

Arrangement
of the Court of First Instance of the Unified Patent Court Local Division
Düsseldorf
issued on April 9, 2024
concerning EP 3 466 498 B1

LEADERSHIPS:

1. Art. 24(1)(c) UPCA in conjunction with Art. 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 grant 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 examination procedure, this can at best have indicative significance for how the skilled person understands the feature in question.
2. In principle, an applicant does not have to take any risks when pursuing legal action in proceedings for interim measures. He only needs to call upon the court if he has reliable knowledge of all the facts that make legal action in the proceedings for interim measures promising and if he can make these facts credible.
3. Pursuant to point 7. sentence 3 of the preamble to the Rules of Procedure, the parties must cooperate with the court and present their arguments as early as possible. Arguments that are only submitted after the conclusion of the oral proceedings do not meet these requirements from the outset 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 in response to a reasoned request during the oral hearing.
4. There is no need for a basic decision on costs in proceedings for interim measures if the summary proceedings are followed by proceedings on the merits. In this case, the Rules of Procedure provide for a provisional reimbursement of costs (R. 211.1 (d) VerfO), with which the successful party can claim its costs of the summary proceedings and have them titled directly. For an analogous application of R. 118.5 VerfO therefore already lacks an unintended regulatory gap.
5. The court may require the provision of appropriate security in favor of the defendant in the event that the order for interim measures is lifted. If the specific case does not exceptionally provide otherwise, this option must be exercised in the event of an appeal.

KEYWORDS:

Request for examination, scope of examination, patent interpretation, grant file, delay, decision on costs, provision of security

APPLICANT:

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STREITPATENT:

EUROPEAN PATENT NO. EP 3 466 498 B1

Panel/Chamber:

Judges of the Düsseldorf local division Co-

Judges:

This order was issued by Presiding Judge Thomas, the legally qualified

Judge Dr. Thom, the legally qualified judge Dr. Schober and the technically qualified judge Dr. Wismeth.

LANGUAGE OF PROCEDURE: German

SUBJECT: R. 212.3 VerFO in conjunction with R. 197.3 and 197.4 VerFO. R. 197.3 and 197.4 VerFO - Application for examination of the ordering of interim measures

ORAL NEGOTIATION: March 5, 2024

BRIEF DESCRIPTION OF THE FACTS:

The applicant is the sole proprietor of the European patent EP 3 466 498 B1 (hereinafter: patent in dispute). The patent in dispute was filed in German on October 9, 2017. The patent application was published on April 10, 2019 and the mention of the grant of the patent in dispute was published on December 4, 2019. The patent in dispute is currently in force in the Federal Republic of Germany and the Republic of Austria, among other countries. The applicant has not declared an opt-out in relation to the patent in suit.

No opposition was filed against the grant of the patent in suit. However, the defendant re 1) challenged the Swiss part of the patent in suit with an action for revocation dated July 11, 2023 (case number: 02023_012). With regard to the content of this nullity action, reference is made to Annexes KAP 15 to KAP 28 and Annex BB 1. A decision by the Federal Patent Court of Switzerland on this nullity action is still pending.

The patent in suit protects an "avalanche transceiver" (hereinafter: avalanche transceiver). Its patent claim 1 is formulated as follows:

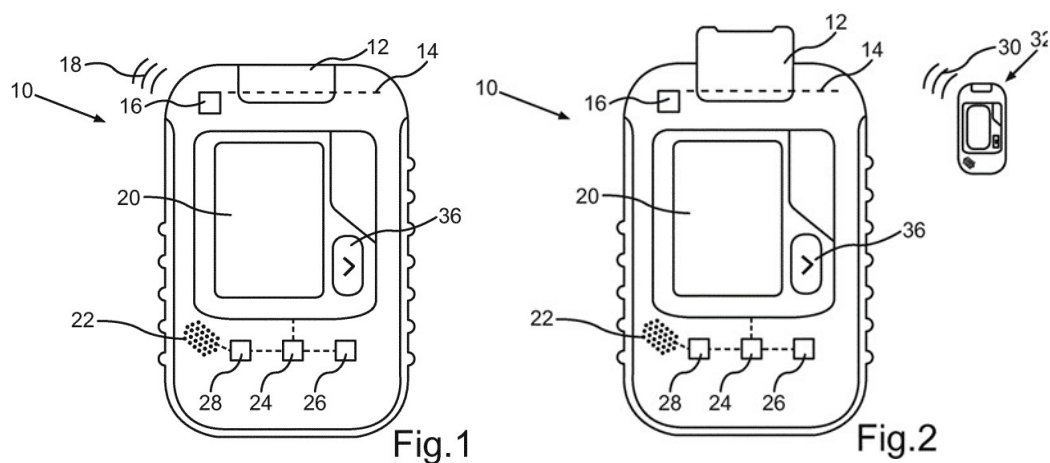
"Avalanche transceiver, comprising a transmitting unit (16) for transmitting at least one transmission signal (18), a receiving unit (16) for receiving at least one transmission signal (30) from at least one further avalanche transceiver (32), and a control device (24) for controlling at least one loudspeaker (22), wherein the control device (24) is designed to control the at least one loudspeaker (22) for outputting at least one voice message as a function of at least one event, wherein the at least one event is associated with a search for the at least one further avalanche transceiver (32), the avalanche transceiver (10) having the at least one loudspeaker (22) and the at least one loudspeaker (22) being designed to output at least one audio signal, **characterized in that** the at least one audio signal is associated with the search for the at least one further avalanche transceiver (32), wherein the control device (24) is designed to control the at least one loudspeaker (22) in such a way that the at least one audio signal is suppressed during the output of the at least one voice message or is output at a reduced volume."

In addition, the patent in suit in claim 13 protects a "method for operating an avalanche transceiver", which is designed as follows:

"Method of operating an avalanche transceiver (10) comprising a transmitter unit (16) for transmitting at least one transmitting signal (18), and a receiving unit (16) for receiving at least one transmitting signal (30) which is output by at least one further avalanche transceiver (32), in which a control device (24) of the avalanche transceiver (10) controls at least one loudspeaker (22), wherein the control device (24) of the avalanche transceiver (10) controls at least one loudspeaker (22).

control device (24) controls the at least one loudspeaker (22) in such a way that the at least one loudspeaker (22) emits at least one voice message, the at least one loudspeaker (22) being controlled by the control device (24) as a function of at least one event, which is associated with a search for the at least one further avalanche transceiver (32), the avalanche transceiver (10) has the at least one loudspeaker (22) and the at least one loudspeaker (22) emits at least one audio signal, **characterized in that** the at least one audio signal is associated with the search for the at least one further avalanche transceiver (32), whereby the control device (24) controls the at least one loudspeaker (22) in such a way that the at least one audio signal is suppressed or output at a reduced volume during the output of the at least one voice message."

Figures 1 and 2, shown below, explain the technical teaching of the patent in suit by means of a preferred embodiment. While the avalanche transceiver (10) in Figure 1 is in a transmit mode, it operates in a receive mode in Figure 2. In this case, another avalanche transceiver (32) is in a transmit mode.



With its application for interim measures, the applicant is directed against the offer and sale of the avalanche transceiver "Barryvox S2" (hereinafter: attacked design), which can be seen in the following illustration:



The defendant (1) exhibited the attacked embodiment at the "ISSW" trade fair in Bend, Oregon (USA), from October 8, 2023 to October 13, 2023, where it was examined by employees of the applicant. At the beginning of November 2023, the applicant received

the notice from a dealer that the challenged design for the year 2024 can be pre-ordered via the B2B platform of the defendants' group. According to the general terms and conditions to be found on this platform, defendant 2) is responsible for offers and deliveries to the Federal Republic of Germany and the Republic of Austria. With regard to the further content of the platform, reference is made to Annex KAP 9.

Furthermore, the defendant 1) was present as a co-exhibitor at the trade fair "ISPO Munich 2023", which took place in Munich from November 28, 2023 to November 30, 2023. The attacked embodiment, which was awarded the "ISPO Award 2023" this year, was also exhibited at this trade fair.

After the applicant had unsuccessfully warned the respondents in a written submission dated November 28, 2023 (Annex KAP 12), it applied to the Düsseldorf Local Chamber for an ex parte order for interim measures in a written submission dated December 1, 2023. In response to a reference order (ORD_591010/2023) issued by the Local Chamber of Düsseldorf, the applicant supplemented its submissions on the need for an ex parte order.

On December 11, 2023, the Düsseldorf Local Chamber, composed of three legally qualified judges, ordered ex parte interim measures with the following content (ORD_592936/2023):

I. The defendants are ordered to refrain from doing so,

1. Avalanche transceivers

in the Federal Republic of Germany and/or the Republic of Austria, to offer, place on the market or use or import or possess for these purposes, with at least

a transmitter unit for transmitting at least one transmission signal,

a receiver unit for receiving at least one transmission signal from at least one further avalanche transceiver,

and with a control device for controlling at least one loudspeaker,

wherein the control device is designed to control the at least one loudspeaker to output at least one voice message depending on at least one event,

wherein the at least one event is associated with a search for the at least one further avalanche transceiver,

wherein the avalanche transceiver has the at least one loudspeaker and the at least one loudspeaker is designed to emit at least one sound signal,

characterized in that

the at least one audio signal is associated with the search for the at least one other avalanche transceiver,

wherein the control device is designed to control the at least one loudspeaker in such a way that the at least one sound signal is suppressed during the output of the at least one voice message or is output at a reduced volume;

2. Devices suitable for carrying out a method for operating a la- wine burial detector

in the Federal Republic of Germany and/or the Republic of Austria for use in the Federal Republic of Germany and/or the Republic of Austria,

wherein the method comprises at least the following:

a transmission unit for transmitting at least one transmission signal,

a receiver unit for receiving at least one transmission signal which is emitted by at least one further avalanche transceiver,

in which a control device of the avalanche transceiver controls at least one loudspeaker,

wherein the control device controls the at least one loudspeaker in such a way that the at least one loudspeaker emits at least one voice message,

wherein the at least one loudspeaker is activated by the control device as a function of at least one event which is associated with a search for the at least one further avalanche transceiver,

the avalanche transceiver has at least one loudspeaker and the at least one loudspeaker emits at least one sound signal,

characterized in that

the at least one audio signal is associated with the search for the at least one other avalanche transceiver,

wherein the control device controls the at least one loudspeaker in such a way that the at least one sound signal is suppressed during the output of the at least one voice message or is output at a reduced volume.

