



Local Division Munich

UPC_CFI_425/2024
ACT_42211/2024
App_7618/2025

Order
of the Court of First Instance of the Unified Patent Court
Local Division Munich
issued on 31 March 2025

Headnotes:

1. Rule 30 RoP does not restrict the patentee in its request to amend the patent to the requirement that the application and the corresponding auxiliary requests must be directly related to the grounds for invalidity asserted in the counterclaim for revocation.
2. If dependent patent claims are made the subject of auxiliary requests within an application according to Rule 30 RoP, it must also be possible for the patentee to make corresponding amendments with regard to the infringement action. Otherwise, although it would be possible to amend the patent, infringement of such an amended version could not be the subject of the corresponding infringement action.
3. It is the aim of the Rules of Procedure to synchronise proceedings before the UPC with those before the EPO. However, such synchronisation can only work if it is possible to introduce claim versions amended by the EPO into (infringement) proceedings before the UPC.

APPLICANT (CLAIMANT IN THE MAIN PROCEEDINGS)

JingAo Solar Co., Ltd., Jinglong Street, Ningjin County - 055550 - Xingtai City, Hebei Province - CN

represented by: Christopher Maierhöfer (Bird & Bird LLP)

RESPONDENTS (DEFENDANTS IN THE INFRINGEMENT PROCEEDINGS)

1. **Chint New Energy Technology Co., Ltd.**, NO.1 Jisheng Road, Jianshan New Zone, 314415 Haining City, Zhejiang Province
2. **Astronergy Europe GmbH**, Stralauer Platz 33-34, 10243 Berlin
3. **Astronergy GmbH**, Stralauer Platz 33-34, 10243 Berlin
4. **Astronergy Solarmodule GmbH**, Stralauer Platz 33-34, 10243 Berlin
5. **Astronergy Solar Netherlands B.V.**, Transformatorweg 38, 1014AK - Amsterdam
6. **Chint Solar Netherlands B.V.**, Transformatorweg 38, 1014AK - Amsterdam

represented by: Phillip Rektorschek (Taylor Wessing PartGmbH)

LANGUAGE OF PROCEEDINGS:

English

PATENT AT ISSUE:

EP 2 787 541

PANEL:

Panel 1 of the Local Division Munich

DECIDING JUDGES:

This order has been issued by the presiding judge Dr. Matthias Zigann, the legally qualified judges Petri Rinkinen and Tobias Pichlmaier (judge-rapporteur) and the technically qualified judge Giorgio Checcacci.

POINTS AT ISSUE:

Application for leave to change claim (RoP Rule 263)

Facts and parties requests

The Applicant requests to change its set of requests set forth in the statement of claim.

The reasons given are that this change became necessary because

- a new version of the Infringing Embodiment (“ASTRO N8 Bifacial Series”) has been placed on the market after the filing of the Statement of Claim,
- claim 13 of the Patent in Suit was amended by the decision of the Opposition Division in the EPO opposition proceedings, and
- the auxiliary requests in the filing of an application to amend the Patent in Suit under R. 30 RoP in response to Defendants’ Counterclaim for Revocation include features of subclaims 2, 3, 4, 9 and 10 as granted.

Applicant therefore requests to change claim I. as follows (changes highlighted in yellow):

I. order Defendants to refrain from

making, offering, placing on the market, using or importing or storing for those purposes within the territory of Germany, France, Italy and the Netherlands, a solar cell (100) comprising: a monocrystalline silicon substrate (10) having a base area (110) including a first conductive type dopant; an emitter area (20) including a doping area of a second conductive type dopant opposite to the first conductive type dopant formed in a front side of the monocrystalline silicon substrate; a first tunneling layer (44) entirely formed over a back surface of the monocrystalline silicon substrate (10); a back surface field area (30) on the back surface of the monocrystalline silicon substrate (10), wherein the back surface field area (30) comprises a first portion (30a) which is disposed on the first tunneling layer (44); characterized in that the solar cell further comprises a first passivation film (21) formed on the emitter area (20); a second passivation film (31) formed on the back surface field area (30), a first electrode (24) directly connected to the emitter area (20) through a plurality of openings of the first passivation film (21), and a second electrode (34) directly connected to the back surface field area (30) through a plurality of openings of the second passivation film (31), wherein the first portion (30a) of the back surface field

area (30) is formed of a polycrystalline silicon doped with the first conductive type dopant (independent claim 1 of the Patent in Suit);

in particular when

the back surface field area (30) further comprises a second portion (30b) which is disposed in a portion of the monocrystalline silicon substrate (10) adjacent to the first tunneling layer (44) and is doped with the first conductive type dopant

