



**Central Division**

**Paris Seat**

**DECISION**  
**of the Court of First Instance of the Unified Patent Court**  
**Central division (Paris seat)**  
**issued on 7 January 2026**  
**in the counterclaim for revocation proceedings**  
**UPC\_CFI\_433/2024**

**HEADNOTES:** 1. The defendant in a counterclaim for revocation action is entitled to amend the patent, provided that the relevant application is included in the statement of defence (or, in any event, meets the filing deadline for this application) and contains the information referred to in Rule 30 'RoP'.

2. The requirements for an application to amend the patent concerning the filing deadline, the inclusion of at least one amendment, and the use of the official language of the patent are objective in nature; failure to comply with these leads to the inadmissibility of the application. Conversely, the assessment of clarity, the sufficiency of the explanation regarding validity and infringement, and the reasonableness of the number of amendments is a matter of judicial discretion. Based on the specific circumstances of the case, the Court may decline to examine amendments that are inadequately formulated, insufficiently explained, or excessive in number.

3. As a general rule, while the mere deletion of claims may not necessitate a consolidated document, any substantive amendment requires the applicant to submit a full set of the amended claims. In accordance with the principle of judicial neutrality, the Court is prohibited from assisting the party in drafting or clarifying amendments. Consequently, the proposed amendments must be immediately intelligible to the Court and the counterclaimant without requiring subjective reconstruction of the applicant's intent, ensuring the accuracy of subsequent annotations in the official patent registers.

**KEYWORDS:** stay of the proceedings; application to amend the patent; added subject-matter.

**COUNTERCLAIMANT:**

**Microsoft Corporation**

- One Microsoft Way - 98052-6399 - Redmond - US

represented by Tilman Müller-Stoy and Nadine Westermeyer, Bardehle Pagenberg

**DEFENDANT IN COUNTERCLAIM:**

**Suinno Mobile & AI Technologies Licensing Oy** - Fabianinkatu 21 - 00130 - Helsinki - FI

represented by Petri Eskola, Backström & Co

**PATENT AT ISSUE:**

European patent n° EP 2 671 173

**PANEL:**

Panel 2

Paolo Catalozzi	Presiding judge and judge-rapporteur
Tatyana Zhilova	Legally qualified judge
Wiem Samoud	Technically qualified judge

**DECIDING JUDGE:**

This decision is issued by the panel.

**SUMMARY OF FACTS:**

1. On 9 April 2024 Suinno Mobile & AI Technologies Licensing Oy filed an infringement action on the basis of EP 2 671 173 ('EP 173') against Microsoft Corporation before this Central Division, registered as No. ACT\_18406/2024 UPC\_CFI\_168/2024.
2. The patent at issue was filed on 29 December 2011 as an international application WO 2012/104474 (WO '474). The patent claims priority from a patent application of 4 February 2011 (US 201113021244). The date of publication and mention of the grant of the patent is 24 October 2018.
3. The patent relates to people browsing the Internet by walking to discover search results as they come near them. The patent has 14 claims, one of which is independent, and the remaining are dependent.
4. Its independent claim 1 reads as follows:  
"A system, comprising: mobile stations and an Internet search engine with processors with an index relation stored in a memory medium,
  - the processors being configured to store in the index relation calculated numerical weights of associations between specific locations of the mobile stations acquired from any of the following: Wi-Fi, GPS, and/or cellular network, and times of incoming

queries from the mobile stations and documents, and configured to store click-through rates for results of searches based on frequency at which the results of the searches are selected at the mobile stations,

wherein,

- the Internet search engine is configured to use the index relation calculated numerical weights and rank documents associated with facilities that are open for business and have high clickthrough rates at the time of the incoming query higher, than documents associated with facilities that are closed at the time of the incoming query and have low click-through rates, wherein said documents are results of a query from a mobile station,
- the mobile station is configured to receive information pages via short range communication links and documents from the Internet search engine, the mobile station is further configured to search the received information pages, and the mobile station and the search engine are further configured to dynamically update the results as the mobile station moves and time passes,
- the mobile station is further configured to display the results to a user".

5. On 25 July 2024 the Microsoft Corporations lodged the statement of defence, requesting the infringement action to be dismissed, and a counterclaim for revocation, requesting the patent at issue to be revoked because its subject matter extends beyond the content of the earlier application as initially filed, lacks novelty, lacks inventive step and does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
6. On 20 September 2024 the claimant filed its defence to the counterclaim and a conditional application to amend patent, together with its Reply to the statement of defence.
7. Subsequently, the parties submitted the remaining written pleadings as provided for by the written procedure.
8. During the course of this procedure, on 27 September 2024, the Court, upon request of the counterclaimant, ordered the claimant to provide a security for costs to the counterclaimant in the amount of EUR 300,000.00 within one month of service of the order and informed the claimant that if it failed to provide the security within the time stated a decision by default may be given in accordance with Rule 355 of the Rules of Procedure ('RoP'). An appeal against this order was lodged but subsequently dismissed by the Court of Appeal.
9. Due to the claimant's failure to pay the security for costs, an application for a decision by default was filed by the counterclaimant and was ultimately granted by the Court of Appeal by means of a decision dated 12 July 2025. By this decision the Court of Appeal dismissed the infringement action, thereby closing the related proceedings.
10. Therefore, only the revocation counterclaim remained to be addressed, as the counterclaimant confirmed its continued interest in a decision on it.
11. In the meantime, following the closure of the written procedure, an interim conference was held on 16 April 2025 in which the judge-rapporteur took several decisions, particularly regarding late-filed grounds of invalidity and documents debated by the parties during the written

procedure. The judge-rapporteur also addressed the application to amend the patent and identified certain main issues that needed to be addressed at the oral hearing with particular attention.