- II. For each individual infringement of the above order, the respondents shall be liable to a (possibly repeated) penalty payment of up to EUR 10,000.

per product and/or up to EUR 30,000 per day in the case of permanent actions such as offers on the Internet.

- III. The defendants are further ordered to hand over the avalanche transceivers referred to under I. or devices suitable for carrying out a procedure for operating an avalanche transceiver to a bailiff for the purpose of safekeeping, which shall continue until the existence of a claim for destruction has been finally decided between the parties or an amicable settlement has been reached.
- IV. This order is only enforceable if the applicant has provided security in favor of the defendants in the form of a deposit or bank guarantee in the amount of EUR 500,000.

The defendants requested a review of this order in a written submission dated January 19, 2024 (App_3217/2024, App_3259/2024 and App_4074/2024).

Following a hearing of the parties, the Düsseldorf Local Chamber issued an order dated January 26, 2024, a technically qualified judge (ORD_3347/2024), who was then assigned to the local chamber by the President of the Court of First Instance.

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

MOTIONS BY THE PARTIES:

The defendants apply,

1. annul the order as part of the review pursuant to R. 212.3 sentence 1 VerfO and reject the application for interim measures,
 - alternatively -
 - 1.1. to allow the defendants to continue the alleged infringing acts against the provision of a security, the amount of which is at the discretion of the court but should not exceed EUR 500,000;
 2. order provisional reimbursement of costs in the amount of EUR 19,858.40 in favor of the defendants;
 3. order the applicant to pay the costs of the proceedings;
 4. order the immediate enforceability of the order;
- in the strongest alternative -
 5. to limit the penalty payment threatened for each individual infringement of the order (which may be repeated) to EUR 2,500 per product and/or up to EUR 5,000 per day in the case of permanent acts such as offers on the Internet;
 6. the applicant's application for provisional reimbursement of costs in the amount of 33,375.70

EUR must be rejected.

The applicant requests,

- I. reject the applications of the defendants dated October 19, 2024;
- II. to amend the order of December 11, 2023 in such a way that the defendants
 1. provisionally reimburse the applicant costs in the amount of EUR 33,375.70;
 2. order the defendant to pay the costs.

FACTUAL AND LEGAL ISSUES:

In the opinion of the defendants, the challenged embodiment does not make use of the technical teaching of the patent in suit because it does not emit a sound *signal* but a so-called sound *pattern*. Moreover, the contested embodiment alternately emits different acoustic signals and at no time two acoustic signals in parallel. Therefore, no sound signal within the meaning of the patent in suit is suppressed when a voice message is output.

Moreover, the defendant 1) is the proprietor of EP 2 527 011 (hereinafter: '011), which is older than the patent in suit. The challenged embodiment makes use of the technical solution disclosed therein. Therefore, the "objection of prior right" is in favor of the defendants, from which a positive right of use of the defendants in the patent in dispute arises. Apart from that, the patent in dispute is in any case covered by a license agreement concluded between the applicant and the second defendant in 2010 and thus licensed in favor of the defendants. With regard to the content of this agreement, reference is made to Annex KAP 36.

Apart from that, the validity of the patent in suit could not be assumed with "sufficient certainty". For such certainty, the patent in suit must in any case prove to be legally valid with a high degree of probability. However, the technical teaching of the patent in suit was anticipated by WO 2006/015721 A1 (Annex KAP 17/BB1 - Exhibit 32), DE 299 22 217 U1 (Annex KAP 19/BB1 - Exhibit 33), EP 2 527 011 A1 (Annex KAP 18/BB1 - Exhibit 28) and EP 1 577 679 A1 (Annex BB 2), which was introduced into the proceedings for the first time one day before the oral proceedings, to the detriment of novelty. In any event, the inventive step was lacking on the basis of the aforementioned documents. Moreover, on the basis of the interpretation put forward by the applicant, patent claim 1 was lacking in feasibility both with regard to the term "suppression" and with regard to the sound signal and the voice message.

The ordering of interim measures was also not necessary.

The challenged embodiment is a mere prototype still in a test phase, the production phase of which is not certain either in fact or in time. Moreover, the applicant had itself refuted the urgency of the matter by its unreasonable delay in applying for the interim measures. According to the applicant's own submissions (Annex KAP 8), its employees had not taken the challenged measures into account.

The new version was presented for the first time at the ISSW (International Snow Science Workshop) trade fair, which was organized by the October 8, 2023 to October 13, 2023 in Bend, Oregon, USA. The ISSW is a highly international event. Since then, the applicant has been aware of the contested embodiment and its mode of operation.

In addition, the applicant was also aware that the "ISPO" and thus the most important trade fair for winter sports equipment in German-speaking countries would take place in Munich at the end of November 2023. Even if business transactions could theoretically still be expected after the trade fair, it would no longer have been possible to prevent alleged business transactions at the trade fair and in the immediate aftermath by ordering interim measures. Insofar as the applicant had relied on the fact that the contracts for the majority of sales would be concluded by Christmas to justify its application, this objective had already been missed because the service of the order for interim measures did not take place until December 21 or 22, 2023.

Moreover, the applicant had not sought legal protection against the manufacture of the contested embodiment in Switzerland and had also shown that the matter lacked urgency.

Apart from this, third-party interests in the form of the chances of survival of avalanche victims should also be included in the necessary balancing of interests.

Moreover, an injunction would cause the defendants irreparable economic damage. A later revocation of an injunction issued in summary proceedings in the injunction proceedings or in the main proceedings would then allow the defendants to enter the market, but the advance orders with the other manufacturers would remain in force.

Moreover, the balance of interests would also be in favor of the defendants from every conceivable point of view. In any case, the legal consequence of a possible patent infringement is not a "claim" to an injunction. Rather, such an order is at the discretion of the court, whereby the interests of the defendants are to be given equal consideration in the exercise of discretion.

The amount of EUR 19,858.40 claimed by the defendants as provisional reimbursement of costs is based on a calculation of costs in accordance with established German practice under the German Lawyers' Fees Act (RVG).

In the highest alternative, the defendants demand a limitation of the amount of the penalty payment. The amounts set are disproportionate in view of the contested form of execution, the relevant facts and the conduct of the defendants in accordance with the order after service of the order for interim measures.

The applicant has countered the arguments of the defendants.

In their opinion, the defendants could not rely on the fact that the "Bar-Ryvox S2" only existed as a prototype. The challenged embodiment could have been ordered without restriction for the area in dispute with voice guidance.

Furthermore, the contested embodiment makes use of the technical teaching of the patent in suit in accordance with the literal meaning. Sound patterns within the meaning of EP '011 are also sound signals within the meaning of the patent in suit. Moreover, the technical teaching protected by the patent in suit is not limited to the simultaneous output of sound signal and voice message.

The legal validity of the patent in suit is sufficiently secured. In the prior art cited by the defendants, the technical teaching protected by claims 1 and 13 is neither disclosed in a manner prejudicial to novelty nor is there a lack of inventive step based on this prior art.

The balance of interests is in favor of the applicant. The economic damage suffered by the applicant if an injunction is not issued is greater than the damage suffered by the respondents if the injunction is lifted. Moreover, the matter was also urgent. The applicant did not have to infer that the challenged embodiment should also be offered in the validation states of the patent in dispute solely on the basis of the exhibition in the USA. Even if it subsequently became apparent that the attacked embodiment was manufactured by the defendant 1) in Switzerland, this was not sufficiently apparent to the applicant at the time of the exhibition in the USA. Until the contrary was proven, the applicant had to assume that the defendants' conduct was lawful. The applicant had proceeded swiftly in pursuing her rights. She did not have to allow herself to be referred to possible proceedings in Switzerland. She was free to decide where she wanted to enforce her patent.

The Rules of Procedure only provide for a provisional reimbursement of costs for the applicant, but not for the defendant. On the basis of the German Lawyers' Fees Act, the applicant asserts a claim for reimbursement in the amount of EUR 33,375.70.

The defendants have countered this argument.

To avoid repetition, reference is also made to the written submissions of the parties exchanged in the run-up to the oral hearing, including annexes.

REASONS FOR THE ORDER:

The admissible application for interim measures is also well-founded in view of the defendants' defense.

I.

According to the extract from the register submitted as Annex KAP 5, the applicant is the registered proprietor of the patent in suit and therefore entitled to file an application pursuant to Art. 47 (1) UPCA.

II.

Furthermore, the Local Division Düsseldorf is convinced with sufficient certainty (R. 211.2 VerFO) that the applicant's right is infringed by the offer and distribution of the attacked embodiment within the Contracting Member States Germany and Austria (Art. 25 (a) UPCA, Art. 26 (1) UPCA). On summary examination, the attacked embodiment makes direct (claim 1) or indirect (claim 13) use of the technical teaching of the patent in suit in accordance with the wording.

1.

The invention relates to an avalanche transceiver with a transmitting unit for transmitting at least one transmission signal, a receiving unit for receiving at least one transmission signal from at least one further avalanche transceiver, and with a control device for controlling at least one loudspeaker, as well as a method for operating such a device.

According to the description of the patent in suit, avalanche transceivers are in the state of the art.

technology is known. For example, WO 2006/015721 A1 describes an avalanche transceiver with a display device which generates stimuli perceptible to the human senses, such as acoustic stimuli in the form of buzzers or loudspeakers. Furthermore, a voice output device is provided which guides a user by voice to a person to be found (para. [0002]).

