



Düsseldorf Local Division

UPC_CFI_452/2023

Order

of the Court of First Instance of the Unified Patent Court

Düsseldorf Local Division

issued on 9 April 2024

concerning EP 3 466 498 B1

HEADNOTES:

1. Art. 24 para. 1 (c) UPCA in conjunction with Art. 69 EPC conclusively determine which documents are to be used in 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 most 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 the context of proceedings for an order for provisional measures. It only needs to call upon the court if it has reliable knowledge of all the facts that make legal action in the proceedings for an order for provisional measures promising and if it can credibly demonstrate these facts.
3. Pursuant to point 7. sentence 3 of the preamble to the Rules of Procedure, the parties must co-operate 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 fulfil 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 application during the oral hearing.
4. There is no need for a basic decision on costs in proceedings for an order for provisional measures if the summary proceedings are followed by proceedings on the merits. In this case, the Rules of Procedure provide for an interim award of costs (R. 211.1 (d) RoP), 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 RoP therefore already lacks an unintended regulatory gap.
5. In the event that the order for provisional measures is revoked, the court may require the provision of appropriate security in favour of the defendant. Unless the specific case does not exceptionally require otherwise, this option is generally to be utilised.

KEYWORDS:

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

APPLICANT:

Ortovox Sportartikel GmbH, Rotwandweg 5, 82024 Taufkirchen, represented by the Managing Director Christian Schneidermeier, *ibid*,

represented by: Attorney Miriam Kiefer, Attorney Robert Knaps, Law firm
Kather Augenstein, Bahnstraße 16, 40212 Düsseldorf,
electronic address for service: kiefer@katheraugenstein.com
Contributing: Patent attorney Michael Siebel, law firm Hofstetter, Schurack &
Partner, Patent- und Rechtsanwälte PartG mbB,

DEFENDANT:

1. Mammut Sports Group AG, Birren 5, 5703 Seon, Switzerland represented by its legal representatives, *ibid*,

represented by: Attorney Oliver Jan Jüngst, Attorney Dr Moritz Schroeder,
Attorney Dr Alexander Bothe, law firm Bird & Bird LLP, Carl-
Theodor-Straße 6, 40213 Düsseldorf,
Electronic address for service: oliver.jan.juengst@twobirds.com
Contributing: Patent attorney Dr Dr Fabian Leimgruber, law firm Thomann
Fischer, Elisabethenstraße 30, CH-4010 Basel,

2. Mammut Sports Group GmbH, Mammut-Basecamp 1, 87787 Wolfertschwenden, Germany, represented by its legal representatives, *ibid*,

represented by: Attorney Oliver Jan Jüngst, Attorney Dr Moritz Schroeder,
Attorney Dr Alexander Bothe, law firm Bird & Bird LLP, Carl-
Theodor-Straße 6, 40213 Düsseldorf,
Electronic address for service: oliver.jan.juengst@twobirds.com
Contributing: Patent attorney Dr Dr [sic] Fabian Leimgruber, law firm
Thomann Fischer, Elisabethenstraße 30, CH-4010 Basel,

PATENT IN SUIT:

EUROPEAN PATENT NO. EP 3 466 498 B1

Panel/Division:

Panel of the Düsseldorf Local Division

Participating Judges:

This order was issued by presiding judge Thomas, legally qualified judge Dr Thom, legally qualified

judge Dr Schober and technically qualified judge Dr Wismeth.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT-MATTER: R. 212.3 RoP in conjunction with R. 197.3 and 197.4 RoP - Request for review of the order for provisional measures

ORAL HEARING: 5 March 2024

SUMMARY OF THE FACTS:

The applicant is the sole proprietor of the European patent EP 3 466 498 B1 (hereinafter: patent in suit). The patent in suit was filed in German on 9 October 2017. The patent application was published on 10 April 2019 and the mention of the grant of the patent in suit was published on 4 December 2019. The patent in suit 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, defendant 1) challenged the Swiss part of the patent in suit with an action for revocation dated 11 July 2023 (case number: 02023_012). With regard to the content of this revocation action, reference is made to Annexes KAP 15 to KAP 28 and set of Annexes BB 1. A decision by the Federal Patent Court of Switzerland on this revocation action is still pending.

