



Local division Munich
UPC_CFI_114/2024
UPC_CFI_448/2024

procedural order
of the Court of First Instance of the Unified Patent Court local division
Munich
issued on 25 September 2024

PLAINTIFFS

- 1) Heraeus Electronics GmbH & Co. KG**
- 2) Heraeus Precious Metals GmbH & Co. KG**

represented by: Paul Szynka (CBH)

DEFENDANT

Vibrantz GmbH

represented by: Christian Paul (Jones Day)

PATENT IN SUIT

European Patent No. 3 215 288

JUDICIAL BODY/CHAMBER

Panel 1 of the Munich local division

PARTICIPATING JUDGES

This Order was issued by presiding judge Dr Matthias Zigann as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS

German

OBJECT

Action for infringement - R 263 RoP

APPLICATIONS BY THE PARTIES

The applicant claims that the Court should:

The amendment of the applications pursuant to Annex CBH 25 is authorised:

Anlage GBH 25

Anlage Klagensachenr. 19.08.2024
 UPC_CFI_114/2024
 Dr. Heidegger, Herr
 GBH Rechtsanwälte

- I. The European patent EP 3 215 288 BI has been infringed by the defendant.
- II. The defendant is ordered, on pain of a penalty payment of EUR 5 000 for each product, to

u n d e r l a s s ,

111a Metal sintering preparations which comprise

- 1.1 (A) 50 to 90 % by weight silver,
 - 1.1.1 which is present in the form of particles, the metal particles having the form of flakes or an irregular shape,
 - 1.1.2 wherein the metal particles have a coating comprising at least one organic compound selected from the group consisting of free fatty acids, fatty acid salts and fatty acid esters, and
- 1.2 (B) 6 to 50 % by weight of one or more organic solvents selected from the group consisting of

Terpineols,
 N-methyl-3-pyrrolidone. Ethylene glycol,
 dimethylacetamide,
 1-tridecanol, 2-tridecanol,
 3-Tridecanol,
 4-Tridecanol,
 5-Tridecanol,
 6-Tridecanol,
 Isotridecanol.
 1-hydroxy-C16-C30-alkanes which are unsubstituted except for a methyl substitution at the penultimate carbon atom
 dibasic esters,
 Glycerine, diethylene glycol,
 Triethylene glycol and
 aliphatic hydrocarbons containing 5 to 32 carbon atoms, wherein
- 1.3 the mathematical product of
 - 1.3.1 Tapped density of the metal particles of component (A). determined according to DIN EN ISO 787-11 1995-10.
 - 1.3.2 specific surface area of the metal particles of component (A). determined according to DIN ISO 9277 : 2014-01.
 - 1.3.3 is in the range of 50,000 to 80,000 cm³

in the French Republic and the Italian Republic

to manufacture, offer, place on the market or use or possess for these purposes,

(Infringement of claim 1 les ff nnzn i r.wen urJrJ itz.llel ll r.wen ! part of EP'288)

and

II 1b Metal sintering preparations according to 11.1a

above in the Federal Republic of Germany

to offer, place on the market or use or for these purposes
to own

if these are intended to be used for the fixed connection of components

(Infringement of claim 1 of the German part of EP'288)

II 1b' AID to item II 1b

Metal sintering preparations according to item II 1a

above in the Federal Republic of Germany

to be prepared in such a way that they are recommended for use in the
permanent connection of components

especially when this happens with the words

"Low Temperature Sintering Silver Paste"

and/or

"-especially designed for metallisation for chip bonding at low
temperature"

and/or

"Low Temperature Sintering" and/or

"low temperature bonding technology"

to offer, place on the market or use such metal sintering preparations or to
possess them for these purposes

(Infringement of claim 1 of the deutch part of EP'288)

and

11.2 Metal sintering preparations according to above

in the Federal Republic of Germany, the French Republic and the Italian Republic

Third parties for use in the Federal Republic of Germany, the French Republic
and the Italian Republic

to offer or deliver.

wenn diese dazu geeignet sind in einem Verfahren zum Verbinden von Bauelementen verwendet zu werden bei dem man eine Sandwichanordnung bereitstellt die wenigstens ein Bauelement 1 ein Bauelement 2 und eine Metallsinterzubereitung nach vorstehender Ziff II 1a die sich zwischen Bauelement 1 und Bauelement 2 befindet, aufweist und die Sandwichanordnung sintert.

(Verletzung des Anspruchs 5 des deutschen bzw. des Anspruchs 6 des französischen und italienischen Teils der EP'288)

especially if

this 'Section _____ II.?' in the form of the sintering paste 6380 0130 ("Low Temperature Sintering Silver Paste").