In addition, US 2006/0148423 A1 describes an avalanche transceiver with a display on which directional arrows indicate the direction in which a searcher should move in order to locate a transmitting avalanche transceiver. The distance from the transmitting search device is also shown. The avalanche transceiver also has a loudspeaker which emits an audio signal in search mode. This audio signal becomes louder as the searching avalanche transceiver approaches (para. [0003]).

In this prior art, the patent in suit describes it as disadvantageous that the search for the transmitting avalanche transceiver is difficult despite the indications for the search shown on the display and the audio signal. In particular, paying attention to the instructions shown on the display and the audio signal in the stressful situation in which the person searching for the buried carrier of the transmitting search device finds himself is a considerable challenge (para. [0004]).

According to the description of the patent in suit, the patent in suit is therefore based on the task of creating an avalanche transceiver and a method of the type mentioned at the beginning, which simplifies the search for a transmitting avalanche transceiver (para. [0005]).

To solve this problem, the patent in suit protects an avalanche transceiver which is characterized by the following features according to patent claim 1:

1. Avalanche transceiver,
 - 1.1. with a transmission unit (16) for transmitting at least one transmission signal (18),
 - 1.2. a receiving unit (16) for receiving at least one transmission signal (30) from at least one further avalanche transceiver (32)
 - 1.3. and with a control device (24) for controlling at least one loudspeaker (22).
2. The control device (24) is designed to control the at least one loudspeaker (22) to output at least one voice message as a function of at least one event.
 - 2.1. The at least one event is associated with a search for the at least one further avalanche transceiver (32).
3. The avalanche transceiver (10) has at least one loudspeaker (22) and the at least one loudspeaker (22) is designed to emit at least one sound signal.
 - 3.1. The at least one audio signal is associated with the search for the at least one further avalanche transceiver (32).
4. The control device (24) is designed to control the at least one loudspeaker (22) in such a way that the at least one sound signal is suppressed or output at a reduced volume during the output of the at least one voice message.

will.

2.

Some features of this claim require further explanation.

a)

According to the invention, the avalanche transceiver (LVS) has, in addition to a transmitter and a receiver unit (16), a loudspeaker (22) and a control device (24) for controlling this loudspeaker (feature group 1.). Why such a control device is required is obvious to the competent expert, a graduate engineer or master in electrical engineering with a degree from a university of applied sciences and several years of professional experience in the development and construction of avalanche transceivers, in view of feature groups 2. to 4.

b)

As the skilled person can see from feature group 3, the at least one loudspeaker is designed according to the invention to emit at least one sound signal which is associated with the search for the at least one further avalanche transceiver. Patent claim 1 is silent on how such a connection is to be designed, as well as on the content and the more detailed technical design of the audio signal. A person skilled in the art who attempts to determine the scope of protection on the basis of the wording of the patent claim therefore has no reason to limit the term "sound signal" to certain acoustic signals. Rather, when considering the aforementioned feature groups in isolation, he will understand a "sound signal" to mean any acoustic signal in connection with another avalanche transceiver, irrespective of whether this signal contains information beyond the required context or not. Purely optical signals, for example in the form of directional arrows, are not to be classified as sound signals within the meaning of the patent in dispute. They may be present in addition to and as a supplement to the sound signals (para. 11, lines 17 - 26), but do not make the presence of sound signals superfluous.

However, the skilled person does not stop at such a view based solely on the wording of the patent claim. According to Art. 69 (1) sentence 2 EPC, the description and the drawings must be used to interpret the patent claim (cf: UPC_CoA_335/2023, order of 26.02.2024, GRUR-RS 2024, 2829, para. 73 - 79 - Nach-

method). If the skilled person looks at the description of the patent in suit on this basis, it is disclosed to him in paragraph [0010] that the sound signals emitted by the at least one loudspeaker are, *for example*, beeps which vary in frequency, repetition rate and/or volume depending on the distance to the buried person (para. 2, lines 49 - 53, emphasis added). Since the description of the patent in suit expressly emphasizes the exemplary character of the sound signals described therein in detail, the skilled person has no reason to assume that the patent in suit understands the term "sound signal" in a way that deviates from the broad understanding previously elaborated. There is no indication in the patent in suit of the distinction between "sound signals" and "sound patterns" advocated by the opponents. If they are associated with the search for at least one other avalanche transceiver, "sound patterns" are therefore also "sound signals" within the meaning of the patent in suit.

Insofar as the defendants refer to EP '011 (Annex KAP 18) in support of their differing view, this was not mentioned in the patent in suit. The evidence that this prior art and in particular the above-mentioned distinction of sound

signals and sound patterns at the time of priority belonged to the general specialized knowledge in the field of the patent in dispute. This document is therefore not admissible interpretative material from the outset.

c)

In his considerations, the skilled person must also take into account that, in addition to the sound signals, claim 1 also recognizes voice messages which are also associated with a search for at least one avalanche transceiver (feature group 2.). Although these voice messages are also emitted by the loudspeaker and are thus acoustically perceptible, feature 4. leaves no doubt that voice messages and sound signals must differ from each other according to the conceptual understanding of the patent in suit. Only then does it make sense to suppress the sound signal during the output of a voice message or to reproduce it at a reduced volume. Even if claim 1 does not contain any specifications for the more detailed form of the sound signal or the voice message, it is clear from the overall system of the claim that a sound signal within the meaning of the patent in suit is any acoustic signal associated with the search for another VAS which is not to be classified as the output of speech and thus as a voice message. By contrast, the patent in suit defines a voice message as an instruction or information to the searcher in the form of words (cf. e.g. para. [0017] f., [0021], [0023] f., [0028] f., para. [0031], [0033] f., para. [0036] - [0039]).

d)

According to the invention, the loudspeaker thus emits two acoustic stimuli (sound signals, voice message) that can be distinguished from one another. If this is done simultaneously, however, the sound signals emitted (for example in the form of beeps) can interfere with the intelligibility of the speech (Sp. 3, lines 3 - 5). Therefore, according to the invention, the control device (24) should be designed such that it can control the at least one loudspeaker as a function of at least one event associated with the search for a further WMS such that the at least one audio signal is suppressed or output at a reduced volume during the output of the voice message (features 2. and 4.).

The expert takes two things from this:

On the one hand, the loudspeaker is to be activated depending on an event associated with the search for a further WMS (features 2. and 2.1.). Insofar as the description of the patent in suit deals in detail with such possible events (cf. para. [0012] - [0039]), these are merely examples which are not reflected in the patent claim. The technical teaching protected by the patent in suit must not be reduced to these.

On the other hand, the at least one audio signal can either be suppressed or output at a reduced volume during the output of the at least one voice message. The second variant enables the sound signal to continue to be generated and output during the output of the voice message. Suppressing the sound signal, on the other hand, requires that the sound signal is no longer audible. The technical means used for this are left open in the patent in suit. At no point does it deal with the more detailed technical design of the suppression of the sound signal. Its technical realization is therefore also left to the skilled person. The scope of protection therefore covers both designs in which the volume of the sound signal is temporarily set to zero and those in which the signal is temporarily no longer generated. If the sound signal is temporarily not generated, the person skilled in the art recognizes this as a temporary deactivation and thus suppression of this signal.

The general use of language cited by the defendants to justify their differing opinion does not compel a different assessment, if only because the term "suppression" can also be understood there in the sense of "not allowing to arise" according to the passage from the Duden dictionary cited by the defendants themselves (see statement of 19.01.2024, p. 12 f.). Apart from that, the provision of Art. 69 para. 1

p. 2 EPC and the drawings show that the patent specification defines terms independently.

e)

Even if patent claim 1 leaves the more detailed technical embodiment of the suppression of the audio signal to the skilled person, the latter must not lose sight of the fact that the control device, audio signal and voice message are in an operative relationship according to the invention: The control device should control the loudspeaker as a function of at least one event associated with the search for a further WMS in such a way that the at least one audio signal is suppressed or output at a lower volume during the output of the voice signal. A functional relationship is therefore required between the activation of the loudspeaker by the control unit and the suppression of the audio signal or the reduction of its volume. The scope of protection therefore does not cover configurations in which the sound signal and the voice message are output independently of each other without the loudspeaker being activated accordingly.

f)

Insofar as the respondents refer to statements made by the applicant in the grant proceedings in the context of the patent interpretation, such statements are generally not admissible interpretation material. They are therefore not to be taken into account in the context of patent interpretation from the outset.

Art. 24(1)(c) UPCA in conjunction with Art. 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 grant file is not mentioned in Art. 69 EPC, it does not in principle constitute admissible material for interpretation (see also Kühnen, Handbuch der Patentverletzung, 16th ed., section A, para. 114; Benkard/Scharen, EPC, Art. 69 para. 32 with further references). If the applicant has commented on the meaning of a feature or term during the examination procedure, this may at best be indicative of how the skilled person understands the feature in question. Whether, on the other hand, at least publicly accessible documents, such as the disclosure document, can be used to interpret the patent claim of the applicable version of the claim (apparently: UPC_CFI_292/2023 (LK München), order of 20.12.2023, GRUR-RR 2024, 93 - Elektronisches Etikett; in contrast: Kühnen loc. cit., para. 118), is not relevant for the present case and therefore does not need to be decided.

If one wanted to see this differently, the applicant's submissions in the grant proceedings do not provide any reason for a different interpretation of the patent claim anyway. It cannot be inferred from the applicant's statements that the simultaneous (and not just alternating) output of both signals is absolutely necessary.

3.

The features of the method claimed in patent claim 13 correspond to those of patent claim 1. The subject-matter of the adjacent patent claim 13 is therefore subject to the same assessment as that of patent claim 1.

4.