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

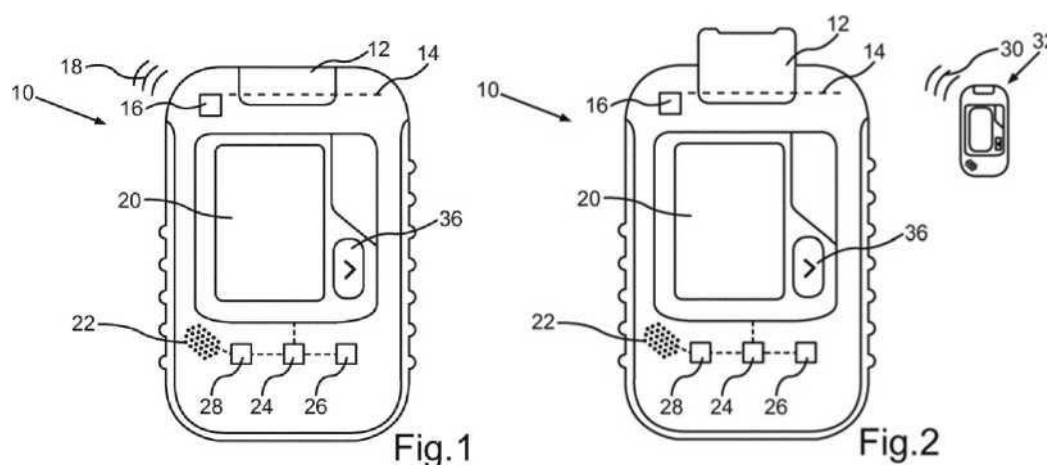
"Avalanche transceiver, having a transmitting unit (16) for transmitting at least one transmit signal (18), a receiving unit (16) for receiving at least one transmit signal (30) from at least one further avalanche transceiver (32), and a control device (24) for controlling at least one loudspeaker (22), wherein the control device (24) is designed to control the at least one loudspeaker (22) to output at least one voice message on the basis 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), wherein the avalanche transceiver (10) has the at least one loudspeaker (22) and the at least one loudspeaker (22) is designed to issue at least one audio signal, **characterised in that** the at least one audio signal is associated with the search for the at least one further transceiver (32), wherein the control device (24) is designed to control the at least one loudspeaker (22) such that the at least one audio signal during the output of the at least one voice message is suppressed or output with 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 for operating an avalanche transceiver (10) which has a transmitting unit (16) for transmitting at least one transmit signal (18), and a receiving unit (16) for receiving at least one transmit signal (30) output from 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) controls the at least one loudspeaker (22) such that the at least one loudspeaker (22) outputs at least

one voice message, wherein the at least one loudspeaker (22) is controlled by the control device (24) on the basis 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) outputs at least one audio signal, **characterised 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) controls the at least one loudspeaker (22) such that the at least one audio signal during the output of the at least one voice message is suppressed or output with a reduced volume."

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 transmitting mode, it operates in a receiving mode in Figure 2. In this case, another avalanche transceiver (32) is in a transmitting mode.



With its application for an order for provisional measures, the applicant is directed against the offer and sale of the avalanche transceiver "Barryvox S2" (hereinafter: contested embodiment), which is shown in the following illustration:



Defendant 1) exhibited the contested embodiment at the "ISSW" trade fair in Bend, Oregon (USA), from 8 October 2023 to 13 October 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 contested

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

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

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

- I. The defendants are ordered to refrain from,
 1. offering, placing on the market or using or importing or possessing for these purposes, in the Federal Republic of Germany and/or the Republic of Austria,

avalanche transceivers with at least

a transmitting unit for transmitting at least one transmit signal,

a receiving unit for receiving at least one transmit 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 on the basis of 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 issue at least one audio signal,

characterised in that

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

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

2. offering and/or delivering 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,

devices suitable for carrying out a method for the operation of an avalanche transceiver

wherein the method comprises at least the following:

a transmitting unit for transmitting at least one transmit signal,

a receiving unit for receiving at least one transmit signal which is output from at least one further avalanche transceiver,

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

wherein the control device controls the at least one loudspeaker such that the at least one loudspeaker outputs at least one voice message,

wherein the at least one loudspeaker is controlled by the control device on the basis of at least one event which is associated with a search for the at least one further avalanche transceiver,

the avalanche transceiver has the at least one loudspeaker and the at least one loudspeaker outputs at least one audio signal,

characterised in that

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

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

- II. For each individual violation of the above order, the defendants are 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 violations 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 method 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 favour of the defendants in the form of a deposit or bank guarantee in the amount of EUR 500,000.

In documents dated 19 January 2024 (App_3217/2024, App_3259/2024 and App_4074/2024), the defendants requested that this order be reviewed.

Following a hearing of the parties, the Düsseldorf Local Division, by an order dated 26 January 2024 (ORD_3347/2024), called in a technically qualified judge, who was then allocated to the Local Division by the President of the Court of First Instance.

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

APPLICATIONS BY THE PARTIES:

The defendants request that,

1. the order in the context of the review pursuant to R. 212.3 first sentence RoP be revoked and the application for the adoption of provisional measures be rejected,

- in the alternative -
 - 1.1. the defendants be allowed 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. an interim award of costs be ordered in favour of the defendants in the amount of EUR 19,858.40;
3. the applicant be ordered to pay the costs of the proceedings;
4. the immediate enforceability of the order be ordered;

- in the strongest alternative -
 5. the penalty payment threatened for each individual violation of the order (which may be repeated) be limited to EUR 2,500 per product and/or up to EUR 5,000 per day in the case of permanent violations such as offers on the Internet;
 6. the applicant's application for an interim award of costs in the amount of 33,375.70 EUR be rejected.

The applicant requests that,

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

FACTUAL AND LEGAL ISSUES:

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

Moreover, defendant 1) is the proprietor of EP 2 527 011 (hereinafter: '011), which is older than the patent in suit. The contested embodiment makes use of the technical solution disclosed therein. The "prior use objection" therefore argued in favour of the defendants, from which a positive right of use of the defendants in the patent in suit arose. Apart from this, the patent in suit is in any case covered by a licence agreement concluded between the applicant and defendant 2) in 2010 and is therefore licensed in favour 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 audio signal and the voice message.

The order for provisional measures was also not necessary.

