



**Düsseldorf local division**  
**UPC\_CFI\_7/2023**

## **Decision**

**of the Court of First Instance of the Unified Patent Court issued on 13  
May 2025  
concerning EP 3 375 337 B1**

### LEADERSHIPS:

1. In order to object to the unreasonable amount of costs, the party raising the objection must make a substantiated factual submission.
2. For the question of the reasonableness of the amount of the costs, it must be explained why these costs are disproportionate, in particular to the importance of the matter, the degree of difficulty and complexity of the legal and factual issues relevant to the decision, as well as to the prospects of success of the measure incurring the costs.

### KEYWORDS:

Determination of costs; unreasonable amount, upper limit

CLAIMANT:

**Franz Kaldewei GmbH & Co. KG**, legally represented by its general partner, Kaldewei Verwaltungsgesellschaft mit beschränkter Haftung, which is represented by its managing director Franz Kaldewei, Christian Helmut, Siegfried Graap, Roberto Martinez and Patrick Nußmann, Beckumer Str. 33-35, 59229 Ahlen, Germany,

represented by: Cordula Schumacher, Attorney at Law, and Benjamin Schnäbelin, Attorney at Law, ARNOLD RUESS Rechtsanwälte Part- mbB, Königsallee 59a, 40215 Düsseldorf, Germany

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DEFENDANT:

**Bette GmbH & Co. KG**, legally represented by its general partner, Bette Verwaltungs- und Beteiligungsgesellschaft mit beschränkter Haftung, which is represented by its managing director Thilo Constantin Pahl, Heinrich-Bette-Str. 1, 33129 Delbrück, Germany,

represented by: Lawyer Jens Künzel, LL.M., KRIEGER MES & GRAF v. der GROEBEN PartG mbB., Bennigsen-Platz 1, 40474 Düsseldorf, Germany

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PATENT AT ISSUE:

European Patent No. 3 375 337 B1 PANEL/CAMBER:

Panel of the Düsseldorf local division

CONTRIBUTING JUDGES:

This decision was taken by Judge Dr Thom as rapporteur. LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Cost assessment procedure - Art. 69 UPCA, R. 150, 151, 152 RoP

BRIEF DESCRIPTION OF THE FACTS:

1. The Claimant has an action against the Defendants for infringement of the European patent EP 3 375 337 B1 (hereinafter: patent at issue), the proceedings being brought under the file number

The defendants have filed an action for a declaration of invalidity (CC\_573257/2023). The defendants have filed an action for revocation of the patent at issue (CC\_573257/2023). The Claimant has opposed the action for revocation and, in the alternative, has filed applications for amendment of the patent at issue (App\_586918/2023).

2. In a decision handed down on 3 July 2024, the Düsseldorf local division largely upheld the infringement action and, in response to the revocation counterclaim brought by the defendants, upheld the patent at issue to a limited extent. According to the basic decision on costs made in this decision, the plaintiff has to bear 15% of the costs of the action and the defendant 85%, and both parties have to bear 50% of the costs of the revocation counterclaim.
3. The Düsseldorf local division did not explicitly set the value in dispute for the action and the counterclaim for annulment in the decision. However, the setting of the upper limits of the reimbursable representation costs for the Claimant at EUR 47,600.00 and for the Defendant at EUR 8,400.00 results in an inherently fixed value in dispute for the action of EUR 500,000.00 and the upper limit for both parties of EUR 28,000.00 each results in a value in dispute for the counterclaim of EUR 500,000.00.
4. By document of 5 August 2024, the Claimant filed an application for costs (ACT\_45185/2024, UPC\_CFI\_7/2023). The Claimant quantifies its costs as follows:

**1. Gerichtsgebühren Verletzungsklage**

**Streitwert: 500.000,00 €**

85% von EUR 11.000,00 9.350,00 €

**2. Vertretungskosten für die Verletzungsklage**

**Streitwert: 500.000,00 €**

85% von EUR 56.000,00 erstattungsfähiger Kosten 47.600,00 €

**3. Vertretungskosten für die Nichtigkeitswiderklage**

**Streitwert: 500.000,00 €**

50% von EUR 56.000,00 erstattungsfähiger Kosten 28.000,00 €

5. The Claimant submits that it has paid the court costs of EUR 11,000.00 and asserts in a lawyer's statement that the costs it has incurred for legal and legal advice amount to a total of approximately EUR 112,000.00, and that it made a test purchase on 25 May 2024 for the infringement product "Bette Floor shower tray with minimum tray support" at a net price of EUR 600.00.

