Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Local division Munich
UPC_CFI_74/2024

Order

of the Court of First Instance of the Unified Patent Court local division Munich
issued on 27 August 2024

LEADERSHIPS:

1. In certain constellations, a direct infringement of a device claim can be recognised if the patent infringer appropriates the actions of its customer in the sense of an extended workbench and it would be inequitable from a valuation point of view to hold the infringer liable only for indirect patent infringement. However, there is always a risk that this could blur the boundaries drawn by the legislator between the legal consequences of direct and contributory patent infringement. Therefore, liability for indirect patent infringement can only be assumed in such cases if a specifically outlined completion of the patent-compliant device can be expected with certainty. This is unproblematically the case, for example, if a kit for assembly into a complete device is supplied by the customer including assembly instructions and the complete device does not function if it is assembled in a different way.

2. However, the circumstances of the present case deviate from this in one decisive point. Due to the challenged programme library, it is possible in connection with the videos and the documentation in the sense of an indirect patent infringement, which constitutes an element of jeopardy, that the customer produces a patent-compliant overall device. However, due to the large number of different programming options and possibilities for assembling the hardware components, this is not certain with the necessary concreteness.

3. In the case of an injunction to prevent contributory patent infringement, it must always be considered whether a relative prohibition or an absolute prohibition should be issued in view of the remaining possibilities for the patent infringer to offer or supply the essential means for other, non-infringing purposes. In particular, it must be considered whether the risk of direct patent infringement by the customers of the indirect patent infringer can be sufficiently averted by a relative prohibition, for example on the basis of warnings, and whether and with what effort it appears possible to redesign the means in such a way that it is no longer suitable for use in accordance with the patent.

4. In proceedings for a preliminary injunction, it is not possible to fully examine all arguments raised against the validity of the patent in dispute, which can be numerous as in nullity proceedings. Rather, the number of arguments raised against the validity of the patent must generally be reduced to the three best arguments from the perspective of the opponent (UPC_CFI_443/2023 ACT_589207/2023 (Munich local division), decision of 21 May 2024, 3rd LS). The background to this is that a summary assessment of questions of fact is conceivable, but not a summary examination of questions of law. The court can either examine a question of law or not. If the court decides to examine the question, it will do so comprehensively. The only way to take account of the summary nature of the proceedings is therefore to reduce the number of questions of law to be fully examined in this way. This is made clear by the requirement to limit the number of arguments to three. As it is up to the defendant to challenge the presumption of validity, it is primarily up to the defendant to select the three arguments to be examined in detail by the adjudicatory body in summary proceedings.

5. In view of the divergent case law on urgency, which grants the applicant only one month, e.g. in UPC_CFI_452/2023 (Dusseldorf local division), Order of 9 April 2024, GRUR-RS 2024, 7207, para. 128, the Munich local division adheres to its case law and grants two months.

KEYWORDS:

Application for a preliminary injunction; distinction between direct and contributory patent infringement; absolute prohibition in the case of contributory patent infringement; limitation of the arguments against the legal validity to three; urgency; urgency period of two months; order of an enforcement security for the USA

Applicant

Hand Held Products, Inc, 855 S Mint Street, NC 28202, Charlotte, US

represented by: Dr Tobias Wuttke (Bardehle Pagenberg)

Defendant

Scandit AG, Hardtturmstrasse 181, 8005, Zurich, CH

represented by: Jan Zecher (Fish)

Patent in dispute

European patent 3 866 051.

Judicial body/chamber

Panel 1 of the local division Munich.

Deciding judges

This Order was issued by presiding judge Dr Matthias Zigann as assessor, legally qualified judge András Kupecz and legally qualified judge Tobias Pichlmaier. A technically qualified judge was not consulted.

LANGUAGE OF THE PROCEEDINGS:

German.

SUBJECT OF THE CASE:

R. 206.1 RoP in conjunction with. R. 211.1 RoP - Application for an Order for provisional measures.

ORAL HEARING

19 JUNE 2024.

FACTS OF THE CASE

The petitioner is asserting a claim against the respondent for infringement of the European patent with unitary effect EP 3 8866 051 (hereinafter: patent in suit). The patent in suit was granted on 8 November 2013, claiming priority US 201261726747P, by the
15 November 2012, US 201261737552P of 14 December 2012, US 201313743477 of 17 December 2012.
The application was filed on 24 January 2013 and US 201313748926 on 24 January 2013. The patent application was published on 18 August 2021. The reference to the grant of the patent in suit with effect in all member states of the UPCA was published by the European Patent Office on 21 February 2024 (B1 specification of the patent in suit EP 3 866 051 as Annex BP 7a).

On 26 January 2024, an application for unitary effect under Rule 6 of the Implementing Regulations for Unitary Patent Protection ("DOEPS") was filed with the European Patent Office for the patent in suit (Annex BP 7b). Although both the name and the address of the patent proprietor stated in the application differ from the patent proprietor currently listed in the European Patent Register and the applicant here, it is nevertheless one and the same company/patent proprietor. The name "Hand Held Products, Inc. doing business as Honeywell Scanning & Mobility" stated in the application is the trade name of the local applicant "Hand Held Products, Inc.". It is the same legal entity. The differences in the address result from a mere change in the registered office of the patent proprietor. Since the requirements of Rules 5(2) and 6 DOEPS are met, the European Patent Office entered the unitary effect in the Register for Unitary Patent Protection on27March 2024. March 2024 for registration. The unitary effect of the patent in suit is thus effective from 21 February 2024 (date of publication of the mention of grant in the European Patent Bulletin) (Art.
4(1) Regulation (EU) No 1257/2012).

No opposition was filed against the grant of the patent in suit.

In the main proceedings initiated on 21 February 2024 between the same parties (ACT_9206/2024), the defendant filed an action for annulment (CC_40710/2024) on 11 July 2024. The date for the oral hearing was set for 29 April 2025.

The patent in suit relates to digital devices for reading decodable characters such as bar codes. In particular, identifiers are read out optically by means of a camera and the information encoded in the identifier is reproduced for the user.

Claim 1 is formulated as follows:

1. an indicia-reading device (100, 1000), comprising:

one or more processors (1060); a memory (1085); an imaging subsystem (1040) configured to acquire an image of decodable indicia (15, 202,204, 206); a display (54); and a communication interface (1604, 1608); wherein said device is configured, responsive to acquiring an image of one or more objects within a field of view (140) of said imaging subsystem, to locate within said image and decode one or more decodable indicia; wherein said device is further configured to display said image on said display and visually mark said one or more successfully decoded de-codable indicia; ***characterised in that*** *said device is further configured to display a product image at a location of an associated image representation of each one or more successfully decoded de- codable indicia.*

decodable indicia, said product image is associated with the successfully decoded decodable indicia by said device based on a lookup table retrieved from a database; wherein said device is fur- ther configured, responsive to accepting user input selecting at least one successfully decoded decodable indicia of said displayed one or more successfully decoded decodable indicia, to out- put at least one decoded message corresponding to the at least one selected successfully decoded decodable indicia and/or at least one product image associated with the at least one selected successfully decoded decodable indicia and/or data determined when the at least one selected successfully decoded decodable indicia is decoded.

In the registered German translation, claim 1 reads as follows:

1. A character reading apparatus (100, 1000) comprising: one or more processors (1060); a memory (1085); an imaging subsystem (1040) configured to capture an image of decodable characters (15, 202, 204, 206); a display (54); and a communication interface (1604, 1608); wherein the apparatus is configured to locate and decode one or more decodable characters within the image in response to capturing an image of one or more objects within a field of view (140) of the imaging subsystem; wherein the apparatus is further configured to display the image on the display and visually identify the one or more successfully decoded decodable characters; ***characterised in that*** *the device is further configured to display a product image at a location of an associated image representation of each of the one or more successfully decoded decodable characters, said product image being associated with the successfully decoded decodable characters by said device based on a look-up table retrieved from a database; wherein the device is further configured to, in response to accepting a user input that selects at least one successfully decoded decodable character of the displayed one or more successfully decoded decodable characters, send at least one decoded message corresponding to the at least one selected successfully decoded decodable character, corresponding to the at least one selected successfully decoded decodable character, and/or at least one product image associated with the at least one selected successfully decoded decodable character, and/or data determined when the at least one selected successfully decoded decodable character is decoded.*

Claim 10 is formulated as follows:

10. An indicia-reading method on an indicia-reading device (100, 1000) comprising: one or more processors (1060); a memory (1085); an imaging subsystem (1040) configured to acquire an image of decodable indicia (15, 202, 204, 206); a display (54); and a communication interface (1604, 1608); the method comprising: responsive to acquiring an image of one or more objects within a field of view (140) of said imaging subsystem, locating within said image and decoding one or more decodable indicia; displaying said image on said display and visually marking said one or more successfully decoded decodable indicia; ***characterised by*** *the method further com- prising: associating each of one or more successfully decoded indicia with a product image based on a lookup table retrieved from a database; displaying the product image at a location of an as- sociated image representation of each of the one or more decoded indicia, and responsive to ac- cepting user input selecting at least one decodable indicia of said displayed one or more decodable indicia, outputting at least one decoded message corresponding to the at least one se-*

lected decodable indicia and/or at least one product image associated with the at least one selected decodable indicia and/or data determined when the at least one selected decodable indicia is decoded.

In the registered German translation, claim 10 reads as follows:

10. a character reading method on a character reading device (100, 1000), comprising: one or more processors (1060); a memory (1085); an imaging subsystem (1040) configured to capture an image of decodable characters (15, 202, 204, 206); a display (1040); characterised in that the imaging subsystem (1040) is configured to capture an image of decodable characters (15, 202, 204, 206).
(54); and a communication interface (1604, 1608); the method comprising: in response to capturing an image of one or more objects within a field of view
(140) of the imaging subsystem, locating one or more decodable characters within the image and decoding; displaying the image on the display and visually identifying the one or more successfully decoded decodable characters; ***characterised in that*** *the method further comprises: associating each of the one or more successfully decoded characters with a product image based on a look-up table retrieved from a database; displaying the product image in a location of an associated image representation of each of the one or more decoded characters; and in response to accepting a user input selecting at least one decodable character of the displayed one or more decodable characters, outputting at least one decoded message corresponding to the at least one selected decodable character, corresponding to the at least one selected decodable character, and/or at least one product image associated with the at least one selected decodable character, and/or data determined when the at least one selected decodable character is decoded.*

The applicant is part of the Honeywell group of companies. Honeywell is a US conglomerate and is active in various industries, such as the aerospace industry, building technology, energy and sustainability, and industrial automation. The Productivity Solutions & Services division develops products and solutions such as barcode scanners, computer devices, printers, wearable technology, software and RFID devices. These products and solutions provide solutions for factories, healthcare and manufacturing facilities as well as for the retail sector. For example, it is essential for logistics companies, but also for manufacturers and retailers, to track inventory and localise individual products within a warehouse or on a transport route. This is made possible by barcode technology, among other things.

The defendant is a technology company based in Switzerland that specialises in the automated capture of barcodes. The defendant distributes in several EPG member states, at least in Germany and France, among other things the software programme library "Data Capture SDK". This provides a variety of functions that customers can select, giving them software tailored to their specific needs (Software Development Kit = SDK). This includes the "BarcodeTrackingAdvancedOverlay" functionality. This function enables the user to be shown a visual representation of information linked to the barcode above, next to or overlapping the barcode on the reader's display after it has been scanned.

The application is directed against all of the defendant's computer programs, in particular the "Data Capture SDK", which have the function according to which an image of data captured with the product

linked information is shown on the display of the character reader, such as the so-called "BarcodeTrackingAdvancedOverlay" functionality ("attacked execution form").

To avoid repetition, reference is also made to the entire contents of the file.

APPLICATIONS BY THE PARTIES:

The applicant requests,

A. The defendant is ordered to refrain from

I.1. In the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia, character reading devices comprising one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface, wherein the device is configured to:

in response to capturing an image of one or more objects within a field of view of the imaging subsystem, to locate and decode one or more decodable characters within the image; to display the image on the display; and to visually label the one or more successfully decoded decodable characters; to display a product image at a location of an associated image representation of each of the one or more successfully decoded decodable characters, said product image being associated with the successfully decoded decodable characters by said device based on a look-up table retrieved from a database; in response to accepting a user input that selects at least one successfully decoded decodable character of the displayed one or more successfully decoded decodable characters, at least one decoded message corresponding to the at least one selected successfully decoded decodable character and/or at least one product image associated with the at least one selected successfully decoded decodable character; characterised in that said at least one successfully decoded decodable character is displayed by said device in response to a user input that selects at least one successfully decoded decodable character of the displayed one or more successfully decoded decodable characters.

and/or output data determined when the at least one selected successfully decoded decodable character is decoded.

to offer, place on the market, use or either import or possess for the aforementioned purposes.

(direct infringement of claim 1 of EP 3 866 051 B1)

I.1.a. in the alternative to item I.1:

Third parties in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia Means, namely software, suitable and intended for character reading devices, comprising: one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface, wherein the device is configured to one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface, wherein the device is configured to:

in response to capturing an image of one or more objects within a field of view of the imaging subsystem, locating and decoding one or more decodable characters within the image; displaying the image on the display; and visually labelling the one or more successfully decoded decodable characters; displaying a product image at a location of an associated image representation of each of the one or more successfully decoded decodable characters, said product image being associated with the successfully decoded decodable characters by said device based on a look-up table retrieved from a database; in response to accepting a user input selecting at least one successfully decoded decodable character of the displayed one or more successfully decoded decodable characters, at least one decoded message corresponding to the at least one selected successfully decoded decodable character, and/or at least one product image associated with the at least one selected successfully decoded decodable character, and/or outputting data determined when the at least one selected successfully decoded decodable character is decoded.

for use in one or more of these countries. (indirect infringement of claim 1 of EP 3 866 051 B1)

II.1. third parties in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden

and/or the Republic of Slovenia means, in particular software, which are suitable and intended for the realisation of a document reading procedure, the procedure comprising

Providing a character reading device comprising: one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface; in response to capturing an image of one or more objects within a field of view of the imaging subsystem, locating one or more decodable characters within the image and decoding; displaying the image on the display and visually labelling the one or more successfully decoded decodable characters; associating each of the one or more successfully decoded characters with a product image based on a look-up table retrieved from a database; displaying the product image in a location of an associated image representation of each of the one or more decoded characters; and in response to accepting a user input that selects at least one decodable character of the displayed one or more decodable characters, outputting at least one decoded message corresponding to the at least one selected decodable character, corresponding to said at least one selected decodable character, and/or at least one product image associated with said at least one selected decodable character, and/or data determined when said at least one selected decodable character is decoded for use in one or more of said states.

(indirect infringement of claim 10 of EP 3 866 051 B1)

B. In the event of any violation of the Order under A., the defendant shall pay to the court a penalty payment (which may be repeated) of up to EUR 100,000 for each day of violation.

C. The defendant is ordered to pay the costs of the proceedings.

D. The Orders are effective and enforceable immediately.

<u>Alternatively to A (as per document dated 13 May 2024):</u>

A. The defendant is ordered to refrain from

I.1. in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia Character reading devices comprising: one or more processors; a memory; an imaging subsystem configured to read an image from decodable

characters; a display; and a communication interface, wherein the device is configured to:

in response to capturing an image ~~of one or more~~ objects within a field of view of the imaging subsystem, to locate and decode ~~one or more~~ decodable characters within the image; to display the image on the display; and to visually label the one or more successfully decoded decodable characters; to display a product image at a location of an associated image representation of each of the one or more successfully decoded decodable characters, said product image being associated with the successfully decoded decodable characters by said device based on a look-up table retrieved from a database; in response to accepting a user input selecting at least one successfully decoded decodable character of the displayed one or more successfully decoded decodable characters, at least one decoded message corresponding to the at least one selected successfully decoded decodable character, and/or at least one product image associated with the at least one selected successfully decoded decodable character, and/or outputting data determined when the at least one selected successfully decoded decodable character is decoded.

to offer, place on the market, use or either import or possess for the aforementioned purposes.