On the basis of such an understanding, the attacked embodiment makes use of the technical teaching of patent claim 1 in accordance with the literal meaning.

a)

The realization of characteristic group 1 as well as characteristics 2. and 2.1. is rightly not in dispute between the parties, so that no further explanation is required in this respect.

b)

In addition, the at least one loudspeaker in the attacked embodiment is also designed to emit at least one sound signal which is associated with the search for the at least one further avalanche transceiver (features 3. and 3.1.).

The sound patterns used in the challenged embodiment are acoustic signals different from voice messages and thus sound signals within the meaning of the patent in suit, irrespective of whether this technology is itself the subject matter of a patent (EP 2 527 011 B1) of the defendant (1). Since in the present case only a literal infringement of the patent in suit is at issue, such patenting of the challenged embodiment is thus relevant at most with regard to the validity of the patent in suit. The question of whether and, if so, under what conditions an equivalent infringement before the Unified Patent Court can be considered therefore does not require a decision, nor does the subsequent problem of dealing with the Formstein objection known from German law (see BGH, GRUR 1986, 803 - Formstein).

c)

Furthermore, the attacked embodiment also makes use of feature 4. in the alternative of "suppressing" in accordance with the literal meaning.

Based on the mode of operation of the search devices at issue described in detail by the defendants themselves, they have two different signal sources, namely one for acoustic patterns (sound patterns) and the other for acoustic speech, whereby during operation of the challenged embodiment in search mode only one of the two sources is selected and played back via the loudspeaker, while the output of the other source is deactivated (see statement of 19.01.2024, p. 8, para. 25.). If the voice message is output in the challenged embodiment, the audio signal is therefore not output. In other words, its generation is temporarily interrupted and thus suppressed within the meaning of the patent in suit. The parallel generation of both signals is, as the Local Board has already explained in detail, not a prerequisite for the realization of the technical teaching under protection. The defendants do not deny that the selection of a source and its reproduction via the loudspeaker is carried out by a control device within the meaning of the patent in suit (R. 171.2 VerFO).

5.

It is undisputed and as can be seen on the video submitted by the applicant as Annex KAP 32 to the file, the "Barryvox S2" shown at the ISPO trade fair in Munich had a voice output. This is also expressly mentioned in the reasons for the ISPO award. Even if, as claimed by the defendants, it was not yet clear at the time of the trade fair in which configuration the "Barryvox S2" would ultimately be launched on the market, the relevant public can assume, at least as long as they do not receive any deviating information, that the product ultimately delivered is essentially similar to the device.

which was exhibited at the trade fair. This applies all the more if the product in question - as here - was distinguished at the trade fair and certain functions such as the voice output were emphasized in this context. Apart from that, the "Barryvox S2" could in any case already be (pre-)ordered on the B2B platform of the defendants' group of companies (cf. KAP 9). The order overview submitted by the applicant also lacks any indication that the "Barryvox S2" is sold in different configurations and, in particular, without a voice output. Even there, purchasers have no reason to assume that the device in question - unlike the award-winning model exhibited at the trade fair - does not have a voice output.

6.

The use of the attacked embodiment also requires the use of the method according to patent claim 13. Reference is made to the above statements in order to avoid repetition. The other requirements for contributory patent infringement are also met, Art. 26 (1) EPC.

In particular, the subjective element of contributory patent infringement is present. The defendants advertise the suitability of the attacked embodiment for supplementary voice output in all search phases. Thus, it is not only obvious from the circumstances that the defendants know that the accused embodiment is objectively suitable to be used in a patent-infringing manner, but also that the customers of the accused embodiment use it to carry out the patent-compliant process. The defendants should therefore have been aware of the objective suitability for use in accordance with the patent and the intention of the users.

III.

The defendants cannot derive any entitlement to use the patent in suit from the fact that the defendant 1) is the proprietor of EP 2 527 011 (hereinafter: EP '011), which is older than the patent in suit. The "objection of prior right" raised by them with reference to the case law of the Federal Court of Justice (see BGHZ 180, 1 = GRUR 2009, 655 - Trägerplatte; Benkard/Scharen, Patentgesetz, 12th edition 2023, para. 5) does not apply.

Even if it can be assumed in favor of the defendants in the present summary proceedings that such an objection developed in national law can also be raised before the Unified Patent Court, the defendants cannot derive a positive right of use from it in the present case. Even according to the principles developed by the Federal Court of Justice, the earlier right is in any case only available to those who exclusively use its teaching and do not make use of additional features that are only taught in the later property right. Otherwise, the person entitled to an earlier right could make use of all dependent inventions, at least as long as he kept within the literal meaning of the patent claim, which would clearly go beyond the exclusive right conferred by the earlier patent (BGH, GRUR 2009, 655, 657, para. 27 - Trägerplatte). However, this is precisely the case with the contested embodiment. The generation of voice messages (feature group 2.) is not provided for in EP '011, as will be explained in detail in the discussion of the legal status, nor is a control device designed in the sense of feature group 4. Therefore, the defendants cannot derive a positive right of use justifying the infringement of the patent in suit from EP '011.

IV.

The license objection raised by the defendants for the first time at the oral hearing is also not valid. The patent-in-suit is covered by the excerpt of the patent application attached as Annex KAP 36 to the

license agreement (Art. 73 EPC). Therefore, the defendants cannot derive a positive right of use to the patent in suit from this agreement and thus also no right to offer and distribute the attacked embodiment in Germany and Austria.

1.

According to the preamble to this agreement, there were a number of differences of opinion between the contracting parties regarding the scope of a previous ruling by the Düsseldorf Higher Regional Court, which found that the German patent DE 10 2004 027 314 B4 had been infringed. These included in particular the validity of the judgment in the future in Germany with regard to the European patent EP 1 577 679 B1 granted in parallel. These differences of opinion were to be resolved by the agreement.

Against this background, the defendant 2) undertakes in the agreement to pay a lump sum, which is also intended to cover "the license fees to compensate for the future use of the patents US 7,403,112 B2, CA 2,501,035 C, DE 10 2004 027 314 B4 and the national parts of EP 1 577 679 B1 in Austria, Switzerland/Lichtenstein, Germany, France and Italy" (Annex KAP 36, No. II. 1.). The patent in suit is therefore neither covered by this provision nor by the subsequent compensation clause.

Nothing else follows from the preamble of the agreement. Even if the agreement was concluded "to avoid further disputes", this does not allow the conclusion that the agreement licenses all of the applicant's intellectual property rights in the field of "avalanche search devices" in favor of the defendants, even against the background of the agreed flat license fee. The contracting parties have clearly regulated the scope of the agreement in Section II. and, in particular, have clearly specified the industrial property rights covered. However, the patent in dispute is not included there.

2.

Insofar as the defendants submitted additional submissions on this topic in a non-admissible pleading dated March 15, 2024 and thus after the conclusion of the oral hearing, these submissions are late and therefore should not be taken into account. Pursuant to point 7. sentence 3 of the preamble to the Rules of Procedure, the parties must cooperate with the court and present their arguments as early as possible. Submissions that are only submitted after the conclusion of the oral proceedings are not in line with these requirements from the outset and must therefore 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. This is the only way to ensure that the respective court panel can assess the case on the basis of the state of facts and disputes reached in the oral hearing. However, the defendants were not granted such an extension of time to submit written pleadings and could not have been granted even if they had requested it. On the one hand, such a time limit for pleadings would run counter to the nature of summary proceedings. Secondly, respondent 2) is itself a party to the agreement in question. The defendants were therefore aware of this, or at least should have been aware of the agreement. To the extent that the representatives and an employee of the legal department of defendant 1) who was present at the hearing stated that they were not aware of the agreement, their knowledge is not decisive. The defendants should therefore have or could have already introduced the agreement into the proceedings with the request for examination. The fact that the petitioner, for its part, did not disclose the relevant agreement until the oral hearing is not decisive.

The fact that the EP 1 577 679 B1 was presented at the oral hearing does not contradict this. The opposing parties themselves have challenged such a procedure by introducing EP 1 577 679 B1 into the proceedings only one day before the oral hearing. It was only as a result of this that the applicant felt compelled to submit the corresponding agreement.

IV.

The legal 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 sufficient conviction of the validity of the patent required for the ordering of provisional measures if the court considers it to be predominantly probable that the patent is not valid. The burden of presentation and 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). On this basis, the local division, also taking into account the submissions of the respondents, is entitled to the decision pursuant to Art. 62 (4) UPCA in conjunction with Art. 62 (4) UPCA.

R. 211.2 VerFO of the legal validity of the dispute.

1.

The fact that the patent in suit has not yet survived any adversarial validity proceedings does not preclude this. If the patent on which a request for interim measures is based has already been maintained in opposition proceedings before the European Patent Office, this must be taken into account in the exercise of discretion, as must the outcome of other proceedings relating to the patent in suit before other courts in accordance with R. 209.2 (a) RP. In other words, the maintenance of the patent in suit in opposition proceedings before the European Patent Office or the maintenance of a national part of the patent in suit before a national court is a strong indication of a sufficiently secure legal position (see Tilmann/Plassmann/v. Falck/Dorn, Unitary Patent, Unified Patent Court, Rule 209 para. 8 f.).

If such other proceedings are merely to be included in the exercise of discretion, it follows conversely that the legal status can also be sufficiently secured without such prior proceedings. This is the case, for example, if the patent in question was published many years ago, but its legal validity was not challenged, and the defendant was not able to present the relevant prior art either in pre-litigation correspondence or in a protective document filed by it (see already UPC_CFI_177/2023 (LK Düsseldorf), order of 22/06/2023, GRUR 2023, 1370 - E-Bike). If the patent in dispute is subject to such a parallel attack on the legal validity, this does not exclude the ordering of provisional measures. In such a case, it is rather the task of the panel to assess whether the legal validity of the patent in dispute is sufficiently secured despite such an attack. Irrespective of the delimitation of certain degrees of probability (see UPC_CFI_2/2023 (LK München), order of 19.09.2023, p. 58 = GRUR 2023, 1513, 1519, para. 148 - Nachweisverfahren), this is in any case the case if the objections raised against the validity of the patent in suit are not likely to give rise to significant doubts as to the validity of the patent in suit.