The contested embodiment is purely a prototype that is still in a test phase and whose production phase is not yet certain, either in fact or in time. In addition, the applicant had itself refuted the urgency of the matter by its unreasonable delay in applying for the provisional measures. According to the applicant's own submissions (Annex KAP 8), its employees had tested the contested

embodiment for the first time at the ISSW (International Snow Science Workshop) trade fair, which was organised from 8 October 2023 to 13 October 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, an order for provisional measures could no longer have prevented alleged business transactions at the trade fair and in the immediate aftermath. Insofar as the applicant relied on the fact that the contracts for the majority of the sales would be concluded by Christmas to justify its application, this objective was missed because the order for provisional measures was not served until 21 or 22 December 2023.

Moreover, the applicant had not sought legal protection against the manufacture of the contested embodiment in Switzerland, thereby demonstrating 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 order 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 was also in favour of the defendants from every conceivable point of view. In any case, the legal consequence of a possible patent infringement is not a "right" 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 an interim award of costs is based on a calculation of costs in accordance with established German practice under the German Lawyers' Fees Act (RVG (*Rechtsanwaltsvergütungsgesetz*)).

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 embodiment, the relevant facts and the behaviour of the defendants in accordance with the order after service of the order for provisional 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 contested embodiment could have been ordered without restriction for the area in suit with voice guidance.

Furthermore, the contested embodiment makes use of the technical teaching of the patent in suit in the literal sense. Audio patterns within the meaning of EP '011 are also audio 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 audio signal and voice message.

The legal validity of the patent in suit was sufficiently certain. 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 favour of the applicant. The economic damage suffered by the applicant if an injunction is not issued is greater than the damage suffered by the defendants if the order is revoked. The matter was also urgent. The applicant did not have to infer that the contested embodiment should also be offered in the validation states of the patent in suit solely on the basis of the exhibition in the USA. Even if it subsequently became apparent that the contested embodiment was manufactured by defendant 1) in Switzerland, this was not sufficiently obvious 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' behaviour was lawful. The applicant had proceeded swiftly in pursuing its rights. It did not have to allow itself to be referred to possible proceedings in Switzerland. It was free to decide where it wanted to enforce its patent.

The Rules of Procedure only provide for an interim award 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 an award in the amount of EUR 33,375.70.

The defendants have countered this argument.

In order to avoid repetition, reference is also made to the documents exchanged by the parties prior to the oral hearing, including the annexes.

REASONS FOR THE ORDER:

The admissible application for an order for provisional measures is well-founded, even taking into account the defendants' defence.

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 is therefore entitled to file an application pursuant to Art. 47 (1) UPCA.

II.

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

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 known in the state of

the art. For example, WO 2006/015721 A1 describes an avalanche transceiver with a display device that 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 a disadvantage that the search for the transmitting avalanche transceiver is difficult despite the search instructions and the audio signal shown on the display. 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 themselves 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 characterised by the following features according to patent claim 1:

1. Avalanche transceiver,
 - 1.1. having a transmitting unit (16) for transmitting at least one transmit signal (18),
 - 1.2. a receiving unit (16) for receiving at least one transmit signal (30) from at least one further avalanche transceiver (32)
 - 1.3. and having 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 on the basis 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 the at least one loudspeaker (22) and the at least one loudspeaker (22) is designed to issue at least one audio 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) such that the at least one audio signal during the output of the at least one voice message is suppressed or output with a reduced volume.

2.

Some features of this claim require further explanation.

a)

According to the invention, the avalanche transceiver has, in addition to a transmitting unit and a receiving unit (16), a loudspeaker (22) and a control device (24) for controlling this loudspeaker (feature group 1.). The reason for the need for such a control device is obvious to the skilled person, a graduate engineer or master of 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 according to the invention is designed to emit at least one audio 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 "audio signal" to certain acoustic signals. Rather, when considering the aforementioned feature groups in isolation, they will understand an "audio 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 audio signals within the meaning of the patent in suit. They may be present in addition to and as a supplement to the audio signals (col. 11, lines 17 - 26), but do not make the presence of audio 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. in respect of the principles applicable thereto: UPC_CoA_335/2023, order of 26 February 2024, GRUR-RS 2024, 2829, paras 73 - 79 - *Nachweisverfahren*). If the skilled person takes this as a starting point and looks at the description of the patent in suit, it is disclosed to them in paragraph [0010] that the audio 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 (col. 2, lines 49 - 53, emphasis added). Since the description of the patent in suit expressly emphasises the exemplary character of the audio signals described therein in detail, the skilled person has no reason to assume that the patent in suit understands the term "audio 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 "audio signals" and "audio patterns" advocated by the defendants. If they are associated with the search for at least one other avalanche transceiver, "audio patterns" are therefore also "audio 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 defendants failed to prove that this prior art and in particular the above-mentioned distinction of audio signals and audio patterns at the time of priority belonged

to the common general knowledge in the field of the patent in suit. This document is therefore not admissible interpretative material from the outset.

c)

In their considerations, the skilled person must also take into account that, in addition to the audio signals, claim 1 also recognises voice messages which are also associated with a search for the 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 audio 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 audio 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 configuration of the audio signal or the voice message, it is clear from the overall system of the claim that a audio signal within the meaning of the patent in suit is any acoustic signal associated with the search for another avalanche transceiver 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] et seq., [0021], [0023] et seq., [0028] et seq., paras [0031], [0033] et seq., paras [0036] - [0039]).

d)

