

UPC CFI, Local Division Munich, 24 January 2025,  
NEC v TCL



PATENT LAW – PROCEDURAL LAW

**Withdrawal of counterclaim for revocation and counterclaim for a FRAND-license offer; parties bearing their own costs, 60% of court fees reimbursed (R. 265 RoP, R. 370 RoP)**

• [analogous application of Rule 370 RoP to e counterclaim for a FRAND-license offer](#)

Source: [Unified Patent Court](#)

UPC Court of First Instance,  
Local Division Munich, 24 January 2025  
(U. Voß. D. Voß, A. Kupecz)  
UPC\_CFI\_487/2023

#### Decision

of the Court of First Instance of the Unified Patent Court issued on 24 January 2025

#### CLAIMANT

**NEC Corporation**, 7-1 Shiba 5-chome Minato-ku, Tokyo 108-8001, Japan, represented by its President and Chief Executive Officer Mr. Takayuki Morita, *ibid*, represented by: Dr. Müller, Dr. Henke, BARDEHLE PAGENBERG Partnership mbB Patent attorneys, attorneys at law, Bohnenstraße 4, 20457 Hamburg.

#### DEFENDANTS:

- 1. TCL Deutschland GmbH & Co. KG**, Am Seestern 4, 40547 Düsseldorf, represented by the general partner TCL Deutschland Verwaltungs GmbH, which in turn is represented by its managing directors, *ibid*,
- 2. TCL Industrial Holdings Co., Ltd.**, 22/F, TCL Technology Building, 17 Huifeng 3rd Road, Huizhou, 516000 Guangdong, China, represented by its directors, *ibid*,
- 3. TCT Mobile Germany GmbH**, Am Seestern 4, 40547 Düsseldorf, Germany, represented by its managing directors, *ibid*,
- 4. TCT Mobile Europe SAS**, 55 Avenue des Champs Pierreux, 92000 Nanterre, France, represented by its directors, *ibid*,
- 5. TCL Communication Technology Holdings Ltd.**, 5/F, Building 22E, Science Park East Avenue, Hong Kong Science Park, Shatin, Hong Kong, represented by its directors, *ibid*,
- 6. TCL Operations Polska Sp., Z.o.o.**, ul. A. Mickiewicza 31/41 96-300 Zyrardow, Poland, represented by its managing directors, *ibid*,

**7. TCL Overseas Marketing Ltd.**, 13/F TCL Tower Tai Chung Road Tsuen Wan, New Territories, Hong Kong, represented by its directors, *ibid*.

Defendants 1), 2), 3), 4), 6) represented by: Dr. Nack, Dr. Gajeck, Noerr Partnerschaftsgesellschaft mbB, Brienner Str. 28, 80333 Munich, Germany.

#### INTERVENER

**Access Advance LLC**, 100 Cambridge Street, Suite 21400, Boston, MA 02114, USA, represented by: Dr. Henke, Bardehle Pagenberg Partnership mbB, Bohnenstraße 4, 20457 Hamburg.

#### PATENT AT ISSUE

European patent no° [EP 2 645 714 B1](#)

#### PANEL/DIVISION

Panel 2 of the Local Division Munich

#### DECIDING JUDGE

This decision has been issued by Presiding Judge Ulrike Voß (Judge-Rapporteur), the Legally Qualified Judge Dr Daniel Voß and the Legally Qualified Judge András Kupecz.

#### LANGUAGE OF THE PROCEEDINGS

English

#### SUBJECT-MATTER OF THE PROCEEDINGS

Patent infringement – Notification of Service Defendant 2)

#### SUBJECT-MATTER OF THE PROCEEDINGS

Withdrawal counterclaim, [R 265 RoP](#) / Reimbursement court fees, [R 370 RoP](#)

#### SUMMARY OF FACTS

- By statement of claim dated 22 December 2023, the Claimant filed a patent infringement action against the Defendants. Defendants 1, 3, 4 and 6 lodged on 8 July 2024 a counterclaim for revocation. Defendant 1 also filed a counterclaim for a FRAND-license offer on the same day.
- Following a settlement and the conclusion of a patent licence agreement covering inter alia the patent-in-suit, Defendants 1, 3, 4 and 6 declared the withdrawal of the counterclaim for revocation in a submission dated 14 January 2025. Defendant 1 also declared the withdrawal of the counterclaim for a FRAND-license offer. With reference to the cost decision, Defendants 1, 3, 4 and 6 state that they will bear their own costs. They do not request cost compensation.
- Pursuant to [R. 370.9\(b\)\(i\) and 370.11 RoP](#), Defendants 1, 3, 4 and 6 request partial reimbursement (60 %) of the court fees paid by them for the counterclaim for revocation.
- Based on [Rule 370.11 RoP](#), Defendant 1 requests for a reimbursement of 100 % of the court fees paid for the counterclaim for a FRAND-license offer. In his view, Art. 32(1)a UPCA, which identifies related defences, including counterclaims concerning licenses, shows that these counterclaims are part of the infringement action itself, so that no court fees are required for this counterclaim. Consequently, in the view of the Defendant 1, the payment already made was voluntary and provisional. He is thereby entitled to demand a full reimbursement of the paid fees. Only if the Court holds a contrary view, Defendant 1 applies to obtain a

reimbursement of 60 % pursuant to Rule 370.9(b)(i) RoP.