APPLICATIONS BY THE PARTIES:

6. The Claimant claims that the Court should,
 

to carry out the cost assessment procedure in accordance with R. 151 RoP and to set the costs to be paid at the tenorised upper limit of EUR 84,950.00 in total.

FACTUAL AND LEGAL ISSUES:

7. The defendant has opposed the Claimant's application for costs.
8. It is of the opinion that the costs of representation filed in accordance with the upper limits are considerably too high in relation to the importance of the case. The period of time for infringement actions was only approx. 11 months before the action was filed. During the legal dispute, the defendant had submitted a settlement proposal to the claimant in September 2023, which stated that only acts of infringement up to 31 May 2023 prior to the filing of the action were at issue. She had offered to pay damages in the amount of EUR 10,000.00 or EUR 15,000. The Claimant also took this as an opportunity to later quantify her claim for damages accordingly in the proceedings. The plaintiff therefore had knowledge of all relevant facts early on in the proceedings in order to recognise the very limited economic value of the case at an early stage. The essential costs of representation were only incurred by the Claimant after September 2023 in the knowledge of the economic importance of the case and were therefore disproportionate and unreasonable. The costs applied for were to be considerably reduced, taking into account the short infringement period, the low turnover in the territories, which were limited from the outset, and the low profit. In this respect, a maximum amount EUR 37,000.00 is appropriate.

REASONS FOR THE ORDER:

9. The admissible application for the determination of costs is well-founded.
10. There are no objections to the admissibility of the application for the determination of costs.
11. The application for determination of costs is also well-founded.

I. Principles

12. Pursuant to Art. 69 para. 1 UPCA, the costs of the proceedings and other costs of the successful party shall, as a rule, be borne by the unsuccessful party up to the upper limit laid down in the Rules of Procedure, provided that there are no equitable grounds to the contrary. In concretisation of this principle, the winning party is entitled under R. 152 para. 1, 2 RoP to reclaim the reasonable and proportionate costs of representation up to the upper limit set by the Administrative Committee.
13. The costs of the legal dispute are those that have (actually) been incurred in the specific proceedings pending or issue. These include in particular the costs listed in R. 151 lit. d) RoP. Other costs are to be understood as those , although not incurred in the pending proceedings, are directly and closely related to the proceedings in question (see UPC\_CFI\_696/2024 (LD Munich, Panel 2), Decision of 19 March 2025 - MSG Maschinenbau v. EJP Maschinenbau; UPC\_CFI\_363/2023 (LD Düsseldorf), Order of 14 April 2024 - Seoul Viosys v. expert).
14. The costs in question must be cumulatively reasonable and appropriate, which is always a question of the individual case. The criteria mentioned serve to ensure the purpose set out in Art. 14 of Directive 2004/28 and Art. 3 of Directive 2004/28 of providing a high level of protection for

European patents by preventing an injured party from being deterred from initiating legal proceedings to protect their rights and ensuring that measures, procedures and remedies necessary to enforce intellectual property rights are not unnecessarily costly (CJEU, 28 April 2022 - C-531/200 - NovaText/Ruprecht-Karls-Universität Heidelberg; CJEU, 28 j.04.2022 - C-559/20 - Koch Media/Funke; ECJ, 28 July 2016 - C-57/15 - United Video Properties/Telenet). This also applies to legal defence.