12. Finally, the oral hearing was held on 31 October 2025.

**GROUND FOR THE DECISION:**

***Request for stay of the proceedings.***

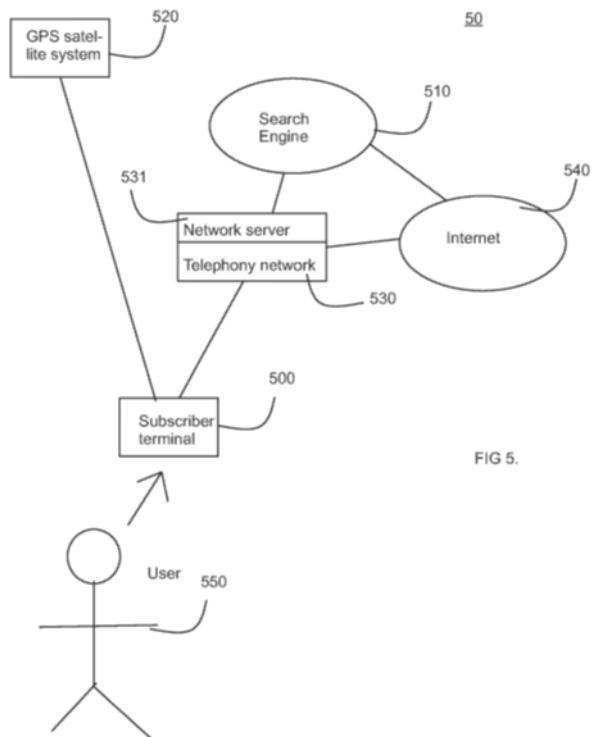
13. On 14 August 2025, the counterclaimant requested that the Court stay these proceedings until the defendant in counterclaim has reimbursed the costs incurred in the infringement proceedings (including related proceedings held before the Court of Appeal), and alternatively until said defendant in counterclaim has provided the security for costs ordered by order of this Court of 27 September 2024.
14. By order of 30 September 2025 the judge-rapporteur dismissed the request, and the counterclaimant did not file an appeal against this order, nor raise this request again during the oral hearing, so that it can be considered withdrawn.
15. In any case, the panel confirms the judge-rapporteur's assessment that the alleged interest in the administration of justice warranting a stay of proceedings is not present.

***The patent at issue.***

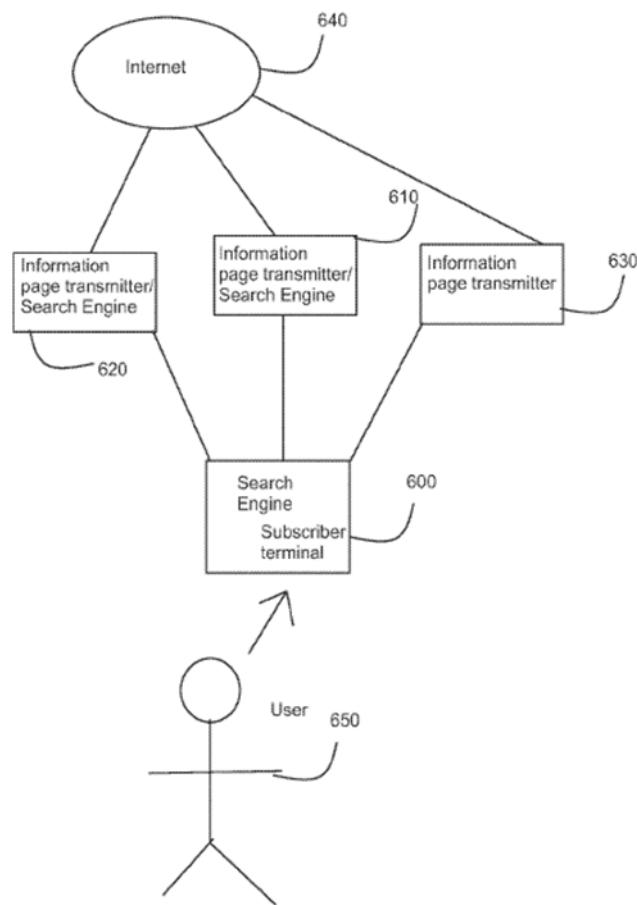
16. As previously mentioned, the invention relates to people browsing the Internet by walking to discover search results as they come near them. More particularly, the invention relates to browsing pages of information based on location and profile and conducting "on the spot" commercial transactions that may involve payments (para. [0001] of 'EP 173').
17. The patent explains that more and more companies and organizations offer their products over the Internet and offer fewer customer attendants on site and, on the other hand, customers move more and more each day. Therefore, there is a clear long felt need for technologies that would allow the customers to automatically access the services and products of companies or organisations, easily, right at the moment, right at the location, with minimum cost (para. [0002-0003]).
18. The patent adds that known search engines use indexing functions with regard to specific keywords, but much time-and-space related information, like geo-coordinates of the individual businesses or their opening hours are not indexed at all or not quoted by web page owners on their sites (para. [0013]). Indeed, where one seeks to locate a specific commercial entity that is open and available while in transit, one is compelled to consult multiple web pages in advance for the purpose of identifying prospective establishments, with reference to the applicable postal code, and to subsequently verify manually the operating status and availability of each.
19. Therefore, the technical problem underlying the patent is to assist the user in passively browsing the information space as he changes location and time goes by, and providing the relevant results thereto, which can be then noticed and re-acted to with minimum effort, and this at low cost and not using cellular roaming connections if cheaper ones are available (see para. [0015]).

20. The patent-in-suit seeks to provide a mobile station, such as a mobile phone (para. [0026]) with results of a search on facilities, like hostels, restaurants and museums, train stations or airports etc., according to location, time and opening times of the facilities, as well as also click-through rates associated to said facilities (para. [0031]-[0032]). The click-through rates are used in ranking the search results (para. [0034]).

21. In this regard, the patent explains that the position of a mobile station (reference 500 in Fig. 5 reproduced below) is determined, for example by GPS. The mobile station communicates with a search engine (reference 510) which accesses the Internet (reference 540) to seek for results based on the location, the time and the click through rates (para. [0051], [0086] and [0093]).



22. Furthermore, the patent in suit explains the possibility for a mobile station (reference 600 in Fig. 6 reproduced below) to obtain information pages via short-range communication (SRC) links from specific facilities (reference 630 "information page transmitter") in addition to the results obtained from Internet search engines (references 610 and 620) (paras. [0061] and [0074]).