- III. The defendant is further ordered, on pain of a penalty payment of EUR 1,000 for each day of delay, to comply with the provisions of R. 118.8 within 45 days of service of the judgment,
- 1 to provide the plaintiff, in a list structured for each month of a calendar year and by infringing product from 13 September 2017, with all relevant information on the products referred to in No. II above, in order to identify all infringing products on the market for recall and destruction and their current or former owners and to calculate damages, including the defendant's profit from 13 August 2018, and for the calculation of reasonable compensation for the territory of the Federal Republic of Germany from 13 September 2017 to 28 August 2018, in particular by providing information on
 - (a) the origin and distribution channels of the products,
 - (b) the quantities produced, manufactured, delivered, received or ordered and the prices paid for the products;
 - (c) the identity of all third parties involved in the manufacture or distribution of the products;
 - 2 to disclose to the plaintiff its accounts to prove the information provided in accordance with No. III.1. by making them available for each month of a calendar year and for each infringing product in electronic form that can be analysed with the aid of a computer:
 - (a) Evidence of the number and dates of products manufactured:
 - (b) Invoices - or, if these are not available, delivery notes - for the individual deliveries, broken down by quantities offered, offer periods, prices of the goods offered and type designations as well as names and addresses of the commercial recipients of the sales offers for all products sold or otherwise disposed of:

(c) Evidence of the advertising carried out, broken down by advertising medium, its distribution, the distribution period and the distribution area: including evidence of these advertising activities:

and for the period from 30 August 2018 additionally

(d) the boxes, broken down by individual box factors and the box factors achieved. Win;

(e) Invoices - or, if these are not available, delivery notes - and corresponding statements of all costs incurred, on which the defendant relies in calculating its profits:

the accuracy of which is checked and confirmed by a sworn auditor appointed by the plaintiff at the defendant's expense, whereby the auditor is obliged to maintain confidentiality vis-à-vis the plaintiff beyond the above-mentioned information;

3. any product directly or indirectly in its possession or ownership referred to in No. II. shall be handed over to a judicial officer to be appointed by the plaintiff for the purpose of destruction on the defendant's behalf;

4. recall the products referred to in point II. and permanently remove them from the distribution channels and inform the third parties from whom the products are to be recalled that this Court has found that the product infringes European patent EP 3 215 288 B1, whereby the defendant must give the third parties a binding undertaking to reimburse the costs incurred, to bear the packaging and transport costs incurred, to reimburse the customs and storage costs associated with the return of the products and to take back the products

IV. The plaintiff is authorised to publish the decision or excerpts thereof on the defendant's box with a maximum amount of EUR 20,000.00 within 14 days.

V. The defendant is ordered to pay to the plaintiff

1. EUR 250,000.00 as provisional damages, which will be adjusted if the actions mentioned under No. II continue;
2. any further damage incurred by Heraeus Precious Metals GmbH & Co. KG, Herausstraße 12-14, 63450 Hanau, Germany, for all past acts pursuant to No. II until 31 July 2023 and by the plaintiff for all past and future acts committed since 1 August 2023 pursuant to No. II or to be incurred in the future,
3. to pay appropriate compensation for all acts according to No. II in the Federal Republic of Germany for which compensation is not already payable according to No. V.2.

vi. The defendant is ordered to pay the costs and expenses of the proceedings.

VII In the event that the defendant does not reply or fails to take other ordered procedural steps, we apply for a default judgement pursuant to R. 355.

The defendant claims:

- 1. The applicant shall bear the costs of the proceedings to the extent of the action withdrawn in accordance with point II 1b.*
- 2. The plaintiff's application of 5 June 2024 for leave to extend the action pursuant to Rule 263.1 RoP to include the applications specified in the document of 5 June 2024 pursuant to application II.1b' (meaningful preparation with "in particular" application) and II.2 (indirect infringement) is not granted.*
- 3. The deadline for filing a statement of defence and the deadline for filing an action for annulment will be extended until 29 July 2024.*

PRESENTATION BY THE PARTIES

The plaintiff argues that the requested amendment of the action reflects, on the one hand, the changed subject matter of the claim due to the withdrawal of the revocation appeal of the present defendant against the German part of the patent in suit and, on the other hand, that the requested amendment of the action is intended to extend the action to include the indirect infringement of the procedural claim.