2.

Based on these principles, the legal validity of the patent in dispute is sufficiently certain. The patent in suit was granted in 2019 without any opposition being filed against its grant. The arguments of the defendants do not give rise to any significant doubts in the aforementioned sense.

a)

Insofar as the defendants deal in detail with the destruction rates of patents in different jurisdictions (cf. statement of 19.01.2024, p. 21 - 26), they cannot get through with such general statistical considerations, if only because no conclusions can be drawn from them as to the sole decisive legal validity of the patent in dispute (cf. R. 211 No. 2 VerFO "of the patent concerned"). Apart from this, the figures submitted by the defendants in any case indicate at best a high destruction rate of patents challenged by an opposition or an action for revocation. However, this is only a small proportion of the patents granted (see also UPC_CFI_2/2023 (LK München), order of 15.09.2023, p. 58 = GRUR 2023, 1513, 1520, para. 151 - Nachweisverfahren).

b)

On summary examination, the subject-matter of claims 1 and 13 proves to be novel compared with the prior art cited by the applicant, Art. 54 EPC.

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/Melullis/Koch, Europäisches Übereinkommen - 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. Findings which a person skilled in the art only obtains on the basis of further considerations or by consulting other publications or uses are not prior art.

bb)

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

(1)

The subject matter of patent claim 1 proves to be new compared to WO 2006/051721 A1 (Annex KAP 17 or B 32, hereinafter WO '721), which was already taken into account in the grant proceedings and acknowledged in the patent in suit. In any event, there is no disclosure of the suppression of a sound signal during the output of a voice message (feature 4.).

Even if both buzzers and loudspeakers are mentioned in the citation (cf. p. 5, lines 16 - 19), these are only disclosed as alternative possibilities for designing the output device:

"In the context of the invention, an output device is understood to be any device that generates stimuli perceptible to the human senses, such as preferably optical stimuli in the form of optical displays and screens and/or acoustic stimuli in the form of buzzers or loudspeakers."

(WO '721, p. 5, lines 16 - 19, emphasis added)

The skilled person will look in vain in the citation for indications that, in addition to a buzzer, a loudspeaker may also be present as an output device. While the humanly perceptible visual or acoustic stimuli can be brought to an output device alternatively or cumulatively ("and/or"), the buzzer and loudspeaker are expressly in an alternative relationship ("or"). Nothing else follows from p. 11, lines 21 - 30 of the citation. The design described there has an optical display and can be

(besides) a voice output. In any case, there is no direct and express disclosure of a suppression of the sound signal during the output of a voice message.

(2)

Compared to DE 299 22 217 U1 (Annex KAP 19 or B 33, hereinafter DE '217), which was also considered in the grant proceedings, the subject-matter of patent claim 1 also proves to be new.

The buried object detector disclosed there has a receiving device that receives signals from a navigation satellite. First position values are calculated from this by means of a position calculating device. A transmitting device can send position values to the receiving device of another avalanche transceiver. The receiving device is also able to receive calculated second position values from another avalanche transceiver. A comparator compares the two position values and calculates the determination values, which enable the other avalanche transceiver to be located. The determination values are output on an output device (claim 1). Based on this, the solution disclosed in DE '217 is characterized by the fact that the position of the buried victim is precisely determined and displayed on the basis of a comparison of the calculated position values and the position signals transmitted by the other avalanche transceiver (DE '217, p. 3, 2nd para.).

Even if the output of the determination values necessary for localization on this basis can comprise a *speech processor* (cf. sub-claim 7 and p. 6, 4th para.), the disclosure of the output of at least one sound signal within the meaning of the patent in suit is lacking. As already explained in detail, sound signal and voice message are not the same according to the technical teaching of the patent in suit. Rather, the invention protected by the patent in suit is characterized by the fact that the control device controls the loudspeaker in such a way that the sound signal is suppressed or at least output at a reduced volume during the output of the voice message. Such a partial suppression or reduction of the volume of the sound signal during the output of the voice message excludes an identity of both signals from the outset.

The opponents correctly point out that an output device enabling the output of a speech signal is also suitable for outputting a sound signal. Moreover, in addition to the speech processor, the citation only mentions a display and a *signaling* device as further output devices (sub-claims 6. and 8.). The latter is only described functionally in sub-claim 8 in that it emits a conspicuous signal when the first and second position values match. Even if the skilled person draws the conclusion from this functional description of such a signaling device that this signal - unlike the signal *light* mentioned on p. 6 in the third paragraph - can also be a signal tone, he finds no indication in the citation that such a tone can be suppressed or at least reduced in volume during the output of the voice message. There is therefore in any event no disclosure of feature 4.

(3)

Nor does EP 2 527 011 A1 (Annex KAP 18 or B 8, hereinafter: EP '011) conflict with the novelty of patent claim 1.

The invention relates to an avalanche transceiver which comprises a receiving unit for determining a receiving direction of a transmission signal, a processing unit and a

acoustic signal generator (para. [0001]). A disadvantage of known search and transmitting devices is that the search for a buried victim requires a lot of time and practice. During a search, it is difficult to concentrate on the topography of the avalanche cone, to simultaneously pay attention to the visual and/or acoustic display of the search and transmitting device and to coordinate the search with other searchers (para. [0008]). Based on this, the search process should be simplified so that it can be successfully completed more quickly (para. [0009]). As a solution, the citation proposes an avalanche transceiver that assigns different sound patterns to different spatial angles depending on the direction of reception (para. [0010]).

The search and transmitting device comprises a receiving unit and a transmitting unit (par. [0055], lines 50 - 53; par. [0056], lines 4 - 5) as well as an acoustic signal generator with a loudspeaker (par. [0055], lines 38 - 41). In addition, the search and transmitting device comprises a visual display in which the direction of reception determined by the receiving unit can be displayed (par. [0064], lines 50 - 53).

In contrast to the solutions known to date, the acoustic signal is not proportional to the strength of the received transmission signal and therefore also to the alignment of the receiving antenna to the direction of reception of the transmission signal. Instead, the direction of reception is signaled independently of the strength of the received transmission signal. Therefore, no swivel movement of the avalanche transceiver is necessary (para. [0016]). For this purpose, the signal generator produces at least three tone patterns. The first tone pattern allows the direction of reception to be assigned to a front solid angle range, the second to a rear solid angle range and the third to a side solid angle range (par. [0010], [0017], [0018], [0020]). Alternatively, it is also possible to assign the receiving direction to more than 10 solid angle ranges. A quasi-continuous or even continuous display of the direction of reception is made possible by a corresponding number of tone patterns (par. [0034]).

Preferably, the tone patterns differ in at least one of the characteristics of tone frequency, repetition rate, duration of the individual tones and volume of periodically repeated individual tones. A tone pattern can also include double tones or multiple tones, whereby their individual tones can in turn differ in the aforementioned characteristics. A temporal variation of individual or several characteristics within a tone pattern is also possible (para. [0039]).

Thus, there is no disclosure of the generation of voice messages within the meaning of the patent in dispute (features 2., 2.1. and 4.). In particular, the sound patterns described in the citation are not to be classified as such. Rather, the document defines the sound pattern as single tones, double tones or multiple tones. The term "acoustic signal" used in paragraph [0046] of the citation is merely used as a synonym for the term "sound pattern".

On the other hand, insofar as the defendants refer to publication DE 10 2014 204 630 A1 (Annex B 58) and the paragraph [0009] therein for the definition of the term "sound pattern", according to which an acoustic source signal comprises all types of signals that can be output via the loudspeakers of a headphone, for example spoken language, music, noises, tones, etc., this does not lead to a different assessment. The decisive factor is not what another publication understands by the term "sound pattern", but which overall technical context is conveyed to the person skilled in the art by the content of a patent specification. It is not the linguistic or scientific definition of the terms used in the patent specification that is decisive, but the understanding of the unbiased person skilled in the art (see UPC_CoA_335/2023, order of 26.02.2024, GRUR-RS 2024, 2829, guiding principle 2 - Nachweisverfahren).

(4)

EP 1 577 679 A1 (Annex BB 2) is also not suitable for significantly calling into question the legal validity of the patent in suit.

(a)

It is not clear why the respondents, who have the burden of presentation and proof with regard to facts concerning the lack of validity of the patent (UPC_CoA_335/2024, order of February 26, 2024, leading sentence 3. and p. 30, penultimate paragraph, GRUR-RS 2024, 2829 - Nachweisverfahren), only submitted this document one day before the oral hearing. This document is a patent which the defendant 2) has already licensed in the past in favor of the applicant (see Annex KAP 36). The defendants were therefore already aware of the document for a long time or should have been aware of it. They could and should have introduced this citation, which is also not mentioned in the statement of claim before the Swiss Federal Patent Court (cf. Annex KAP 15), into the proceedings without further ado as part of their request for examination. According to R. 212.3

S. 2 VerfO in conjunction with. R. 197.3 sentence 2 (b) VerfO, the request for examination must already contain the facts and evidence submitted. The submission of the rebuttal immediately before the oral hearing and outside the time limits set by the local division for commenting does not even begin to meet this requirement. Rather, the defendants are also in breach of the obligation to submit their arguments as early as possible, as set out in point 7. sentence 3 of the preamble to the Rules of Procedure. On this basis, the belatedly submitted rebuttal must be rejected for formal reasons alone.

(b)

Apart from that, the document does not in any case anticipate the technical teaching protected by patent claims 1 and 13 in a manner prejudicial to novelty.

The caveat relates to a search device for locating a transmitter and in particular an avalanche transceiver. This is swiveled by the user to search a search area in an angular range of search angles which covers the search area. The device is equipped with a search antenna, a signal processing device and an output device for outputting result signals to the user (patent claim 1). The output unit (10) can be designed for the graphic output of result signals which represent the transmitter search angle (sub-claim 7).