23. As suggested by the counterclaimant, the features of claim 1 of the patent at issue can be broken down as follows:

- (1.1) A system, comprising: mobile stations and an Internet search engine with processors with an index relation stored in a memory medium,
- (1.2) the processors being configured to store in the index relation calculated numerical weights of associations between specific locations of the mobile stations acquired from any of the following: Wi-Fi, GPS, and/or cellular network, and times of incoming queries from the mobile stations and documents,
- (1.3) and configured to store click-through rates for results of searches based on frequency at which the results of the searches are selected at the mobile stations,
- (1.4) wherein, the Internet search engine is configured to use the index relation calculated numerical weights and rank documents associated with facilities that are open for business and have high clickthrough rates at the time of the incoming query higher, than documents associated with facilities that are closed at the time of the incoming query and have low click-through rates, wherein said documents are results of a query from a mobile station,
- (1.5) the mobile station is configured to receive information pages via short range communication links and documents from the Internet search engine,

- (1.6) the mobile station is further configured to search the received information pages, and
- (1.7) the mobile station and the search engine are further configured to dynamically update the results as the mobile station moves and time passes,
- (1.8) the mobile station is further configured to display the results to a user.

***Person skilled in the art.***

- 24. The counterclaimant did not provide a definition of the person skilled in the art.
- 25. On its Defence to the counterclaim, the defendant argues that the person skilled in the art should have a B.Sc./M.Sc. level scientific/technical education in the technical field. During the oral hearing, the defendant defines the person skilled in the art as someone with a B.Sc./M.Sc. degree in Electronics and Communication, with up-to- date knowledge of the prior art. Specifically, the defendant alleges that the person skilled in the art is expected to have read the book by Richard Belew cited in the “background” section of the patent in suit.
- 26. The Court agrees with the defendant in that the person skilled in the art is to be identified as a holder of a B.Sc./M. Sc degree in Electronics and Communication. In fact, claim 1 refers to communications between a mobile station and an internet search engine (feature 1.1), communications via short range communication links (feature 1.5), acquiring a location of the mobile station from a communication network, especially Wi-Fi, GPS, and/or cellular network (feature 1.2), and displaying results on the mobile station (feature 1.8). The Court considers that the person skilled in the art also possesses knowledge on data processing, such as searching and ranking (features 1.3, 1.4, 1.6).

***Claim interpretation.***

- 27. With regard to the interpretation of the claims, it must be borne in mind that: the patent claim is not only the starting point, but the decisive basis for determining the protective scope of the European patent; the interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used, as the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim, but this does not mean that the patent claim serves only as a guideline and that its subject-matter may extend to what, from a consideration of the description and drawings, the patent proprietor has contemplated (see, Court of Appeal, order of 26 February 2024, UPC\_CoA\_335/2023).
- 28. The relative assessment must be carried from the point of view of a person skilled in the art, as previously identified.
- 29. Feature 1.2 requires careful examination as the parties debated its interpretation, and it relates to a core aspect of the claimed invention.
- 30. The counterclaimant alleges that the expression “calculated numerical weights of associations” should be interpreted as calculated numerical weights, wherein a singular weight could be calculated for many associations, collectively.
- 31. The Court considers that this interpretation does not appear to be the most obvious systematic interpretation for a person skilled in the art. The Court is of the opinion that the expression “calculated numerical weights of associations” is understood by the person skilled in the art as

referring to each of the associations individually, that is, where a said weight is calculated for an (one singular) association. This interpretation is supported by the content of the application from which the patent in suit was issued (WO '474), as is particularly inferable, for example, from the disclosure on page 12, lines 13 to 16, where it is stated that “the index is arranged to calculate a numerical weight to the association between at least one time and/or user location of an incoming query and at least one document”.

32. Feature 1.4 also requires interpretative clarification. The literal wording appears somewhat ambiguous, as it could lead to the conclusion that the determination of the “calculated numerical weights” is independent of the ranking of the documents. Under such an interpretation, the former would be a function of the location of the mobile station, the times of the query, and the document, while the latter would depend solely on the opening of the facility and the click-through rate. This would imply that the generation of the ranking is indifferent to the location of the mobile station from which the request originates.
33. However, a careful comprehensive analysis of claim 1 – conducted by also leveraging the patent description for explanatory purposes – suggests a functional synergy between these two features. Specifically, the search engine utilizes the weights of space/time/page associations to identify specific facilities, and subsequently, a ranking is created among those facilities based on their opening hours and the number of click-throughs.

***Added subject-matter: claim 1, feature 1.1.***

34. According to the counterclaimant the subject-matter of claim 1 is not directly and unambiguously disclosed in the application as filed.
35. It must be stated at the outset that according to the case-law of this Court there is added matter if the claim as granted or amended contains subject-matter that extends beyond the content of the application as filed. In order to ascertain whether there is added matter, the Court must thus first ascertain what the skilled person would derive directly and unambiguously using their common general knowledge and seen objectively and relative to the date of filing, from the whole of the application as filed, whereby implicitly disclosed subject-matter, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be considered as part of its content (see Court of Appeal, order of 14 February 2025, UPC\_CoA\_382/2024).
36. However, the removal or replacement of a feature is not considered added-subject matter if the feature is not described as being essential in the application as filed, it is not indispensable to the function of the invention, and the removal or replacement requires no real modification of other features to compensate for the change.
37. Any features which, even if mentioned throughout the application in the context of the invention, do not actually contribute to the solution of the technical problem are not essential features.
38. With regard to feature 1.1, the counterclaimant argues that the system comprising mobile stations and an Internet search engine specified therein is not present in the original international application WO '474. While original dependent claims 68 and 69 do refer to a “system” as allegedly specified in claims 35, 44, 52 or 60, there is in fact no system in these claims. The original claims only refer to individual entities, namely a “mobile station” or a

“network server”, but not to a system that comprises two or more of these entities, let alone a system that specifically comprises mobile stations and an Internet search engine. Therefore, the counterclaimant concludes that the “system” according to claim 1 as granted represents an overarching entity that encompasses the standalone entities that were originally disclosed in isolation.

