issued by a panel (see [Court of Appeal, order of 21 March 2024, UPC CoA 486/2023, APL 595643/2023 para 21](#)).

I. Leave required

22. The first requirement is met. Pursuant to [R.220.2 RoP](#) leave to appeal is required.

23. As laid down in [R.220.2 RoP](#), only orders other than those referred to in paragraph 1 need leave to appeal if, as here, they are not subject of an appeal together with the appeal against the decision.

24. The [impugned order](#) does not qualify as an order referred to in [R.220.1 RoP](#), even though, according to [R.363.2 RoP](#) it is a final decision within the meaning of [R.220.1 \(a\) RoP](#) where the decision is taken by the Court of First Instance inter alia pursuant to [R.361 RoP](#).

25. This is because [R.363.2 RoP](#) only concerns orders granting a '[R.361 RoP](#) request'. This is clear from the heading of [R.363 RoP](#), which reads: 'Orders dismissing manifestly inadmissible claims'. Furthermore, according to the wording of [R.363.2 RoP](#), this provision only relates to decisions taken inter alia pursuant to [R.361 RoP](#). As can be seen from the heading of [R.361 RoP](#) ('action manifestly bound to fail') as well as from the fact, that [R.361 RoP](#) only stipulates that the Court may give a decision by way of order where it is clear that the Court has no jurisdiction to take cognizance of an action or of certain of the claims therein or where the action or defence is, in whole or in part, manifestly inadmissible or manifestly lacking any foundation in law, also [R.361.2 RoP](#) only concerns orders rejecting the action as manifestly inadmissible.

26. This corresponds to the purpose of [R.220.1 RoP](#) to enable an appeal without leave to appeal against such decisions with which the proceedings are terminated

(see [R.220.1\(b\) RoP](#)). In line with this, [R.21.1 RoP](#) makes clear that only a decision of the judge-rapporteur allowing a Preliminary objection may be appealed pursuant to [R.220.1\(a\) RoP](#). A decision rejecting a Preliminary objection is subject to [R.220.2 RoP](#).

2. Direct appeal

27. The [impugned order](#) of the judge rapporteur may not be appealed directly.

28. Unless otherwise provided, a case management decision or a case management order of the judge-rapporteur may not be appealed directly. The admissible legal remedy against such decisions and orders is an application for review by the panel in accordance with [R.333.1 RoP \(Court of Appeal, order of 21 March 2024, UPC CoA 486/2023 APL 595643/2023, para 21\)](#).

29. The order denying a [R.361 RoP](#) request is a case management order as meant in [R.333.1 RoP](#). The notion of 'case management decision or order' is a broad concept that calls for a broad interpretation. All case management orders and decisions, notably those mentioned in [R.334 RoP](#), can be subject of review under [R.333 RoP \(Court of Appeal, order of 21 March 2024, UPC CoA 486/2023 APL 595643/2023, para 35\)](#). According to [R.334\(h\) RoP](#), to dismiss a claim summarily if it has no prospect of succeeding is the use of case management powers. A fortiori this includes the rejection of a [R.361 RoP](#) request.

30. The fact that the panel shall review the order denying a [R.361 RoP](#) request is also supported by the fact that only the panel may grant a [R.361 RoP](#) request ([R.363.1 RoP](#)).

ORDER

The request for discretionary review is dismissed.

Issued on 21 August 2024

Patricia Rombach Standing Judge