The requested amendment to the action was not to be taken into account in the original action, as the national proceedings on the substance of the law had not yet been concluded and the the version of the claim asserted in the action was pending there with the cross-appeal. The amendment to the action was only recognised by the legally binding termination of the of the national nullity proceedings has become necessary. This also applies to the current assertion of the indirect infringement of the procedural claim. At the time the action was brought, there was no reason to do so, as the defendant was to be ordered to cease and desist due to the use of the substantive claim. Since the withdrawal of the appeal meant that a use claim was now to be asserted with regard to the Federal Republic of Germany, on the treatment of which in infringement proceedings no case law had yet been established in the UPC (as far as could be seen), the assertion of indirect infringement served as a precautionary measure to safeguard the plaintiff's claims with regard to the defendant's distribution of the attacked embodiments. The plaintiff had prepared the application to amend the action immediately after its sister company had been served with the order of the BGH terminating the proceedings.

The defendant argues that the plaintiff's applications should be classified as a mere clarification of the wording of the application (application II.1.a), a withdrawal of the action triggering costs (II.1b, II.1b', III.) and in part as an inadmissible extension of the action (II.2, III.).

The amendments in the application under point II.1a were merely clarifying with regard to the French and Italian parts of the patent in suit. The defendant therefore does not oppose these amendments any further.

The new version of the applications in section II.1b is admissible as a withdrawal of the action, but leads to the plaintiff bearing the costs to the extent of the withdrawal.

In connection with the auxiliary request according to item II.1b', there is an inadmissible extension of the action. In the German nullity proceedings, the plaintiff had already cited the

patent in suit in its

In its statement of grounds of opposition of 17 March 2022, the plaintiff only defended its claim in the version now asserted, which was ultimately also confirmed by the Federal Patent Court in its judgment of 7 November 2023. The plaintiff itself did not initially lodge an appeal, but only on 15 March 2024 - i.e. three days after the action was brought in these proceedings on 12 March 2024 - cross-appeal filed. Why the plaintiff did not already file an auxiliary request in line with the version of the patent in suit already confirmed by the Federal Patent Court when filing its action is not apparent in this respect and is also not justified by the plaintiff. The plaintiff could therefore have filed the now filed auxiliary request "earlier" with due care and consideration of its own procedural behaviour - e.g. also as an auxiliary request conditional on the entry into force of the judgement of the Federal Patent Court. Finally, the plaintiff's statement of grounds also remained incomplete in this respect, which in turn could justify the rejection of the auxiliary request. Furthermore, the "in particular" application was also not admissible. So-called.

"In particular" applications would have no influence on the material scope of the operative part. Admission is therefore also prohibited for this reason.

With the application in No. II. 2, the plaintiff asserts for the first time the indirect infringement of claim 5 of the German and claim 6 of the French and Italian part of the patent in suit and justifies the extension of its request with the entry into legal force in the German proceedings. This is not to be followed. Firstly, the decision in the German proceedings does not result in any change for the other patents in France and Italy as a result of the German proceedings, which are independent of them. Even in the German proceedings, the plaintiff had already limited itself to defending the German patent in its current version since its statement of opposition of 17 March 2022. The plaintiff had therefore been aware long before filing the action that an indirect patent infringement could become necessary. According to the plaintiff's own explanations, there had been no change in the legal situation to date. Moreover, the plaintiff based its application solely on the changed situation in Germany. For the French and Italian parts, there were already no deviations at all in this respect, so that no grounds for the amendment of the action had already been submitted for the French and Italian parts.

Finally, the plaintiff overlooks the fact that its amendments to the main applications also lead to an extension of the subject matter of the dispute with regard to the related applications in section III. In this respect, the plaintiff already justifies its extension which should therefore be rejected for this reason alone. Furthermore, it was also not recognisable in this respect why a corresponding application had not been possible earlier.

In addition, the defendant is threatened with an obstruction of the conduct of the proceedings because further effort is required for the defence with regard to the acts of infringement now asserted. The defendant would have to completely re-examine corresponding actions with regard to possible objections and proportionality considerations, which in turn would tie up time and resources.