(direct infringement of claim 1 of EP 3 866 051 B1)

I.1.a. in the alternative to item I.1:

Third parties in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia Means, namely software, suitable and intended for character reading devices, comprising: one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface, wherein the device is configured to one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface, wherein the device is configured to:

in response to capturing an image ~~of one or more~~ objects within a field of view of the imaging subsystem, locating and decoding ~~one or more~~ decodable characters within the image; displaying the image on the display; and visually labelling the one or more successfully decoded decodable characters; displaying a product image at a location of an associated image representation of each of the one or more successfully decoded decodable characters, said product image being associated with the successfully decoded decodable characters based on a look-up table retrieved from a database by said device; in response to accepting a user input that includes at least one successfully decoded decodable character; characterised in that said product image is associated with the successfully decoded decodable characters based on a look-up table retrieved from a database by said device.

of the displayed one or more successfully decoded decodable characters, to output at least one decoded message corresponding to the at least one selected successfully decoded decodable character, and/or at least one product image associated with the at least one selected successfully decoded decodable character, and/or data determined when the at least one selected successfully decoded decodable character is decoded.

for use in one or more of these countries. (indirect infringement of claim 1 of EP 3 866 051 B1)

II.1. third parties in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia means, in particular software, which are suitable and intended for the performance of a character reading procedure, the procedure comprising

Providing a character reading device comprising: one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display and a communication interface; in response to capturing an image ~~of one or more~~ objects within a field of view of the imaging subsystem, locating ~~one or~~ more decodable characters within the image and decoding; displaying the image on the display and visually identifying the one or more successfully decoded decodable characters; associating each of the one or more successfully decoded characters with a product image based on a look-up table retrieved from a database; displaying the product image in a location of an associated image representation of each of the one or more decoded characters, and in response to accepting a user input selecting at least one decodable character of the displayed one or more decodable characters, outputting at least one decoded message corresponding to the at least one selected decodable character; characterised in that the product image is displayed in a location of an associated image representation of each of the one or more decodable characters.

and/or at least one product image associated with the at least one selected decodable character, and/or data determined when the

at least one selected decodable character is decoded for use in one or more of these countries.

UPC_CFI_74/2024

(indirect infringement of claim 10 of EP 3 866 051 B1)

The defendant applies:

1. The application for the adoption of provisional measures is dismissed.

In the alternative:

2. The application will not be decided without an oral hearing.

As a last resort:

3. The continuation of the challenged behaviour is made dependent on the provision of security by the application opponent.

As a last resort:

4. The Order or the enforcement of the provisional measures is made dependent on the provision of security by the applicant.

In the event that the application is rejected or withdrawn:

5. Orders the applicant to pay the costs.

In addition:

6. The applicant's auxiliary requests of 13 May 2024 are rejected.

7. Orders the applicant to pay the costs.

FACTUAL AND LEGAL POINTS OF CONTENTION

The **applicant** considers the offer and distribution of the software programme library "Data Capture SDK" (attacked embodiment), in particular in Germany and France, to be a direct or indirect infringement of claims 1 and 10 of the patent in dispute. It illustrates the various possible uses of the software development kit (hereinafter "SDK") on the basis of the documentation Appendix BP 3b and the following application examples advertised by the defendant with videos:

1) Video "Barcode Scanner SDK"
available at https://www.scandit.com/de/produkte/barcode-scanner-sdk/
(CD-Rom attachment BP 3d, screenshots attachment BP 3e)

2) Video "Matrix Scan AR" (based on the "Electronics Demo App")
available at https://www.scandit.com/de/produkte/augmented-reality/
(CD-Rom Appendix BP 3f, screenshots Appendix BP 3g)

The petitioner argues that the respondent is not entitled to the asserted patent claims.

claims **not only indirectly, but also directly**. According to the applicant, the fact that it is up to the defendant's customers to create executable software from the offered software development kit, which has the patent-compliant properties, and then to install it on an electronic device, cannot be decisive. There is a direct patent infringement if the patent infringer delivers a product disassembled into individual parts and instructs its customers to assemble these individual parts into a patent-infringing construction. An advantage of the SDK advertised by the defendant is that the software created with it can be executed on (almost) all commercially available smartphones and tablets and the defendant's customers therefore do not need any special hardware but can use generally available devices. The modular principle of the SDK also means that the defendant's customers do not have to use every function offered by this modular system. It is possible to create executable software from the SDK that does not have the patented functions. However, the defendant specifically instructs its customers to use the SDK in such a way that patent-infringing software is produced. It is undisputed that the defendant provides the videos submitted as well as detailed documentation on its website, which not only advertises that patent-infringing executable software can be created from the SDK. The defendant expressly instructs its customers to implement these functions, in particular in the documentation it provides.

The **legal validity of** the patent in dispute is sufficiently secured. There is a presumption in favour of the legal validity of already granted patents. The burden of proof for its absence lies with the defendant.

The Order for provisional measures was **necessary**. The applicant would be threatened with considerable damage if she could only enforce her claim for injunctive relief by way of proceedings on the merits. The applicant's rights arising from the injunction patent are infringed to a large extent by the cited infringing acts of the defendant. The parties are competitors in the sale of readers and software for decoding barcodes. According to the defendant, it supplies six of the ten leading "Fortune 500" companies and its technology is currently used on more than 150 million devices. This leads to an almost irreversible loss of market share for the applicant. The marketing activities of the defendant are likely to cause considerable, in particular long-term damage to the applicant by directly reducing the applicant's market shares. This reduction in the applicant's market opportunities could not be compensated purely in monetary terms. The patent for injunction loses duration every day without the possibility of enforcement, within which the protection of own sales opportunities is only guaranteed by the exclusive right of the patent for injunction. This temporal value of the dispositive patent is irreversible. Furthermore, with regard to the purchasers of barcode scanner products, it cannot be assumed that they will quickly switch to products from another manufacturer, namely the applicant. A company that has focussed its operations on a specific scanner and the corresponding scanner software and, in particular, has trained its employees on a specific user interface of the software, will not be able to switch to another manufacturer in the short and medium term.

refrain from purchasing a different scanner product. This is because this would mean a changeover effort in operational processes and training costs for employees, which the companies in question were trying to avoid from a business perspective.

The application for an Order for provisional measures was **urgent**. It was filed on 21 February 2024 and thus at the earliest possible date and without undue delay (R 211.4 RoP). The patent in dispute was only granted on 21 February 2024, i.e. on the same day.

The issuance of the requested Orders was also justified according to the **balancing of interests** to be carried out (Art. 62 para. 2 UPCA, R 211.3 RoP). In any case, the balancing of interests to be carried out should be understood in such a way that it serves to cushion undue hardship in individual cases, but in principle an interim injunction should be issued if the other requirements, in particular those of Art. 62 UPCA, are met (Bopp/Kircher, Handbuch Europäischer Patentprozess, 2nd ed. 2023, § 22, para. 94). Such hardships are not apparent on the part of the defendant. In particular, it should be possible for the defendant to remove the disputed function from the software it distributes by means of an update. This is supported by the explained "Software Development Kit", which has a whole range of different functions that are not challenged in the present case. According to the documentation of the software, it is by no means mandatory that all functionalities are used when using the software. Although the defendant explains in its promotional videos and documentation how the disputed function can be used, the user can decide for himself not to use this function. Accordingly, the defendant can remove the advertising for the function at issue and all similar functions that realise the features of the patent in suit as well as the corresponding parts of its software without rendering the software unusable as a whole.

In the opinion of the **defendant**, the contested embodiment does not make use of the technical teaching of the patent in suit. In any event, feature 1.8 of claim 1 and features 1.8 and 1.9 of claim 10 are not realised.

The **video "Barcode Scanner SDK"** does not show an actual programme. The video does not show the software development kit. The video also does not show an actually existing computer programme. It is a video for advertising purposes that shows a possible use of programme libraries of the software development kit. An existing computer program was not simply "filmed" for the video. Instead, video recordings were subsequently edited ("post-production"). In particular, the highlighting of the barcodes and the insertion of a product image (the screw) were subsequently added to the video. The video therefore shows the fictitious output of a computer programme that does not exist. The "embodiment 1" challenged by the applicant therefore does not exist.

The **video "Matrix Scan AR"** of the defendant (keyword "superimposed headphones") also does not show the software development kit. It shows an executable computer program that the defendant developed for demonstration purposes and that shows a possible use of programme libraries of the software development kit (**hereinafter the "Electronics Demo App"**). The computer programme has a very limited scope of performance. Only a series of exemplary barcodes and exemplary image files specified by the defendant could be used; the programme reacted to other barcodes.

not. Furthermore, this app does display a product image. However, it does not show the product image in the patent-compliant position. In the "Electronics Demo App", the product image is not superimposed on the barcode. The barcode is fully visible. The app also does not use a patent-compliant database. The "Electronics Demo App" uses a data structure stored separately in the memory to assign a decoded character to a product image. In the data structure, the names of certain image files are matched with certain decoded characters. However, the data structure itself does not contain any product images. The image files are stored separately from the "Electro- nics Demo App". Only a series of exemplary barcodes and exemplary image files specified by the defendant could be used. The "Electronics Demo App" searches for the decoded character in the data structure. If the When the "Electronics Demo App" finds the decoded character in the data structure, it reads the name of the image file from the data structure, which is compared to the decoded character in the data structure. It then calls up the image file using the name of the image file. However, the image file is not located within the data structure. The data structure is therefore not a look-up table that is retrieved from a patent-compliant database. The "Electronics Demo App" does not use such a database. The fact that the device also contains the image files in addition to the data structure does not change this. A device does not become a database simply because data is stored on it in a sensibly organised and individually retrievable manner. If that were correct, every data processing device would be a database. Nothing else emerges from the applicant's submission. It does not argue that the "Electronics Demo App" retrieves a look-up table from a database. She also does not argue that the "Electronics Demo App" uses a database with product images. The applicant merely states that a product image is assigned to each decoded sign with the help of an electronically retrievable link. It does not comment on the question of where this electronically retrievable link is retrieved from. Strictly speaking, the applicant's submission is already inconclusive.

A **direct patent infringement** by the **software development kit** is also ruled out because the software development kit is not an independently executable computer program. For this reason alone, it could not fulfil the patent-compliant features. Among other things, it could not capture images of decodable characters, localise, decode or identify these characters or display product images. Nothing else is apparent from the videos submitted by the applicant.

As far as the use of its software development kit by its customers is concerned, the defendant is **not responsible for the actions of its customers**. The divergent view of the applicant is wrong. According to this view, direct patent infringement and contributory patent infringement can no longer be distinguished from each other. There would hardly be any meaningful area of application left for the special rules on contributory patent infringement. According to the applicant's standards, almost every indirect patent infringement would also be a direct patent infringement.

However, there was also **no indirect patent infringement**. This is because the software development kit is not a means that relates to an essential element of the invention. It is undisputed that the defendant does not provide any product images, databases with product images or look-up tables with the software development kit that match certain decoded characters with certain product images. However, this was essential for the invention. In the

The invention essentially concerns a certain way of allocating decoded characters to product images. If the challenged functions were to infringe the patent, the affected programme libraries of the software development kit would only be used occasionally when using the invention. The programme libraries would only be used for process steps that are upstream or downstream of the patent-compliant process steps. The patent-compliant assignment of decoded characters to product images is not performed by the program libraries, but by parts of the computer programs which are supplemented by the users of the software development kit.

The software development kit of the defendant is also not intended for a patent-compliant display of the product images. The programme libraries concerned leave open where the product images are displayed. The same applies to the documentation. The defendant also does not encourage users of the software development kit to display the product images in a patent-infringing manner. This applies in particular with regard to the defendant's "Electronics Demo App". In the "Electronics Demo App", the product images are not displayed in the patent-compliant position. In the "Electronics Demo App", the barcode remains fully visible.

Furthermore, the software development kit of the defendant is not intended for the patent-compliant manner in which a decoded sign is allocated to a product image. The programme libraries in question leave open how the assignment is made. The same applies to the documentation. An assignment in which the device transmits a decoded character to an external database and this database then only returns a product image to the device (and not the complete look-up table of the database) would not be infringing. The defendant also does not encourage the users of the software development kit to allocate the product images in a way that infringes the patent. This applies in particular with regard to the defendant's "Electronics Demo App". In the case of the "Electronics Demo App", the allocation is not carried out in a patent-compliant manner. In the "Electronics Demo App", the look-up table is not retrieved from a database that also contains the product images.

In any case, assuming an indirect patent infringement, an **unlimited prohibition** would go too far. The software development kit could also be used on a large scale for non-patent infringing purposes. The focus of the functions lies in the non-patent-infringing area. The applicant submits both itself. The programme libraries that can be used for the challenged functions could also be used to a large extent for non-infringing purposes (namely when no product images are displayed). If the offering of the software development kit actually constituted an indirect patent infringement (which the defendant denied), a warning would therefore suffice that the software development kit could not be used without the consent of the defendant.

applicant may be used for the production of computer programmes covered by patent protection. A prohibition per se would be completely disproportionate in comparison.

In the opinion of the defendant, any **prior right of use of the defendant** is irrelevant. If the court is of a different opinion, it would ask for a corresponding judicial reference.

The **legal status** was not secured to the extent required for the Order of provisional measures.

In view of the prior art submitted, the **obvious prior use** of the attacked embodiment by the defendant was no longer relevant. If the court were to take a different view, it would ask for a corresponding judicial reference. The defendant's software development kit had already contained programme libraries since 2010 and 2011 that could have been used for the challenged functions. Since then, the defendant has also advertised the software development kit in a manner from which the applicant now wishes to identify an indirect patent infringement.

In any case, the defendant limits itself - as suggested by the court - to **three solutions from the prior** art (see document of 28 May 2024, p. 3, para. 331), namely the "Flow App", the "Barinsa App" and JP 2009/093489 (hereinafter "the Japanese patent specification"). The technical teaching sought to be protected was not new compared to the Flow App and the Barinsa App. In any case, there was no inventive step based on the Japanese patent specification.

The **limited claims asserted** are also not legally valid. Like the claims granted, these were inadmissibly extended. The way in which the applicant asserts the claims in a limited manner is already questionable. The claims require that "the one" or "the several" successfully decoded decodable characters be visually labelled, etc. Alternative scenarios could be discussed here. The limited claims are also suggested by the two apps.

The applicant also **unreasonably delayed** its application**.** The features of the kit as well as the allegedly infringing activities of the defendant had been known to the applicant since November 2022 at the latest. The applicant's group of companies had already approached the defendant in May 2019 (Annex FR 20) regarding alleged patent infringement. The allegation was also based on the patent family of the patent in suit. The applicant had also asserted US patent 9208367, the priority of which the patent in suit claimed, among other things. The applicant had already objected to the defendant's software development kit at that time. In February 2023 (Annex FR 21), the applicant's group of companies repeated the allegations. However, it only took action on 21 February 2024.

Ordering provisional measures is **not necessary**. The Unified Patent Court is designed to issue a final injunction within one year if necessary. Ordering provisional measures is therefore only necessary and permissible in special circumstances. Damage that can be compensated by damages cannot per se justify the ordering of provisional measures. Rather

such damage must be so great that it cannot be remedied by compensation at the end of the process. The applicant had not proven the risk of such damage. The applicant's products and the challenged embodiments were not interchangeable, so that the applicant was not threatened with a loss of market share.
Even if there is a loss of market share, this would cease in the event of an injunction after the trial. The mere allegation or even the mere finding of a possible loss of market share does not per se necessitate the ordering of provisional measures or guarantee the risk of significant or irreparable damage. Moreover, the damage arising from the issuance of an injunction at a later date is low.

Any damage to the applicant would also be negligible. Only any additional damages that could be expected as a result of waiting until a provisionally enforceable decision on the merits would be relevant. The extent of such damages would be extremely manageable. This also applies in view of the fact that the applicant has tolerated the software development kit for many years. The defendant's software development kit is not new. The defendant has been offering it for many years. This also applies in particular with regard to the possible functions of computer programs that can be created with the software development kit, which are attacked as patent infringing. With its software development kit, the defendant has long since acquired a market share on the relevant market. The software development kit not only enables the creation of computer programs with the functions that the applicant is attacking as infringing the patent. The functions are not necessarily part of the computer programs created, but only possible components. The functions are only a small part of the functions whose provision is made possible by the software development kit. They are also not the most important functions that the software development kit enables to be provided. The nature and scope of how the defendant offers its software development kit has not changed significantly in recent times. The defendant also has no corresponding plans. This applies in any case to the functions attacked as patent infringing that can be provided with the software development kit. It was not to be expected that the intensity of a possible infringement would increase in the near future. The applicant had also not submitted anything in this regard. In addition, the "Electronics Demo App" is a computer programme for demonstration purposes. The defendant does not sell the "Electronics Demo App", but gives it away free of charge. The computer programme has a very limited scope of performance. Only a series of exemplary barcodes and exemplary image files specified by the defendant could be used; the programme did not react to other barcodes. From a commercial point of view, the "Electronics Demo App" is virtually meaningless.