(dependent claim 2 of the Patent in Suit);

and/or

a doping concentration of the first portion (30a) of the back surface field area (30) is higher than a doping concentration of the second portion (30b) and that the second portion (30b) has the same crystal structure as the monocrystalline silicon substrate

(dependent claim 3 of the Patent in Suit);

and/or

a thickness of the first portion (30a) of the back surface field area (30) is 50 nm to 500 nm, and a thickness of the second portion (30b) of the back surface field area (30) is 5 nm to 100 nm

(dependent claim 4 of the Patent in Suit)

and/or

the solar cell (100) further comprises a first anti-reflective film (22) on the first passivation film (21)

(dependent claim 5 of the Patent in Suit);

and/or

the solar cell (100) further comprises a second anti-reflective film (32) on the second passivation film (31)

(dependent claim 6 of the Patent in Suit);

and/or

the first tunneling layer (44) has a thickness of 0.5 nm to 5 nm

(dependent claim 7 of the Patent in Suit);

and/or

a doping concentration of an area of the first portion (30a) of the back surface field area (30) adjacent to the first electrode (24) is higher than a doping concentration of an area of the first portion (30a) of the back surface field area (30) adjacent to the first tunneling layer (42)

(dependent claim 9 of the Patent in Suit);

and/or

the first portion (30a) and the second portion (30b) of the back surface field area (30) have a same dopant

(dependent claim 10 of the Patent in Suit);

and/or

the emitter area (20) includes a first region (201) having a high dopant concentration and a second region (202) having a lower dopant concentration than the first region (201), wherein the first region (201) contacts at least a part of the first electrode (24) and the second region (202) is formed in a region of the emitter area (20) between the first electrode (24) directly connected to the emitter area (20) through the plurality of openings of the first passivation film (21)

(dependent claim 12 of the Patent in Suit);

and/or

the first and second electrodes (24, 34) include a plurality of finger electrodes (24a, 34a) having a first pitch (P1) and being disposed in parallel to each other and bus bar electrodes (24b, 34b) formed in a direction crossing the finger electrodes (24a, 34a)

(dependent claim 13 of the Patent in Suit);

and/or

the emitter area (20) has a p-type conductivity, and the first passivation film (21) includes at least one of aluminum oxide, zirconium oxide, and hafnium oxide having a negative charge

(dependent claim 14 of the Patent in Suit);

and/or

the back surface field area (3) has an n-type conductivity, and the second passivation film (31) includes at least one of silicon oxide and silicon nitride having a positive charge

(dependent claim 15 of the Patent in Suit);

in particular

solar cell modules of the “Astro N-Series”, especially:

- ASTRO N5 Bifacial Series
- ASTRO N5 Monofacial Series
- ASTRO N5s Monofacial Series
- ASTRO N7 Bifacial Series
- ASTRO N7s Bifacial Series
- **ASTRO N8 Bifacial Series.**

Respondents request,

to dismiss the Claimant's application for leave to change claim.

Respondents argue that the counterclaim for revocation does not disclose any of the features of dependent claims 2, 3, 4, 9 and 10. Therefore in the view of respondents there is no reason to include said dependent claims to the initial infringement claim. Such amendment must be considered as clearly late-filed. In respondents' view the claims to be made in the statement of claim refer to the infringement allegation, which is completely independent from the validity or invalidity of the patent in suit. Therefore, it is clear for respondents that the inclusion of dependent claims 2, 3, 4, 9 and 10 could have been made with reasonable diligence at an earlier stage.

Also the amendment of dependent claim 13 could have been made at an earlier stage: The EPO Opposition Division had already stated in its preliminary opinion issued on 6 March 2024 that claim 13 is considered to amount to an unallowable intermediate generalization due to the omission of the features “having a first pitch P1 and being disposed in parallel to each other”. With its response dated 2 August 2024, the Claimant already restricted its main claim to the version which was now for the first time claimed in the underlying UPC infringement proceedings.