According to the invention, the loudspeaker thus emits two acoustic stimuli (audio signals, voice message) that can be distinguished from one another. If this is done simultaneously, however, the audio signals emitted (for example in the form of beeps) can interfere with the intelligibility of the speech (col. 3, lines 3 - 5). Therefore, the control device (24) according to the invention 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 avalanche transceiver 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 skilled person takes two things from this:

On the one hand, the loudspeaker is to be controlled on the basis of an event associated with the search for a further avalanche transceiver (features 2. and 2.1.). Insofar as the description of the patent in suit deals in detail with such possible events (cf. paras [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 allows the audio signal to continue to be generated and output during the output of the voice message. Suppressing the audio signal, on the other hand, requires that the audio 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 audio signal. Its technical realisation is therefore also left to the skilled person. The scope of protection therefore covers both designs in which the volume of the audio signal is temporarily set to zero and those in which the signal is temporarily no longer generated. If the audio signal is temporarily not generated, the person skilled in the art recognises this as a temporary deactivation and thus suppression of this signal.

The general use of language cited by the defendants to justify their differing view 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 document of 19 January 2024, p. 12 et seq.). Apart from this, 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 design 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 operatively connected in accordance with the invention: The control device should control the loudspeaker as a function of at least one event associated with the search for a further avalanche transceiver 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 control 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 audio signal and the voice message are output independently of each other without the loudspeaker being controlled accordingly.

f)

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

Art. 24 para. 1 (c) UPCA in conjunction with Art. 69 EPC conclusively determine which documents are to be used for the interpretation of the patent claims determining the scope of protection, namely the patent description and the patent drawings. Since the 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 most have indicative significance as to 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 so: UPC_CFI_292/2023 (LD Munich), order of 20 December 2023, GRUR-RR 2024, 93 - *Elektronisches Etikett*; against this: Kühnen loc. cit., para. 118), is not relevant for the present case and therefore does not need to be decided.

If this were to be seen differently, the applicant's submissions in the grant proceedings do not in any case provide any reason for a different interpretation of the patent claim. 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 contested embodiment makes literal use of the technical teaching of patent claim 1.

a)

The realisation of feature group 1 as well as features 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 contested embodiment is also designed to emit at least one audio signal which is associated with the search for the at least one further avalanche transceiver (features 3. and 3.1.).

The audio patterns used in the contested embodiment are acoustic signals different from voice messages and thus audio signals within the meaning of the patent in suit, irrespective of whether this technology is itself the subject of a patent (EP 2 527 011 B1) of defendant 1). Since in the present case only a literal infringement of the patent in suit is at issue, such patenting of the contested 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 contested embodiment also makes literal use of feature 4. in the alternative of "suppression".

On the basis of 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 (audio patterns) and the other for acoustic speech, whereby during operation of the contested 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 document of 19 January 2024, p. 8, para. 25.). If the voice message is output in the contested 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. As the Local Division has already explained in detail, the parallel generation of both signals is not a prerequisite for the realisation of the protected technical teaching. 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 RoP).

5.

It is undisputed that the "Barryvox S2" shown at the ISPO trade fair in Munich had a voice output, as can be seen on the video submitted by the applicant as Annex KAP 32 to the file. 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 information to the contrary, 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 labelled at the trade fair and certain functions such as the voice output were emphasised 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, customers 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 contested 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) UPCA.

In particular, the subjective element of contributory patent infringement is given. The defendants advertise the suitability of the contested embodiment for supplementary voice output in all search phases. Thus, it is not only obvious from the circumstances that the defendants know that the contested embodiment is objectively suitable for patent infringing use, but also that the customers of the contested embodiment use it to carry out the method according to the patent. 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 authorisation to use the patent in suit from the fact that 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 German Federal Court of Justice [Bundesgerichtshof] (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 favour 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 this in the present case. Even according to the principles developed by the German Federal Court of Justice, the right of prior use 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 a right of prior use could make use of all dependent inventions, at least as long as they 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 validity, 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 licence objection raised by the defendants for the first time at the oral hearing is also not valid. The patent in suit is not covered by the licence agreement submitted to the file as Annex KAP 36 in

extracts (Art. 73 EPC). The defendants can therefore not derive a positive right to use the patent in suit from this agreement and thus also no right to offer and distribute the contested 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 judgement by the Düsseldorf Higher Regional Court [*Oberlandesgericht*], which found an infringement of the German patent DE 10 2004 027 314 B4. These included in particular the validity of the judgement 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, defendant 2) undertakes in the agreement to pay a lump sum which is also intended to "cover the licence fees to compensate for the future use of 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, Section II. 1.). The patent in suit is therefore neither covered by this provision nor by the subsequent indemnity 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 licences all of the applicant's industrial property rights in the field of "avalanche search devices" in favour of the defendants, even against the background of the agreed flat-rate licence fee. The contracting parties have clearly regulated the scope of the agreement in Section II. and in particular also clearly named the industrial property rights covered. However, the patent in suit is not included there.

2.