5. The Defendants 1, 3, 4 and 6 request, that 60 % of the court fees for the counterclaim for revocation in the total amount of € 20.000,00, i. e. € 12.000,00 be reimbursed to Defendants 1, 3, 4 and 6 following the successful withdrawal of the counterclaim for revocation.

6. The Defendant 1 requests, that 100 % of the court fees for the counterclaim for a FRAND-license offer in the total amount of € 15.000,00 or, in the alternative, 60 % of the court fees for the counterclaim for a FRAND-license offer in the total amount of € 9.000,00 be reimbursed to Defendant 1 following the successful withdrawal of the counterclaim for a FRAND-license offer.

7. The Claimant has not submitted any comments.

#### **REASONS FOR THE ORDER**

I.

8. Pursuant to [Rule 265.1, first sentence, RoP](#), a claimant may, as long as there is no final decision in the action, request that the action be withdrawn. The application for withdrawal is not allowed, according to sentence 3, if the other party has a legitimate interest in the action being decided by the Court.

9. On this basis, both withdrawals are permitted. Actions within the meaning of [Rule 265.1 RoP](#) are also counterclaims for revocations or counterclaims for a FRAND-license offer. The withdrawals of the counterclaims were declared before a final decision by the Court was issued. The Claimant has not asserted any legitimate interests pursuant to [Rule 265.1 RoP](#), nor can any such interests be identified in any other way.

II.

10. The consequence of permitting a withdrawal is, according to [Rule 265.2\(a\) and \(b\) RoP](#), to give a decision declaring the proceedings closed and to order the decision to be entered on the register.

11. According to [Rule 265.2\(c\) RoP](#), when permitting the withdrawal, the Court issues a decision on costs in accordance with Part 1, Chapter 5. An agreement between the parties regarding the costs or a settlement must be taken into account.

III.

12. Pursuant to [Rule 370.9\(b\)\(i\) RoP](#) in conjunction with [Rule 370.11 RoP](#), 60 % of the court fees paid are to be reimbursed if the action – as in this case – is withdrawn before the closure of the written procedure.

13. Consequently, the court fees paid by Defendants 1, 3, 4 and 6 regarding the counterclaim for revocation and the court fees paid by Defendant 1 regarding the counterclaim for a FRAND-license offer are to be reimbursed to them in the stated amount and thus in part.

IV.

14. There is no entitlement to a full refund of the court fee paid by Defendant 1 for the counterclaim for a FRAND-license offer. The payment of these court fees was not voluntary. The filing of the counterclaim for a FRAND-license offer is subject to a fee. The fees paid by Defendant 1 for this counterclaim are not covered by the fees paid by Claimant for the patent infringement action.

15. Pursuant to [Art. 70\(1\) UPCA](#), the parties to the proceedings shall pay court fees, which, according to [Art. 70\(2\) UPCA](#) are generally payable in advance. The UPC is thus not based on the principle of free proceedings, but on the idea that the party who initiates proceedings and thus an activity of the court by filing a statement of claim or an application must pay fees. This ensures, as [Article 36\(3\) UPCA](#) makes clear, inter alia, that the parties contribute for the costs incurred by the court.

16. The general obligation under [Article 70 UPCA](#) is specified in [Rule 370 RoP](#). Paragraph 1 of this Rule provides that the court fees provided for in the Rules of Procedure shall be paid in accordance with the court fee table adopted by the Administrative Committee. Paragraphs 2 to 5 of [Rule 370 RoP](#) then list the type of fee to be paid for each action or application. Each item of the list refers to the provisions of the Rules of Procedure in which - also in further specification of [Art. 70 UPCA](#) - the obligation to pay fees is explicitly listed.

17. The list in [Rule 370.2-5 RoP](#) does not mention the counterclaim for a FRAND-license offer. Nor is there any other provision in the Rules of Procedure which explicitly states that this type of counterclaim is subject to a fee. A counterclaim for a FRAND-license offer cannot be subsumed under any of the (counter)claims explicitly mentioned in [Rule 370.2-5 RoP](#). In particular, it is neither an infringement action within the meaning of [Rule 370.2\(a\)](#) in conjunction with [Rule 15 RoP](#) nor a counterclaim for infringement within the meaning of [Rule 370.2\(b\)](#) in conjunction with [Rule 53 RoP](#). The subject matter of the counterclaim for a FRAND-license offer is not the unlawful use of a patent by the counterdefendant or the claimant in the infringement action in connection with the legal consequences of patent infringement. Rather, the counterclaim for a FRAND-license offer is directed at the offer of a specific licence offer with a specific royalty to the defendant.