However, the **damage to the defendant** if the provisional measures applied for were ordered would be considerable. The defendant would be threatened with damage to its reputation that would be almost irreparable. Apart from that, it would be threatened with a serious interruption and impairment of its business operations. The same applies to the defendant's customers who use the defendant's software development kit to create and maintain their own computer programmes. The defendant would be forced to temporarily stop offering its software development kit without restriction. It would also be prevented from offering error corrections, adaptations and improvements on an ongoing basis, for example when the operating systems of the devices used change. It would then have to discontinue the Software Development

Kit in such a way that it no longer contains the programme libraries for the functions attacked as patent infringing. The same applies to the accompanying documentation, which would otherwise suggest functions that are not actually available. The revised software development kit would also have to be tested before release. By their very nature, software development kits are more complex and demanding than computer programmes. It involves programme libraries for the creation of computer programmes. Exemplary software created with the software development kit must also be tested. The defendant estimated that the modification and testing of the software development kit and the associated documentation would require considerable calendar and development time. During this period, the defendant would not be able to offer its software development kits without restriction. This would not only impair the acquisition of new customers. It would also damage existing customer relationships in a way that would be almost irreparable, including customer relationships that have nothing to do with the dispositive patent. This applies in particular in view of the fact that the defendant would temporarily no longer be able to offer ongoing error corrections, adaptations and improvements for the programme libraries in question. This is also important because the defendant's customers also use the defendant's software development kit for the ongoing maintenance of their own computer programs.

In any case, the **auxiliary request** should **no longer** be **urgent**. The applicant relied on alleged facts with several decodable characters for the first time in its Reply of 13 May 2024. This was almost three months after the application for an injunction was filed on 21 May 2024. February 2024. The applicant had obviously not reacted to new developments in the facts of the case, but to the defendant's defence that the patent in dispute was not legally valid. The defendant's defence options would be drastically shortened. It would not be compatible with the urgency requirement if the applicant could change its application "at the last minute" at will several months after the start of the proceedings. The case is no different than if the applicant were to belatedly assert the (alleged) infringement of a second patent, which was recognisable from the outset (see Munich Higher Regional Court, judgment of 12 October 2023, file no. 6 U 2570/23 e, on the conversion of the application for an injunction to a limited version of the claim after an attack on the legal status, unpublished). This should also not be possible in injunction proceedings before the UPC.

In the context of the always necessary **balancing of interests**, the serious doubts as to the validity of the patent in dispute must be taken into account in particular. These doubts also exist insofar as the patent in suit covers devices that localise, decode and mark several decodable characters and simultaneously display product images, etc.

The **applicant** has countered the respondent's arguments.

To avoid repetition, reference is also made to the documents exchanged between the parties, including the annexes. This applies in particular with regard to the submission on infringement

and legal validity of the alternative limited version of claims 1 and 10.

REASONS FOR THE ORDER

The admissible application for an Order for provisional measures is partially justified.

I. Active legitimisation

The applicant is the registered proprietor of the patent in suit pursuant to Art. 47 (1) EPC. i.V.m. R. 8.5 (a) and (c) RoP. As the defendant does not question the right to bring an action, there is no need for any further comments in this regard.

II. Injury

The Munich local division is convinced with sufficient certainty (R. 211.2 RoP) that the applicant's rights are infringed by the offer and distribution of the challenged embodiment within the Contracting Member States, in particular in Germany and France. On summary examination, the challenged embodiments make indirect and literal use of the technical teaching of the patent in suit as granted, which is protected by patent claims 1 and 10 (Art. 26 UPCA). In contrast, a direct infringement of patent claim 1 (Art. 25 UPCA) cannot be established either for the granted version or for the restricted version.

1. The **patent in suit** relates to digital devices for reading decodable characters such as bar codes. In particular, identifiers are read optically by means of a camera and the information encoded in the identifier is reproduced for the user.

The patent in suit assumes that machine-readable and thus automatically readable identifiers such as barcodes, which can be used to represent various pieces of information, are known (see patent in suit [0003]). Such decodable characters can be recognised and decoded with reading devices, whereby in the case of barcodes optical reading devices, such as digital cameras, can be used (patent in suit, [0005]). Readers for reading decodable characters are available in numerous variants. The patent in suit cites numerous examples, in particular devices such as smartphones, which have a touch screen that serves as a control panel and for displaying information (see patent in suit, [0006]).

The task of the patent in suit, which is not explicitly stated in the patent specification, is to provide an improved system for capturing barcodes.

The problem is solved according to the patent in dispute in particular by a device and a method according to the independent patent claims 1 and 10, in which not only the captured barcodes are shown optically on a display, but are also labelled. Furthermore, in connection with the labelled barcodes, product images are displayed which have been assigned to the labelled barcodes via a database. (see para. [0088]). A further functionality includes the output of messages, product images or

Data in response to a user input (see par. [0010], [0024]) in relation to the labelled barcodes and product images.

Claims 1 and 10 can be structured as follows (corresponds to the structure submitted by the applicant):

Claim 1

1	An indicia-reading device (100, 1000), comprising:	Zeichenlesevorrichtung (100, 1000), umfassend:
1.1	one or more processors (1060)	einen oder mehrere Prozessoren (1060);
1.2	a memory (1085)	einen Speicher (1085);
1.3	an imaging subsystem (1040) configured to acquire an image of decodable indicia (15, 202, 204, 206)	ein Bildgebungssubsystem (1040), das konfiguriert ist, um ein Bild decodierbarer Zeichen (15, 202, 204, 206) zu erfassen;
1.4	a display (54); and	eine Anzeige (54); und
1.5	a communication interface (1604, 1608);	eine Kommunikationsschnittstelle (1604, 1608);
1.6	wherein said device is configured, responsive to acquiring an image of one or more objects within a field of view (140) of said imaging subsystem, to locate within said image and decode one or more decodable indicia;	wobei die Vorrichtung konfiguriert ist, um als Reaktion auf das Erfassen eines Bildes eines oder mehrerer Objekte innerhalb eines Sichtfeldes (149) des Bildgebungssubsystems ein oder mehrere decodierbare Zeichen innerhalb des Bildes zu lokalisieren und zu decodieren;
1.7	Wherein said device is further configured to display said image on said display and visually mark said one or more successfully decoded decodable indicia;	wobei die Vorrichtung ferner konfiguriert ist, um das Bild auf der Anzeige anzuzeigen und das eine oder die mehreren erfolgreich decodierten decodierbaren Zeichen visuell zu kennzeichnen;

	characterized in that	dadurch gekennzeichnet, dass
1.8	said device is further configured to display a product image at a location of an associated image representation of each one or more successfully decoded decodable indicia, said product image is associated with the successfully decoded decodable indicia by said device based on a lookup table retrieved from a database;	die Vorrichtung ferner konfiguriert ist, um ein Produktbild an einer Stelle einer zugeordneten Bilddarstellung von jedem des einen oder der mehreren erfolgreich decodierten decodierbaren Zeichen anzuzeigen, wobei das besagte Produktbild basierend auf einer aus einer Datenbank abgerufenen Nachschlagetabelle durch die besagte Vorrichtung den erfolgreich decodierten decodierbaren Zeichen zugeordnet ist;
1.9	wherein said device is further configured, responsive to accepting user input selecting at least one decoded indicia of said displayed one or more decoded indicia, to output at least one decoded message corresponding to the at least one selected decoded indicia and/or at least one product image associated with the at least one selected decoded indicia and/or data determined when the at least one selected decoded indicia is decoded.	wobei die Vorrichtung ferner konfiguriert ist, um als Reaktion auf das Annehmen einer Benutzereingabe, die mindestens ein erfolgreich decodiertes decodierbares Zeichen des/der angezeigten einen oder mehreren erfolgreich decodierten decodierbaren Zeichen auswählt, mindestens eine decodierte Nachricht, die dem mindestens einen ausgewählten erfolgreich decodierten decodierbaren Zeichen entspricht, und/oder mindestens ein Produktbild, das dem mindestens einen ausgewählten erfolgreich decodierten decodierbaren Zeichen zugeordnet ist, und/oder Daten auszugeben, die bestimmt werden, wenn das mindestens eine ausgewählte erfolgreich decodierte decodierbare Zeichen decodiert wird.

Claim 10

1	An indicia-reading method on an indicia-reading device (100, 1000), comprising:	Zeichenleseverfahren auf einer Zeichenlesevorrichtung (100, 1000), umfassend:
1.1	one or more processors (1060)	einen oder mehrere Prozessoren (1060);
1.2	a memory (1085)	einen Speicher (1085);
1.3	an imaging subsystem (1040) configured to acquire an image of decodable indicia (15, 202, 204, 206)	ein Bildgebungssubsystem (1040), das konfiguriert ist, um ein Bild decodierbarer Zeichen (15, 202, 204, 206) zu erfassen;
1.4	a display (54); and	eine Anzeige (54); und
1.5	a communication interface (1604, 1608);	eine Kommunikationsschnittstelle (1604, 1608);
	the method comprising:	wobei das Verfahren umfasst:

1.6	responsive to acquiring an image of one or more objects within a field of view (140) of said imaging subsystem, locating within said image and decoding one or more decodable indicia;	als Reaktion auf das Erfassen eines Bildes eines oder mehrerer Objekte innerhalb eines Sichtfeldes (140) des Bildgebungssubsystems, Lokalisieren eines oder mehrerer decodierbarer Zeichen innerhalb des bildes und Decodieren;
1.7	displaying said image on said display and visually marking said one or more successfully decoded decodable indicia;	Anzeigen des Bildes auf der Anzeige und visuelles Kennzeichnen des einen oder der mehreren erfolgreich decodierten decodierbaren Zeichen;
	characterized by the method further comprising	dadurch gekennzeichnet, dass das Verfahren ferner umfasst:
1.8	associating each of one or more successfully decoded indicia with a product image based on a lookup table retrieved from a database;	Zuordnen jedes von einem oder mehreren erfolgreich decodierten Zeichen zu einem Produktbild basierend auf einer aus einer Datenbank abgerufenen Nachschlagetabelle;
1.9	displaying the product image at a location of an associated image representation of each of the one or more decodable indicia, and	Anzeigen des Produktbildes an einer Stelle einer zugeordneten Bilddarstellung jedes der einen oder mehreren decodierten Zeichen, und
1.10	responsive to accepting user input selecting at least one decodable indicia of said displayed one or more decodable indicia, outputting at least one decoded message corresponding to the at least one selected decodable indicia and/or at least one product image associated with the at least one selected decodable indicia and/or data determined when the at least one selected decodable indicia is decoded.	als Reaktion auf das Annehmen einer Benutzereingabe, die mindestens ein decodierbares Zeichen des angezeigten einen oder der mehreren decodierbaren Zeichen auswählt, Ausgeben mindestens einer decodierten Nachricht, die dem mindestens einen ausgewählten decodierbaren Zeichen entspricht, und/oder mindestens eines Produktbildes, das dem mindestens einen ausgewählten decodierbaren Zeichen zugeordnet ist, und/oder von Daten, die bestimmt werden, wenn das mindestens eine ausgewählte decodierbare Zeichen decodiert wird.

2. **Interpretation**:

a) According to Art. 69 EPC in conjunction with the Protocol on its interpretation, the patent claim is not only the starting point, but the decisive basis for determining the scope of protection of a European patent. The interpretation of a patent claim does not depend solely on its exact wording in the linguistic sense. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to that which, after examination of the description and the drawings, appears to be the patent proprietor's request for protection. The patent claim must be interpreted from the perspective of the person skilled in the art. (UPC_CoA_335/2023, Order of 26 February 2023 in conjunction with the Order of 11 March 2024, GRUR-RS 2024, 2829, Principle 2. and para. 73 - 77 - Proof procedure; UPC_CFI_452/2023 (LK Düsseldorf), Order of 9 April 2024, p. 13, GRUR-RS 2024, 7207, para. 49).

The parties have not commented on the identity of the specialist concerned. In the view of the local division, the expert is a team consisting of a graduate engineer in electrical engineering with several years of experience in the development and design of character reading devices and a graduate engineer in software with several years of experience in the development and design of software for character reading devices.

b) With this in mind, patent claim 1 protects a character reading device, the generic term of which is taken from US specification 5 821 523 A [0006]. Features 1.8 and 1.9 add to this known device the ability to display a product image in place of an associated image representation of the successfully decoded character and to display further information in response to a user input in relation thereto.

The possible applications are many and varied. The barcode scan can be used, for example, to identify the desired product within a variety of product packaging. This is particularly useful if the product itself cannot be identified from the packaging. Furthermore, the operator can retrieve additional product information linked to the barcode based on the scan. A further functionality is that the displayed product image and/or the retrieved linked product information can be compared with the actual product.

c) As the skilled person can see from patent claim 1, the protected character reading device has, as hardware components, one or more processors, a memory, an imaging subsystem, e.g. a camera, a display, e.g. a screen, a communication interface, e.g. a touch-sensitive screen, and a decoding device. All of this is regularly provided, for example, by a commercially available smartphone [0011].

d) Feature 1.3 also requires that the imaging subsystem can capture an image of a decodable character, e.g. a barcode [0006].

e) Feature 1.6 further requires that the imaging subsystem is further able to recognise a decodable character located on an object within the field of view that is not

but also to localise and decode them. If there are several decodable characters on several objects in the field of view, the device must be able to localise and decode them.

The localisation sub-feature requires that the imaging subsystem can not only recognise that there is a decodable character in the image section at all, but also where it is located within the current image section. This is a prerequisite for the implementation of feature 1.8, because according to feature 1.8, a product image must be displayed at the location of the image representation of the decoded character.

f) Furthermore, the device according to feature 1.7 must be able to display the captured image and visually identify the decodable characters visible in the image section, provided they have been successfully decoded.

This visual labelling or marking can be done in different ways according to the description of the disposition patent. One possibility of visual marking is to emphasise the decodable characters (see para. [0055]). This can be done, for example, by drawing a neutral frame around the representation of the successfully decoded character (as indicated by the digits R316, R318, R320, R322 and R324 in Fig. 11 shown below; see also par. [0099]):

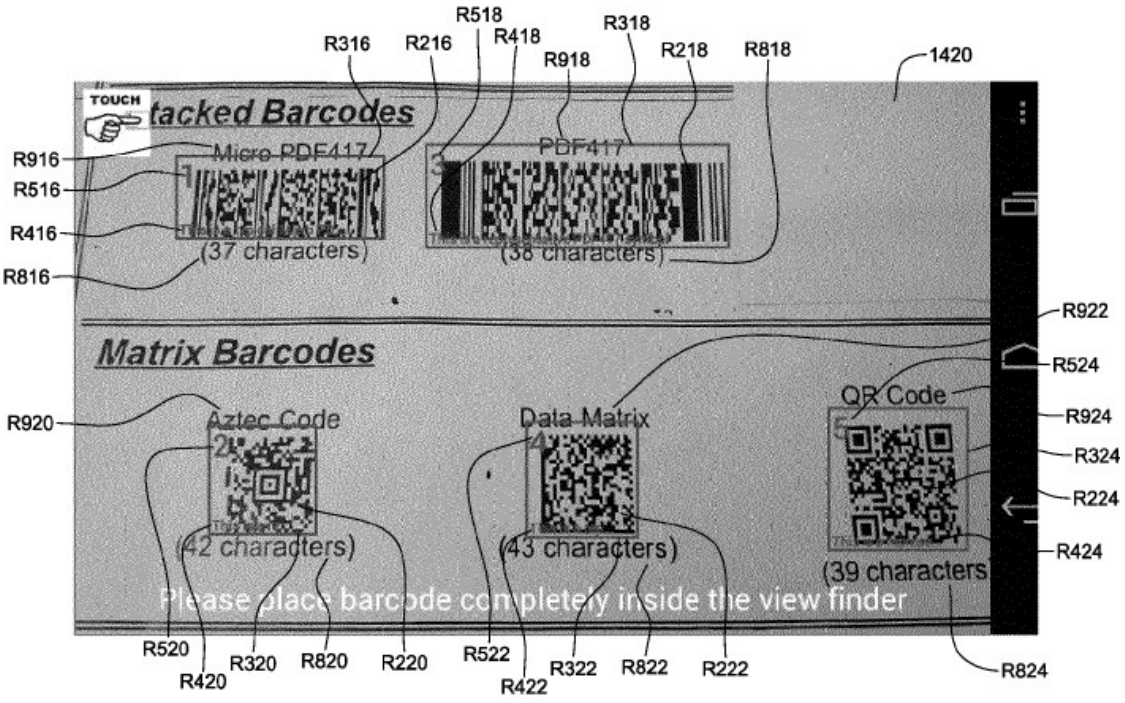


Fig. 11

The frames shown can also be displayed in colour. Of course, other forms of labelling are also possible (see section [0099]), such as the display of a circular dot, for example.

or another marker in or around the centre of the successfully decoded characters (see para. [0055]).