Insofar as the defendants submitted still lengthy submissions supplemented on this topic dated 15 March 2024 and thus after the conclusion of the oral hearing, this submission is 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. Arguments that are only submitted after the conclusion of the oral hearing 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 in response to a reasoned application during the oral hearing. This is the only way to ensure that the respective panel can judge 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 and could not have been granted even if a corresponding application had been made. On the one hand, such a deadline for written submissions would run counter to the nature of summary proceedings. On the other hand, defendant 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. Insofar as the authorised representatives and an employee of the legal department of defendant 1) who was present at the oral hearing stated that they were not aware of the agreement, their knowledge is not decisive. The defendants therefore should or could have introduced the agreement into the proceedings with the request for review. The fact that the applicant, for its part, did not

disclose the relevant agreement until the oral hearing does not preclude this. The defendants themselves have challenged such an approach 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 suit is certain to the extent required for the order 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 order of provisional measures if the court considers it to be predominantly probable that the patent is not valid. The burden of presentation and proof of facts relating to the lack of validity of the patent lies with the defendant (UPC_CoA_335/2023, order of 26 February 2023, p. 30, GRUR-RS 2024, 2829 - *Nachweisverfahren*). On this basis, the Local Division, also taking into account the submissions of the defendants, is not convinced with the "sufficient certainty" needed pursuant to Art. 62 (4) UPCA in conjunction with R. 211.2 RoP of the legal validity of the patent in suit.

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 an application for an order for provisional 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) RoP. 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 certain validity (see Tilmann/Plassmann/v. Falck/Dorn, Unitary Patent, Unified Patent Court, Rule 209 para. 8 et seq.).

If such other proceedings are merely to be included in the exercise of discretion, it follows conversely that the legal validity can also be sufficiently certain without such prior proceedings. This is the case, for example, if the patent in suit was published many years ago but its legal validity was not challenged and the opposing party was unable to present the relevant prior art either in pre-litigation correspondence or in a protective letter filed by it (see UPC_CFI_177/2023 (LD Düsseldorf), order of 22 June 2023, GRUR 2023, 1370 - E-Bike). If the patent in suit is subject to such a parallel attack on legal validity, this does not preclude 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 suit is sufficiently certain despite such an attack. Irrespective of the delimitation of certain degrees of probability (see UPC_CFI_2/2023 (LD Munich), order of 19 September 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 suit is sufficiently certain. The patent in suit was granted in 2019 without any opposition being lodged 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 revocation rates of patents in different jurisdictions (cf. document of 19 January 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 suit (cf. R. 211 No. 2 RoP "of the patent concerned"). Apart from this, the figures submitted by the defendants in any case indicate at best a high revocation rate of patents challenged with an opposition or an action for revocation. However, this is only a small proportion of the patents granted (see also UPC_CFI_2/2023 (LD Munich), order of 15 September 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 novel 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 the 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 novel compared to WO 2006/051721 A1 (Annex KAP 17 or B 32, hereinafter WO '721), which was already considered in the grant proceedings and recognised in the description of the patent in suit. In any event, there is no disclosure of the suppression of a audio signal during the output of a voice message (feature 4.).

Even if both buzzers and loudspeakers are mentioned in the cited prior art (cf. p. 5, lines 16 - 19), these are only disclosed as alternative options for the design of 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 cited prior art 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 cited prior art. The design described there has an optical display and can

comprise (besides) a voice output. In any case, there is no direct and express disclosure of a suppression of the audio 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 novel.

The avalanche transceiver 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 characterised 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 localisation on this basis can comprise a *speech processor* (cf. sub-claim 7 and p. 6, 4th para.), there is no disclosure of the output of at least one audio signal within the meaning of the patent in suit. As already explained in detail, audio 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 characterised by the fact that the control device controls the loudspeaker in such a way that the audio 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 audio 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 audio signal. Moreover, in addition to the speech processor, the cited prior art only mentions a display and a *signalling* 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 signalling device that this signal - unlike the signal *light* mentioned on p. 6 in the third paragraph - can also be a signal tone, they find no indication in the cited prior art 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) preclude 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 cited prior art proposes an avalanche transceiver that assigns different audio 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 (para. [0055], lines 50 - 53; para. [0056], lines 4 - 5) as well as an acoustic signal generator with a loudspeaker (para. [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 (para. [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 signalled independently of the strength of the received transmission signal. Therefore, no swivelling 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 can be used to assign the direction of reception to a front solid angle range, the second to a rear solid angle range and the third to a side solid angle range (paras [0010], [0017], [0018], [0020]). Alternatively, it is also possible to assign the receiving direction to more than 10 solid angle ranges. A corresponding number of tone patterns enables a quasi-continuous or even continuous display of the direction of reception (para. [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 suit (features 2., 2.1. and 4.). In particular, the audio patterns described in the cited prior art are not to be classified as such. Rather, the document defines the audio pattern as single tones, double tones or multiple tones. The term "acoustic signal" used in paragraph [0046] of the cited prior art is merely used as a synonym for the term "audio pattern".

In contrast, to the extent that the defendants refer to the publication DE 10 2014 204 630 A1 (Annex B 58) and the paragraph [0009] therein for the definition of the term "audio 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 "audio 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 February 2024, GRUR-RS 2024, 2829, headnote 2 - *Nachweisverfahren*).