With respect to the Infringing Embodiment “ASTRO N8 Bifacial Series” respondents argue that applicant has not even tried to explain when it got knowledge of the Astro N8 series and why it has waited, assumingly, for months before seeking to amend the claim respectively.

Applicant replies that he became aware of the additional offer of the Astro N8 on 9 December 2024. In his view a period of time must be granted in which claimant can examine the prospects of success of and inclusion of additional infringing embodiments, including the features of the product in question, and to coordinate the application with the content of the other motions and pleadings which only had to be submitted at a later stage. The pooled or bundled submission of pleadings also serves the purpose of orderly litigation and process management.

Grounds for the order

I.

The applicant's request to include subclaims 2, 3, 4, 9 and 10 within the infringement action is granted.

With this request, the applicant intends to adjust his infringement action in accordance with the requests under Rule 30 RoP.

Rule 30 RoP does not restrict the patentee in its request to amend the patent to the requirement that the application and the corresponding auxiliary requests must be directly related to the grounds for invalidity asserted in the counterclaim for revocation. The patentee may also request amendments to the patent that are not directly related to the grounds for invalidity arising from the counterclaim. The purpose of Rule 30 RoP is to give the patentee the opportunity to 'save' its patent in an amended form in the event of a successful invalidity challenge – irrespective of the grounds that have been asserted in the counterclaim for revocation.

According to Rule 30 RoP, an application to amend the patent can only be submitted in response to a counterclaim for revocation. If dependent patent claims are made the subject of auxiliary requests within an application according to Rule 30 RoP, it must also be possible for the patentee to make corresponding amendments with regard to the infringement action. Otherwise, although it would be possible to amend the patent, infringement of such an amended version could not be the subject of the corresponding infringement action. This makes no sense and would also contradict Rule 30.1(b) RoP, according to which the patentee must indicate why the proposed amended patent claims are valid and, if applicable, infringed.

II.

The amendment of dependent claim 13 in line with the amendments made by the Opposition Division is also to be allowed.

The applicant was entitled to await the decision of the Opposition Division and did not have to assert claim 13 in amended form already in the infringement action in

anticipation of a decision of the Opposition Division. Rule 295(a) RoP clearly shows the RoP's aim of synchronising proceedings before the UPC with those before the EPO. This applies in general and in particular with regard to ROP 30. However, such synchronisation can only work if it is possible to introduce claim versions amended by the EPO into (infringement) proceedings before the UPC. If such amendments are possible under Rule 30, it must also be possible to amend the claims of the infringement action accordingly.

III.

The introduction of the further attacked embodiment (ASTRO N8 Bifacial Series) into the infringement proceedings was also to be granted.

The applicant only became aware of this embodiment after the infringement action had been filed. It was therefore not possible to assert this embodiment in the infringement action. Respondents did not argue that this embodiment had already been introduced before the infringement action was filed in those states for which the patent had been granted.

The applicant was also to be allowed a certain period of time to examine the question of infringement of this embodiment in consultation with its legal representatives before such infringement was asserted in the proceedings. In the court's view, there is no reason to object to the fact that the applicant filed this request with his reply. An earlier request would not have changed the fact that the respondents are to be given the opportunity to comment on the new attacked embodiment within their rejoinder.

IV.

The respondents are to be given the opportunity to respond to the amended claims and the corresponding statement of facts within a reasonable period of time. The court therefore extends the deadline for the rejoinder to 14 June 2025.

It can therefore be stated overall that respondents are not unreasonably hindered in the conduct of their action.

Order

1. The application for leave to change claim as set forth in the written submission of 14 February 2025 is granted.
2. The deadline for lodging a rejoinder to the reply to the infringement action is extended to 14 June 2025. All other deadlines for written submissions remain unaffected by this deadline extension.

Dr. Zigann Presiding judge	
Rinkinen Legally qualified judge	
Pichlmaier Judge-Rapporteur	
Checcacci Technically qualified judge	

INFORMATION ON THE APPEAL

A request for a discretionary review to the Court of Appeal may be made according to Rule 220.3 RoP.