As the person skilled in the art can see from paragraph [0049] of the citation, in a preferred embodiment the avalanche transceiver can have a display and a loudspeaker for outputting a synthetically generated search tone as feedback for the user. In such a design, the graphic display is therefore supplemented by a search tone. However, there is no voice output within the meaning of the patent in suit (feature group 2.). Therefore, no control device within the meaning of feature group 4 is required. Insofar as the defendants refer to paragraph [0097] with regard to the voice output, such a device is mentioned there. However, the relevant paragraph must be read together with paragraph [0096]. Accordingly, it is conceivable to combine a search device *according to the invention* with a GPS system (emphasis added). If use is made of this possibility, the search device therefore has a graphic output as well as a GPS system. The addition of a sound signal is merely a (different) embodiment example. There is no indication of a combination of both embodiments in the citation. Based on this, *the search device can* be combined with voice control, as is known, for example, with GPS for motor vehicles. In this case, the searcher receives acoustic instructions in the form of a voice generated by the search device (para.

[0097]). A voice output is to be added to "the search device", i.e. the one described above. This device, comprising a graphical output and a GPS system, is to be supplemented alternatively or additionally by a voice output. The result is thus a search device which has a graphic output as well as a voice output and - optionally - also a GPS system. A combination of voice message and audio signal is therefore also not disclosed here. There is therefore no need to control the output of two acoustic signals and therefore no need for a control device within the meaning of feature group 4.

c)

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 submissions of the defendants are not such as to give rise to significant doubts as to the existence of an inventive step.

aa)

This applies first of all to the extent that the defendants rely on a combination of WO '721 with the common general knowledge.

Contrary to the defendants' view, the citation does not disclose a design in which both sound signals and voice messages are output. Instead, the buzzer and loudspeaker are described exclusively as possible alternative designs of the output unit (p. 5, lines 16 - 19). The loudspeaker mentioned only enables the output of an acoustic stimulus in the form of a sound signal or a voice message. Therefore, based on this document, there was no reason for the person skilled in the art to output both signals through a loudspeaker and to think about their interaction in accordance with feature 4.

The defendants' attempt to derive such an occasion from the justification of the "ISPO Awards 2021" cannot be successful, if only because it is always an inadmissible retrospective view in this respect.

bb)

Nor are there any significant doubts as to inventive step based on DE '217.

If the person skilled in the art chooses this document as a starting point, he does not receive any suggestion to provide, in addition to the voice output described therein and the presentation on a display, an audio signal within the meaning of the patent in suit, which is suppressed by a control device during the output of at least one voice message (feature 4.).

Consideration of the general technical knowledge does not lead to a different result. Even if it can be assumed in favor of the defendants that sound signals are customary in the trade, there is no suggestion to the effect that such sound signals should be combined with other acoustic stimuli and in particular with voice messages in such a way that the output of the sound signals is suppressed or at least reduced in volume at the time the voice message is output.

The fact that knowledge of a technical issue is part of the general specialized knowledge does not prove that it was obvious for the skilled person to make use of this knowledge when solving a specific technical problem. The fact that the fundamental possibility of using sound signals in the search for buried victims is part of the general specialized knowledge

therefore does not indicate that it was obvious for the person skilled in the art to use sound signals in addition in the solution according to DE '217, which does not work with a combination of two acoustic stimuli.

cc)

The same applies to EP '011.

There, as explained, there is in any event no disclosure of a voice message within the meaning of the patent in suit. Insofar as, according to para. [0045] of the citation, sound patterns can be generated which comprise periodically repeated individual tones which differ in repetition rate, duration, tone frequency or in the volume of the individual tones and in which the individual parameters can also be combined, this is associated with the advantage that the searcher can intuitively read the direction of reception from the sound pattern generated by the signal generator (para. [0045]). In addition to audible acoustic tones, the spectrum of sound patterns also includes "inaudible acoustic signals" (para. [0046]), from which it cannot be deduced, however, that certain sound patterns should not be output during the output of other sound patterns.

As the skilled person understands from paragraph [0047] f. of the citation, the receiving device can be equipped with a visual display to supplement the acoustic signaling by means of the sound patterns. In this way, the searcher is guided acoustically through the sound patterns while he can concentrate visually on the terrain.

Even if the mention of such a visual indication should give the skilled person cause to explore ways of simplifying the search for a buried person, he has no reason to consider a voice output without falling into an always inadmissible retrospective view. The search disclosed in the citation is essentially based on the use of different sound patterns that vary depending on the spatial angle, so that the user can be guided by these sound patterns. Insofar as the embodiment discloses an optical display in addition to the sound guidance, this is merely an optical supplement to the sound guidance. The optical display appears alongside the acoustic sound guide without interfering with it or overlapping with it. The situation is different with voice output. Since voice output naturally involves the addition of further acoustic signals that may interfere with the sound pattern-based search, this presents the specialist with new challenges and problems. If acoustic signals in the form of voice messages are output in addition to the vector-related sound patterns, the question of prioritizing certain acoustic signals arises for the first time. The person skilled in the art therefore does not necessarily regard the addition of voice guidance to the different sound patterns depending on the spatial vector and thus the addition of further acoustic signals in the form of voice messages as a simplification. Rather, he is prevented from adding voice signals to the solution disclosed in EP '011 simply because the citation itself reveals a simpler way of optimizing the search: In addition to the sound signals assigned to a specific vector in each case, an optical display can be used. This not only avoids the problem of overlapping two acoustic signals. It also proves to be advantageous because it provides the searcher with the information required for the search in an additional way. This information is now presented not only acoustically, but also visually.

Based on these considerations, there are no obvious reasons why the skilled person should combine EP '011 with WO '721 and/or DE '217 and also consider adding voice guidance to the sound pattern-based search in EP '011. This

applies all the more since both documents disclose an overall concept which is clearly different from EP '011. If navigation is carried out on the basis of GPS-supported position signals, as in the solution disclosed in WO '721 and DE '217, no mandatory fixed assignment of certain sound patterns to certain vectors as the basis for navigation is required for proper functioning. The problem of overlapping sound signals therefore does not arise, nor does the question of prioritizing such signals.

dd)

Finally, EP 1 577 679 A1 (Annex BB 2), which was in any case introduced late into the proceedings and therefore rejected on formal grounds alone, does not preclude the inventive step. What reason the skilled person should have to modify the solution disclosed therein in such a way that a search device now emits both audio signals and voice messages is neither sufficiently presented nor apparent. In this respect, the above statements apply accordingly.

f)

The objection raised by the defendants that the invention in suit is not practicable (Art. 83 EPC) also does not give rise to any substantial doubt as to the validity of the patent in suit.

aa)

Insofar as the respondents question the practicability of patent claim 1 with regard to an allegedly non-executable disclosure of sound signal and voice message, these considerations are based on an alleged understanding of the applicant of the claimed technical teaching.

In the applicant's view, a constant simultaneity runs counter to the wording of the claim of the patent in suit, "since a sound signal is functionally related to the search for at least one further WMS, whereas a voice message is always functionally related to at least one event in the search for at least one WMS". Insofar as the applicant wishes to express that the sound signal and voice message can be output independently of each other without the loudspeaker being triggered accordingly, this contradicts the technical teaching of the patent in suit, which has already been explained in detail. This requires a functional connection between the event, the activation of the loudspeaker and the suppression of the sound signal or the reduction of its volume. Based on such an understanding, the objection of lack of disclosure has no basis.

bb)

The defendants' additional allegation that the patent in suit lacks an executable disclosure "how to realize the control of the loudspeaker if an ungenerated sound signal is to be suppressed" does not support the objection of insufficient disclosure either.

If a patent has been granted, sufficient disclosure must be assumed until the contrary is proven. In the present case, this leads to the burden of proof on the defendants that it is not possible for a person skilled in the art to carry out the claimed teaching using his technical knowledge and without unreasonable difficulty, even after taking note of the information in the description and the drawings of the patent in suit. The merely general allegation of lack of disclosure does not meet these requirements.

V.

The ordering of interim measures is necessary in the present case in order to prevent the continuation of the infringement or at least to prevent an imminent infringement (see R. 206.2 (c) VerfO).

According to the Rules of Procedure, both temporal and factual circumstances are relevant for the necessity of ordering interim measures. In addition to R. 209 No. 2 (b) of the Rules of Procedure ("urgency"), the relevance of temporal circumstances is also derived in particular from R. 211 No. 4 of the Rules of Procedure, 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 ordering of interim measures is derived, for example, from R. 211 No. 3 VerfO, according to which the possible damage that the applicant may suffer must also be taken into account when deciding on the application for interim measures. In contrast, potential damage to the opposing party must be taken into account when balancing interests (UPC_CFI_2/2023 (LK München), order of 19.09.2023 = GRUR 2023, 1513, 1523, para. 255 - detection method).

1.

Due to the circumstances in this case, the ordering of the requested interim measures is urgent in terms of time (R. 209.2 (b) VerfO).

a)

The temporal urgency required for the ordering of interim measures is only lacking if the injured party has been so negligent and hesitant in pursuing its claims that, from an objective point of view, it must be concluded that the injured party is not interested in the swift enforcement of its rights, which is why it does not seem appropriate to allow it to claim interim legal protection (cf. also UPC_CFI 2/2023 (LK München), order of 19.09.2023, p. 84 f. = GRUR 2023, 1513, 1524, para. 259 - Nach-procedure).