Furthermore, the visual mark must be clearly and easily recognisable for the user and be associated with the decoded character. This is already clear from the wording "visually mark" or "to be visually labelled" of feature 1.7. This also follows from a functional interpretation, because the purpose of the visual mark within the meaning of feature 1.7 is to indicate to the user that the decoding process has been successfully completed.

It is therefore essential to the invention, on the one hand, that the user can recognise which barcode has been decoded. On the other hand, the labelling of a barcode according to the invention is characterised precisely by the fact that it is physically or virtually connected to the marked object in the sense of the representation of an augmented reality. Accordingly, the embodiments of the patent in suit also provide that the visual labelling is virtually connected to the barcode (see patent in suit, [0015] and [0038]).

In this respect, the claim does not explicitly state how long the decoded sign including the labelling is to be displayed and whether and, if so, from when the product image to be displayed according to feature 1.8 may (completely) superimpose the image of the labelled decodable sign. Sub-claim 9 states that the user sees the decoded character through a semi-transparent product image and paragraph [0073] of the description mentions in connection with Figure 10

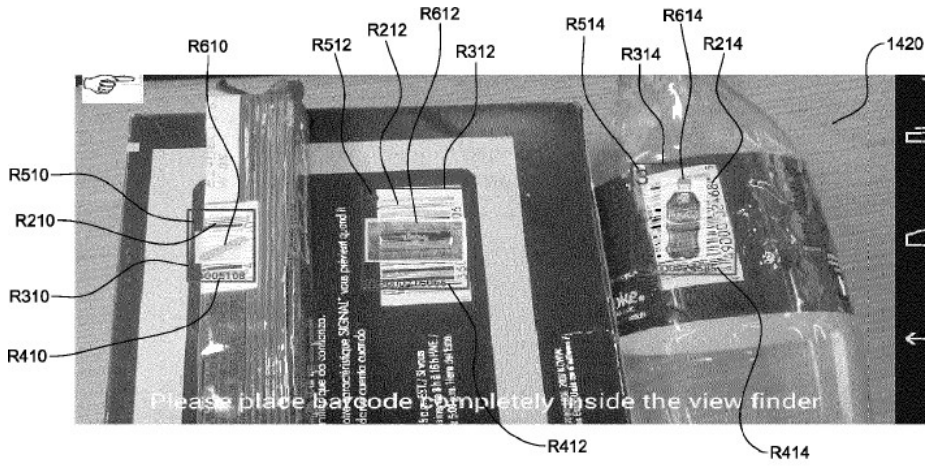


Fig. 10

expressly states that the decoded characters in the display can be replaced by product illustrations *("Referring to the illustrative embodiment as set forth in FIG. 10 the representations of the bar codes (serving as decodable indicia) can be removed and replaced with a display of one or more highlight of each decodable indicia").*

However, it is always necessary that the display of the labelling of the decoded sign lasts long enough for the user to perceive it and establish a spatial reference.

especially if the image is later completely overlaid by a product image. The product image according to feature 1.8 must be displayed at a position that is occupied by the image of the decodable character or has been occupied for a sufficiently long time. Only in this way is it clear to the user moving through this augmented reality which real product image is to be assigned to which virtual labelling of a decoded character. Therefore, the labelling must also move with the movements of the camera within the image section and also disappear accordingly when the decoded symbol is no longer in the image section. The product image must therefore serve as its placeholder if it completely overlaps the decodable character.

There is also no other conceivable way for the user to be able to make the targeted input required in feature 1.9 in the case of the initial display of several labels of successfully decoded barcodes if these are completely overlaid by identical product images at the time of input. This only appears possible if the user continues to be shown visual reference points so that he can infer the actual spatial positioning of the objects bearing the barcodes based on the spatial positioning of the labelling or the later positioning of the product images within the image section.

g) Feature 1.8 adds to known devices the ability to display a product image at a position of an image representation of the successfully decoded character. The product image originates from a look-up table held in a database and is assigned to the successfully decoded character.

With regard to the sub-characteristic "at a location", reference is first made to the explanations above.

According to the patent description, the product image can be displayed either separately from the representation of the decoded character (cf. Fig. 9 and para. [0071]), or directly in the place of the image representation of the decoded character, whereby the product image can partially (cf. Fig. 10, item R614 and [0072]) or completely cover the latter. From the fact that the un
If a certain article is used "at a location", it follows that the product image can be displayed not only at one location (where the barcode is visible), but also at other locations. However, it is necessary that the product image is assigned to the decoded barcode. There must therefore be a connection recognisable to the user between

barcode and product image must be present. This is explained in paragraph [0071] of the description and illustrated in Figure 9:

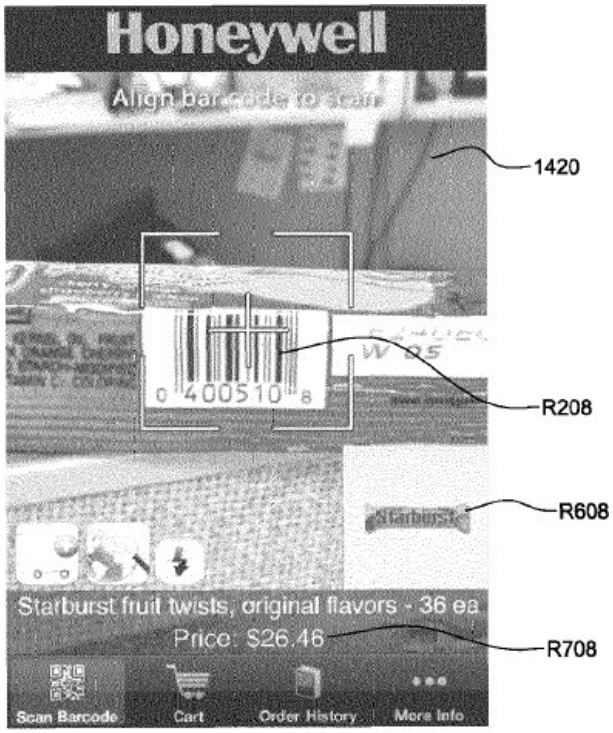


Fig. 9

Figure 9 shows that the product representation R608 is located next to the labelling of the image of the successfully decoded barcode R208.

The fact that it is explained in the following paragraph [0072] of the description that positioning the product image at the position where the barcode is reproduced is (also) part of the invention does not mean that the previous paragraph is excluded from the scope of protection of the claims. An interpretation of the claim which excludes an embodiment example from the scope of protection of the patent is regularly only considered if an interpretation which includes all embodiment examples would lead to irreconcilable contradictions. This is not the case here. Moreover, a functional interpretation also speaks against the position of the defendant, according to which a representation of the product image next to the associated barcode should not be covered by the claim. This is because, according to the teaching of the patent in suit, it is clearly important that a clear association between the product image and the barcode is established for the user. However, this does not require the product image to be displayed directly above or on the barcode.

According to the wording of the device claim, in the event that several decodable characters visible in the image section are localised and successfully decoded, the device must be configured to display a product image "of each" successfully decoded character at a position of an associated image representation; the method claim speaks of

product images in one place of "each" character. According to the wording, it is therefore not sufficient for only one product image to be displayed when several decodable characters are decoded and successfully decoded. It is necessary for a product image to be displayed for each successfully decoded character. If several characters are successfully decoded, several product images must therefore be displayed simultaneously. This interpretation is also supported by the figures in the patent description. The figures show only one embodiment example in which several characters are localised, decoded and visually identified, namely Fig. 10. In this figure, a product image is displayed for each of the three decoded characters. The three product images are displayed simultaneously

With regard to the database and look-up table subfeatures, it should be noted that the database and the look-up table themselves are not part of the protected device, but merely interact with it.

A database is technically understood to be a system for electronic data management, whereby the data is provided as permanently as possible and can be retrieved by the user as required. Ultimately, data is stored in every electronic storage medium in such a way that it can be found and retrieved from the working memory according to certain criteria - otherwise the stored data would be useless and not reusable. It is irrelevant for a database whether the data is stored on one or more physical or logical memories. If a database is used by computers (and not by people), it is often not at all recognisable where the data is stored. In this sense, the disposition patent also uses the term database, which according to [0069] can be a server, for example:

One or more program 1800 at block 1802 can message a resource and in one embodiment can message an external resource, e.g. a database of server 2000 or server 3000.

In German:

One or more programs 1800 may send messages to a resource in block 1802 and, in one embodiment, may send messages to an external resource, such as a database of server 2000 or server 3000.

According to the claim, a look-up table is retrieved from this database. In the field of data processing, a look-up table is understood to be the assignment of one or more input parameters (input) to a specific result or output parameter (output). In the look-up table according to the patent, a decodable character (barcode) is assigned to a product image. How this assignment is made is left open by the claim. In particular, the claim does not specify that the image file assigned to a decodable character must be stored in the same database as the look-up table. The opposing view of the defendant is not supported either in the wording of the claim or in the patent description.

The respondent's view that the databases consist of look-up tables and other information (cf. objection, para. 269) is also incorrect and is incompatible with the

clear wording of the claim. This provides that the look-up tables are retrieved from a database, the database therefore contains the look-up table.

h) According to feature 1.9, the device is further capable of accepting a user input in relation to the successfully decoded character displayed and, in response, displaying a further associated decoded message. This further message is decoded, i.e. immediately understandable for the human user. The further message can contain the sequence of digits behind the barcode or a (further) product image or other information relating to the successfully decoded character. In the example shown in Figure 9, further information is displayed in text form under the reference character R708:

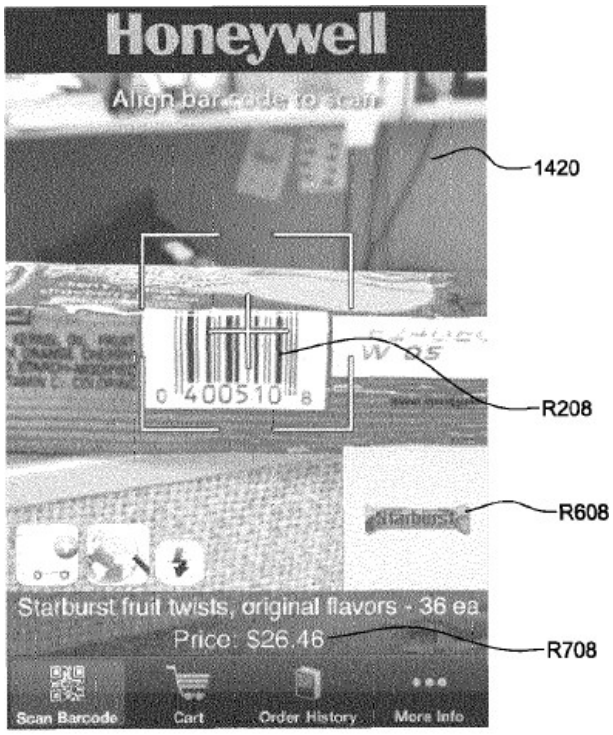


Fig. 9

3. Patent claim 10 protects a corresponding method. There are no material deviations from the result of the interpretation reproduced above. The structure of the individual features differs slightly.

4. On the basis of such an understanding, it is at least predominantly probable that the contested embodiment is a means by which the customers of the opponent are enabled to make use of the technical teaching of claims 1 and 10 in accordance with the literal meaning. The local division is therefore convinced with sufficient certainty of an indirect infringement of claims 1 and 10 of the patent in suit in the granted version by the attacked embodiment (Art. 62 (4) EPC in conjunction with Art. 62 (4) EPC). R.

211.2 RoP, cf. UPC_CoA_335/2023, Order of 26 February 2023, GRUR-RS 2024, 2829, headnote 3. and para. 90 - 94 - Evidence procedure). However, the local division could not form a sufficient conviction of an imminent patent infringement of claim 1, neither with regard to the granted version nor with regard to the version asserted in a restricted manner.

a) According to the applicant's statements in the document of 13 May 2024 (page 51 et seq.), the software development kit (SDK) and embodiments with identical cores are at issue. The two videos explained in the statement of claim ("Barcode Scanner SDK" and "Matrix Scan AR") do not represent two different challenged embodiments, but rather each show slightly different application examples of the SDK offered by the defendant. The applicant is challenging the defendant's software, in particular its SDK, which has the patented function. Whether the SDK can be used to produce software that uses the features of claims 1 and 10 can therefore be verified on the basis of the SDK documentation and the two promotional videos.

b) The realisation of features 1 to 1.7 and 1.9 of claim 1 is rightly not in dispute between the parties, so that no further explanation is required in this respect.

c) In addition, feature 1.8 is also realised.

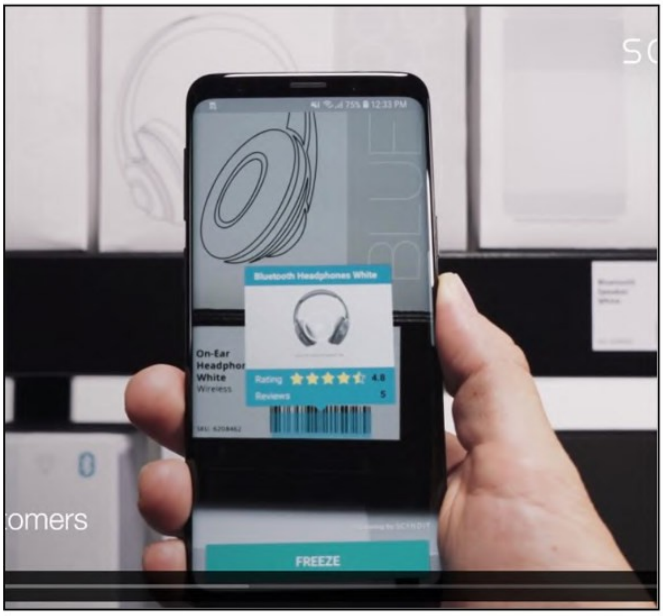
UPC_CFI_74/2024

(1) Sub-feature "Display "in one place""

The interpretation of the defendant that for a patent-compliant display in the place of the decoded sign it is required that the decoded sign is at least partially superimposed by the product image cannot be followed, as shown.

In the "Barcode Scanner SDK" video, the product image (the image of a screw) is shown over the labelled barcode as follows.

In the "Matrix Scan AR" video, the product image (the image of a headphone) is shown partially superimposed over the labelled barcode as follows:



Furthermore, it must be taken into account that the defendant expressly points out in the documentation of the SDK (Annex BP 3b) that the product image can and should be displayed above the decoded barcode, but that a deviation from the selected anchor point is also possible. This is stated on page 2:

BarcodeTrackingAdvancedOverlayListener.viewForTrackedBardoce() asks for a view to animate on top of the barcode.

In German:

BarcodeTrackingAdvancedOverlayListener.viewForTrackedBardoce() asks for a view to be placed over the barcode.

The documentation in Appendix BP 3b explains in detail that for each image a "anchor point" must be defined, which is referred to as the "anchor". The image is then displayed in the centre above the anchor point and a "deviation", called "offset" in order to change the position of the image. This is stated literally (Appendix BP 3b, p. 2):

BarcodeTrackingAdvancedOverlayListener.anchorForTrackedBarcode() asks how to anchor the view to the barcode through Anchor. Beaware that it anchors the view's centre to the anchor point. To achieve anchoring the top of the view or the bottom etc. you will have to set an offset as explained in the next point.

In German:

BarcodeTrackingAdvancedOverlayListener.anchorForTrackedBarcode() asks how the view should be anchored by an anchor in relation to the barcode. Note that the centre of the view is anchored to the anchor point. To anchor the top side

or the bottom etc. of the view, you must define an offset, as explained in the next point.

The following pseudocode then shows in concrete terms how the anchor point is defined and explained (Appendix BP 3b, p. 2 at the bottom):

// As we want the view to be above the barcode, we anchor the view's centre to the top-centre of the barcode quadrilateral. // Use the function 'offsetForTrackedBarcode' below to adjust the position of the view by providing an offset.