(4)

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

(a)

It is not clear why the defendants, who have the burden of presentation and proof with regard to facts relating to the lack of validity of the patent (UPC_CoA_335/2024, order of 26 February 2024, headnote 3 and p. 30, penultimate paragraph, GRUR-RS 2024, 2829 - *Nachweisverfahren*), only submitted this document one day before the oral hearing. This cited prior art is a patent which defendant 2) had already licensed in the past in favour 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 cited prior art, 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 review. According to R. 212.3 sentence 2 RoP in conjunction with R. 197.3 sentence 2 (b) RoP, the request for review must already contain the facts and evidence presented. The submission of the cited prior art immediately before the oral proceedings and outside the time limits set by the Local Division for commenting does not even begin to fulfil 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 cited prior art 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 cited prior art relates to a search device for locating a transmitter and, in particular, an avalanche transceiver. This is swivelled 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 skilled person can see from paragraph [0049] of the cited prior art, 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 an audio signal is merely a (different) embodiment example. There is no indication in the cited prior art of a combination of both embodiments. 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, which comprises 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 considered to involve an inventive step if it is not obvious to a person skilled in the art from the state of the 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 insofar as the defendants rely on a combination of WO '721 with the common general knowledge.

Contrary to the defendants' view, the cited prior art does not disclose a design in which both audio 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 aforementioned loudspeaker only enables the output of an acoustic stimulus in the form of an audio 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 the inventive step based on DE '217.

If the person skilled in the art chooses this document as a starting point, they do 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.).

The consideration of general expertise does not lead to a different result. Even if it can be assumed in favour of the defendants that audio signals are customary in the trade, there is no suggestion to the effect that such audio signals should be combined with other acoustic stimuli and in particular with voice messages in such a way that the output of the audio 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 specialised 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 audio signals in the search for

buried victims is part of the general specialised knowledge therefore does not indicate that it was obvious for the person skilled in the art to additionally use audio signals 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 cited prior art, audio 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 audio pattern generated by the signal generator (para. [0045]). In addition to audible acoustic tones, the spectrum of audio patterns also includes "inaudible acoustic signals" (para. [0046]), from which it cannot be deduced, however, that certain audio patterns should not be output during the output of other audio patterns.

As the skilled person can see from paragraph [0047] et seq. of the cited prior art, the receiving device can be equipped with a visual display to supplement the acoustic signalling by means of the sound patterns. In this way, the searcher is guided acoustically through the audio patterns while they can concentrate visually on the terrain.

Even if the mention of such a visual display should give the skilled person cause to explore ways of simplifying the search for a buried person, they have no reason to consider a voice output without falling into an always inadmissible retrospective view. The search disclosed in the cited prior art is essentially based on the use of different audio patterns that vary depending on the spatial angle, so that the user can be guided by these audio patterns. Insofar as the cited prior art discloses an optical display in addition to the audio guidance, this is merely an optical supplement to the audio guidance. The optical display appears alongside the acoustic audio 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 audio pattern-based search, this poses new challenges and problems for the skilled person. If acoustic signals in the form of voice messages are output in addition to the vector-related audio patterns, the question of prioritising 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 audio patterns depending on the spatial vector and thus the addition of further acoustic signals in the form of voice messages as a simplification. Rather, they are prevented from adding voice signals to the solution disclosed in EP '011 simply because the cited prior art itself reveals a simpler way of optimising the search: In addition to the audio 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 audio pattern-based search in EP '011. This applies all the more since both documents disclose an overall concept

that 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 audio patterns to certain vectors as the basis for navigation is required for proper functioning. The problem of overlapping audio signals therefore does not arise, nor does the question of prioritising 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 an obvious manner and without retrospective consideration to the effect 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 feasible (Art. 83 EPC) also does not cast any significant doubt on the validity of the patent in suit.

aa)

Insofar as the defendants question the feasibility of patent claim 1 with regard to an allegedly non-enabling disclosure of audio 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 audio signal is functionally related to the search for at least one further avalanche transceiver, whereas a voice message is always functionally related to at least one event in the search for at least one avalanche transceiver". Insofar as the applicant wishes to express that the audio signal and the 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 audio 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 enabling disclosure of "how the control of the loudspeaker is to be realised if an ungenerated audio 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 their common general 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 generalised allegation of insufficient disclosure does not meet these requirements.

V.

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

According to the Rules of Procedure, both temporal and factual circumstances are relevant for the necessity of ordering provisional measures. In addition to R. 209 No. 2 (b) RoP ("urgency"), the relevance of temporal circumstances is also derived in particular from R. 211 No. 4 RoP, according to which the court takes into account unreasonable delays in applying for interim measures. The fact that factual circumstances must also be taken into account when deciding on the order of provisional measures can be seen from R. 211 No. 3 RoP, for example, according to which the possible damage that the applicant may suffer must also be taken into account when deciding on the application for an order. In contrast, potential damage to the defendant must be taken into account when balancing interests (UPC_CFI_2/2023 (LD Munich), order of 19 September 2023 = GRUR 2023, 1513, 1523, para. 255 - *Nachweisverfahren*).

1.

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

a)

The temporal urgency required for the order of provisional measures is only lacking if the infringed party has behaved in such a negligent and hesitant manner in the pursuit of its claims that, from an objective point of view, it must be concluded that the infringed party is not interested in the rapid enforcement of its rights, which is why it does not seem appropriate to allow it to claim provisional legal protection (cf. also UPC_CFI 2/2023 (LD Munich), order of 19 September 2023, p. 84 et seq. = GRUR 2023, 1513, 1524, para. 259 - *Nachweisverfahren*).