The applicant does not need to take any risks when pursuing the claim. Pursuant to R. 213.2 of the Rules of Procedure, the court may order the applicant to submit all reasonably available evidence in order to satisfy itself with sufficient 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 interim measures promising and if he can make these facts credible. The applicant may prepare 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 carry out subsequent investigations only during ongoing proceedings if necessary and to obtain the necessary documents retrospectively if necessary. On the flip side of this, however, 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 determined manner.

and bring it 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 interim measures within one month.

b)

Based on these principles, the applicant treated the matter with the necessary urgency.

aa)

Even if employees of the applicant were able to inspect a prototype of the attacked embodiment at a trade fair in the USA at the beginning of October 2023, they were at best aware of the attacked embodiment and its mode of operation from this point in time. However, this alone is not sufficient as a basis for an application for interim measures. Rather, for such an application to be successful, concrete evidence of infringing acts in at least individual member states in which the patent in dispute is validated is required. The appearance at a trade fair in the USA does not meet these requirements even if the contested embodiment is shown - as here - with an emergency number "Europe: 112". The patent in dispute is not valid in all European countries. Therefore, the applicant did not have to infer from such an exhibition alone with the certainty required for the application for interim measures that the attacked embodiment would be offered or offered and sold not only in Europe, but also in the validation states of the patent in dispute in the configuration shown. It did not have to take any risk at this time, but had to and was allowed to gather further information.

bb)

The defendants have not been able to show any concrete evidence that the applicant, contrary to its assertion, was already aware of offers within the contract territory before November 3, 2023.

(1)

The fact that the applicant did not seek urgent legal protection in advance of the "ISPO" trade fair is also not to her disadvantage. As long as it proceeds with overall determination in its legal action, it is its decision whether it seeks legal protection before the trade fair or waits until the start of the trade fair in order to obtain further information there, for example on the design of the attacked embodiment or the (intended) sales territory. In the present case, the defendants themselves provide a reason for such a wait. If they refer to the fact that the attacked embodiment currently only exists as a prototype, whereby it is not yet certain which version will ultimately be marketed, the applicant had every reason to first get an idea of the embodiment of the attacked embodiment shown there within the scope of the patent in suit at the trade fair. Since the applicant filed its application for interim measures immediately after the trade fair, the urgency is therefore given.

(2)

From the outset, the applicant does not have to be referred to possible summary proceedings in Switzerland. Such proceedings cannot be used to obtain an order for interim measures - unlike in the case already decided by the Local Chamber of Munich and cited by the defendants in support of their differing view (UPC_CFI_292/2023 (LK München), order of 20.12.2023, GRUR-RR 2024, 93 - Elektronisches

label) - for the Contracting Member States at issue here, Germany and Austria. The merely abstract possibility that such an order might also have indirectly prevented distribution in the contracting member states in question here does not represent an equivalent alternative for the applicant from the outset to summary proceedings now initiated before the Unified Patent Court. For the effective enforcement of the patent in suit, it is dependent on a title extending directly to Germany and Austria.

(3)

Whether interim measures can also be ordered ex parte immediately after a trade fair does not need to be answered in the review proceedings. Its subject matter is not the examination of the legality of the original order, but rather the examination of whether the prerequisites for the ordering of interim measures exist, taking into account the submissions of the defendants at the time of the conclusion of the hearing. In any case, action directly at the trade fair is not a prerequisite for an inter partes order. This applies all the more since the applicant also had to consider extensive submissions by the defendants in the nullity proceedings before the Swiss Federal Patent Court in the course of preparing summary proceedings. It may be that the applicant was already aware of these proceedings in Switzerland in the run-up to the trade fair. However, it must be conceded that, before filing an application for interim measures with the Unified Patent Court, it reviewed the comprehensive submission made there to determine what risks would arise in summary proceedings before the Unified Patent Court and whether, on the basis of the knowledge gained at the trade fair regarding the facts of infringement, it would seek an order for interim measures from the Unified Patent Court despite these risks. Such a risk analysis was all the more necessary since, according to the Rules of Procedure (R. 213.1 VerfO), the applicant must file an action on the merits in a timely manner if provisional measures are ordered. If this is the case, it must also expect that the legal validity of the patent in dispute will then also be challenged before the Unified Patent Court in the context of an action for revocation.

(4)

Even if the conduct after the ex parte order was issued must be taken into account when assessing urgency, no conduct on the part of the applicant that is detrimental to urgency is discernible at this stage of the proceedings. After the order for interim measures was issued on December 11, 2024, the applicant had already ordered service on December 15, 2023 (Annex KAP 33). In addition, the local division made the enforcement of the interim injunction dependent on the provision of security. It must be granted a reasonable implementation period to provide this (cf: UPC_CFI_177/2023 (LK Düsseldorf), order of 23.06.2023 = GRUR 2023, 1370 - E-Bike).

2.

The order for interim measures is also necessary from a factual point of view due to the damage that the applicant is threatened by the infringing product range of the defendants.

As the applicant has explained in detail and made credible with the help of an affidavit (Annex KAP 29), the "ISPO Munich" trade fair is the central leading trade fair for winter sports and winter tourism. Even if it is no longer possible to prevent business transactions at the trade fair by ordering interim measures after the trade fair, it is undisputed that business transactions can still be concluded after such a trade fair. This applies all the more if a product exhibited there - such as

here the attacked embodiment - was awarded a prize such as the ISPO Award at the trade fair. Even if the distribution of the attacked embodiment to end customers does not begin until summer 2024, the relevant transactions are already being concluded with retailers according to the undisputed submission of the applicant. In the current pre-order phase, commercial customers are currently placing binding orders for those products that they will receive from the manufacturers next summer and then offer to end customers in their stores. In addition, the challenged embodiment is a direct competitor product to a product of the applicant ("Ortovox Direct Voice"). Since each pre-order of the contested embodiment satisfies a demand that the applicant would otherwise have been able to satisfy, each pre-ordered copy of the contested embodiment already constitutes irreparable damage for the applicant. Since the applicant has also not granted any licenses to the patent in dispute, only the applicant is currently on the market with the special function of voice output (in combination with the search based on sound signals).

In order to grant the applicant effective legal protection in such a market environment, interim measures must be ordered. In proceedings on the merits, an oral hearing is expected within one year (see Rules of Procedure, Preamble, No. 7.). Such a procedure would therefore not effectively prevent the distribution of the contested design for the 2024/2025 winter season. The fact that, based on the defendants' submission, the attacked embodiment currently only exists as a prototype cannot change this because the "Barryvox S2" can already be pre-ordered for later delivery.

VI.

The balancing of interests to be carried out is also in the applicant's favor.

1.

Pursuant to Art. 62(2) UPCA (R. 211 no. 3 RP), the court must exercise its discretion in weighing 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 is that the right 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 opposed by possible damages of 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 milder 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 19.09.2023, p. 98 = GRUR 2023, 1513, 1525 f., para. 300 f. - Proof procedure).

2.

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

After the defendants were unable to establish a violation of the

patent in dispute, the Local Board is convinced on summary examination of an infringement of the patent in dispute by the actions of the defendants. In addition, the respondents have not been able to create significant doubts as to the legal validity of the patent in suit. Moreover, the Local Chamber is clearly convinced that one-off measures are necessary due to the infringement of the patent in dispute, both in terms of substance and time.

Against the background of the established infringement of the patent in suit, the defendants have no legitimate interest in offering or distributing the accused embodiment infringing the patent in suit in Germany or Austria, either without or against security. Insofar as they claim that an injunction would lead to an irrevocable disadvantage for them, the disadvantages listed by them are ultimately only the consequence of the competitive situation described by the applicant. Without such an injunction, the resources of the dealers are tied up due to (potential) orders of the attacked embodiment. They are therefore not available for the applicant's product, which threatens the applicant with irreparable damage. The fact that this is the case is ultimately confirmed indirectly by the defendants themselves, in that they refer to the fact that in the event of an in-ter-partes order, pre-orders would be canceled, which would free up the relevant resources for other orders, such as for the applicant's devices. Conversely, these resources are therefore lacking insofar as they are tied up by orders for the challenged embodiment. In such a situation, the applicant's interest in enforcing the patent in dispute takes precedence. In view of the established infringement of the patent in suit, the defendants have no interest worthy of protection in securing the pre-existing orders. If it suffers damages as a result of the injunction order, it can demand compensation from the applicant in accordance with R. 213.2 VerfO.

The reference of the defendants to alleged third-party interests is in the present case already in vain because, according to their own submission, the challenged embodiment exists so far only as a prototype. If the avalanche search devices at issue are not currently in use in practice, the disadvantages for the survival chances of avalanche victims mentioned by the defendants are at best of a theoretical nature. This applies all the more since at least two alternative avalanche search devices are available with the applicant's product as well as with the predecessor product of the challenged design and can therefore already be used in the search for buried victims. These cannot change the result of the balancing of interests.

VII.

The Düsseldorf Local Court is convinced with the certainty required for the ordering of provisional measures that the defendants are making unlawful use of the technical teaching of the patent in suit by offering and selling the contested embodiment within the scope of the patent in suit. Likewise, the legal validity of the patent in suit is secured to the extent required for the ordering of provisional measures. Since the ordering of provisional measures is also necessary both in terms of time and substance and, in addition, the balancing of interests is also in favor of the applicant, the following legal consequences result:

1.

The Court, exercising its discretion (R. 209.2 RP), considers the issuance of an interim injunction to be appropriate and justified (Art. 62(1), 25(a), 26(1) UPCA). Only an injunction takes into account the applicant's interest in the effective enforcement of the patent in suit. This must be overridden by the interest of the defendants in the

continuation of the sale - without or against security - for the reasons stated.

2.

The seizure order is based on Art. 62 para. 3 UPCA in conjunction with Art. R. 211.1 (b) of the Rules of Procedure. Such an order appears appropriate and necessary, taking into account the interests of both parties. It is not apparent that the defendants have an interest in keeping copies of the contested embodiment infringing the patent in suit in their possession. As stated, the applicant did not have to be referred to possible summary proceedings in Switzerland. The possibility of initiating such proceedings therefore does not affect the need for legal protection for an injunction from the outset.

3.