In German:

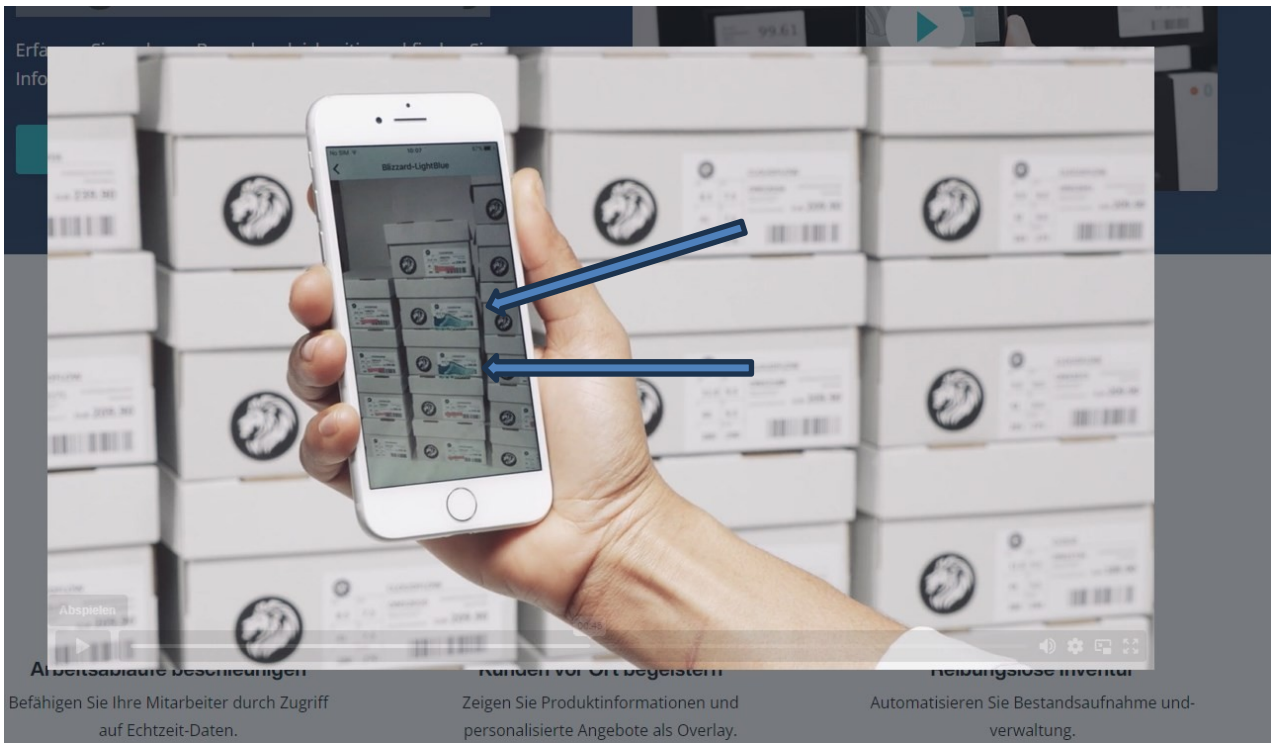
// Since we want to have the view above the barcode, we anchor the centre of the view to the top centre of the barcode square. // Use the 'offsetForTrackedBarcode' function below to adjust the position of the view using an offset.

The SDK therefore explicitly provides for product images to be displayed at the position of the barcode, this can be above the barcode or partially overlapping.

Both are in accordance with the interpretation of the local division.

(2) Sub-feature "Display of multiple product images"

It is true that the screenshots submitted by the applicant do not show a representation of several product images, which would be necessary for the realisation of feature 1.8 in the event that several decodable characters belonging to different products have been successfully decoded. However, the applicant pointed out at the hearing that several trainers were successfully decoded in the video "Matrix Scan AR" at 00:45. The defendant did not dispute this again when asked by the Chamber. The applicant's submission is therefore deemed to be undisputed (Rule 171.2 RoP). Furthermore, it should be noted that the SDK indisputably permits such programming. The defendant has merely (rightly) criticised the lack of corresponding statements in the applicant's written submission. There are also no screenshots of this scene. The following screenshot has therefore been prepared by the Chamber for illustrative purposes:



You can see that the mobile phone display shows two overlapping, green-coloured images of trainers [the arrows were added by the camera].

It is therefore possible with the SDK to programme the patent-compliant display of multiple product images in the event of multiple "hits".

(3) Sub-feature "look-up table retrieved from a database"

The database and the look-up table are not themselves part of the protected device, but merely interact with it. According to the above interpretation, the realisation of this part does not depend on the exact location of the databases containing the look-up table and the product images. It is undisputed that a corresponding functional connection to databases and look-up tables can be programmed by means of the challenged embodiment (SDK). This is also to be expected in practice, as the scanning of a large number of barcodes is the regular use case. These barcodes, the associated product images and other information must therefore be made available in databases and look-up tables.

d) There are no deviations with regard to the method according to claim 10.

5. The fact that it offers and supplies the challenged embodiment, the SDK, in the Contracting Member States, in particular in Germany and France, is not a defence for the defendant.

is not disputed. In addition, the accused embodiments were and are undisputedly advertised on the internet. This constitutes an indirect infringement of claims 1 and 10 as granted (Art. 26 EPGP).

a. According to Art. 26 (1) EPC, a patent grants its proprietor the right to prohibit third parties from offering or supplying, without his consent, in the territory of the Contracting Member States in which the patent has effect, means relating to an essential element of the invention for use of the invention in that territory to persons other than those authorised to use the patented invention, if the third party knows or ought to have known that these means are suitable and intended to be used for the purpose of using the invention.

b. The SDK is a means which relates to an essential element of the invention. By means of this programme library, the defendant's customers are able to create a software programme which, as shown, makes use of the technical teaching of claims 1 and 10 in the literal sense. The fact that the defendant does not provide any product images, databases with product images or reference tables with the SDK does not prevent this, as these are not essential for the invention. Rather, what is essential is the ability of the software to juxtapose certain decoded characters with certain product images in a certain way. By means of the SDK, the customer is able to write such software.

c. As the videos and documentation discussed above show, the defendant also offers the SDK to its customers for the use of the invention, although it knows that this means is suitable and intended to be used for the use of the invention. This determination in turn follows from the videos and documentation for which the defendant is responsible. This is because it can regularly be assumed that the supplied party will use the means in the manner suggested to him in the supplier's advertising messages, instructions for use and other documents. The defendant has not argued that the situation is exceptionally different in the present case.

6. However, the Chamber was unable to establish a direct infringement of claim 1.

a. Claim 1 is a device claim. With the SDK, the defendant merely supplies an essential means for implementing the invention according to claim 1. However, it supplies neither the required hardware nor the required software. Rather, the customer must provide the hardware, the product images and the decodable characters. Furthermore, the customer must develop the operating software. The SDK makes this possible.

b. It is recognised in national patent case law that in certain constellations a direct patent infringement can be recognised, namely if the patent infringer adopts the actions of its customer as its own in the sense of an extended workbench and it would be unfair from a valuation point of view to hold the infringer liable only for an indirect patent infringement. However, the danger must always be taken into account that this could blur the boundaries drawn by the legislator between the legal consequences of direct and indirect patent infringement. Therefore, liability for direct patent infringement can only be assumed in such cases if a specifically outlined completion of the patented device with

safety is to be expected. This is unproblematic, for example, if a kit for assembly into a complete device is supplied by the customer including assembly instructions and the complete device does not function if it is assembled differently.

c. However, the circumstances of the present case deviate from this in one decisive point. Due to the programme library provided by the SDK, it is possible in connection with the videos and the documentation in the sense of an indirect patent infringement, which constitutes an element of jeopardy, that the customer manufactures a patent-compliant overall device. However, due to the large number of different programming options and possibilities for assembling the hardware components, this is not certain with the required concreteness.

7. This also applies with regard to the restricted combination of features asserted in the auxiliary requests.

8. The defendant cannot oppose the defendant's right of prior use (Art. 28 UPCA), as it has not made any submission in this regard. On the contrary, it has stated that, in its view, this is not relevant. The request for a judicial indication to the effect that a right of prior use must be submitted because the other arguments do not prevail was not to be complied with. This is because the parties alone determine the subject matter of the legal dispute and the evidence supporting their submissions (Art. 43 UPCA).

III. Legal status

The legal validity of the patent in suit is secured to the extent required for the Order of provisional measures. Even taking into account the defendant's submissions, the Munich local division is convinced of the legal validity of the patent in dispute with the "sufficient certainty" required under Art. 62 (4) UPCA in conjunction with R. 211.2 RoP. Such "sufficient certainty" is lacking if the court considers it to be predominantly probable that the patent in suit is not valid (UPC_CoA_335/2023, Order v.
26 February 2023, GRUR-RS 2024, 2829, guiding principle 3. and para. 73 - 77 - Nachweisverfahren).

1. Having said this, the local division assumes that the subject-matter of patent claims 1 and 10 will prove to be patentable with sufficient certainty.

2. European patents applied for are presumed to be valid from the date of publication of their grant. From this point in time, they therefore enjoy the full protection guaranteed, inter alia, by Directive 2004/48 (ECJ GRUR Int 2020, 1071 para. 48 - Generics (UK) and others; GRUR 2022, 811 - Phoenix Contact GmbH & Co. KG/HARTING Deutschland GmbH & Co. KG and others, para. 41).

3. Accordingly, the burden of presentation and proof for facts concerning the lack of validity of the patent and other circumstances supporting the defendant's position lies with the defendant (UPC_CoA_335/2023, Order of 26 February 2023, GRUR-RS 2024, 2829, para.

93 - Evidence procedure). Against this background, it is the defendant's task in the present case to present arguments on the basis of the prior art which make the legal validity of the patent in suit appear insufficiently secure.

4. It is then the task of the adjudicating body to assess whether the legal validity of the patent in dispute is sufficiently established on the basis of the arguments put forward by the opposing party. This is in any case the case if the arguments put forward against the validity of the patent in suit are not capable of giving rise to significant doubts as to the validity of the patent in suit.

However, due to the summary nature of the examination of the legal validity in proceedings for the issuance of provisional measures, it is not possible to consider a full examination of all arguments, which are sometimes presented in large numbers, as in nullity proceedings. Rather, the number of arguments raised against the legal validity must generally be reduced to the three best arguments from the defendant's point of view (UPC_CFI_443/2023 ACT_589207/2023 (LK München), Order of 21 May 2024, 3rd LS). The background to this is that while a summary judgement on questions of fact is conceivable, a summary examination of questions of law is not. The court can either examine or not examine a question of law. If an examination is carried out, this examination is comprehensive. In this respect, the summary nature can only be taken into account by reducing the number of questions of law to be comprehensively examined in this way. This is illustrated by the requirement to limit the number of arguments to three as a rule. Since it is the defendant's task to fight against the presumption of legal validity, it is first and foremost also the defendant's responsibility to select the three regular arguments to be examined in more detail by the Board in the summary proceedings.

In the present case, the defendant has complied with this in the statement of 28 May 2024 (p. 3, para. 331). It limited itself to arguing on the basis of three solutions from the prior art, namely the "Flow App", the "Barinsa App" and the Japanese patent specification. The fact that the defendant has put forward more than three arguments on the basis of these three citations does not require further elaboration, as all the arguments put forward do not hold water.

3. Based on the principles set out above, the legal validity of the patent in suit is sufficiently certain in the present case. On summary examination, the defendant's arguments are not capable of giving rise to significant doubts as to the legal validity of patent claims 1 and 10.

a) The fact that the applicant has decided to submit auxiliary requests against the background of the defendant's submissions cannot in itself give rise to any doubts as to the legal position. On the contrary, the formulation of such auxiliary requests is an expression of legal caution. It is necessary, if only because the Court of Appeal in its Order of 26 June 2009 did not make such a decision.

UPC_CFI_74/2024

On 26 February 2024, the Federal Supreme Court addressed the possibility of the inadmissibility of auxiliary requests in the second instance, but left it open (UPC_CoA_335/2023, Order of 26 February 2023, GRUR-RS 2024, 2829, para. 116 - Nachweisverfahren).

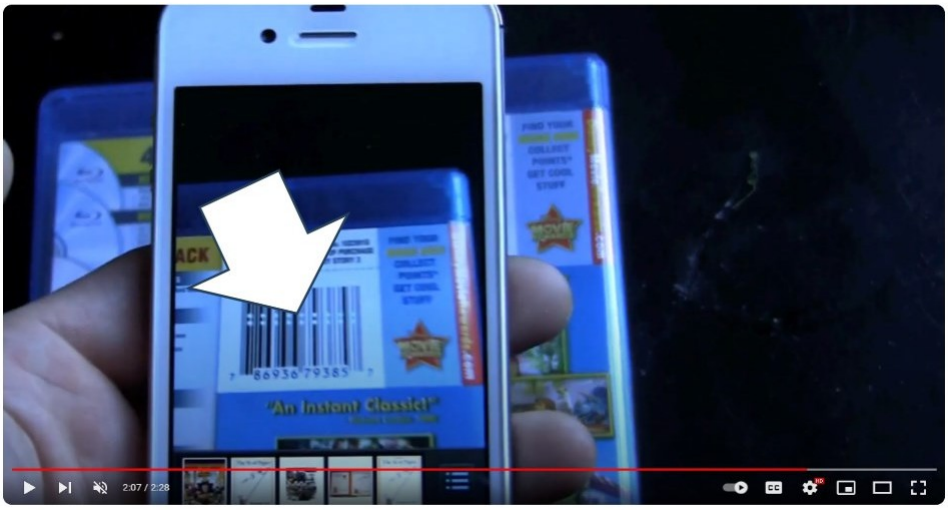
b) The subject-matter of claims 1 and 10 proves to be novel, Art. 54 EPC, on the requisite summary examination compared with the prior art cited by the applicant.

aa) A technical teaching is new if it deviates from the prior art in at least one of its known features. It is anticipated if all its features can also be found in prior art (see Benkard/Melulis/Koch, Europäisches Patentübereinkommen - EPÜ, 4th ed., EPC Art. 54 para. 22). Only that which is directly apparent to a person skilled in the relevant technical field from the publication or prior use is anticipated in the prior art. Knowledge that the person skilled in the art only gains on the basis of further considerations or the use of further documents or uses is not relevant for the assessment of novelty (see UPC_ CFI_452/2023 (LK Düsseldorf), Order of 9 April 2024; UPC_CFI_7/2023 (LK Düsseldorf), Order of 3 July 2024).

bb) Having said this, the following applies in the present case:

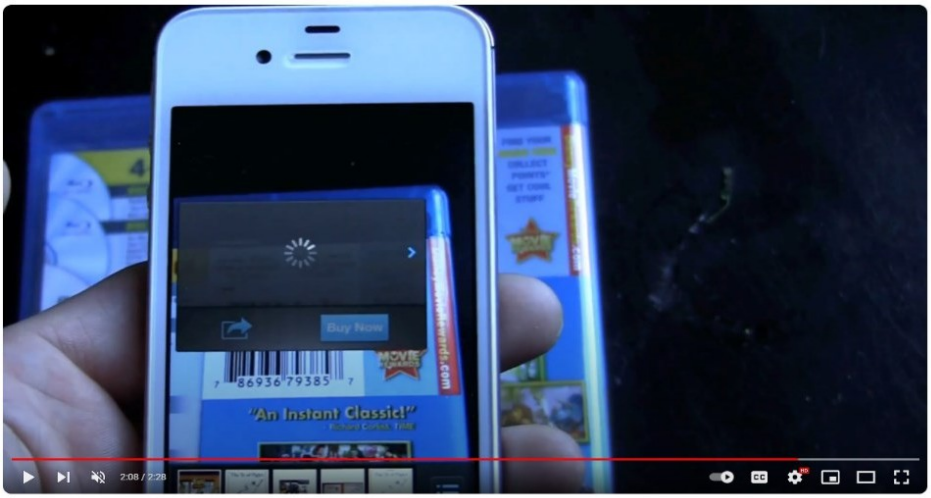
(1) The Flow App (https://www.youtube.com/watch?v=ThUQyi0BO_k, Annexes FR1-6) does not directly and unambiguously disclose all the features of claims 1 and 10.

- A9.com, Inc., a subsidiary of Amazon, has been offering a shopping application (app) with augmented reality under the name "Flow" since November 2011. The functionality of this "Flow App" is explained in numerous videos that are available on YouTube. As an example, the defendant referred to the video entitled "Flow by Amazon iPhone app demo: Augmented reality meets shopping" of 2 November 2011, hereinafter "Flow Video" (Exhibits FR 1-6). The Flow Video was available online from 5 November 2011 at the latest. The Flow Video shows the use of the "Flow App" with a smart phone. The Flow App enables a user to call up product information by scanning a barcode. The video first shows a barcode (Flow video, at minute 2:07). The barcode shows a series of white dots (see arrow):



The defendant sees this as an indication of successful decoding.