39. The defendant rebuts that the system disclosed in feature 1.1 is directly and unambiguously displayed and explained in Figs. 5 and 6, page 30, line 10, and page 35, line 20, of WO ‘474. In the oral hearing, the defendant argues that claim 1 belongs to the “system” category.
40. The Court considers that a system claim is a known category of claims relating to a product that describes an invention composed of two or more physically distinct apparatuses or devices that work together to achieve a common technical result.
41. Therefore, in order to decide whether such a system was disclosed in the original application, it is necessary to verify whether a person skilled in the art deduces from the application as filed directly and unambiguously that all the apparatuses of the claimed system – specifically, mobile stations, an Internet search engine, processors and an index relation stored in a memory medium – are disclosed, along with their interaction, by the application as filed.
42. The Court is of the opinion that, as detailed further, all these apparatuses of the claimed system are disclosed, and they are necessarily cooperating to provide a user with the “browsing by walking” technique.
43. The counterclaimant further argues that the application as filed does not directly and unambiguously disclose an “Internet search engine” as what is originally disclosed is a generic search engine. Indeed, the embodiment of Fig. 5 describes the Internet 540 and the search engine 510, both of which can be accessed by a user, but there is no direct and unambiguous disclosure of an “Internet search engine” as the claimed combined entity. Hence, said “Internet search engine” is novel over the expressions “search engine” and “internet” according to the relevant legal standard and the skilled person is equipped with additional technical information not originally disclosed.
44. The defendant replies that an “internet search engine” is “a search engine which web-crawls the Internet, indexing the webpage documents” and points out that the summary of the invention, page 5, line 11, to page 8, line 25, of WO ‘447 explains how the Internet is searched with a search engine, thus disclosing an “internet search engine”.
45. The Court agrees with the defendant and notes that “internet search engine” is a feature supported by the original application, as it is evident from page 7, line 31, which mentions a search engine which returns a webpage, page 17, line 7, which mentions a search engine which searches with the search query the file system of the mobile station and/or at least one network computer and/or the Internet, page 18, line 1, which refers to a Google search engine, and page 19, line 29, which mentions a search engine over the Internet.
46. The counterclaimant, then, argues that the application as filed does not disclose a “processor”, let alone (multiple) “processors”, and certainly not that the processors are attributable to the “Internet search engine”.

47. The defendant reacts by pointing out that the original application, page 30, line 10, discloses that computer servers 531 with Internet 540 search engines 510 have processors.
48. The Court considers that an Internet search engine is inherently equipped with processors.
49. Furthermore, Fig. 5 and the associated description in the original application disclose a search engine 510 which may be “a conventional search engine such as Google®, Yahoo®, A1taVista®, Lycos®, Baidu® or the like” (page 31, line 9); page 17, line 13, to page 18, line 2, cite the example of “Google, Yahoo or other common search engines”; page 22, line 31, to page 23, line 2, disclose that “In some embodiments different phases are executed by different network computers or networks of computers in accordance with the invention”.
50. Thus, the phase 130 where the “Search engine searches file system and/or Internet” (Fig. 1) and/or the phase 150 of “Update parameters refresh search results as location and time change” could be implemented by different computers and thus a plurality of processors.
51. In conclusion, while the application as filed does not use the word “processor” or “processors”, a person skilled in the art knows that an Internet search engine necessarily possesses at least one processor. Furthermore, the plurality of processors can be deduced from the examples cited above.
52. Lastly, the counterclaimant argues that there is no disclosure of a “mobile station” in the original application. Actually, this application mentions “mobile stations” only with regard to the alleged advantages from the service provider perspective, but this specific passage is not related to the subject-matter of granted claim 1. Therefore, there is no (let alone clear) basis for the combination of “mobile stations” with the remainder of claim 1.
53. The Court notes that the original application cites mobile stations (in plural) at pages 9, line 29, and 10 lines 5-7, and points out that the person skilled in the art understands this technology of “browsing while walking” as being directed for use by many persons, so many mobile stations.
54. Therefore, the added subject-matter arguments presented by the counterclaimant with regard to feature 1.1 are not well-grounded.

***Added subject-matter: claim 1, feature 1.2.***

55. The counterclaimant contends that the application as originally filed only discloses a (singular) numerical weight for each of the associations individually; thus, there is no disclosure for weights representing the associations collectively.
56. The Court, proceeding from the interpretation of the expression "Calculated numerical weights of associations" adopted previously, finds that there is no prospective extension of the scope of the claimed patent protection, given that this expression indicates, as disclosed in WO '747, page 12, lines 13-16, that a single weight is calculated for a specific association.
57. The counterclaimant further argues that the feature consisting of the “locations of the mobile stations acquired ... from Wi-Fi” is not supported by WO '747. The application as filed only discloses WIFI identities, which refer to the credentials and identifiers used to authenticate and identify devices on a Wi-Fi network, and not Wi-Fi *per se*, which refers to the technology that allows electronic devices to connect to a wireless local area network and it provides the actual

wireless communication link that enables devices to access the Internet or communicate with each other within a certain range.

58. The defendant objects that it is clear to everyone that Wi-Fi and WIFI are used interchangeably as they refer to the same thing, and argues that “The claim does not describe, require or encompass “WIFI identity-less” location determination with Wi-Fi, because this does not exist in the first place”.
59. The Court agrees with the counterclaimant.
60. The Court considers that the identities of a Wi-Fi network are a specific feature of the WIFI network and that the application as filed discloses that location can be obtained from WIFI identities (see page 32, lines 7-12).
61. The defendant’s argument assuming that locating via a network necessarily implies the use of the identities of said network for location is not convincing. The application itself discloses the case where the mobile station is connected to a cellular network, that the location of the mobile station can be determined from cell identities or by triangulation or read from any network register such as HLR and/or VLR (page 15 lines 27-29 and page 31 lines 5-7). Thus, using the identities is not the sole method for locating the mobile station.
62. In the case where the mobile station is connected to a Wi-Fi network, location acquired from WIFI identities is a particular example of location acquired from Wi-Fi, but this does not exclude other alternatives. The location using the Wi-Fi network can be acquired for example by receiving a message via the Wi-Fi.
63. As claim 1, as granted, covers an embodiment where location is obtained by receiving a message via Wi-Fi, this is not supported by the content of the application as filed and that leads to an inadmissible extension by intermediate generalisation.
64. The counterclaimant further contends that feature 1.2 contains added subject-matter in terms of an intermediate generalisation also with regard to the determination of the location. Specifically, while the application as filed mentions that the search engine deduces the location of the mobile station, claim 1 as granted leaves open which entity acquires the location and thus generalises the teaching of the original application.
65. The Court holds that the determination of which entity acquires the location of the user does not appear to be an essential feature, as it does not actually contribute to the solution of the technical problem.
66. The counterclaimant also argues that while feature 1.2 stipulates that the specific locations of the mobile stations are acquired from any of the following: “Wi-Fi, GPS, and/or cellular network”, the application as filed only mentions these examples in the alternative and not in combination. Hence, the determination of a location by way of “Wi-Fi, GPS, and/or cellular network” together is not originally disclosed.
67. The defendant objects that Fig. 5 and pages 30-32 of WO ‘747 disclose the use of GPS, cellular and WIFI all in the same mobile station to determine location.