The plaintiff submits in this regard that the defendant does not justify what the extension of the claim should be. It is correct that the application under point II.1b' is not directed at mere use, but at meaningful preparation. However, this differentiation does not constitute an extension of the claim, as the previous application for injunctive relief was not limited to use. In fact, the meaningful figuration

("Recommendation for the firm bonding of components") as part of the original application for an injunction. The action sought (inter alia) an injunction against acts of offering with regard to the sintering pastes covered by the patent in suit. Now it was requested that the sintering pastes according to the patent in suit should not be recommended for the permanent bonding of components or that metal sintering preparations prepared in this way should not be offered. A surplus of content was neither shown nor apparent. This is also confirmed by the following comparative consideration: The application under No. II.1b was directed, inter alia, to the omission of offering sintering pastes according to the patent in suit (if these are suitable for firmly joining components, which already follows from the realisation of the spatial-physical claim features). According to the unanimous opinion of the parties, the application under item II.1b was an auxiliary application to this, thus also forming a "minus" from this point of view. Against this background, there is no need to decide whether auxiliary requests are generally subject to admissibility pursuant to R. 263 VfO.

The defendant's submission on the "in particular" applications (SSTZ, p. 6 para. 2) is not entirely comprehensible. Neither does the case law of the Mannheim Regional Court appear to be of particular importance to the court, nor does the inclusion of non-materially restrictive formulations in the application lead to the inadmissibility of the application, let alone the inadmissibility of the application.

than the amendment. On the contrary. The decision of the Mannheim Regional Court (7 O 145/09 BeckRS 2010, 21526 - covenant not to sue) primarily concerned the "in particular" assertion of sub-claims. Moreover, it does not state that such an application is inadmissible (although this is also not a question of R. 263 VfO, but at most of R. 13.1 (k)

VfO), but only that the court is free not to include them in the operative part of the judgement, i.e. to choose a broad operative part (cf.

Case law also BGH GRUR 2012, 945, para. 22 - Tribenuronmethyl). However, the court seized and competent in this case included "in particular" formulations in the operative part if this served - as here - to specify the infringing acts (Order of 3 July 2024 UPC_CFI_7/2023 ACT_459767/2023 ORD_598324/2023 - Franz Kaldewei / Bette; Order of 21 May 2024 UPC_CFI_443/2023 ACT_589207/2023 ORD_598328/2023 - Franz Kaldewei / Bette).

SharkNinja / Dyson). However, even if the court were to have admissibility concerns, these would have to be dealt with in accordance with R. 111 (b), 334 (c) VfO and not R. 263.2 VfO.

The defendant's submission on the possibility of an earlier assertion (SSTZ, p. 6 para. 1) is also not comprehensible from the outset: For the sake of good order, it should first be clarified that the defendant's assertion that the plaintiff only filed a cross-appeal in the German nullity proceedings after the infringement action was filed here (SSTZ p. 6 para. 1) is false - this is already apparent from the file. The plaintiff had filed a cross-appeal on 12 March 2024 - before the present action was filed on the same day (Annex CBH 09; cf. action, para. 14). On 15 March 2024, the plaintiff again filed a cross-appeal as a precautionary measure (Annex CBH 26, cf. application for amendment of the action, para. 2), after the Chairman of the X. Civil Senate had expressed concerns about admissibility. All of this is irrelevant for the present proceedings. It is correct that the use claim was introduced with the grounds for opposition in the German nullity proceedings (cf. on the asserted claim i.Ü. Action, paras. 14, 37, 117; application to amend the action, paras. 1-5).

The court is aware (and in this respect there is also agreement between the parties, see SSTZ p. 4 para. 2) that, according to German case law, the limited defence in nullity proceedings is not binding (cf. as a precautionary measure the case law cited in Annex CBH 26, para. 9, which is not relevant here). However, if a claim can be defended (and has been defended) in national validity proceedings, the defence is not binding.

It is not apparent why this should not be the subject of infringement proceedings. However, the defendant does not object to this either. Rather, it appears to be of the opinion that the plaintiff was required to assert both the substantive claim defended in the German nullity proceedings and, in the alternative, the claim for use now asserted. However, this was not comprehensible: Even against the background of "front-loaded" proceedings, the maxim of promoting the process - also reflected in R. 263 VfO - does not require the proceedings to be burdened at the earliest possible stage with auxiliary requests for which there is no specific reason (comparable Hessel/Gessat, GRUR Patent 2024, 197, para. 17 et seq.).

Otherwise, a patent proprietor who defends his patent in European opposition proceedings with numerous auxiliary requests at an early stage in view of the Rules of Procedure there in order to counter all eventualities would have to assert all these auxiliary requests already with the infringement action in order not to be accused - as the defendant does here - of having been able to file the auxiliary requests earlier. R. 263.1 sentence 2 and R. 263.2 (a) VfO thus do not state, even according to the case law of the Chamber, that new applications must always be rejected if they could theoretically have been filed earlier. R. 263 is rather based on "due diligence" and is about preventing a delay in proceedings or undue obstruction of the defendant in the event that the late assertion cannot be justified. In the present case, however, there was no reason for an earlier (alternative) assertion of the use claim: The Federal Patent Court had stated (BPatG according to Annex CBH 08, p. 14, para. A II.2, p. 18 et seq.; cf. para. 12 et seq. of the cross-appeal according to Annex CBH 26) in its judgement that it already considered the substantive claim to be patentable. The fact that the defendant withdrew the nullity appeal and thus the use "cemented" was not to be expected with due care.