The applicant does not need to take any risks when pursuing the claim. Pursuant to R. 213.2 RoP, 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 it has reliable knowledge of all the facts that make legal action in the proceedings for an order for provisional measures promising and if it can credibly demonstrate these facts. The applicant may prepare for every possible procedural situation that may arise in the circumstances in such a way that it 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. The downside, however, is that the applicant must not delay unnecessarily. As soon as it is aware of the alleged facts of the infringement, it must investigate them, take the necessary clarification measures and obtain the documents required to support its claim. In doing so, the claimant must take the necessary steps in a targeted manner and bring them to a conclusion. As

soon as the applicant has all the knowledge and documents that reliably enable a promising legal action, it must submit the application for an order for provisional 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 contested embodiment at a trade fair in the USA at the beginning of October 2023, they were at best aware of the contested embodiment and its mode of operation from this point in time. However, this alone is not sufficient as a basis for an application for an order for provisional measures. Rather, for such an application to be successful, there must be concrete evidence of acts of infringement in at least individual contracting member states in which the patent in suit is validated. The appearance at a trade fair in the USA does not fulfil these requirements even if the contested embodiment is shown - as here - with an emergency number "Europe: 112". The patent in suit 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 an order for provisional measures that the contested embodiment would be offered or offered and sold not only in Europe, but also in the validation states of the patent in suit in the configuration shown. It did not have to take any risks 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 3 November 2023.

(1)

The fact that the applicant did not seek urgent legal protection in advance of the "ISPO" trade fair is also not to its 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 contested embodiment or the (intended) sales territory. In the present case, the defendants themselves provide a reason for such a wait. Citing the fact that the contested embodiment currently only exists as a prototype and that it is not yet clear which version will ultimately be marketed, the applicant had every reason to first visit the trade fair to get an idea of the design of the contested embodiment shown there within the scope of the patent in suit. Since the applicant filed its application for an order for provisional measures immediately after the trade fair, the urgency is thus 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 provisional measures - unlike in the case already decided by the Munich Local Division and cited by the defendants in support of their differing view (UPC_CFI_292/2023 (LK München), order of 20 December 2023, GRUR-RR 2024,

93 – *Elektronisches Etikett*) - for the Contracting Member States in question here, Germany and Austria. The merely abstract possibility that such an order might also have indirectly prevented distribution in the Contracting Member States at issue here does not, from the outset, represent an equivalent alternative for the applicant 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 provisional 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 review of the legality of the original order, but the review of whether the prerequisites for the order of provisional 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 Federal Patent Court of Switzerland as part of the preparation of 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 an order for provisional 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, despite these risks, it would request an order for provisional measures from the Unified Patent Court on the basis of the knowledge gained at the trade fair regarding the facts of infringement. Such a risk analysis was all the more necessary since, according to the Rules of Procedure (R. 213.1 RoP), the applicant must promptly file an action on the merits if provisional measures are ordered. If this is the case, it must also expect that the legal validity of the patent in suit will then also be challenged before the Unified Patent Court in the context of an action for revocation.

(4)

Even if the behaviour after the *ex parte* order was issued must be taken into account when assessing urgency, no behaviour on the part of the applicant that is detrimental to urgency is discernible at this stage of the proceedings. After the order for provisional measures was issued on 11 December 2024, the applicant had already ordered service on 15 December 2023 (Annex KAP 33). In addition, the Local Division made the enforcement of the provisional order 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 June 2023 = GRUR 2023, 1370 - E-Bike).

2.

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

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 leading central trade fair for winter sports and winter tourism. Even if it is naturally no longer possible to prevent business transactions at the trade fair by ordering provisional 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 contested embodiment - was honoured with a prize such as the ISPO Award at the trade fair. Even if the sale of the contested embodiment to end customers does not begin until summer 2024, the relevant transactions are already being concluded with retailers according to the applicant's undisputed submission. 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 shops. In addition, the contested embodiment is a direct competitor product to a product of the applicant ("Ortovox Direct Voice"). Since each pre-order of the contested embodiment fulfils a demand that the applicant would otherwise have been able to meet, each pre-ordered copy of the contested embodiment already constitutes irreparable damage for the applicant. Since the applicant has not granted any licences for the patent in suit, only the applicant with the special function of voice output (in combination with the search based on audio signals) is currently on the market.

In order to grant the applicant effective legal protection in such a market environment, provisional 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 proceedings would therefore not effectively prevent the sale of the contested embodiment for the 2024/2025 winter season. The fact that, based on the defendants' submission, the contested 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 favour of the applicant.

1.

Pursuant to Art. 62(2) UPCA (R. 211 No. 3 RoP), 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 countered 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, allowing the alleged infringement to continue or even dismissing the application subject to the provision of security (UPC_CFI_2/2023 (LD Munich), order of 19 September 2023, p. 98 = GRUR 2023, 1513, 1525 et seq., para. 300 et seq. - *Nachweisverfahren*).

2.

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

Since the defendants in the summary proceedings have been unable to significantly challenge the

infringement of the patent in suit, the Local Division is convinced on summary examination that the patent in suit has been infringed by the defendants' actions. In addition, the defendants have not been able to raise significant doubts as to the legal validity of the patent in suit. Moreover, the Local Division is clearly convinced that one-off measures due to the infringement of the patent in suit are necessary 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 contested 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 contested embodiment. They are therefore not available for the applicant's product, which threatens the applicant with irreparable damage. 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 inter partes order, advance orders would be cancelled, which would free up the resources concerned 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 contested embodiment. In such a situation, the applicant's interest in enforcing the patent in suit 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 RoP.