68. The Court notes that using several techniques of location simultaneously is not provided by the application as filed, which discloses the use of a single technique at a time (GPS, WiFi or cellular), but not the three techniques or two of them at the same time.
69. Indeed, page 3, lines 15-18, of WO '747 cites several techniques of location according to the prior art of google mobile search and google maps for mobile ("It is also known that Google mobile search and Google Maps for mobile deduces the location of the mobile phone from GPS data, WLAN-based / WIFI based services and Cell transmitter based services") and expressly states that this happens "in this order of precedence". A person skilled in the art understands that all the cited techniques can be used but cannot deduce that these techniques are used together at the same time. Thus, only one technique is applied according to this order of preference: GPS data, then WLAN/Wi-Fi based services, then cell transmitter-based services.
70. It follows that also with regard to the combination of methods for determining the location, claim 1 as granted contains added subject-matter.
71. Lastly, the counterclaimant argues that the "browsing by walking" embodiment, as disclosed in the application as filed, page 30, line 25 to page 31, line 7 does not provide for a determination of the location by way of "Wi-Fi", as claimed in feature 1.2, but only provides for determination of locations by way of the GPS transceiver/receiver and/or triangulation. As none of this is specified in claim 1, this generalises the "browsing by walking" embodiment in a manner not originally disclosed.
72. The Court notes that page 33, lines 7-8 of WO '747 discloses location using WLAN/WiFi identities, and that the WO '747 application specifies several times that the different disclosed embodiments can be combined. For example, page 33 lines 12-14 cites "It should be noted that any features, phases or parts of the system 50 can be freely permuted and combined with embodiments 10, 20, 30, 40, 60, 70, 80, 90 and/or 91 in accordance with the invention."
73. Nevertheless, for the reasons stated above the invalidity ground based upon Art. 76 (1) 'EPC' is considered well-founded with regard to the feature 1.2. Accordingly, the patent cannot be maintained in the form as granted.

***Added subject-matter: claim 1, feature 1.4.***

74. For completeness, the ground for invalidity of the patent due to added subject-matter may also be examined with reference to other features.
75. The counterclaimant argues that claim 1 presents added subject-matter also with reference to feature 1.4. Specifically, it highlights that in the application as filed, there is no comparison between click-through rates which are time dependent and click-through rates which are not dependent on time. The comparison between these two conditions is, however, present in claim 1 as granted.
76. The defendant objects, stating that claim 1 does not require this comparison, it just states whether the click-through rates are high or low.
77. The Court notes that, according to the feature at issue, documents, which are the results of a query from a mobile station, are ranked and those "associated with facilities that ... have high

click-through rates at the time of the incoming query higher, than documents associated with facilities that ... have low click-through rates”.

78. This ranking involves a comparison between time-dependent and time-independent click-through rates, and this is not disclosed by the content of the application as filed. Indeed, the application only discloses that click through rates may be stored as a function of the location or the time of the query (page 11, line 28, to page 12, line 1) and, thus, not as a factor which is independent of these criteria.

79. Therefore, also with regard to this feature, the subject-matter of claim 1 extends beyond the original application.

80. The counterclaimant contends that the original claim only mentions that click-through rates from the user and/or mobile station location can be stored. In fact, it is the location of the click-through rate that is deemed of importance according to the description as filed (page 13 line 31 to page 14 line 4, and page 11 line 28 to page 12 line 3). However, feature 1.4 does not perform such comparison based on the click-through rate at a certain location and this omission constitutes an intermediate generalisation.

81. The defendant objects that the location is already been acquired (see feature 1.2) and that click-through rates are disclosed on page 39, lines 10-11, and claims 8 and 69 of the application as filed.

82. In this regard, the Court refers to its previous findings concerning the interpretation of feature 1.4, according to which the generation of the ranking is influenced by the determination of the calculated numerical weights and, therefore, also depends on the location of the mobile station from which the query originates. It follows that the counterclaimant’s argument cannot be upheld, as it is based on an incorrect interpretation of feature 1.4.

83. The counterclaimant further adds that the application as filed does not disclose a comparison in which an acknowledgement of click-through rates and facilities being open/closed for business is performed simultaneously as now claimed.

84. This argument cannot be accepted as page 40, lines 18-21, discloses ranking documents according to 4 categories: relevant and open, relevant and closed, irrelevant and open, (and) irrelevant and closed.

85. Lastly, the counterclaimant contends that the specific comparison required by feature 1.4 is not disclosed in combination with the browsing and walking embodiment.

86. The Court disagrees with the counterclaimant on this point, as the features may be permuted and combined in the disclosed embodiments and no incompatibility has been demonstrated.

87. Therefore, the invalidity ground based upon Art. 76 (1) ‘EPC’ is considered well-founded also with regard to the feature 1.4 within the limits and for the reasons referred to.

***Added subject-matter: claim 1, features 1.5 and 1.6.***

88. The counterclaimant argues that according to ‘WO 474’ the mobile station is configured to receive information pages and documents in parallel, as the information pages and documents are searched simultaneously.

89. The defendant in counterclaim objects that the original application discloses in parallel or in series query strings.
90. The Court disagrees with the counterclaimant. While it is true that 'WO 474' states that "In a preferred embodiment the systems 50 and 60 work in parallel, i.e. information pages received via short range communication links and Internet pages are searched simultaneously", it also adds that "Naturally both embodiments 50, 60 can be implemented in the same mobile station, to work separately or together, and in parallel or in series" (page 35, lines 3-5). It follows that the feature consisting of receiving information pages and documents simultaneously is not to be considered essential.

91. It follows that, the added subject-matter ground of invalidity is not well-founded with regard to features 1.5 and 1.6.