The defendant is also not hindered by the amendment to the complaint. Substantial - because a certain degree of obstruction does not prevent admission (Order of 11 December 2023 UPC_CFI_9/2023 ACT_459771/2023 App_587438/2023 GRUR-RS 2023, 45174 - Huawei/Netgear) - cannot be inferred from their statement: The "adaptation of their submission" (SSTZ, p. 6 et seq.) is inherent in every amendment to the complaint and therefore does not constitute a

Disability. The reference to the adjustment of expert reports remains vague.

It also appears to be inconclusive: Firstly, the defendant must already be able to prove its defence at the level of the application (which the parties agree is admissible).

The court is not concerned with the infringement of the right of use in section II.1b. The admission of the application under item II.1b' is not accompanied by any change in this respect. Secondly, the structural or spatial-physical characteristics of the use claim are identical to the substantive claim that has always been asserted (cf. Annex CBH 29). "Investigations at the client's premises in three countries" had - if at all - already been necessary beforehand. An additional burden was not apparent. The assertion of additional "considerable time and resources" remains phrase-like. The fact that the plaintiff has "not yet raised a corresponding allegation of infringement in any proceedings" is due to the fact that no infringement proceedings have yet been pending between the parties. As the defendant correctly states, it has been aware of the use claim since 17 March 2022 and the plaintiff's sister company, as the former patent holder, had also stated in the pending inspection proceedings (see complaint, para. 9, 12, 108 et seq.) that the patent infringement (as well as the findings of the court expert there) was not affected by the change from a substantive claim to a use claim. The defendant did not oppose this there either. The defendant had deliberately brought about the requested amendment to the action by withdrawing its appeal for annulment.

It is also not unreasonably hindered insofar as it cannot be surprised by the requested amendment to the complaint.

In the context of the assertion of the procedural claim, it is correct that (alone) the application to II.2 with the assertion of the indirect patent infringement of the procedural claim constitutes an extension of the action. However, this alone does not constitute inadmissibility. The defendant relies primarily on the fact that the amendment made to the German part of the patent in suit is not relevant for the French and Italian parts. With regard to the German part, it emphasises that the plaintiff must have been aware that an indirect infringement "could become necessary". Conversely, the defendant was hindered by the fact that it had to "relevant facts" in relation to the further elements of the offence of indirect infringement in "three jurisdictions". There is no need to elaborate on the fact that the change to the use claim caused by the defendant's withdrawal of the nullity appeal is the starting point of the indirect infringement now asserted. As already explained in the context of the admissibility of the application under II.1b (para. 15 et seq.), there is no legal principle to this effect and it is not part of due diligence to file applications for which there is no concrete or obvious reason. The amendment to the action was triggered by the unforeseeable withdrawal of the appeal for annulment.

Since the action was admissible and based on the defended substantive claim in accordance with due diligence, there was also no reason *ex ante* to assert contributory patent infringement. This is because the plaintiff could not have achieved anything by asserting the indirect patent infringement that it could not have achieved by asserting the direct infringement of the substantive claim.

There was only cause for the additional assertion of the indirect infringement of the procedural claim when the defendant "fixed" the claim for use.

However, since the extension of the action with regard to the German procedural claim is admissible against this background without further ado pursuant to R. 263 VfO, there is no reason to assert the parallel assertion of the substantively identical claim of the substantively identical procedural claims of the French and Italian parts of the patent in suit differently.

to be treated. The patent infringement arises technically and under patent law for the same reasons. In this respect, too (as already explained in the context of the admissibility of the application under II.1b - para. 21 et seq.), the defendant is obviously not - let alone unreasonably - hindered and does not argue this: It already remains unclear which additional facts are to be clarified for the indirect patent infringement. The existence of an essential means is already unclear with regard to the submission on the realisation of the claim. of the substantive claim. The fact that the defendant has used the attacked embodiment and advertised for use in accordance with the patent in suit, and thus the implementation of the procedure in accordance with the claim is also obvious, it is also already apparent that from the statement of claim. The assertion of a processing in "three jurisdictions" overlooks the applicability of uniform substantive law, Art. 24 (1)(b), 26 (1) UPCA.

