



Order
of the Court of First Instance of the Unified Patent Court
issued on 20 November 2024
concerning EP 3 320 604 B1

APPLICANT:

Valeo Electrification, 14 avenue des Béguines, 95800 Cergy, France, represented by the President Thierry Kalanquin, with the same address,

Represented by: Attorney-at-law Felix Rödiger, Attorney-at-law Jonas Smeets, Attorney-at-law Fabian Saupe, Bird & Bird LLP, Carl-Theodor-Straße 6, 40213 Düsseldorf, Germany,

Electronic address for service: felix.roediger@twobirds.com

Contributing European patent attorneys: Nicolas Cardon, Amandine Ricard, Pierre Prigent, Valeo Electrification, Cergy

DEFENDANTS:

- 1. Magna PT B.V. & Co. KG**, Herrmann-Hagenmeyer-Str. 1, 74199 Untergruppenbach, Germany, represented by its general partner, Magna PT Management B.V., with the same address, which is jointly represented by the managing directors Thomas Klett and Sandro Gildo Morandini, with the same address,
- 2. Magna PT s.r.o.**, Perinska cesta 282, Kechnec 044 58, Slovakia, represented by its managing directors Martin Hluchý und Katarína Vaškovičová, with the same address,
- 3. Magna International France**, SARL, 4 route de Gisy Bâtiment 26, Biévres 91570, France, represented by its managing directors Thierry Servouse and Franz Trummer, with the same address,

All Defendants represented by: Attorney-at-law Klaus Haft, Attorney-at-law Sabine Agé, Attorney-at-law Sebastian Kratzer, Hoyng, ROKH, Monegier, Steinstraße 20, 40213 Düsseldorf, Germany,

Collaborating attorney: Attorney-at-law Dr Wolfgang Kellenter, Hengeler Müller, Benrather Straße 18-20, 40213 Düsseldorf, Germany,

Collaborating European Patent attorneys: European Patent Attorney Jan Ackermann, European Patent Attorney Felipe von Heereman, European Patent Attorney Dr Margarete Rittstiegl, Cohausz & Florack, Bleichstraße 14, 40211 Düsseldorf, Germany

PATENT IN SUIT:

EUROPEAN PATENT NO. EP 3 320 604 B1

PANEL/DIVISION:

Panel of the Düsseldorf Local Division

DECIDING JUDGES:

This Order was issued by Presiding Judge Thomas as judge-rapporteur, legally qualified judge Dr Thom, legally qualified judge Bessaud and technically qualified judge Sanchini.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT: R. 353 RoP – Application for rectification

SUMMARY OF THE FACTS:

On 31 October 2024, the Düsseldorf Local Division delivered an Order requiring the Defendants to refrain from offering, placing on the market, or using or importing or storing the product for those purposes, certain electric motor generators and the replacement parts supplied for the spare parts business (challenged embodiment I) and the 7HDT400 gearbox as an assembly with one of the aforementioned electric motor generators (challenged embodiments II) in Germany and France. The Court made an exemption to that injunction by permitting the Defendants to fulfil their current obligations with regard to the challenged embodiments towards their customer BMW within the framework and the scope of existing delivery obligations (status: 8 October 2024) for five specified BMW models.

The Defendants filed an application for rectification on 6 November 2024, to which the Applicant responded on 12 November 2024. Outside any time limit set by the Court, both parties filed further written submissions on 17 November 2024 (Defendants) and 18 November 2024 (Applicant).

INDICATION OF THE PARTIE'S REQUESTS:

The Defendants request

- to amend Section II. of the Order as follows (requested amendment highlighted in underlined text):

II. *As an exception to the injunction in Section I, the Defendants are permitted to fulfil their current obligations with regard to the challenged embodiments I and II towards their customer BMW within the framework and the scope of the existing delivery obligations (Status: 8 October 2024) for the following models:*

- *X1*
- *X2*
- *1 Series*
- *2 Series Active Tourer*
- *2 Series Gran Coupé*
- *Mini Countryman.*

This exception shall no longer apply if the Defendants do not provide security in form of a deposit or a bank guarantee issued by a bank licensed to do business in the EU in the amount of EUR 500,000 by 21 November 2024.;

- to clarify in the Order that the vindication action filed with the Paris Court of First Instance on 13 September 2024 is not limited to the French part of the patent in suit, but also expands to the German part of the patent in suit; specifically, to amend the following section of the Order, p. 3 (requested amendment highlighted in underlined text):

On 2 August 2024, the Applicant filed an infringement action against the Defendants at the Düsseldorf Local Division (ACT_44736/2024, UPC_460/2024) with respect to the patent in suit. With regard to the French and German part of the patent in suit, Defendant 1) filed a vindication action before the Paris Court of First Instance on 13 September 2024 (see Exhibits HRM 22a-1 – 22a-85). Furthermore, on 4 October 2024, Magna Automotive Holding (Germany) GmbH filed a revocation action at the Central Division in Paris (ACT_54372/2024, UPC_CFI_581/2024) seeking revocation of the patent in suit with effect in France and Germany.