***Added subject-matter: claim 1, feature 1.7.***

92. The counterclaimant contends that feature 1.7 discloses a mobile station, without a search engine, capable of allowing for receiving information pages via SRC links (feature 1.5), for searching (feature 1.6), and for dynamically updating the results (feature 1.7). This is not consistent with 'WO 474' which discloses a "subscriber terminal" which needs to have a search engine to perform these tasks and, as such, does not represent the mobile station of feature 1.7 which does not have a search engine inside.
93. The Court considers that the description of the embodiment of Fig. 5 in the original application mentions that the subscriber terminal could be a mobile station, mobile phone, or a computer (page 30, lines 10-23). Besides, the original application discloses, relating to the same embodiment, that "The user 550 accesses the Internet 540 and a Search Engine 510 via the telephony network 530" (page 31, lines 9-10) and that the subscriber terminal 500 is connected to the telephony network 530 (page 31, lines 18-21). A person skilled in the art understands that the subscriber terminal 500 is a mobile station, since it is able to connect the telephony network 530.
94. The Court further notes that in page 32 lines 6-11, always in relation to the same embodiment of Fig. 5, the term "the mobile station" is used instead of "subscriber terminal" and that the passage in page 34 line 30 to page 35 line 5, related to the embodiments of Figs. 5 and 6, uses both terminologies "subscriber terminal" and "mobile station" to designate the same.
95. From these passages the Court concludes that the terminologies "subscriber terminal" and "mobile station" used in the description associated to Figs. 5 and 6, seem to designate the same item.
96. With regard to the counterclaimant's argument that the mobile station implementing the feature 1.7 of claim 1 is necessarily "a subscriber terminal with a search engine inside", it must be noted that although the description associated to Fig. 6 discloses, in page 33 lines 29-31, that the subscriber terminal which receives SRC information pages comprises a search engine, the original application discloses other embodiments where the search engine is not comprised in the subscriber terminal.

97. In particular, it can be observed that on page 33, line 6, in relation to the embodiment of Fig. 5, it reads that “In some embodiments there is also a search engine in the subscriber terminal 500”. Thus, it is not necessary that a subscriber terminal comprises a search engine. Furthermore, on page 35, lines 3-5, it reads that “Naturally both embodiments 50, 60 can be implemented in the same mobile station, to work separately or together, and in parallel or in series”. Page 12, lines 26-32, and page 13, lines 1-9, disclose a mobile station that receives information pages via SRC communications and searches these information pages. These passages do not indicate whether the mobile station has an internal search engine or not. Same conclusion may be drawn from page 13, lines 25-31, of the original application which cites a mobile phone or a mobile station “that can connect to a search engine over a network” and in page 21, lines 15-21, which states that the mobile station collaborates with a search engine to update the results (phase 150) without specifying if the search engine is comprised or not in the mobile station.

98. The counterclaimant alleges that feature 1.7 contains added subject-matter also with regard to the updating of the results, as the original application cites movement of the terminal and passing of time in a list of four conditions that are disclosed in the alternative, and relies on page 21, lines 15.16, where it is stated that “As the location changes by the mobile station moving, or time changes as it goes by, the aforementioned searches are conducted again [...].”

99. The Court disagrees with the counterclaimant as the original application cites in page 6, lines 29-31, that “The query parameters are automatically updated as the user moves in space-time and hence the search results are updated on the mobile phone screen as the user walks the streets and time goes by.” Page 27 lines 25-29 cites “...will then dynamically search for both items as the user moves with his mobile station around the city and as time goes by». From these passages, the Court concludes that the content of the application as filed discloses an update “as the mobile station moves and time passes”.

100. Anyway, the Court considers that the time always passes by and, thus, the passage cited by the counterclaimant must be understood as the use of “or” refers to the case where the time passes by and the mobile station is not moving.

101. Lastly, the counterclaimant argues that feature 1.7 contains added subject-matter also because the dynamically update of the search results is only disclosed in the context of the aggregate hit list of both hit lists 340, 440 on the subscriber terminal and this feature is omitted in claim 1, leading to an intermediate generalisation. The counterclaimant points out that the original application discloses hit list 340, which shows the results from the internet (page 26, line 9) and a hit list 440, which shows the results of “information pages” from short range communication links (page 28, lines 5-18). Hence, both hit lists are required, in case both ways of communications are to be employed.

102. The Court disagrees with the counterclaimant.

103. In the original application it is disclosed that “in some preferred embodiments the mobile station reads and searches both the incoming information page signals and the Internet to deduce the hit lists 340 and 440. In this embodiment for example the hit lists 340 and 440 would be merged into one hit list” (page 29, lines 6-20) and that “new matches are dynamically updated to the aggregate hit list of both hit lists 340, 440” (pages 34-35, lines 25-6). From these passages

the Court concludes that, according to the original application, two different lists (one for internet and one for SRC links) could be used separately or could be merged into one list.

104. Therefore, the invalidity ground based upon Art. 76 (1) 'EPC' is considered not well-founded with regard to the feature 1.7 within the limits and for the reasons referred to.

105. In conclusion, claim 1 is invalid for subject-added matter and, consequently, also the dependent claims are equally invalid for the same reasons.

***Auxiliary Requests: admissibility.***

106. Having established the invalidity of the patent as granted, the conditional application to amend the patent filed by the defendant must be examined. In particular, in this application, the defendant requested the Court to maintain the patent at issue "in amended form" ('Annex 1'), which admittedly consists of the correction of claims 6, 10, and 12 (Auxiliary Request I), or, under Rule 30 (2) 'RoP', in other amended forms, consisting of the deletion of any dependent claim as needed (Auxiliary Request II) or the reformulation of claim 1 as resulting from the combination of claim 1 with one or more specifically indicated dependent claims (Auxiliary Requests III – XVII).

107. With regard to Auxiliary Request I, the counterclaimant objects that the request is indefinite and inadmissible. Moreover, the amendments do not satisfy the requirements of Article 84 and Art. 123 (2) 'EPC', and formal deficiencies are present.

108. With regard to the other Auxiliary Requests, the counterclaimant contends that these requests are unclear and, as they are filed as a subsequent request to amend the patent, they should have been previously authorized by the Court and, in any event, to the extent that it is construed as merely an intention to reserve the right to amend the patent, a concrete proposal is lacking. The counterclaimant further objects that these auxiliary requests are inadmissible as they appear to rely on Auxiliary Request I which, for the reasons already disclosed, is inadmissible, and that should these auxiliary requests be considered filed under Rule 30 (1) 'RoP', their number is excessive and therefore neither appropriate, nor reasonable, and their patentability has not been sufficiently substantiated.

109. With its Rejoinder, the defendant, in addition to contesting the counterclaimant's objections, filed documents concerning a clean claims and correction markup for claim numbering (Annex 11a) and renumbered claims for patent publication in amended form, with markup (Annex 11b), relating to Auxiliary Request I (consisting of the deletion of claims 6 and 12) and requesting that this be considered the Main [Auxiliary] Request. Furthermore, it also filed a document containing the alternative set of claims, specifically those relating to Auxiliary Request I and Auxiliary Requests III–XVII (Annex 13).