An extension by referring back to the application under no. III is not apparent. Item III contains the applications for information (III.1), disclosure of the books (III.2), destruction (III.3) and recall (III.4), in each case with reference to the products pursuant to No. II. These applications are therefore ancillary and do not go beyond the scope of the amendments in No. II, which are admissible in accordance with the above. The defendant raises specific objections only with regard to the admissibility of the applications for recall and destruction with regard to contributory patent infringement and refers to Art. 64 (EPGA, probably meaning the UPCA). The plaintiff could not infer any corresponding restriction from Art. 64 UPCA. Corresponding doubts should, moreover, relate to the merits and not to admissibility pursuant to R. 263.2 VfO

relate. Last but not least, the plaintiff is not only asserting an indirect infringement, but above all a direct patent infringement, which justifies the claims for recall and destruction. In addition, not every amendment in the applications leads to an amendment of the action subject to R. 263 VfO. Just as corrections and clarifications do not constitute an amendment to the claim, the same applies to - assumed - vagueness that does not change the content of the claim.

With regard to the consequence of costs, the court requested the defendant to comment on the application to amend the action by Order dated 19 June 2024. The defendant's priority application for costs under no. 1 does not concern any question of admissibility pursuant to R. 263 VfO. Pursuant to R. 118.5 VfO, the court should make a basic decision on costs together with its decision on the merits. Nevertheless, in accordance with the Order of 3 July 2024, the following should be noted now as a precautionary measure: Art. 69 (1), (2) UPCA regulates the bearing of costs in principle according to the proportion of winning and losing. The defendant's application (1) assumes that the defendant was unsuccessful on the merits and that the plaintiff would apparently bear the costs in accordance with the principles of Section 269 (3) sentence 2 of the German Code of Civil Procedure. Such a provision is missing in R. 265 VfO; R. 265.2 (c) VfO merely refers to R. 150 et seq. VfO. Even if one assumes that a (partial) withdrawal of the action pursuant to R. 265 VfO or a restrictive amendment of the action pursuant to R. 263 VfO constitutes a partial victory within the meaning of Art. 69(2) UPCA, such a case does not exist here: According to general principles, the assessment of victory or defeat is determined according to economic aspects. A formalistic approach is not required. It is correct that the claim for utilisation now asserted represents a minus compared to the original claim in kind. However, this minus had no significant effect on the plaintiff's claim. With the original application under II, the plaintiff had requested, among other things, that the defendant be prohibited from manufacturing, offering, placing on the market, using or possessing metal sintering preparations/sintering pastes in the Federal Republic of Germany for these purposes. With the present application under II.1b, the plaintiff requests that the defendant be prohibited from offering, placing on the market or using or possessing for these purposes sophisticated metal sintering preparations/sintering pastes in the Federal Republic of Germany if they are suitable for being used for the permanent bonding of components.

Since the suitability for use follows from the realisation of the claim, the only substantive minus of the amended application II.1b compared to the original application II.1 is that the plaintiff no longer seeks an injunction against the manufacture of the attacked embodiments in the Federal Republic of Germany. This may have an economic value; however, in view of the fact that the defendant may have Germany could not market embodiments manufactured in Germany or in any other way - because the export also constituted placing on the market under patent law - this was, however, negligible. The applicant would therefore not have to bear any costs for reasons of equity (Art. 69 (2) UPCA).

The defendant has commented on this as follows:

- Section II.1a & Section II.1b:

The clarifications in point II.1a and the limitation of the application in point II.1b are no longer in dispute between the parties (see document of 21 June 2024 p. 3 f. point I, II). In the event of an extension of the claim, the defendant refers to the previous statements and merely notes in this respect that the determination of "due diligence" within the meaning of Rule

263.1 RoP does not depend on the occurrence of res judicata, but on the specific circumstances of the individual case. That the applicant has been pursuing the limitation of the patent in suit in the German nullity proceedings since its statement of opposition of 17 March 2022, is undisputed, §§ 404, 402 BGB (see document dated 21 June 2024 p. 4).