18. It also does not follow from [Art. 32\(1\)\(a\) UPCA](#) that the counterclaim for a FRAND-license offer is to be understood as an infringement action under [Rule 370.2\(a\)](#) in conjunction with [Rule 15 RoP](#) or a counterclaim for infringement according to [Rule 370.2\(b\)](#) in conjunction with [Rule 53 RoP](#). This provision concerns (only) the competence of the UPC. [Art. 32\(1\)\(a\) UPCA](#) (only) provides that the UPC has exclusive competence for infringement actions, including counterclaims concerning licences.

19. The types of actions are also not equated in [Art. 32\(1\)\(a\) UPCA](#). Rather, the explicit mention in [Art. 32\(1\)\(a\) UPCA](#) makes it clear that these are different types of actions. If one were to take a different view, the mention of a counterclaim for a FRAND-license offer in [Art. 32\(1\)\(a\) UPCA](#) would make no sense. It would be superfluous and redundant.

20. A counterclaim for a FRAND-license offer is also not a claim under [Rule 80.3 RoP](#) or a counterclaim for revocation under [Rule 26 RoP](#). These claims also have a different subject matter.

21. Therefore, a direct application of [Rule 370 RoP](#) is excluded. However, an analogous application of [Rule 370 RoP](#) is appropriate.

22. [Article 70 UPCA](#) provides, as already explained, that the parties to the proceedings shall pay court fees. No exception to this principle can be derived from this provision. Nor can it be inferred from [Article 36\(2\) or \(3\) UPCA](#) that certain types of actions are to be exempted from the general obligation to pay fees. Consequently, the provisions of the Rules of Procedure are also based on the idea that fees must be paid for actions and applications. This applies in particular to counterclaims brought by a defendant in pending proceedings. Counterclaims are independent actions by which the defendant seeks to enforce his own legal rights against the claimant. This enforcement of rights by way of legal action goes beyond the (simple) defence in proceedings, as it seeks a legal consequence and/or the exercise of judicial powers that goes beyond what could be pronounced in the action. By filing a counterclaim, the defendant initiates a separate and independent proceeding. This justifies demanding court fees from him. The same situation arises when a counterclaim is filed for a FRAND-licence offer. This goes beyond the simple licence objection and the motion to dismiss the action. It is also a claim that is independent of the claim for relief.

23. The absence of a provision in the Rules of Procedure for a court fee to be levied in the case of a counterclaim for a FRAND-licence offer is an unplanned gap in the Rules of Procedure. This unintentional gap in the Rules cannot be attributed to any conscious decision not to regulate this matter.

24. Nothing else can be concluded from [Art. 32\(1\) \(a\) RoP](#). The allocation of counterclaims regarding licenses to the jurisdiction of the UPC does not imply that this type of counterclaim would be free of court fees and/or that the fees paid for the infringement action would cover the filing of a (separate and independent) counterclaim on licenses. Competence and court fees are different issues and concern independent aspects.

#### **ORDER**

1. The withdrawal of the counterclaim for revocation is permitted.
2. The withdrawal of the counterclaim for a FRAND-licence offer is permitted.
3. The proceedings mentioned in number 1. and 2. are declared closed.
4. This decision is to be entered on the register.
5. The parties shall bear their own extrajudicial costs in relation to each of these actions. There shall be no reimbursement of costs between the parties.
6. Defendants 1, 3, 4 and 6 are to be reimbursed 60 % of the court fees of the counterclaim for revocation paid by them, and thus an amount of € 12.000,00.
7. Defendant 1 is to be reimbursed 60 % of the court fees of the counterclaim for a FRAND-licence offer paid by him, and thus an amount of € 9.000,00

#### **INSTRUCTION FOR THE REGISTRY**

The Registrar is instructed to make a payment of € 12.000,00 to the Defendants 1, 3, 4 and 6 and a payment

of € 9.000,00 to the Defendant 1 as soon as possible in accordance with number 6 and 7 of the Order, Rule 370.11 RoP.

#### **DETAILS OF THE ORDER**

Order no. ORD\_23222/2025 in Action no. ACT\_595922/2023  
UPC no.: UPC\_CFI\_487/2023  
App\_2192/2025  
App\_2196/2025  
Ulrike Voß Presiding Judge  
Dr Daniel Voß Legally Qualified Judge  
András Kupecz Legally Qualified Judge

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