

**EIP**

# Düsseldorf Local Division issues the first UPC decision on the merits and grants injunction in seven UPC member states

## **Franz Kaldewei GmbH & Co. KG v Bette GmbH & Co. KG (UPC\_CFI\_7/2023)**

### **Decision of 3 July 2024 (ORD\_598324/2023 [1]) concerning EP 3 375 337 B1**

Franz Kaldewei GmbH & Co. KG, a German company which offers bathroom solutions, sued the competitor and German bathtub manufacturer Bette GmbH & Co. KG for patent infringement of EP 3 375 337 B1 in the seven UPC Contracting Member States Austria, Belgium, Denmark, France, Italy, Luxembourg, and the Netherlands. Germany, in which the patent is also in force and which is the domestic market for both companies, was however excluded from the claimant's infringement action.

EP 3 375 337 B1 has the title "sanitation bath tub device" and its claim 1 is directed to a sanitary-tray device such as a shower tray. With the infringement action, the claimant sought an injunction to prevent offering and sale of shower trays (attacked embodiment I) and so-called "minimum tray carriers" (attacked embodiment II) by Bette in the seven above-listed UPC member states. The claimant based its infringement action on a direct infringement of claim 1 by the contested attacked embodiment I and on an indirect infringement of claim 1 by the contested attacked embodiment II. Moreover, the claimant argued that claims 2 and 3 would be infringed as well.

The Defendant sought revocation of the patent in suit to the extent of claims 1-3 by way of a counterclaim for revocation, and raised lack of novelty and lack of inventive step as grounds for invalidity. The claimant opposed the counterclaim for revocation and, in the

alternative, filed a motion to amend the patent in suit in the form of the combination of granted claims 1, 2 and 3 as an auxiliary request. By order of 1 December 2023, the Düsseldorf Local Division decided to hear the infringement action and the counterclaim together pursuant to Art. 33 (3) a) UPCA. The oral hearing on 16 May 2024 was the first substantive hearing at the Düsseldorf Local Division for an infringement action.

The Düsseldorf Local Division argues in its decision of 3 July 2024 that the UPC Court of Appeal has already confirmed the principles for the interpretation of a European patent claim under Art. 69 EPC in conjunction with the Protocol on the interpretation of Art. 69 EPC (see UPC Court of Appeal, Nanostring/10x Genomics, ORD\_595990/2023 [2]) and that this interpretation is therefore the common basis on which both validity and the question of infringement must be decided.

It is not surprising that the Düsseldorf Local Division applied these principles (see confirmation of the BoA interpretation principles by the Düsseldorf Local Division already in the order of 30 April 2024 granting 10x Genomics, Inc. a preliminary injunction against Curio Bioscience Inc. (UPC\_CFI\_463/2023) [3]), but it is notable in this context that just some days ago questions were referred under G1/24 [4] to the Enlarged Board of Appeal of the EPO which address inter alia the question whether Art. 69 EPC is to be applied for the assessment of validity or not. Hence, even though many Boards of Appeal at the EPO have voiced concerns about this question in the past, it seems the UPC has delivered its answer to this question unilaterally.

Based on these interpretation principles the Düsseldorf Local Division comes to the conclusion that although claim 1 of the patent is – contrary to the argumentation of the defendant – novel over the prior art document DE 197 10 945 C1, it is in any case not inventive, because the distinguishing feature over said prior art document, defining that the mouldings of the sanitary tray are made of rigid plastic foam, could not be considered to be inventive. The considerations made by the skilled person in order to form profiled pieces/angle pieces from rigid plastic foam (feature 4a in claim 1) represent only routine further development.

However, the additional features of claims 2 and 3 directed to further specifications of the moulding were considered to be inventive over DE 197 10 945 C1 by the Düsseldorf Local Division. As the claimant had admissibly filed an auxiliary request based on the combination of claims 1, 2 and 3, this auxiliary request was considered novel and inventive over DE 197 10 945 C1 (and other combinations of prior art documents cited by the Defendant).

After this validity analysis, the Court in its decision states that the infringement action is also well-founded on the merits, because the Defendant infringes the patent in suit and

cannot invoke a right of prior use. It was undisputed that both challenged embodiments make use of the teaching of the patent in suit both in the version of the (invalid) main request and in the version of the (valid) auxiliary request. So the Defendant focussed – at least in writing – on an alleged prior use right. However, in assessing the documents filed by the defendant, the Court came to the conclusion that, within the framework of Art. 28 UPCA, a right of prior use cannot be granted to the defendant, because a prior use would need to be demonstrated for each jurisdiction concerned (Austria, Belgium, Denmark, France, Italy, Luxembourg and the Netherlands). According to the Court, the defendant has at best submitted information on the ownership of the invention and its utilization in Germany, but not in the contracting member states at issue here.

These considerations led to the judgment against the defendant Bette GmbH & Co. KG, and the Court granted inter alia an injunction, and a right to information for the claimant for assessment of damages, and decided on the payment of provisional damages. With regard to the plaintiff's right to information and the plaintiff's original request for disclosure of the books pursuant to Art. 68 (1) UPCA in conjunction with R. 131.1 (c) and R. 141 RoP, the Court elaborates that this request was rightly withdrawn by the plaintiff as such a request should not be made as part of the infringement proceedings. However, such information can now be requested as part of an application for the determination of damages.

[1] <https://www.unified-patent-court.org/en/node/896>

[2] <https://www.unified-patent-court.org/en/node/576>, reported at <https://eipamar.com/en/knowledge-hub/article/why-did-the-court-of-appeal-reverse-the-local-division-injunction-in-10x-genomics-vs-nanostring/>

[3] <https://www.unified-patent-court.org/en/node/683>

[4] <https://www.epo.org/en/law-and-practice/boards-of-appeal/communications/referral-enlarged-board-appeal-q-124-heated>