- Section II.1b':

The defendant argues that the prohibition of meaningful dressing was already covered by its original application and was therefore not an extension of the action (see document of 10 July 2024 p. 3 f.). This is not to be agreed with. The prohibition of preparatory acts in relation to the obvious preparation for the purpose of use and the prohibition of acts of use in relation to the product claim are not congruent. The plaintiff claims prohibitions in relation to alleged indications of use such as "low temperature sintering" or "low temperature joining technology", which are outside of the alleged infringement of the original product claim and merely contain information on use, without at the same time containing, for example, an offer relating to the use of the product on the initially challenged product. Moreover, it remains undisputed that the plaintiff had already been aware of the limitations of the patent in suit since its statement of opposition of 17 March 2022, but in any case since the judgment of the Federal Patent Court of 7 November 2023, at the time the action was filed and it should therefore have filed its auxiliary request, which was only filed on 5 June 2024, with due diligence already when the action was filed. It was readily recognisable to the plaintiff - on the basis of its own application - that the patent in suit would only continue to exist in the territory of the Federal Republic of Germany subject to the restrictions now introduced. It was not apparent why the plaintiff could not have taken this into account by filing a corresponding application when filing the action. The fact that the amendments made resulted in considerable additional expense for the defendant was also evident. It is undisputed that the plaintiff, with the extension of its action, had for the first time alleged the infringement of the claim for use and the further characteristics resulting from this, although it would have been possible for it to file a corresponding application at the time the action was filed. Furthermore, the defendant refers to the previous statements in this regard (see document of 21 June 2024 p. 5 f.).

- Section II.2:

With regard to the indirect patent infringement now asserted, the plaintiff did not submit anything. It therefore remains without any justification why the plaintiff did not assert contributory patent infringement for the territory of the French and Italian Republics until after the action had been brought. The same applies with regard to the Federal Republic of Germany. In view of its limited defence of the patent in suit in the nullity proceedings, it would have been possible and necessary for the plaintiff to file a corresponding (auxiliary) application when the action was filed. Finally, direct and indirect patent infringement do not correspond either in terms of their objective or their requirements under Art. 25, 26 UPCA (see also document of 21 June 2024 p. 7 para. IV).

- Section III.3 & Section III.4:

According to the plaintiff, a reference of the applications in para. III.3 and para. III.4 to the amended claims in para. II must be admissible, as these are merely accessory applications

(see document of 10 July 2024 p. 9 f. item 4). This is not the case. Rule 263.1 RoP does not distinguish between an extension of accessory and non-accessory applications, but makes an amendment to the original scope of the action dependent on the conditions stated therein, on which the plaintiff, who is burdened with the burden of presentation, has not stated anything. had submitted anything concrete. The defendant therefore refers to its previous explanations in this regard (see document of 21 June 2024 p. 7 f. item V).

- Decision on costs:

Pursuant to Rule 265.2 (c) RoP, a decision on costs must be made if withdrawal is permitted ("If withdrawal is permitted, the Court shall: ... issue a cost decision"), whereby the costs of withdrawal must in principle be borne by the applicant, Sec. 69 (2) UPCA (cf.

Momtschilow in Luginbühl/Hüttermann, Unitary Patent System, 1st edition 2024, Art. 69 para. 52: "In the absence of a specific provision on the consequences of costs in the event of a withdrawal of an action (here

there is only the referral of R 265.2.[c] RoP to the cost determination procedure of R 150-157 RoP) or a declaration of settlement, these cases can be treated as exceptional circumstances under para. 2."; Dold/W. Tilmann in Tilmann/Plassmann, UPCA, 2024, Art. 69 para. 72, para. 109: "In order to apply Art. 69 UPCA to the withdrawal of an action, it must be assumed that in the case of withdrawal of an action, an exceptional circumstance i.

within the meaning of Art. 69 para. 2 UPCA. Then the costs are to be apportioned on an equitable basis. In principle, this means that the plaintiff has to bear the costs.").

The limitation of the German part of the patent in suit was already obvious to the plaintiff before the action was filed as a result of its own application, the decision of the Federal Patent Court of 7 November 2023 and the appeal it did not file itself.

CONTROVERSIAL POINTS

The admissibility of the amendment to the complaint and the consequences for the time limit regime must be decided.

REASONS FOR THE ORDER

I. The defendant filed a counterclaim for revocation of the patent in suit (CC_43919/2024 UPC_CFI_448/2024) against Heraeus Precious Metals GmbH & Co. KG on the grounds that at the time the revocation counterclaim was filed, the latter was entered in the register as the patent proprietor and was therefore to be regarded as the correct defendant in the revocation counterclaim for formal reasons pursuant to Rules 25.1, 42.2 and 8.6 RoP.

For the sake of simplicity, this company is referred to in the headline as plaintiff 2). The action was brought solely by plaintiff 1).

