

EIP

REVIEW of EX PARTE PI

Mammut Sports Group AG and Mammut Sports Group GmbH**Düsseldorf Local Division****Order of 09 April 2024[1]****Introduction**

In its order dated 11 December 2023, the Düsseldorf Local Division (in the following “LD”) granted an ex parte PI in favor of Ortovox Sportartikel GmbH (in the following “Applicant”). We have reported on this decision here[2]. Mammut Sports Group GmbH and Mammut Sports Group AG (in the following “Defendant”) requested a review (Rule 212.3 RoP) of this order on 19 January 2024. After hearing the parties, the LD allocated a technically qualified judge to the panel.

The Applicant owns the EP 3 466 498 B1 which relates to a “Search device for avalanche victims and method for operating a search device for avalanche victims”. The Defendant offers their avalanche victim search device “Barryvox S2” (in the following “attacked embodiment”).

The Defendant argues that the attacked embodiment does not infringe the patent in dispute because it does not emit a sound signal but a so-called sound pattern.

Furthermore, no sound signal within the meaning of the patent in dispute is suppressed when a voice message is output. They also claim that they already have an earlier patent (EP 2 527 011) containing similar technical solutions and therefore have a positive right to use the patent in dispute (“objection of earlier right”). They further questioned the validity of the patent in dispute because several other patents anticipate the technical teaching of the patent in dispute and the inventive step is lacking. According to the Defendant, the preliminary injunction is also not necessary, because the attacked embodiment is merely a prototype that is still in a test phase, the production phase of which is not concretely

determined either in fact or in time. The Applicant had shown by their unreasonable delay in applying for the interim measures that the matter was not urgent. Finally, the defendant argued that the balance of interests was in favor of the Defendant.

According to the Applicant, the Defendant cannot rely on the fact that the attacked embodiment was a prototype since the product "Barryvox S2" could be ordered without restriction. Furthermore, they argue that the attacked embodiment clearly infringes the patent in dispute and that sound patterns within the meaning of EP '011 are also sound signals within the meaning of the patent in dispute. In the prior art cited by the Defendants, the technical teaching is neither disclosed as novelty-destroying nor is there a lack of inventive step based on this prior art. The Applicant also argued that the matter is urgent and that the balance of interests is in the Applicant's favor.

Decision

The LD ruled that also after hearing the Defendant, the grant of the PI is justified.

Infringement

The LD stated that it is (still) convinced with sufficient certainty (R. 211.2 RoP) that the Applicant's rights are infringed by the offer and distribution of the attacked embodiment. The Court also made further explanations concerning the interpretation of a patent:

"Art. 24(1)(c) UPCA in conjunction with Art. 69 EPC conclusively determine which documents are to be used for the interpretation of the patent claims determining the scope of protection, namely the patent description and the patent drawings. Since the prosecution file is not mentioned in Art. 69 EPC, it does not in principle constitute admissible material for interpretation. If the applicant has commented on the meaning of a feature or term in the course of the prosecution procedure, this can at best have indicative significance for how the skilled person understands the feature in question."

Insofar as the Defendant refers to EP 011, this was not mentioned in the patent in dispute. The Defendants have failed to prove that this prior art and in particular the aforementioned distinction between sound signals and sound patterns was part of the general technical knowledge in the field of the patent in dispute at the time of priority. The LD stated that this document is therefore not admissible interpretative material.

Further, the LD explained that the Defendant cannot derive any entitlement to use the patent in dispute from the fact that the Defendant is the proprietor of EP 011, which is older than the patent in dispute. The "objection of earlier right" raised by the Defendant (with reference to the German case law of the Federal Court of Justice) does not apply. Even if it can be assumed in favor of the Defendant that such an objection developed in

national law can also be raised before the Unified Patent Court, the Defendant cannot derive a positive right of use from it in the present case. This is because the defendant would then only be allowed to use the teaching of EP 011 and not make use of additional features that are only taught in the more recent patent.

Submission after oral hearing

The Defendant filed further submission after the oral hearing (in relation to a licence objection). They filed this submission without approval of the LD. The LD rejected this submission as late and did not take it into account. It stated that, pursuant to paragraph 7 of the Preamble to the RoP, the “parties shall cooperate with the Court and set out their full case as early as possible in the proceedings”. Submissions that are only filed after the conclusion of the oral proceedings do not meet these requirements and must therefore generally be rejected as late. This applies in any case if the party concerned was not exceptionally granted the right to make additional submissions within a time limit set by the court during the oral hearing in response to a reasoned request.

Validity

The LD found – also after hearing the Defendant – that the validity of the patent in dispute is secured to the extent required for the ordering of provisional measures. According to the case law of the Court of Appeal, there is a lack of conviction of the validity of the patent if the court considers it to be overwhelmingly probable that the patent is not valid. The burden of proof for facts relating to the lack of validity of the patent lies with the defendant (UPC_CoA_335/2023, order of 26.02.2023, p. 30, GRUR-RS 2024, 2829 - Nachweisverfahren). In its review, the LD dealt with the prior art documents submitted and is (still) convinced of the legal validity of the patent in dispute with the necessary “sufficient certainty”. The LD again emphasized that this was not precluded by the fact that the patent in dispute had not yet survived any adversarial proceedings.

Urgency

The LD has emphasized that the urgency required to order interim measures is only lacking if the requesting party has been so negligent and hesitant in pursuing its claims that, from an objective point of view, it must be concluded that the party is not interested in enforcing its rights quickly. However, the applicant does not need to take any risks in pursuing the claim. After a detailed examination of the circumstances of the present case, the LD came to the conclusion that the Applicant had handled the matter with the necessary urgency.

Balancing of interests

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The LD has stated that the degree of probability to which the court is convinced of the existence of the individual circumstances to be weighed up is decisive for the exercise of discretion. The more certain the court's conviction is that the right holder is claiming 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 suffered by the opponent or other justified objections, the more likely it is that the issuance of an injunction is justified. The LD decided that the issuance of the requested injunction in the present case is justified, as the Defendants could not substantially dispute the infringement of the patent and also did not raise any significant doubts as to the validity of the patent. The alleged disadvantages of the Defendants ultimately result from the competitive situation described by the Applicant.

The Defendant can appeal this review decision within 15 days (Art. 73 (2) (a), 62 UPCA, R. 220.1 (c), 224.2 (b) RoP.

[1]

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[court.org/sites/default/files/files/api_order/AB037EBC57A01D29201764FEBDB80AB8_de.pdf](https://www.unified-patent-court.org/sites/default/files/files/api_order/AB037EBC57A01D29201764FEBDB80AB8_de.pdf)

[in German]

[2] <https://eipamar.com/en/knowledge-hub/article/ex-parte-pi-granted/>