The defendants' reference to alleged third party interests is in the present case in vain because, according to their own submission, the contested embodiment has so far only existed 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 contested embodiment and can therefore already be used in the search for buried victims. These cannot change the result of the weighing of interests.

VII.

The Düsseldorf Local Division is convinced with the certainty required for the order 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 certain to the extent necessary for the order of provisional measures. Since the ordering of provisional measures is also necessary both in terms of time and substance, and the balancing of interests is also in favour of the applicant, the following legal consequences result:

1.

The Court, exercising its discretion (R. 209.2 RoP), considers the issuance of a preliminary injunction to be appropriate and justified (Art. 62(1), 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 defendants' interest 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 R. 211.1 (b) RoP. 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 explained above, 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 Division has also threatened to impose penalty payments in the event of non-compliance, this threat is based on R. 354.3 RoP. With the number of products or the number of days, a value for the calculation of the penalty payment is already fixed in each case. However, setting a maximum limit per product or day gives the Local Division the necessary flexibility to also take into account the behaviour of the infringer 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 RoP.

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 contested embodiment. 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 behaviour. 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 (LD Düsseldorf), order of 18 October 2023 = GRUR 2024, 280, 285, para. 54 - E-Bike III). This is taken into account by the threatened penalty payment, which allows the Local Division 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 Division, which can be assumed in their favour, 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 violation of the injunction 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 contested embodiment and permanent trade, such as offers on the Internet, is appropriate from the point of view of proportionality.

4.

By requesting reimbursement of pre-trial costs in its defence to the defendants' application for review, the applicant has subsequently extended its application for an order for provisional

measures to include this claim. The applicant can apply for such an extension at any time (R. 263.1 first sentence RoP). However, pursuant to R. 263.2 RoP, 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 favour, it should be noted that the question of the handling of the interim award 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 of 11 December 2023 issued in the present proceedings, the Düsseldorf Local Division 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 Division referred to the lack of an application for an interim award of costs (UPC_CFI_452/2024, order of 11 December 2023, p. 10 below = GRUR-RR 2024, 97, 101, para. 44 - *Verschüttetensuchgerät*). The applicant responds to this reference with its subsequent application for an interim award 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 an interim award of costs. If the applicant had already included the request for an interim award of costs in its original application, the ex parte order would have already contained a corresponding obligation to pay. 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 review 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 its 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 review was unsuccessful, an interim award of costs in favour of the defendants is ruled out from the outset. The question of whether R. 211.1 (c) RoP also permits an order for an interim award of costs in favour of the defendant (see UPC_CFI_182/2023 (LD Vienna), 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 first sentence RoP, the court may, in the event of the revocation of the order

for provisional measures by the court, require the defendant to provide adequate security for the damage that the defendant is likely to suffer. If the specific case - as here - does not exceptionally require otherwise, this option should generally be utilised. The decision to order provisional measures is based on only a 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 its economic activity. This uncertainty and the intensity of the interference can only be taken into account by ordering the provision of security (Tilman/Plassmann, Unified Patent Court, Rule 211 para. 32).

As far as the amount of the security deposit 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 RoP. 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 value of the dispute. Even if the value of the dispute does not necessarily correspond to the risk of damage, it does provide an indication of the economic importance that the applicant attaches to the matter. The defendants had the opportunity to present the risks to be covered by the security deposit as part of the review procedure. As they did not make use of this opportunity, there is no reason to change the amount of the security.

IX.

In any case, there is no reason for a basic decision on costs in proceedings for the order of provisional 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 unsuccessful party are to be borne (contra: UPC_CFI_2/2023 (LD Munich), order of 19 September 2023, p. 103 = GRUR 2023, 1513, 1526, para. 315 - *Nachweisverfahren*). 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 RoP (see Dold/W. Tilman in: Tilman/Plassmann, Unitary Patent, Unified Patent Court, Art. 69 paras 1 and 3). However, this provision already concerns the main proceedings according to its systematic position. There is no corresponding provision in R. 205 et seq. RoP concerning the ordering of provisional measures.

2.

For an analogous application of R. 118.5 RoP, 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 (LD Munich), order of 19 December 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) RoP, the court may order an interim award of costs as a provisional measure. If the applicant does not initiate the main proceedings within the time limit following the order for provisional measures, the corresponding order is to be revoked in accordance with

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

ORDER:

- I. The order for provisional measures dated 11 December 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 application of the defendants to order an interim award of costs in their favour in the amount of EUR 19,858.40 is dismissed.
- IV. This order is provisionally enforceable.

DETAILS OF THE ORDER:

App_4074/2024 for main file reference ACT_589655/2023

UPC number: UPC_CFI_452/2023

Type of proceedings: Application for an order for provisional measures

Issued in Düsseldorf on 9 April 2024

NAMES AND SIGNATURES

Presiding judge Thomas

Legally qualified judge Dr Thom

Legally qualified judge Dr Schober

Technically qualified judge Dr Wismeth

for the Deputy Registrar Strycio

INFORMATION ABOUT THE APPEAL

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

INFORMATION ON ENFORCEMENT (ART. 82 UPCA, ART. ART. [sic] 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP)

A certified copy of the enforceable decision or enforceable order is issued by the Deputy Registrar on application by the enforcing party, R. 69 RegR.