15. Taking this into account, reasonable essentially means necessary. In principle, based on the ex ante point of view of a reasonable and economically sensible party, the decisive factor is whether the measure incurring the costs in each case appeared objectively necessary and suitable for achieving the legitimate objective of the proceedings. Accordingly, the measure must have appeared appropriate for the prosecution or legal defence.
16. Reasonableness essentially focuses on the amount of the costs. The costs actually caused by the necessary measure must not disproportionate in terms of the specific amount. In particular, they must not be disproportionate to the amount in dispute, the importance of the matter, the degree of difficulty and complexity of the legal and factual points in dispute that are relevant to the decision and the prospects of success of the measure incurring the costs. An ex-ante assessment is also appropriate here (on these principles: UPC\_CFI\_696/2024 (LD Munich, Panel 2), decision of 19 March 2025, para. 18 - 22 - MSG Maschinenbau v. EJP Maschinenbau; see also UPC\_CFI\_363/2023 (LD Düsseldorf), decision of 14 April 2025 - Seoul Viosys v. expert and UPC\_CFI\_121/2025 (LD Düsseldorf), decision of 22 April 2025 - Ortovox v. Mammüt).

## II. Eligibility for reimbursement in individual cases

17. Based on these principles, there are no objections to the reimbursability of the costs claimed by the Claimant. The costs claimed by the Claimant for the main proceedings, including the action for annulment, are reimbursable in the of EUR 84,950.00, taking into account the reimbursement rate 85% and 50% respectively.

### 1. Court fees for the infringement action

18. Pursuant to Rule 151 (d) RoP, the recoverable costs may also court fees. These are to be awarded to the Claimant in the claimed amount of EUR 9,350.00. Insofar as the defendants criticise the amount in dispute of the infringement action for the first time in the cost assessment proceedings, this does not hold water. Apart the fact that this could and should have been done in the dispute proceedings, the amount in dispute of EUR 500,000.00 is not translated, as the scope of the action extends to actions in seven different European countries.

### 2. Representation costs for the action for annulment

19. The reimbursement of costs for the representation costs relating to the counterclaim are ultimately unobjectionable and are therefore to be reimbursed as requested in the amount of EUR 28,000.00. The objection of inappropriateness is only based on circumstances relating to the counterclaim.

### 3. Representation costs for the infringement action

20. The Claimant must also be reimbursed the costs claimed in the amount of EUR 47,600.00.
21. The objection that the costs are unreasonable does not hold water. The defendant does not substantiate why these costs are disproportionate, in particular to the importance of the matter, the degree of difficulty and complexity of the legal and factual points in dispute relevant to the decision and the prospects of success of the measure incurring the costs. Substantiated submissions require in particular that the reasons presented here also deal with the amount and do not deal with the reasonableness or necessity of the cost-triggering measure.
21. The fact the defendant argues in the lawsuit that it has already discontinued the distribution of the contested embodiment has no for the reasonableness of the costs. It is also irrelevant in this context that the Claimant rejected an out-of-court settlement proposal by the Defendant during the trial. Even if, contrary to the defendant's submission, these reasons were to be regarded as an objection of lack of necessity, they do not apply to the merits of the case. The continuation of the legal dispute and the associated legal costs are appropriate.
22. In this particular individual case, it may also have to be taken into account in favour of the Claimant that this was the first ever decision on the merits of the newly established court. Its preparation by means of a lawsuit and documents requires more effort than a comparable lawsuit in an already known court system. For this reason, too, there is no recognisable unreasonableness.

ORDER:

1. The defendant must reimburse the claimant costs totalling EUR 84,950.00.
2. The defendant is ordered to pay the costs by 13 June 2025 (R. 156 para. 3 RoP).

DETAILS:

ACT\_45185/2024 for the main file references ACT\_459767/2023 and CC\_573257/2023

UPC number: UPC\_CFI\_7/2023

Type of proceedings: Action for infringement and action for annulment

Issued in Düsseldorf on 13 May 2025 NAMES

AND SIGNATURES

Judge Dr Thom

INFORMATION ON THE APPEAL

party adversely affected by a decision referred to in R. 157 RoP may submit an application for leave to appeal to the Court of Appeal within 15 days of service of the decision, R. 221 para. 1 RoP.