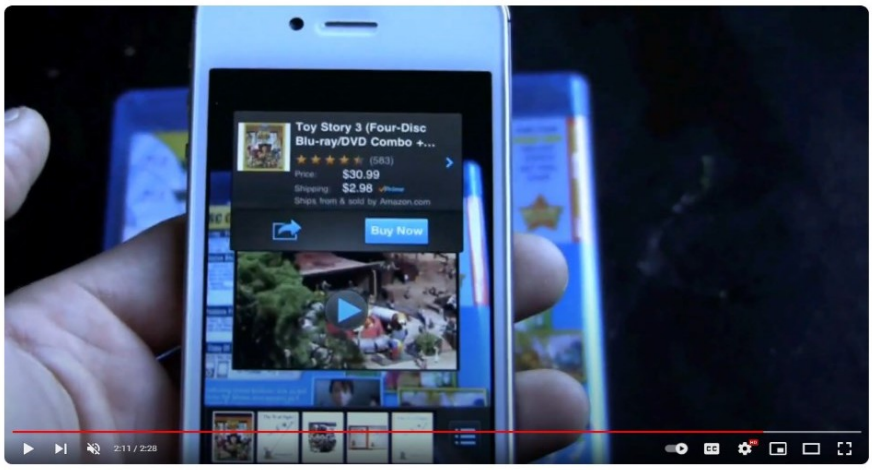
A greyed-out dialogue box is then displayed above the barcode (flow video, at minute 2:08):



Product information is retrieved (Flow Video,
at minute 2:09) and faded in (flow video, at minute 2:11). The

UPC_CFI_74/2024

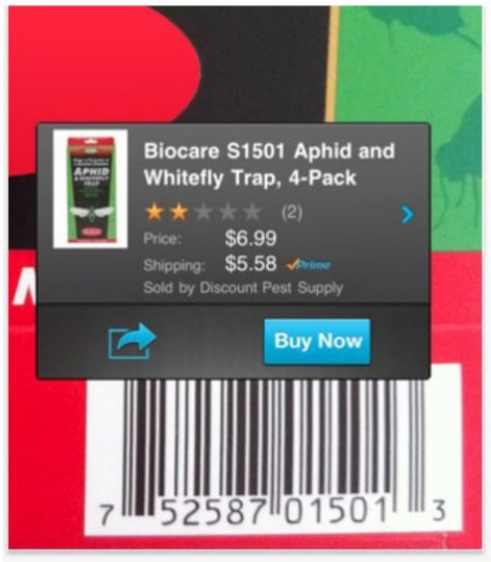
Product information includes a product image, the product name, a product price, etc:



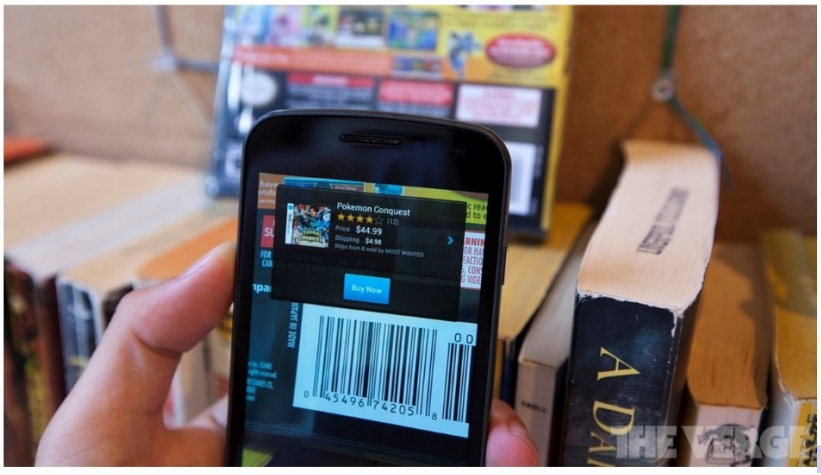
In response to a user input, in this case tapping on the product information superimposed on the barcode, the user receives further information or functions (flow video, at minute 1:44-1:46). The additional information can include one or more further product images, stock levels, purchase options, etc. (id.):

The "Flow App" displays the product images in different ways. In some cases, the decoded barcode is no longer visible (see above). In other cases, the decoded barcode is partially visible:

UPC_CFI_74/2024



In other cases, the decoded barcode can be seen in full:



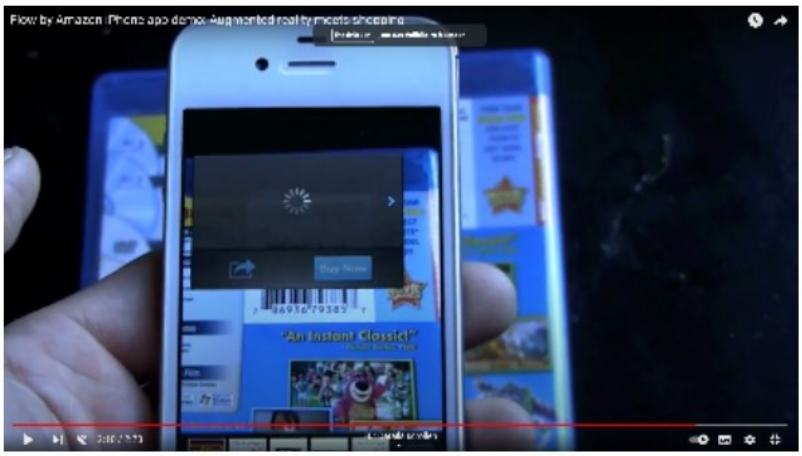
According to the defendant, the "Flow App" retrieves the product information from an Amazon database. The product description of A9.com, Inc. (product description of A9.com, Inc. (archived on 4 November 2011), Annex FR 6) states under the heading "How does it Work?":

"Flow uses continuous scan technology developed by A9.com's visual search team to identify products and provide related information found on Amazon.com. The app then overlays Amazon's popular shopping features such as product details, customer reviews and ratings, as well as sharing via Twitter, Facebook, or email; and immediate purchasing, including shipping with Amazon Prime."

- Thus, feature 1.8 of claim 1 and feature 1.9 of claim 10 are not directly and unambiguously disclosed. This feature requires, as explained above, that the device is configured to display a product image at a position of an image representation of the successfully decorated sign (claim 1) and that the product image is displayed (claim 10). The product image originates from a look-up table held in a database and is assigned therein to the successfully decoded character. The product image according to feature 1.8 must be displayed at a position that is different from the image of the product.

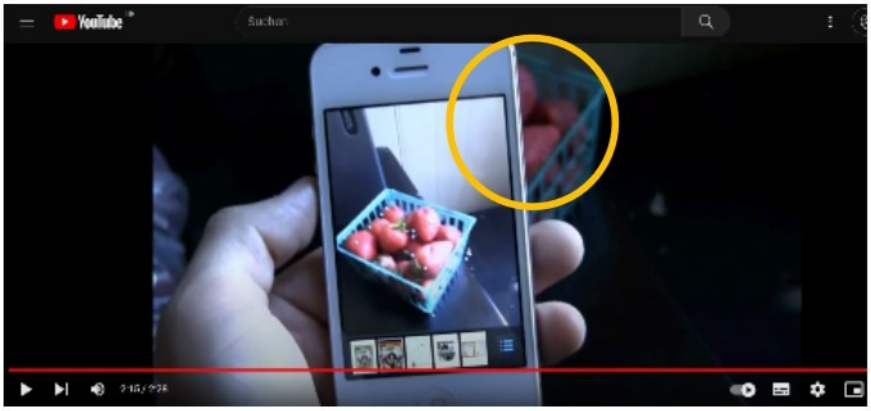
decodable character is taken or - for a sufficiently long time - has been taken. Only in this way is it clear to the user moving in this augmented reality which real product image is to be assigned to which virtual labelling of a decoded drawing. Therefore, the labelling must also move within the image section according to the movements of the camera and also disappear accordingly when the decoded character is no longer in the image section.

As can be seen from the example shown from minute 2:04-2:12 with the scanning of a barcode and verified by the local division during the appointment by visual inspection, the product image is always displayed in the same place on the screen even if the image section is changed due to a movement of the mobile phone and even if the product being filmed has disappeared from view:



Das Mobiltelefon wird vom Nutzer von der DVD-Hülle wegbewegt:

Vorstehend orange markiert ist die Schale mit Erdbeeren zu sehen, auf die das Handy gehalten wird, die graue Dialogbox auf dem Display zeigt jedoch noch die angeblich zum Barcode auf der DVD-Hülle ermittelten Informationen an. Erst nachdem der User aktiv die Einblendung auf dem Display weggeklickt hat, sind die Erdbeeren auch auf dem Bildschirm sichtbar:



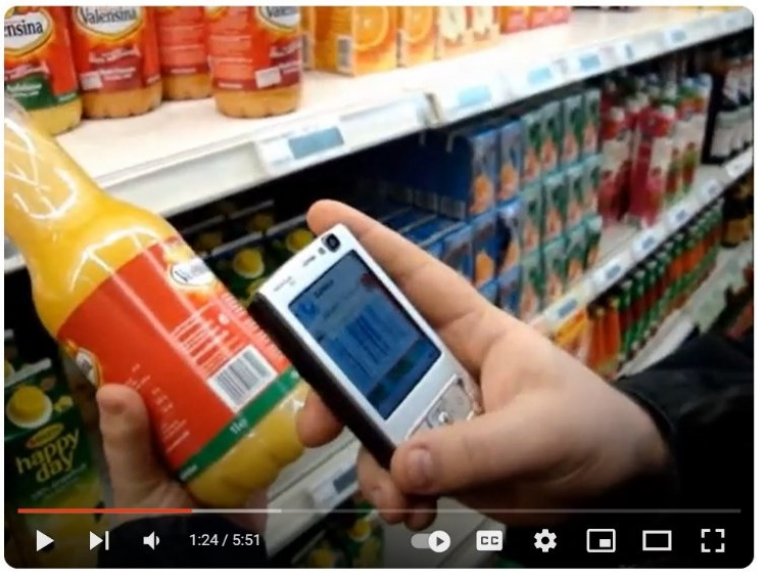
Furthermore, the YouTube video does not directly and clearly disclose how the device (i.e. the smartphone) is actually configured or how the procedure actually proceeds.

(2) The Barinsa APP (https://www.youtube.com/watch?v=odNl4lAED5M, Annexes FR 7-9) does not directly and unambiguously disclose all the features of claims 1 and 10.

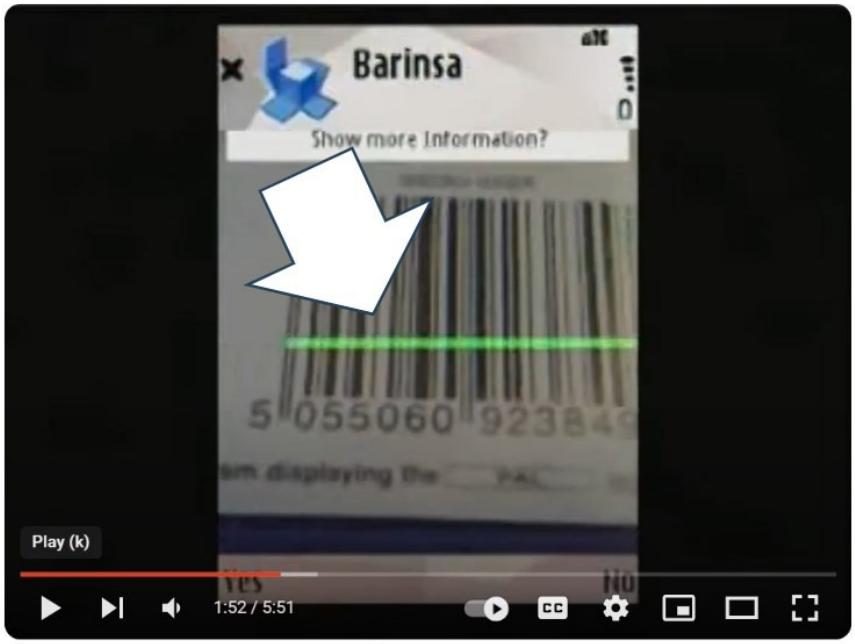
- The video entitled "Barinsa - New Barcode Scanner For Symbian Nokia", hereafter "Barinsa Video", shows the use of the "Barinsa App" with a smartphone (at minute 1:24). The "Barinsa App" enables a user to retrieve specific product information by scanning a barcode. According to YouTube, this video is from 1 November 2009 and shows an exemplary implementation of the Barinsa software, hereinafter referred to as the "Barinsa App". According to the website archiving service "archive.org", this video was available online on 9 February 2012 at the latest (Annexes FR 7-9). In its default state, the "Barinsa App" plays back a live video recorded via the smartphone camera (Barinsa Video, at

UPC_CFI_74/2024

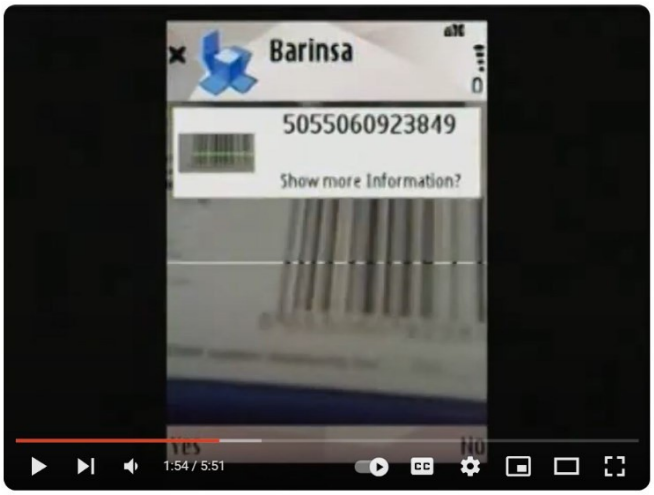
Minute 1:24):



A barcode displayed in the live video shows a scan line that changes from red to green (Barinsa video, at minute 1:52-1:55):

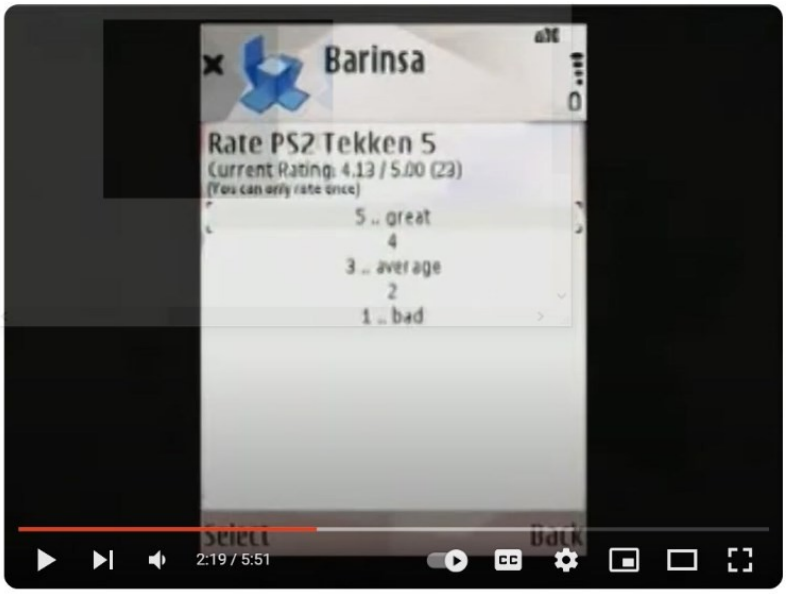


The barcode and the image of the barcode are then displayed (Barinsa video, at minute 1:54):



Product information is then called up and displayed (Barinsa video, at minute 1:49-1:59). The product information includes a product image, the product name, a product price, etc.:

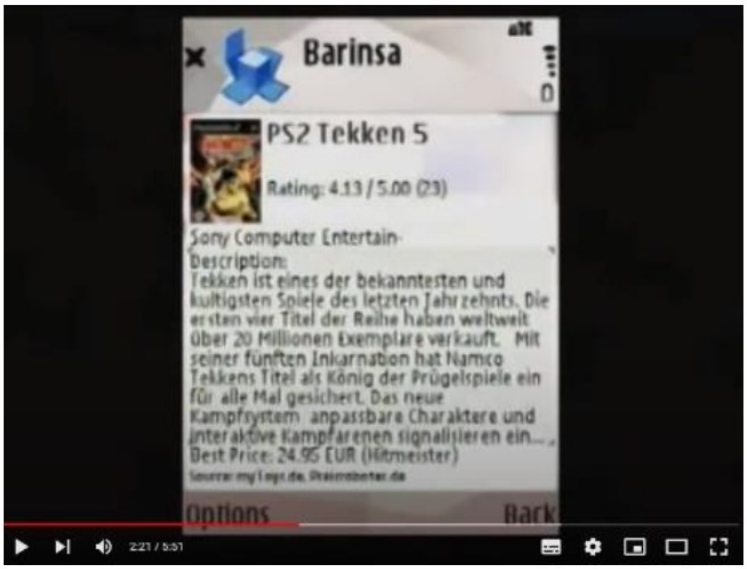
In response to a user input, in this case the selection of the product information "Rating", the user receives further information or functions (Barinsa Video, at minute 2:17-2:19). In the example shown, the additional information relates to a current rating of the product and the option to submit a rating (Barinsa video, at minute 2:19):



- Thus, feature 1.8 of claim 1 (1.9 of claim 10) is in any event not directly and unambiguously disclosed. This is because the product representation is always displayed at the same position on the screen, as verified by the local division by visual inspection at the hearing, and not at a position in the image representation of the decoded barcode:


Barinsa
Coca Cola light
Cola
Not just yet been rated
1.5-Liter
Großbritannien
Ingredients:
Wasser, Kohlensäure, E 150d,
Phosphorsäure, Zitronensäure,
Natriumcylamat, Acesulfam-K, Aspartam,
Koffein
Options
Back


Barinsa
Gradius V
Rating: 3.67 / 5.00 (3)
Konami Digital Entertainment GmbH
Description:
Vor langer Zeit wurde eine zerstörerische
Lebensform, entsprungen aus den Tiefen
des Weltraums, in einem langen, heftigen
Kampf von der Gradius-Armee ausgelöscht.
Doch in einer dunklen und unerfor ...
Best Price: 49.95 EUR (Hitmeister)
Options
Back



The product image is only displayed in a second step, independently of the decoded barcode and without reference to its positioning within the image section, always at the same screen position. Since at least features 1.8 (claim 1) and 1.9 (claim 10) are not fulfilled, the Barinsa app as shown in the Barinsa video is not novelty-destroying for claims 1 and 10.

c) The Chamber does not address a possible obvious prior use, as the defendant has not made any (concrete) submission on this. Rather, it stated that, in its view, this was not relevant. It was not necessary to comply with the request for a judicial indication to the effect that an obvious prior use must be submitted because the other arguments do not prevail. This is because the parties alone determine the subject matter of the legal dispute and the evidence supporting their submissions (Art. 43 UPCA).

The defendant limited the number of arguments it put forward against the legal status as required and in this respect no longer took up the argument of obvious prior use.

d) According to Art. 56 EPC, an invention is deemed to involve an inventive step if it is not obvious to a person skilled in the art from the prior art. Measured against this, the defendant's submission is not suitable to cast significant doubt on the existence of an inventive step.

aa) Whether an inventive step is recognised must always be assessed on a case-by-case basis and requires a legal assessment of all relevant facts and circumstances. An objective approach must be taken when assessing inventive step. The subjective ideas of the applicant or inventor are irrelevant. In principle, it is also irrelevant whether the invention is the result of chance or systematic work with (possibly costly and laborious) experiments. It is only relevant what the claimed invention actually contributes to the state of the art. The inventive step is to be assessed from the point of view of the person skilled in the art on the basis of the entire state of the art, including the general technical knowledge of the person skilled in the art. It is assumed that the person skilled in the art had access to the entire generally accessible state of the art at the relevant time. The decisive factor is whether the claimed subject-matter is derived from the prior art in such a way that the skilled person would have found it on the basis of his knowledge and skills, for example by obvious modifications of what is already known. In order to assess whether or not a claimed invention was obvious to a person skilled in the art, a starting point in the prior art must first be determined. Reasons must be given as to why the person skilled in the art would consider a certain part of the prior art to be a realistic starting point. A starting point is realistic if its teaching would have been of interest to a person skilled in the art who, at the priority date of the patent in suit, was seeking to develop a product or process similar to that disclosed in the prior art, i.e. having a similar basic problem to the claimed invention (see CoA Na- nostring/10x Genomics, p. 34 under "cc" in the original German version, "For a person skilled in the art who was faced with the task at the priority date of the patent in suit, [...] D6 was of interest"). There can be several realistic starting points. It is not necessary to determine the "most promising" starting point. If the claimed subject-matter is compared with the prior art after interpretation, the question then arises as to whether it would have been obvious for the skilled person to arrive at the claimed solution on the basis of a realistic disclosure of the prior art in view of the underlying problem. If it was not obvious to arrive at this solution, the claimed subject-matter fulfils the requirements of Article 56 EPC.

In general, a claimed solution is obvious if, on the basis of the prior art, the skilled person would be motivated (i.e. would have an incentive, see the reasons for decision in NanoString v. 10x Genomics, p. 34) to consider the claimed solution and implement it as the next step ("next step", reasons for decision in NanoString v. 10x Genomics, p. 35, second paragraph) in the development of the prior art. On the other hand, it may be relevant whether the skilled person would have anticipated particular difficulties in implementing the next step or steps. Depending on the facts and circumstances of the case, it may be permissible to combine prior art disclosures. A technical effect or advantage achieved by the claimed subject-matter compared to the prior art may be an indication of inventive step.

A feature that was arbitrarily selected from several possibilities cannot generally contribute to inventive step. A retrospective view must be avoided. The question of inventive step should not be answered by retrospectively searching for (combined) prior art disclosures from which this solution could be derived, knowing the patented subject-matter or the patented solution (UPC CFI 1/2023 ACT_459505/2023 (Central Chamber Munich), GRUR-RS 2024, 17255).

bb) Based on the Japanese patent specification JP 2009/093489 A (Annexes FR 11-12), the statements of the respondent do not give rise to any significant doubts as to the inventive step of claims 1 and 10.

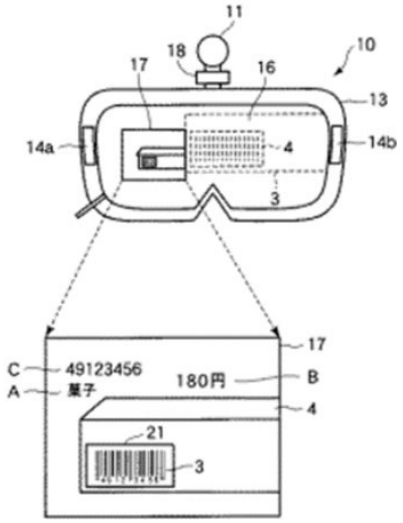
- The Japanese patent specification was published on 30 April 2009. It relates to a system with a terminal (e.g. a cash register of a retail shop) and a server that can be connected to the terminal via a network (see para. [0002]). The terminal is equipped with a product processing device that can read the barcodes applied to products, register product sales and process payments (cf. para. [0002]). The product processing device comprises a barcode scanner for this purpose (see paragraph [0002]). However, the barcode scanning process is laborious and not always reliable (cf. para. [0005]). The task of the present publication is therefore to improve the code reading process (cf. para. [0006]). To solve this problem, a product processing device is described, among other things. As described in paragraph [0007], this product processing device can include an imaging device and a
"Head-mounted display" (HMD). The imaging device captures, among other things, code information of the product, which is displayed to the customer with the HMD. Image processing can decode a product code contained in the code information. A product information acquisition collects product information based on the decoded code information. Finally, an information display shows the product information in the HMD.

The publication describes that the terminal comprises an HMD 10, a video camera 11 as an image recording device and an interface box 12 (see para [0011]). The interface box 12 is equipped with a computer with CPU, RAM, ROM, etc. and further comprises a transmitting and receiving unit.
/receiving unit 21 (see par. [0015]).

The image data captured by the video camera 11 is displayed in real time on the HMD 10 (see paragraphs [0015], [0016]). Frame data 21 is added to the displayed image data in rectangular form around the barcode 4 and is also displayed (see par. [0016]). The frame 21 around the barcode 4 serves the user to recognise that the barcode 4 has been successfully decoded. The patent description states in para [0033]:

"When the barcode 3 is identified, ..., frame data 21 formed, for example, in a rectangle surrounding the barcode 4 is added to the chapter image data. By visually checking that the frame data 21 has been added to the barcode 4 displayed on the monitor display unit 17, the cashier 15 can recognize that the product code of the product 3 has been obtained from the barcode 3..."

The HMD can therefore display product information belonging to the displayed barcode 4 in addition to the barcode 4. The product information can include the product name A of the product 'confectionery', the unit price B '180 yen' and the product code C '49123456', etc. This is shown in Figure 2 below:



The displayed product information is stored on the server (see section [0019]). This product information is obtained by the interface box 12 sending the product code to the server. The server uses the product code to search for the product information assigned to this product code (cf. Para. [0019]). The server sends back the found interface box 12.

After the product information associated with the barcode 4 is displayed, the user can confirm registration of the product for purchase. By confirming, the product is added to a purchase list and the total price is determined (see para. [0026], [0030], [0033]). According to the defendant, the confirmation, which takes place by looking at the product information, is a user input for the successfully decoded barcode within the meaning of the patent in suit. Adding the product to a shopping list and determining the total price are outputs of decoded messages for the barcode.

According to the defendant, the printed matter thus discloses all the features of claim 1. It merely does not expressly disclose that a product image is displayed as product information (feature 1.8 of claims 1 and 10). However, according to the defendant, the printed matter already describes that product information in the form of product name, price, product code, etc. is returned. The print thus already indicated that further or other product information could also be returned by the server for display. A product image merely represents further product information in addition to the product information mentioned (product name, price, product code). Returning a product image instead of or in addition to the product information already returned by the server is only one of many possible product information options. The integration of a product image does not require any adaptation of the Japanese print system. The database can be easily expanded with it and does not pose any difficulties for the specialist. This customisation is therefore within the control of the specialist. The fact that the Japanese patent specification is intended to make it easier for a cashier at a checkout to process a purchase does not call this into question. The same applies with regard to the fact that the cashier already has the product with the decodable symbol in front of him. It still makes sense for the cashier that the device displays a product image. A product image enables the cashier to carry out a plausibility check. The cashier can use the product image to check whether the decodable character has been decoded correctly. The cashier can use the

The applicant also states that the cashier should be able to check the product image to see whether the product has been incorrectly labelled (accidentally by a colleague or fraudulently by a customer). The applicant itself mentions that, according to the Japanese patent specification, the cashier should be able to check whether it has successfully scanned a product or whether an error has occurred. A check of the product name, the product price and the product group is mentioned. This is all about a plausibility check of the scanning process. A simple and obvious way to do this is to display a product image. The fact that the cashier has a specific product in front of them does not change this assessment. The situation is no different to that of the patent in dispute. There, too, the user always has at least one specific object in front of him at which he points the camera of his device.

Even if feature 1.8 is not directly and unambiguously disclosed, the Japanese patent specification suggests that further information is displayed after selecting a decoded character. This applies in particular with regard to the plausibility check already mentioned. The displayed product image could suggest that the scanning process was faulty. In this case, the cashier will want to check the result of the scanning process. A simple and obvious way to do this is to check further information on the (possibly incorrectly recognised) product.

- These statements did not convince the Board. Irrespective of the fact that the opponent of the application does not give any reason why the skilled person would use the Japanese script as a realistic starting point for his considerations on how to solve the problem according to the patent, the Japanese script is intended to simplify the scanning process for the cashier at the point of sale, whereby the cashier holds the product to be scanned in his own hands. The cashier therefore knows which item they are scanning, which also has a single barcode. This barcode is shown on the HMD 10 ("head mounted display") along with information relevant to the checkout process, such as the product name, product price and product code, but nothing else. This is because the task addressed by the text does not require the display of any other information, let alone product images. The respondent has not presented any reason, and no such reason is otherwise apparent, why the specialist should extend the HMD to the effect that, in addition to the real image of the product on the checkout belt and the other information that already serves to verify the correctness of the scanning process, a product image retrieved from a database should also be virtually displayed on the HMD for the cashier. Insofar as the defendant also bases its argumentation on the disclosure of the patent specification, this should not be taken into account because this would lead to an inadmissible retrospective view.

Irrespective of this, feature 1.9 (1.10 in claim 10) is also not directly and unambiguously disclosed. Nowhere is a user input in the sense of the patent disclosed. The view of the cashier on the product information referred to by the defendant cannot be recognised by the system and therefore cannot constitute user input. The defendant's submission on obviousness in relation to feature 1.9 is also not convincing. It would be absurd for a person skilled in the art, on the basis of this document, to provide a user input whereby, in response to this input, further information relating to the decoded character is displayed in addition to the product name, the unit price, the product code and the product image from the database (feature 1.8 in claim 1, 1.9 in claim 10). It has not yet been submitted what further information this could usefully be.

or how this abundance of images and information could all fit into the display and be profitably captured by an average cashier. According to the Japanese script, all the necessary information about the product is already displayed automatically as a result of the decoding process. User input is therefore not necessary. Rather, the system assumes that the scanning process as such is the only action with which the cashier sends information to the system. Against this background, the cashier's work process should be simplified so that he or she has to carry out as few actions as possible. It would run counter to this objective if the cashier had to make an additional user input beyond the scanning process and the viewing of the displayed information in order to obtain even more information (which information?) regarding the decoded character. In this respect, too, the document teaches away from the subject matter of the patent in suit.

IV. Necessity

The Order for provisional measures is necessary to prevent the continuation of the infringement or at least to prevent an imminent infringement (see R. 206.2 (c) RoP).

According to the Rules of Procedure, both temporal and factual circumstances are relevant for the necessity of ordering provisional measures. In addition to R. 209 No. 2 (b) RoP ("urgency"), the relevance of temporal circumstances also results in particular from R. 211 No. 4 RoP, according to which the court takes into account unreasonable delays in applying for interim measures. The fact that factual circumstances must also be taken into account when deciding on the Order for provisional measures results, for example, from
R. 211 No. 3 RoP, according to which the possible damage that the applicant may suffer must also be taken into account when deciding on the application for an injunction. In contrast, the potential damage to the defendant must be taken into account when weighing up the interests (UPC_CFI_2/2023 (LK München), Order of 19 September 2023, GRUR 2023, 1513, 1525 - Nachweisverfahren).

1. Due to the circumstances in this case, the Order of the requested provisional measures is urgent in terms of time (R. 209.2 (b) RoP).

a) The temporal urgency required for the ordering of provisional measures is only lacking if the injured party has behaved so laxly and hesitantly in pursuing their claims that, from an objective point of view, it must be concluded that the injured party is not interested in the swift enforcement of their rights, which is why it does not appear appropriate to allow them to take advantage of provisional legal protection (cf. also UPC_CFI 2/2023 (LK München), Order of 19 September 2023, 1513, 1524 - Nachweisverfah- ren).

Pursuant to R. 213.2 RoP, the court may, as part of the decision-making process, order the applicant to submit all reasonably available evidence in order to satisfy itself with reasonable certainty that it is entitled to initiate the proceedings pursuant to Art. 47 UPCA, that the patent in question is valid and that its right is infringed or threatened to be infringed. In summary proceedings, the applicant must regularly respond to such an Order within a short period of time, which requires appropriate preparation of the

proceedings. Therefore, the applicant only needs to apply to the court if he has reliable knowledge of all the facts that make legal action in the proceedings for an Order for provisional measures promising and if he can credibly establish these facts. The applicant may prepare himself for every possible procedural situation that may arise in the circumstances in such a way that he can present the requested information and documents to the court in response to a corresponding Order and successfully respond to the arguments of the defendant. In principle, the applicant cannot be instructed to only carry out subsequent investigations during ongoing proceedings if necessary and to procure the necessary documents retrospectively if necessary. On the other hand, the applicant must not delay unnecessarily. As soon as he is aware of the alleged facts of the infringement, he must investigate them, take the necessary clarification measures and obtain the documents required to support his claim. In doing so, he must take the necessary steps in a targeted manner and bring them to a conclusion. As soon as the applicant has all the knowledge and documents that reliably enable a promising legal action, he must submit the application for an order for provisional measures within two months (UPC_CFI_443/2023 ACT_589207/2023 (LK München), LS 1; also within one month: UPC_CFI_452/2023 (LD Düsseldorf), Order of 9 April 2024, GRUR-RS 2024, 7207, para. 128).

b) Based on these principles, the applicant treated the matter with the necessary urgency. This is because the application was filed on the same day on which the registration of the unitary effect became effective. The applicant could not have successfully asserted the patent in dispute earlier. Insofar as the defendant refers to parallel US property rights, it is known to the court that in the United States of America, due to the case law of Merck v. eBay, injunctive relief can currently only be obtained in exceptional cases, even in main proceedings. The defendant has not argued that such an exceptional situation can be assumed in the present case. A possible injunction issued by a US court would also have no effect on the territory of the contracting member states of the UPCA.