Insofar as the Düsseldorf Local Chamber has also threatened to impose penalty payments in the event of non-compliance, this threat is based on R. 354.3 VerfO. With the number of products or the number of days, a value for the calculation of the penalty payment is already fixed. However, setting a maximum limit per product or day gives the local chamber the necessary flexibility to also take into account the behavior of the offender in the event of an infringement and to be able to set an appropriate penalty payment on this basis in accordance with R. 354.4 VerfO.

On this basis, there is no reason for the reduction of the penalty payment sought by the defendants, even taking into account the envisaged sales price of the challenged design. The penalty payment is intended to reliably deter the debtor from future infringements and violations and therefore primarily has a punitive function. In addition, the penalty payment represents a penalty-like sanction for the violation of the court prohibition. This dual purpose of the penalty payment makes it necessary to assess the penalty payment first and foremost with regard to the debtor and their behavior. In particular, the type, scope and duration of the infringement, the degree of fault, the advantage of the infringer from the infringing act and the dangerousness of the committed and possible future infringing acts for the infringed party must be taken into account (UPC_CFI_177/2023 (LK Düsseldorf), order of 18.10.2023 = GRUR 2024, 280, 285, para. 54 - E-Bike III). This is taken into account by the threatened penalty payment, which allows the local chamber to set an appropriate penalty payment in each individual case, taking into account the aforementioned factors.

Even if the defendants have complied with the cease-and-desist order of the Düsseldorf Local Chamber, which can be assumed in their favor, such legally compliant conduct does not provide grounds for the reduction of the threatened penalty payment sought by the defendants. Rather, it is an expression of the fact that the threat of a penalty payment already has sufficient effect. If there is no breach of the cease and desist order, the imposition of penalty payments is ruled out. By contrast, the mere threat of such fines does not impose a disproportionate burden on the defendants.

The differentiation between the distribution of the challenged embodiment and permanent trade, such as offers on the Internet, is appropriate from the point of view of proportionality.

4.

By requesting the reimbursement of pre-trial costs in its response to the defendants' application for review, the applicant has not yet submitted its application for interim measures.

subsequently extended to include this claim. The applicant can apply for such an extension at any time (R. 263.1 p. 1 VerfO). However, pursuant to R. 263.2 of the Rules of Procedure, such an application must be rejected if the applicant cannot convince the court, taking into account all the circumstances, that the amendment in question could not have been made earlier with due diligence and that the amendment does not unreasonably impede the other party in its conduct of the proceedings.

Both requirements are met in the present case.

In the applicant's favor, it should be noted that the question of the handling of the reimbursement of costs in summary proceedings before the Unified Patent Court, which will be discussed in detail below, has not yet been clarified by the highest court and has already been handled differently at first instance. In the ex parte order issued in the present proceedings on December 11, 2023, the Düsseldorf Local Chamber rejected the applicant's request for a basic decision on costs in summary proceedings for the first time ever. At the same time, the Local Court referred to the lack of an application for provisional reimbursement of costs (UPC_CFI_452/2024, order of December 11, 2023, p. 10 below = GRUR-RR 2024, 97, 101, para. 44 - Verschüttetensuchgerät). The applicant responds to this reference with its subsequent application for provisional reimbursement of costs. It cannot be denied this from the point of view of the right to be heard.

The defendants are also not unreasonably hindered by the subsequent admission of the application for provisional reimbursement of costs. If the applicant had already included the request for provisional reimbursement of costs in her original application, the ex parte order would have already contained a corresponding payment obligation. This is now made up for by the extension of the application by adding a corresponding statement to the original order. A supplement - albeit a minor one - would have been necessary anyway. The costs incurred by the examination proceedings had not yet been incurred at the time of the ex parte order. These would therefore have had to be subsequently supplemented by an extension of the application anyway. If, on the other hand, the local division had followed the applicant's original request and issued the requested basic decision on costs, the defendants would subsequently have had to undergo cost assessment proceedings.

Insofar as the applicant calculates her preliminary costs on the basis of the German Lawyers' Fees Act (RVG), the costs recoverable under this law are in the lower range. It can be assumed that these are below the amount ultimately recoverable before the Unified Patent Court. If the applicant decides to limit itself to these amounts in summary proceedings for simplification purposes, this is therefore a suitable reference point for the reasonable and therefore at least recoverable costs. Such an approach is therefore not objectionable.

5.

Since their request for examination was unsuccessful, a provisional reimbursement of costs in favor of the defendants is ruled out from the outset. The question of whether R. 211.1 (c) VerfO also permits the ordering of a provisional reimbursement of costs in favor of the defendant (for this UPC_CFI_182/2023 (LK Wien), p. 19 = GRUR-RS 2023, 35213, para. 48 et seq. - Milchaufschäumer) therefore does not need to be decided in the present proceedings.

VIII.

Pursuant to R. 211.5 VerfO p. 1 VerfO, the court may, in the event of the revocation of the order

The court may require the defendant to provide appropriate security for the damage that the defendant is likely to suffer in the event of interim measures. If the specific case - as here - does not exceptionally require otherwise, this option should generally be used. The decision to order interim measures is based on an only preliminary assessment of the factual and legal situation, which is inherently uncertain. In addition, the provisional measure represents a considerable encroachment on the rights of the patent infringer, who is massively restricted in the exercise of his economic activity. This uncertainty and the intensity of the interference can only be taken into account by ordering the provision of security (Tilman/Plassmann, Einheitspa- tent, Einheitliches Patentgericht, Rule 211 para. 32).

As far as the amount of the security is concerned, this should cover the legal costs, other costs due to the enforcement and possible compensation for damages incurred or likely to be incurred, R. 352.1 VerfO. However, it is difficult for the local division to estimate the amount of possible enforcement damages at the time this order is issued. Against this background, the security set is based on the amount in dispute. Even if the amount in dispute does not necessarily correspond to the risk of damage, it does provide an indication of the economic importance the applicant attaches to the matter. The defendants had the opportunity to present the risks to be covered by the security deposit during the examination procedure. As they did not make use of this opportunity, there is no reason to change the amount of the security deposit.

IX.

There is no reason for a basic decision on costs in proceedings to order interim measures if the summary proceedings - as here - are followed by proceedings on the merits.

1.

Pursuant to Article 69(1) UPCA, the costs of the proceedings and other costs incurred by the successful party shall be borne by the unsuccessful party up to a maximum amount determined in accordance with the Rules of Procedure, unless there are equitable grounds to the contrary. The standard therefore determines the content of the cost decision, namely by whom and to what extent the costs of the legal dispute and the other costs of the losing party are to be borne (a. A.: UPC_CFI_2/2023 (LK München), order of 19.09.2023, p. 103 = GRUR 2023, 1513, 1526, para. 315 - Evidence procedure). However, it does not relate to the proceedings in which the decision on costs is made. Rather, this is the subject of R. 118.5 VerfO (see Dold/W. Tilman in: Tilman/Plassmann, Unitary Patent, Unified Patent Court, Art. 69 para. 1 and 3). However, according to its systematic position, this provision already relates to the main proceedings. In the R. 205 et seq. VerfO concerning the ordering of provisional measures.

2.

For an analogous application of R. 118.5 VerfO, there is at least a lack of an unintended regulatory gap as a basic prerequisite for such an application (see also: UPC_CFI_249/2023 (LK München), order of 19.12.2023, headnote, GRUR-RS 2023, 40572), if - as here - the summary proceedings are followed by proceedings on the merits.

Pursuant to R. 211.1 (d) VerfO, the court may order the provisional reimbursement of costs as an interim measure. If the applicant does not initiate the main proceedings within the time limit following the order for interim measures, the corresponding order is to be revoked in accordance with

R. 213.1 VerfO must be lifted. As a rule, the ordering of interim measures is therefore followed by proceedings on the merits. For the decision there, R. 118.5 VerfO requires that a basic decision on costs be issued. If the main proceedings are preceded by an order for interim measures, the Rules of Procedure therefore provide for a two-stage procedure: So that the applicant does not have to advance the costs arising from the application for interim measures over a longer period of time and thus also bear the insolvency risk of the other party, he has the option of having an obligation on the part of the defendant to reimburse provisional costs included in the interim order. In the main proceedings, the court then makes a basic decision on costs on the basis of R. 118.5 VerfO, which forms the basis of any subsequent cost assessment proceedings (R. 150 et seq. VerfO). As long as the proceedings for interim measures are followed by proceedings on the merits, there is therefore no (unintended) regulatory gap. The requirements for an analogous application of R. 118.5 VerfO are therefore not met, at least in such a case constellation.

ARRANGEMENT:

- I. The order for provisional measures dated December 11, 2023 (ORD_591011/2023) is upheld, including the obligation to provide security in the amount of EUR 500,000.00 contained therein.
- II. The defendants are ordered to provisionally reimburse the applicant costs in the amount of EUR 33,375.70.
- III. The defendants' application to order provisional reimbursement of costs in their favor in the amount of EUR 19,858.40 is dismissed.
- IV. This order is provisionally enforceable.

DETAILS OF THE ARRANGEMENT:

App_4074/2024 for main file reference ACT_589655/2023

UPC number: UPC_CFI_452/2023

Type of proceedings: Application for interim measures

Issued in Düsseldorf on April 9, 2024 NAMES

AND SIGNATURES

Presiding Judge Thomas

Ronny
Thomas

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for the Deputy Chancellor Strysio

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INFORMATION ABOUT THE APPOINTMENT

The respondents may appeal against this order within 15 days of its notification (Art. 73(2)(a), 62 UPCA, R. 220.1(c), 224.2(b) RP).

INFORMATION ON ENFORCEMENT (ART. 82 EPGÜ, ART. ART. 37(2) EPGS, R. 118.8, 158.2, 354, 355.4 VERFO)

A certified copy of the enforceable judgment or order is issued by the Deputy Registrar at the request of the enforcing party, R. 69 RegR.