- to amend the following section of the Order, p. 40 (requested amendment highlighted):

The mere fact that the patent in suit is not mentioned in Attachment #11 of the Nomination Letter (Exhibit HRM 9e; HRM 22a-13) does not change this. Even if the patent in suit should have been mentioned there (which is not necessary to decide in the present case), Defendants could not rely on this list. ~~That it is not to be understood as a black list, which would allow the Defendants to develop (alleged) workarounds with legal certainty, can already be seen from the fact that the parties did not agree on an obligation to update this list.~~

The Applicant requests to reject the request for rectification.

POINTS AT ISSUE:

In the view of the Defendants, there is an obvious slip in the list of BMW models in Section II of the Order. The clear and unambiguous intention of the Court was to ensure the full compliance with the Defendants' current obligations with respect to BMW. In view of this, the model "2 Series Gran Coupé" must be added because, according to the Defendants, this model was also subject to supply obligations on 8 October 2024.

The Defendants further argue that the Order refers to the vindication action filed by Defendant 1) before the French Court as being relevant only to the French part of the patent in suit. According to the Defendants, this is erroneous and contrary to the Court's intention. The vindication action covered not only the French part but also the German part of the patent in suit, as shown in Exhibit HRM 22a-1, No. 21.

Finally, the Defendants argue that the assertion in the grounds of the Order that the parties did not agree to an obligation to update the attached list is in clear contradiction to the wording of margin No. 7.3 of the 2019 Nomination Letter (Exhibit HRM 9e, p.11).

GROUNDS OF THE ORDER:

The application is admissible, in particular it was filed within the deadline pursuant to R. 353 RoP, but unfounded.

I.

According to R. 353 RoP, the Court may upon an application by a party made within one month of service of the decision or order, rectify clerical mistakes, errors in calculation and obvious slips in the decision or order. "Obvious slips" within the meaning of R. 353 RoP are all incorrect or incomplete statements of what the Court actually intended in the order or decision. In other words, the declaration of the Court's intention in the decision or order must deviate from the intention that existed when the decision was made (UPC_CFI_177/2023, Order dated 30 June 2023, under II.1. – *myStromer/Revolt Zycling*).

II.

On the basis of these principles, there is no reason to correct the Order in the present case.

1. Correct list of BMW models

The model "2 Series Gran Coupé" was not introduced into the proceedings by the Defendants before their application for rectification of 6 November 2024. This model was therefore not the subject of the written submissions prior to the oral hearing, nor of the oral hearing itself. It could therefore not be taken into account in the Order. Its absence from the Order is therefore neither an error nor an obvious slip that could give rise to a correction of the Order.

The Applicant has rightly pointed out that it explicitly referred to the five BMW car models listed in the Court's Order of 31 October 2024. This enumeration was conclusive and remained undisputed. Looking at the reference made by the Defendants in the reasoning of their application for rectification, the quote in the objection rather confirms this understanding by stating that the accused machines are part of the transmissions supplied by Defendants to BMW, which are installed in models such as the 1 and 2 Series, X1, X2 and MINI Countryman. The named series are in line with the specific models named by the Applicant. In this context, the use of 'such as' does

not extend the scope of the models referred to, as the Defendants would now like to make it appear. Insofar as the Defendants referred to the “2 Series” in general, they did not, until the end of the oral hearing, dispute the Applicant’s understanding that this meant the “2 Series Active Tourer”. Nor did they mention the model “2 Series Gran Coupé”.

This remains true in the light of margin no. 5 of Exhibit HRM 25a. Quite apart from the fact that the Court is not obliged to search for further information in the exhibits if it is not expressly referred to in the briefs and pleadings, in this particular case a search would have led nowhere. The corresponding brief did not mention the model „2 Series Gran Coupé“ or its internal vehicle code. At the time of the Order, the Court simply did not have the information to link any vehicle codes to any of the models, particularly those not mentioned.

Against this background, there is no room for an obvious slip.

2. Vindication action in France

In this regard, there is already a lack of a “slip”.

The statement in the Order is “With regard to the French part of the patent in suit, Defendant 1) filed a vindication action before the Paris Court of First Instance on 13 September 2024 (see Exhibits HRM 22a-1 – 22a-85).”

The Defendants overlook the wording of R. 353 RoP, which speaks only “of clerical mistakes, errors in calculation and obvious slips”. There is no mention of omission. Nor is it an incomplete statement as mentioned in the Court’s definition of what an obvious slip can cover. In the context of the vindication action in France, the Court referred to the French part and said nothing about the other parts. It did not need to do so because it is not important for the reasons given. The statement as such is not wrong in itself.

3. Obligation to update the list

Again, there is no obvious slip. The Defendants substitute their understanding of the wording of the Nomination Letter referred to for the Court's assessment that it does not impose an obligation. This is not a valid argument for rectifying the Order.

III.

Pursuant to R. 9.2 RoP, the parties written submissions of 17 November 2024 and 18 November 2024, submitted without having been given the opportunity to be heard by the Court, were not taken into account.

ORDER:

The application for rectification is dismissed.

DETAILS OF THE ORDER:

App_59992/2024 under main file reference ACT_39183/2024

UPC number: UPC_CFI_368/2024

Type of procedure: Application for provisional measures

Issued in Düsseldorf on 20 November 2024

NAMES AND SIGNATURES

Presiding Judge Thomas	
Legally Qualified Judge Dr Thom	
Legally Qualified Judge Bessaud	
Technically Qualified Judge Sanchini	
for the Sub-Registrar Boudra-Seddiki	