110. With regard to the issues raised by the counterclaimant and, more generally, concerning the admissibility of the application to amend the patent proposals, this Court observes the following.

111. According to Rule 30 'RoP', the defendant in a counterclaim for revocation action is entitled to amend the patent, provided that the relevant application is included in the statement of defence (or, in any event, meets the filing deadline for this application) and contains the information referred to in Rule 30 (1) (a) (c) 'RoP'. This includes the language of the application,

an indication of whether the amendments are conditional or unconditional, and an explanation of how the amendments comply with Articles 84 and 123 (2) (3) 'EPC' and why the proposed amended claims are valid. Rule 30 (1) (c) also requires that the proposed amendments must be reasonable in number in the circumstances of the case.

112. Furthermore, Rule 30 (2) 'RoP' allows for a subsequent request to amend the patent, provided that such request is admitted into the proceedings with the permission of the Court. The term 'subsequent' must be interpreted as referring to a request which follows a previous one, making it sufficiently clear that the term refers to any request that amends the original application to amend the patent (see CD Paris, decision of 19 July 2024, UPC\_CFI\_255/2023 and o.). When deciding on a subsequent request to amend the patent, the Court must take into account all the relevant circumstances of the case, including whether the party seeking the subsequent amendment is able to justify that the amendment in question could not have been made with reasonable diligence at an earlier stage, and the amendment will not unreasonably hinder the other party in the conduct of the action (see Court of Appeal, decision of 25 November 2025, UPC\_CoA\_457/2024 and o.).

113. The assessment of the requirements concerning the deadline within which the application must be filed, the fact that it must contain at least one amendment, and that the same (or the same amendments) must be formulated in the language of the patent has an objective character, and their absence inevitably leads to a finding of inadmissibility of the application. Conversely, the assessment of the further requirements – in particular, the comprehensibility and clarity of the amendments and of the reformulated claims, the sufficiency of the explanation for the reasons why the proposed amendments are valid and infringed, and the reasonableness of the number of amendments – requires a discretionary evaluation by the Court, which must necessarily be conducted in light of the circumstances of the case, and may lead to a finding that the amendment or amendments that are inadequately formulated or explained, or are excessive compared to the number deemed reasonable, will not be examined.

114. With particular regard to the formulation of the amendments of the claims, this Court holds that, generally speaking, while a request for the deletion of one or more claims may not require the concurrent submission of a document containing the full set of the claims, as proposed to be amended, in all other cases, where the proposed amendments have a more significant impact on the patent as granted, it is necessary that they be accompanied by a document containing a full set of the claims, as proposed to be amended. Indeed, the patent content – whether in the descriptive part, the figures, or the claims – is solely the responsibility of the applicant, and no manipulative intervention by the Court is permitted, or, in any case, no assistance may be provided by the Court to the party in producing a clear and intelligible draft, in consideration of its jurisdictional nature and its impartial role. Furthermore, it must be noted that both the Court and the counterclaimant must be immediately enabled to easily understand the exact content of the proposed amendments of the claims, without being compelled to make subjective reconstructions of the applicant's intent, and this is also required in view of the possible annotation of the same in the relevant registers maintained by the European Patent Office and/or the national patent offices.

115. The document containing the proposed set (or sets) of claims, where deemed necessary, must be provided together with the application to amend the patent or, anyway, in respect of

the same deadline as this application. Indeed, after the submission of the application to amend the patent, the defendant may lodge its Defence setting out the reasons of opposition to the application; then the proprietor may lodge a Reply and the defendant may lodge a Rejoinder. This legal framework, consistently with the one provided for the main claim, define a procedural system whereby the parties are required to set out their full case as early as possible (see also Preamble ‘RoP’, para. 7, last sentence) in order to ensure that the opposing party is aware of the factual elements and grounds upon which the requests are based, as well as the evidence available, and is able to prepare an adequate defence, and, at the same time, to expedite the proceedings.

116. As for the assessment on the reasonableness of the number of Auxiliary Requests, this Court has already stated that the complexity of the case (in particular, the number of lines of attacks to the patent) must be taken into account and that the lack of a consistent interpretation of the expression ‘reasonable in number’ may suggest a less strict interpretation of this relevant provision (see CD Paris, decision of 20 October 2025, UPC\_CFI\_189/2024 and o.). In any case, the sanction in case the requirement of “reasonable number” is not met is not made explicit by the Rules of Procedure and the prevailing interpretation is that it would be unreasonable and too far-reaching to reject the application to amend altogether and, instead, appropriate to deal with the auxiliary requests in the order they have been submitted until a reasonable number has been reached (see CD Paris, decision of 20 October 2025, UPC\_CFI\_189/2024 and o.; LD Munich, order of 18 April 2025, UPC\_CFI\_526/2024; CD Paris, decision of 5 November 2024, UPC\_CFI\_309/2023).

117. Applying the aforementioned principles to the case at hand, it must be observed that the application to amend the patent was timely filed, contains the indication of the proposed amendments in the language of the patent, with indication of the priority for examination; therefore, from this perspective, as highlighted by the judge-rapporteur in the Order of 21 April 2025, issued following the Interim Conference, the application must be held admissible.

118. The number of auxiliary requests does not appear unreasonable, taking into account the complexity of the case.

119. With regard, however, to the method of formulating the proposed amendments of the claims, it is noted that Auxiliary Request I, consisting of the correction of claims 6, 10, and 12, is accompanied by the corresponding document containing the set of claims reformulated accordingly (Annex 1), while Auxiliary Request II amounts to a request to “delete any dependent claim as needed. Dependent claims do not contribute to the scope of the protection” without further reasoning. The further Auxiliary Requests are expressed in the form of a combination of claim 1 with one or more dependent claims and the subsequent renumbering of the remaining claims. With reference to both Auxiliary Request II and Auxiliary Requests III – XVII, the application is not accompanied by the enclosure of a document containing the reformulation of the set of claims. Such a document was filed by the defendant only with its Reply.