2. The Order for provisional measures is also necessary from a factual point of view due to the damage threatened to the applicant by the defendant's infringing product range.

The applicant would be threatened with considerable damage if it could only enforce its claim for injunctive relief by way of proceedings on the merits. The parties are competitors in the sale of readers and software for decoding barcodes. According to the defendant, it supplies six of the ten leading Fortune 500 companies and its technology is currently used on more than 150 million devices. This leads to an almost irreversible loss of market share for the applicant. The marketing activities of the defendant are therefore likely to cause considerable, in particular long-term damage to the applicant by indirectly reducing the applicant's market share. This reduction in the applicant's market opportunities cannot be compensated in purely monetary terms. The injunction patent loses its term every day without the possibility of enforcement, within which the protection of the applicant's own sales opportunities is guaranteed by the exclusive right of the injunction patent. This temporal value of the patent of disposition is irreversible. In addition, with regard to the purchasers of bar

code scanner products, it cannot be assumed that there will be a quick willingness to switch to products from another manufacturer, namely the applicant. A company that has focussed its operations on a specific scanner and the corresponding scanner software and, in particular, has trained its employees on a specific user interface of the software, will refrain from purchasing a different scanner product in the short and medium term. This is because this would mean a changeover effort in operational processes and a training effort for employees, which the companies in question are trying to avoid from a business point of view.

These damages cannot be compensated in money either, so that the requested authorisation to continue the patent infringement against the provision of security is out of the question.

On the other hand, the damages that the defendant is threatened with if the requested provisional measures are ordered do not go beyond what a patent infringer regularly has to realise. In view of the security ordered, these can largely be compensated with money. In detail:

a) The loss of sales suffered by the defendant as a result of not being allowed to offer or supply the SDK unchanged for the patented purposes for the duration of the injunction will be covered by the security deposit, as will any costs for adapting the SDK and the documentation. The amount of the security follows the defendant's application.

b) The same applies to any damage suffered by the defendant during the period of validity of the injunction due to the satisfaction of claims for damages by its customers.

c) Insofar as the defendant argues that its reputation has been damaged in a way that is almost irreparable and that it has therefore also lost the opportunity to attract new customers, these are also regular consequences of a judgement to cease and desist, which, insofar as they cannot be compensated for with money, must be included in the balancing of interests. In the present case, the balancing of interests is in favour of the applicant.

V. Weighing of interests

The balancing of interests to be carried out is also in favour of the applicant.

1. Pursuant to Art. 62(2) UPCA (R. 211 no. 3 RoP), the court has discretion to weigh the interests of the parties with regard to the issuance of the Order or the rejection of the application; in doing so, all relevant circumstances must be taken into account, in particular the possible damage that the parties may suffer as a result of the issuance of the Order or the rejection of the application for an Order. The degree of probability to which the court is convinced of the existence of the individual circumstances to be weighed up is also decisive for the exercise of discretion. The more certain the court's conviction is that the rights holder is asserting the infringement of a valid patent, that there is a need to issue an injunction due to factual and temporal circumstances and that this is not precluded by possible damages to the opponent or other justified objections, the more likely it is that the issuance of an injunction is justified.

On the other hand, the sooner there are relevant uncertainties with regard to individual circumstances relevant to the balancing of interests that are detrimental to the court's conviction, the court will have to consider as a more lenient measure the admission of the continuation of the alleged infringement subject to the provision of security or even the dismissal of the application (UPC_CFI_2/2023 (LK München), Order of 19 September 2023, 1513, 1525 f. - Nachweisverfah- ren).

2. Having said this, the issuance of the requested Order is also justified after weighing up the interests involved.

Since the respondent was not able to significantly deny an indirect infringement of patent claim 1 and patent claim 10 of the patent in suit in the summary proceedings, the local division is convinced on summary examination of an indirect infringement of the patent in suit by the actions of the respondent. Moreover, the defendant has not succeeded in creating significant doubts as to the legal validity of the patent in suit. Finally, the local chamber is also clearly convinced that the Order for interim measures is necessary in the present case due to the infringement of the patent in dispute, both in terms of substance and in terms of time.

Against the background of the established infringement of the patent in suit, the defendant has no legitimate interest in offering or supplying the accused embodiment indirectly infringing the patent in suit in the territory of the EPC treaty states.

The disadvantages for the applicant that cannot be compensated in monetary terms in the event of a referral to the main proceedings are offset by the disadvantages for the defendant that cannot be compensated in monetary terms if the injunction requested is issued. In such a situation, the interests of the patent proprietor are regularly to be given preference (UPC_CFI_2/2023 (LK München), Order of 19 September 2023, GRUR-RS 2023, 25256 - Nachweis- verfahren, para. 270), as is the case here, especially since the defendant has conceded that it is possible and useful to use the SDK even without the patent-compliant functionality and that an adaptation of the SDK is possible in principle. In view of the early approach of the applicant to the defendant in May 2019 (Annex FR 19), at that time still with reference to the parallel US patent 9208367, the defendant acted at its own risk if it offered and distributed the SDK unchanged in the territory of the contracting member states in the knowledge of the US patent. This is because it could have taken note of the application for the patent in dispute published on 18 August 2021 and drawn the necessary conclusions from it.

VI. Legal consequences

The Munich local division is convinced with the certainty required for the ordering of provisional measures that the defendant, by offering and supplying the SDK within the scope of the patent in dispute, is making unlawful indirect use of the technical teaching protected by patent claim 1 and patent claim 10 of the patent in dispute. Likewise, the legal validity of the patent in suit is secured to the extent necessary for the Order of provisional measures. Since the Order for provisional

measures are also necessary both in terms of time and substance and, moreover, the balancing of interests is in the applicant's favour, the following legal consequences arise:

1. The Court, exercising its discretion (R. 209.2 RoP), considers the issuance of a preliminary injunction to be appropriate and justified (Art. 62(1), 26(1) UPCA). Only an injunction takes into account the applicant's interest in the effective enforcement of the patent in dispute. The respondent's interest in the continuation of distribution - even if security is provided - must take second place for the reasons stated.

2. Under the circumstances of the present case, it is justified to issue this injunction as an absolute prohibition, as requested.

a) In the case of an injunction to prevent contributory patent infringement, it must always be considered whether a relative prohibition or an absolute prohibition should be issued in view of the remaining possibilities for the patent infringer to offer or supply the essential means for other, non-infringing purposes. In particular, it must be considered whether the risk of direct patent infringement by the customers of the indirect patent infringer can be sufficiently averted by a relative prohibition, for example on the basis of warnings, and whether and with what effort it appears possible to redesign the means in such a way that it is deprived of its suitability for use in accordance with the patent.

b) In the present case, it is undisputed that it is possible for the defendant to remove the disputed function from the programme library it distributes and from the corresponding advertising statements by means of an update. This would not render the SDK unusable, but would continue to provide a large number of non-infringing functionalities. According to the defendant, this would even be the main focus of the functions. Furthermore, it is much more difficult to control the behaviour of a large number of customers, especially since the software developed with the SDK will mostly be used within the customers' internal operations. Taking these circumstances into account, the Chamber considers an absolute prohibition to be justified in the present case. The amendment of the SDK is possible and also justified in view of the described problems of controlling the lawful behaviour of the customers.

c) When formulating the cease and desist order, it had to be emphasised that the SDK in particular is covered by the prohibition as a means of creating operating software. A partial rejection is not associated with this.

3. The threat of penalty payments in the event of non-compliance is based on R. 354.3 RoP. The number of days is already a fixed figure for calculating the penalty payments. The setting of a maximum limit per day of non-compliance gives the local authority the power to impose fines.

However, in the event of an offence, the Chamber has the necessary flexibility to also take into account the behaviour of the infringer and, based on this, to be able to impose an appropriate penalty payment in accordance with R. 354.4 RoP.

4. However, a direct infringement of claim 1 of the patent in suit cannot be established, at least according to the current state of facts and disputes. Therefore, the application for the ordering of provisional measures had to be rejected in this respect.

VII. Security deposit

1. Pursuant to R. 211.5 RoP p. 1, the court may require the provision of adequate security for the defendant for the damage that the defendant is likely to suffer in the event that the court cancels the order for provisional measures. According to the case law of the Munich Local Court, e.g. in the case of 10x Genomics v. NanoString, there is no reason to do so in bilateral preliminary injunction proceedings if no particular difficulties are to be expected in connection with the enforcement of any title for damages, both in view of the applicant's economic situation and in view of the enforcement law in the applicant's home state (UPC_CFI 2/2023 (LK Mün- chen), Order of 19 September 2023, 1513, 1524 - Nachweisverfahren).

2. In the present case, unlike the defendant in the 10x Genomics case, the defendant argued at the hearing that proceedings for the recognition and enforcement of a foreign claim for damages in the United States of America would result in considerable legal costs which, even if successful, would not have to be reimbursed by the debtor. The applicant has not commented on this. This submission by the defendant is therefore deemed to be undisputed in the present proceedings (Rule 171.2 RoP). Since full compensation is owed to and must be ensured for the party seeking injunctive relief, such non-refundable legal costs must be taken into account if they are significant. This aspect leads to the local division exercising its discretion to order the provision of security.

3. As far as the amount of the security deposit is concerned, this should cover the legal costs, other costs of enforcement and possible compensation for damages incurred or likely to be incurred, R. 352.1 RoP. In the absence of any contrary submissions by the applicant, the local division shall set the security at the amount of € 500,000.00 requested by the defendant at the hearing.

4. According to R. 211.5 RoP p. 3, the court decides whether the security is to be provided by deposit or by bank guarantee. The local division exercises the discretion thus granted to it to the effect that the security is to be provided by deposit. This relieves the parties and the court of the need to discuss the matter.

The question of which bank is suitable as guarantor and which guarantee conditions appear to be sufficient to fulfil the purpose of the guarantee. It is neither argued nor otherwise apparent that this discussion does not need to be held in the present case.

VIII. Costs

There is generally no reason for a basic decision on costs in proceedings for the Order of interim measures if the summary proceedings - as here - are followed by proceedings on the merits. Since the partial defeat of the applicant side is not economically significant, no exception to this principle can be made in the present case.

1. Even if the Court of Appeal has not yet had to deal in detail with the question of the reimbursement of costs in summary proceedings, it has already recognised that a basic decision on costs is not required in every case. If a decision is not a basic decision "final order" or a "final decision", the court of appeal can, in the opinion of the court of appeal, only determine in the context of a later final decision whether and to what extent a party must bear the costs of the other party because it has lost within the meaning of Art. 69 UPCA (UPC_CoA_433/2023, UPC_CoA_435/2023; UPC_CoA_436/2023; UPC_CoA_437/2023; UPC_CoA_438/2023, Order of 3 April 2023, headnote 2). Such a procedure is at least also appropriate if - as here - the summary proceedings are followed by proceedings on the merits. For an analogous application of R. 118.5 RoP, there is already a lack of an unintended regulatory gap as a basic prerequisite for such an application (UPC_CFI_452/2024 (LK Düsseldorf), Order of 9 April 2024, headnote 2 and p. 34 f., GRUR-RS 2024, 7207, para. 161 - 163; a.A.: UPC_CFI_249/2023 (LK Munich), Order of 19 December 2023, headnote, GRUR-RS 2023, 40572).

2. In the present case, the defendant partially prevailed; the application for injunctive relief aimed at a direct infringement of claim 1 was rejected. However, the auxiliary application for indirect infringement of claim 1 was successful, and an injunction was issued in this respect. Therefore, the partial dismissal is not economically significant. The defendant can therefore be expected to wait for the main proceedings.

ORDER

I. The defendant is ordered to refrain from doing so,

1. Third parties in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia

   Means, namely software, namely the SDK, suitable and intended to be used as operating software or to create operating software for character reading devices, comprising: one or more processors; a memory; an imaging subsystem,

configured to capture an image of decodable characters; a display; and a communication interface, wherein the device is configured to:

in response to capturing an image of one or more objects within a field of view of the imaging subsystem, locating and decoding one or more decodable characters within the image; displaying the image on the display; and visually identifying the one or more successfully decoded decodable characters; displaying a product image at a location of an associated image representation of each of the one or more successfully decoded decodable characters, said product image being associated with the successfully decoded decodable characters by said device based on a look-up table retrieved from a database; in response to accepting a user input selecting at least one successfully decoded decodable character of the displayed one or more successfully decoded decodable characters, at least one decoded message corresponding to the at least one selected successfully decoded decodable character, and/or at least one product image associated with the at least one selected successfully decoded decodable character, and/or outputting data determined when the at least one selected successfully decoded decodable character is decoded,

for use in one or more of these countries. (indirect infringement of claim 1 of EP 3 866 051 B1)

2. Third parties in the territory of the Kingdom of Belgium and/or the Republic of Bulgaria and/or the Kingdom of Denmark and/or the Federal Republic of Germany and/or the Republic of Estonia and/or the Republic of Finland and/or the French Republic and/or the Italian Republic and/or the Republic of Latvia and/or the Republic of Lithuania and/or the Grand Duchy of Luxembourg and/or the Republic of Malta and/or the Netherlands and/or the Republic of Austria and/or the Portuguese Republic and/or the Kingdom of Sweden and/or the Republic of Slovenia

   Means, in particular software, in particular the SDK, which are suitable and intended as operating software or for the creation of operating software for character reading devices, which are suitable and intended for carrying out a character reading method, the method comprising

   Providing a character reading device comprising: one or more processors; a memory; an imaging subsystem configured to capture an image of decodable characters; a display; and a communication interface; in response to capturing an image of one or more objects within a field of view of the imaging subsystem, locating one or more decodable characters within the image and decoding; displaying the image on the display and visually labelling the one or more successfully decoded decodable characters; associating each of the one or more successfully decoded characters with a product image based on a lookup table retrieved from a database; and

belle; displaying the product image at a location of an associated image representation of each of the one or more decodable characters, and in response to accepting a user input selecting at least one decodable character of the displayed one or more decodable characters, outputting at least one decoded message corresponding to the at least one selected decodable character and/or at least one product image associated with the at least one selected decodable character and/or data determined when the at least one selected decodable character is displayed, corresponding to the at least one selected decodable character, and/or at least one product image associated with the at least one selected decodable character, and/or data determined when the at least one selected decodable character is decoded,

for use in one or more of these countries. (indirect infringement of claim 10 of EP 3 866 051 B1)

II. For each violation of the above Order, the defendant must pay the court a (possibly

repeated) penalty payment of up to EUR 100,000.00 for each day of the violation.

III. In all other respects, the application for an Order for provisional measures is dismissed.

IV. The application of both parties to order the other party to pay the costs or to reimburse the costs is rejected.

V. This Order is only enforceable for the applicant if she has provided security in favour of the respondent in the form of a deposit in the amount of EUR 500,000.00.

INFORMATION ABOUT THE APPOINTMENT
Both parties may appeal against this Order within 15 days of its notification (Art. 73(2)(a), 62 UPCA, R. 220.1(c), 224.2(b) RoP).

INFORMATION ON ENFORCEMENT (ART. 82 EPGÜ, ART. ART. 37(2) EPGS, R. 118.8, 158.2, 354, 355.4 ROP):
A certified copy of the enforceable judgement or enforceable Order is issued by the Deputy Registrar on application by the enforcing party, R. 69 RegR.

ORDER DETAILS

Order No.	ORD_46277/2024
PROCEDURE NUMBER:	ACT_9216/2024
UPC number:	UPC_CFI_74/2024
Type of application:	Application for provisional measures (Rule 206 of the Regulation)

Issued in Munich on 27 August 2024

Dr Zigann Presiding judge and judge-rapporteur	Matthias ZIGANN signed by Digital Matthias ZIGANN Date: 2024.08.27 10:05:54 +02'00'
Kupecz legally qualified judge	András Ferenc Kupecz Digitally signed by András Ferenc Kupecz Date: 2024.08.27 10:16:57 +02'00'
Pichlmaier legally qualified judge	Tobias Günther Pichlmaier Digitally signed by Tobias Günther Pichlmaier Date: 2024.08.27 10:22:44 +02'00'
for the Deputy Chancellor	Florian Zintl Digital signed from Florian Zintl Date: 2024.08.27 10:32:28 +02'00'