II. The requirements for the admission of the amendment to the complaint are only partially met:

1. Pursuant to Rule 263 RoP, a party may apply to the court at any time during the proceedings for the admission of an amendment or addition to the claim, including a counterclaim. The application must state the reasons why the amendment or addition was not already contained in the original document. Subject to paragraph 3, leave shall be refused if, having regard to all the circumstances, the party seeking leave to amend is unable to satisfy the court that (a) the amendment in question could not have been made earlier with due diligence and (b) the party

seeking leave to amend could not have been made earlier with due diligence.

amendment does not unreasonably impede the other party in its conduct of the proceedings. The unconditional limitation of a claim is always permitted. The court may reassess the fees already paid in the light of an amendment.

Both conditions must be fulfilled independently of each other. If one of the conditions is not met, the court's discretion is reduced to zero and it must reject the application. The burden of proof that both the requirements of R. 263.1 RoP and the grounds for exclusion under R. 263.2 RoP are not met lies with the applicant. Therefore, the applicant must explain why the amendment was not included in the original documents, R. 263.1 RoP. Likewise, the court must be able to decide on the exclusion criteria contained in R. 263.2 RoP on the basis of the applicant's explanation (LK München, APP_25265/2024 UPC_CFI_42/2024).

Having said this, the following applies:

2. Application II.1a

The application remains unchanged with regard to the French Republic and the Italian Republic.

With regard to the Federal Republic of Germany, it was withdrawn or replaced by applications II.1b and II.1b'. Reference is made to the comments there.

3. Application II.1.b

The application takes into account that the judgment of the Federal Patent Court (Annex CBH 8) became final on 7 May 2024. In this judgement, the device claim was destroyed and the use claim asserted in the alternative was upheld. Since the use claim has a lesser scope of protection than the device claim and the application is unconditional as the main application, there is an unconditional limitation of the claim, which is always allowed. This also applies with regard to the subsequent claims referring to it.

There is currently no need for a decision on costs. The principle of the unity of the decision on costs applies.

4. Application II.1.b`

This application is in an auxiliary relationship to application II.1.b, so that there is no unconditional limitation. The application concerns a meaningful preparation for later use and therefore takes into account the legal force of the judgment of the Federal Patent Court (Annex CBH 8), which entered into force on 7 May 2024. In this judgement, the device claim was destroyed and the use claim asserted in the alternative was upheld. Although it is possible to amend the application before the judgement becomes final, this is not required under Rule 263 RoP. The delay between service of the order of 7 May 2024 on 13 May 2024 and the declaration of the amendment to the claim on 5 June 2024 is still within the bounds of due diligence. This also applies with regard to the subsequent claims relating to this.

The defendant is not unduly hindered in its conduct of the proceedings by the authorisation. The recovery of technical expert opinions does not appear necessary in this respect because only non-technical details of the bidding actions have been added as a further aspect. Irrespective of this, the defendant has already had time to prepare its defence to the new situation since the day the application was filed. As a precautionary measure, it has been granted a further 30 days to submit its defence

5. Application II.2

This application concerns the indirect use of the procedural claim and therefore does not take into account the res judicata effect of the judgment of the Federal Patent Court (Annex CBH 8), which occurred on 7 May 2024, for the territory of the Federal Republic of Germany. This application could therefore already have been asserted in the action of 12 March 2024. The amendment of the action almost three months later is no longer within the scope of due diligence and must therefore be rejected. This also applies with regard to the subsequent claims referring to it. The plaintiff is free to assert these claims by way of a further action to be filed separately.

ORDER

1. With the exception of the application under II.2 including the subsequent claims relating thereto, the amendment of the action by the plaintiff under 1) pursuant to Annex CBH 25 is admitted and otherwise rejected.
2. The defendant may comment in writing on the subject matter of the admitted amendment to the action within a further 30 days.

NOTES TO THE PARTIES

The defendant's statement must be submitted in the present workflow.

INFORMATION ON A REVIEW BY THE ADJUDICATING BODY

Either party may request that this Order be referred to the adjudicating body in accordance with R. 333 RoP. The Order remains effective until it has been reviewed (R. 102.2 RoP)

ORDER DETAILS

Order No. ORD_36668/2024 in PROCEDURE NUMBER: ACT_13227/2024


UPC number: UPC_CFI_114/2024

Nature of the action: Action for infringement

No. of the related proceedings Application no.: 33728/2024

Type of application: Application for leave to amend or extend the claim (Rule 263 of the Regulation)

Matthias
ZIGANN

 Digitally signed by Matthias
ZIGANN
Date: 2024.09.25 15:46:47
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Dr Zigann
Presiding judge and judge-rapporteur