120. The way that the proposed amendments of claims are formulated is compliant with the provisions of Rule 30 'RoP' only insofar as it concerns Auxiliary Request I. With reference to the other Auxiliary Requests – proposed by the applicant pursuant to Rule 30 (2) 'RoP' but more correctly to be considered made pursuant to Rule 30 (1) 'RoP', as they are conditional requests

rather than subsequent requests – it is observed that Auxiliary Request II is indeterminate in its subject matter, as the proposed amendment is not clearly indicated. Indeed, a proposed amendment that leaves the Court with the task of identifying its content, following an assessment of necessity (“as needed”), does not satisfy the requirement of clarity.

121. Similarly, the further Auxiliary Requests also lack clarity. These requests, due to the scope of the proposed amendments relative to the original claims, would have required (inter alia) the formulation of specific sets of claims in order to permit an exact understanding of the tenor of the claims as resulting from the proposed amendments.

122. In conclusion, only Auxiliary Request I is properly filed and must be examined.

#### ***Auxiliary Request I.***

123. Auxiliary Request I amends claims 6, 10 and 12.

124. As the patent as granted has been considered invalid for added subject-matter in claim 1, this Auxiliary Request is unable to remedy the detected defect, and consequently, the patent remains invalid even in the formulation proposed by this Auxiliary Request.

#### ***Auxiliary Requests: further considerations.***

125. Since Auxiliary Requests II – XVII were not filed in compliance with the requirements provided in Rule 30 (1) 'RoP' and, in particular, were not filed in such a way as to enable the Court to unambiguously understand the scope of the proposed amendments to the claims, they must be deemed inadmissible, thereby relieving the Court of the obligation to examine them.

126. It can, in any event, be observed that even when interpreting the content of the proposed amendments in the manner most favourable to the applicant, none of them is capable of remedying the detected defect of added subject-matter in claim 1. In particular, the infringement of Article 123 (2) 'EPC' found with reference to features 1.2 and 1.4 remains unrectified.

#### ***Inventive step***

127. For completeness, the Court considers that claim 1 as issued also lacks inventive step in view of the document EP 2 264 662 A1 ('BP07') completed with the teaching of the document US 2006/0253409 ('BP08').

128. Indeed, document 'BP07' is directed to a similar purpose as the invention of the patent in suit: providing a user, using a search engine, with relevant information updated when the user moves. 'BP07' could be considered as a realistic starting point.

129. 'BP07' discloses: feature 1.1 (see claim 6, Figs. 1 and 11 and paras. [0014]: “communication terminals”; [0015]; [0044]: “advertisement-information provision system SS” and “advertisement display server S. Each of these computers is connected to each other via the Internet”; [0047]; [0054]; [0055]; [0091]: “the advertiser database D stored in the storage device 22 of the advertisement display server S”); feature 1.2 (see paras. [0014] and [0063] on the specific locations of the mobile stations acquired from GPS; [0017] and [0021] on the calculated numerical weights of the associations; [0032] on the use of the advertiser database for displaying the location information, the association of the location information with the

advertisement information and the ranking of the advertisement information); feature 1.3 (see paras. [0019], [0076] and [0077]); feature 1.4 (see paras. [0021] and [0076]); feature 1.7 (see paras. [0063] on the GPS information of the user's cell phone, and [0093] and Fig. 10); and feature 1.8 ([see paras. [0043] and [0066] and Fig. 10]).

130. Claim 1 as issued differs from the disclosure of 'BP07' only with respect to feature 1.5 "the mobile station is configured to receive information pages via short range communication links and documents from the Internet search engine", and to feature 1.6 "the mobile station is further configured to search the received information pages".

131. The Court considers that there is a synergy between the two distinguishing features. The objective technical problem solved by these features could be defined as increasing location-contextual relevance of search results.

132. 'BP08' deals with the same technical problem. Its paragraph [0058] discloses: "the invention also enable a combination of local and global searches, enabling the user to obtain more, and higher quality, information than can be obtained using only the Internet search engine 70A [...]. So, the person skilled in the art is intended to consult 'BP08'.

133. To solve the defined technical problem, 'BP08' suggests equipping mobile stations with a local area receiver to connect to nodes of local entities or establishments (see Fig. 3 and paras. [0033]; [0039]: "the MS makes use of the information obtained through the local area receiver from one or more local service points"; [0040]: on the results of wide area Internet search and the results of the local area search"; [0041]: "a combination of the searches by, *inter alia*, using a local search algorithm" and Fig. 4; paras. [0041]-[0044]: on using Internet and local service to search a restaurant. Thus, 'BP08' discloses features 1.5 and 1.6 and raises the attention of the person skilled in the art to specific advantages of the combined search of the internet and of the local services. The person skilled in the art would have modified the teaching of 'BP07' in the expectation of solving the technical problem.

134. The Court notes that additional features of claims as issued 2 to 6, 8 to 10, 12 and 14 are not novel over 'BP07', so these claims do not involve an inventive step, for the same reasons raised for claim 1. The Court notes also that claim 7 does not involve inventive step over 'BP07' combined with the teaching of US 2009 0299980 A1 ('BP16'), that claim 11 does not involve an inventive step in view of 'BP07', completed with the common general knowledge of the skilled person or with 'BP16', and that claim 13 does not involve an inventive step in view of 'BP07', completed with the common general knowledge of the skilled person.

### ***Conclusions.***

135. For these reasons, the grounds for invalidity raised by the counterclaimant against the patent at issue are well founded and the arguments of the parties which have not been specifically considered must be deemed subsumed.

136. Therefore, patent EP 2 671 173 shall be revoked.

### ***Costs.***

137. The costs of the Court and of the claimant shall be borne by the defendant in counterclaim, as the unsuccessful party.

138. The panel notes that during the interim conference, the value of the revocation action for the purpose of applying the scale of ceilings for recoverable costs was set at EUR 5.000,000.00 euros and confirms this evaluation.

## **DECISION**

The Court:

- a) declares the European patent n° EP 2 671 173 revoked in its entirety with regard to the territories of the Contracting Member States in which the European patent has effect;
- b) orders that the Registry shall send a copy of this decision to the European Patent Office and to the national patent offices of any Contracting Member States concerned after the deadline for appeal has passed;
- c) orders that the costs of the proceedings shall be borne by the defendant in counterclaim.

Issued on 7 January 2026.

The presiding judge and judge-rapporteur

Paolo Catallozzi

The legally qualified judge

Tatyana Zhilova

The technically qualified judge

Wiem Samoud

The clerk

Margaux Grondein