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European Patent Office
Registry of the Enlarged Board of Appeal
Attn. Mr. Nicolas Michaleczek (via email: EBAamicuscuriae@epo.org)

Re: G 1/25

Dear Members of the Enlarged Board of Appeal,

Thank you for providing an opportunity to submit our views for your consideration.

Introduction

In T 0697/22, the Board concluded that the claims of auxiliary request 1E do not add matter, are sufficiently disclosed, novel and inventive, but that the adapted description was inconsistent with claim 1 of auxiliary request 1E. The validity of the patent was thus found to turn on whether this inconsistency contravenes the requirements of the EPC. After identifying diverging lines of case law on this point, the Board referred the following questions to the Enlarged Board of Appeal:

1. If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, is it necessary, to comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency?
2. If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?
3. Would the answer to questions 1 and 2 be different if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?

IPO's Interest in the Enlarged Board Decision

IPO represents a broad cross-section of intellectual property owners across all major technology sectors. Its 125 corporate members develop, manufacture, and sell technology-based products worldwide, with substantial research, development, and commercial activity in Europe. As global innovators with significant patent portfolios before the EPO, IPO's members rely on a stable,

predictable, and well-functioning patent system to support their investments in new technologies.

IPO's corporate members collectively invest tens of billions of dollars each year in research and development and employ hundreds of thousands of scientists, engineers, and technical professionals who design, build, and bring to market advanced products and services. The clarity, consistency, and uniform application of EPO law directly influence these investments, affecting innovation incentives, market dynamics, and long-term planning for companies operating across a wide range of industries.

Given this substantial and ongoing engagement with the European patent system, questions addressed by the Enlarged Board of Appeal regarding the interpretation of the EPC have practical importance for IPO and its members. The Enlarged Board's decisions can shape examination practices, patentability standards, and legal certainty in ways that materially affect the environment in which IPO's members innovate. Accordingly, IPO has a demonstrable interest in contributing its perspective to matters that bear on the transparency, consistency, and predictability of the EPO framework.

IPO's Recommendation

Consistent with IPO's comments in the enclosed letter sent to the EPO in March 2023, Patentees should **not** be obliged to amend the description when claim amendments are made during opposition proceedings but **should** be allowed to make such amendments provided that such amendments meet the requirements of the EPC.

IPO agrees with the second line of case law identified in T 0697/22 reason 15: no basis in the EPC exists for description amendments to be mandated when claims are amended. Further support for this position is set out in an article by M. Wilming in EPI issue 3/2022 "*For discussion: Has the requirement that claims be "supported by the description" been perverted over time?*": the travaux préparatoires suggest that the legislator did not intend to require amendment of the description when claim amendments are made. Deletion of "*fully*" from an earlier version of Article 84 EPC requiring "*that the claims must be clear and concise and that they must be ~~fully~~ supported by the description*" suggests that full correspondence between the claims and the description was not intended.

Removing the requirement for description amendments would make opposition procedures simpler, faster and more consistent for Patentees, saving significant time and costs on what is essentially an additional administrative process. Elimination of the requirement strikes the proper balance of costs to Patentees versus any perceived benefits of description amendments, thereby prioritizing efficiency without jeopardizing public

notice expectations or creating undue risk of improper interpretation of the claims as amended.

Comparison with and impact on other jurisdictions

Given the international nature of IPO's members and their wealth of experience in other jurisdictions, IPO is well positioned to compare the EPO's practice with that in the other IP5 offices, and to highlight the impact of this practice on other jurisdictions.

This requirement is unique to European patents, so removing it would also help to harmonize the EPO approach with that of the other IP5 offices. It would thus make the EPO a more desirable route to protection.

Importantly, having to make amendments to the description at the EPO disadvantages Patentees worldwide, as it is often used to infer meaning and limitations to the claims in other jurisdictions, including the US. Prosecution history estoppel is frequently used in litigation for the purposes of claim construction and to preclude Patentees from invoking the doctrine of equivalents to broaden the scope of their claims to cover subject matter ceded by the amendments. European prosecution history estoppel can be used worldwide as admissions by Patentees that limit claim scope interpretation.

Forcing Patentees to delete subject matter from the description following claim amendments can be used to:

- *Infer a lack of novelty or inventive step*: litigants argue that amendments are an admission of a lack of patentability;
- *Infer limitations to claim construction*: litigants argue that the applicant knowingly and intentionally limited the scope of their claims by deleting or "disclaiming" subject matter from the description;
- *Limit the use of the doctrine of equivalents*: Requiring strict compliance between description and claims will result in litigants arguing that strict compliance with the literal meaning of the claims was an essential requirement of the invention and that equivalents cannot therefore be deemed to infringe the claims.

In addition, this practice also introduces the risk that the amendments to the description introduce added matter leading to revocation of the patent, as was the case in T 1227/10 reason 1.1.4. Given the numerous disadvantages to Patentees of amending the description not just in Europe but beyond, and the lack of basis in the EPC for this requirement, IPO recommends that Patentees should **not** be obliged to amend the description when claim amendments are made during opposition proceedings.

Arguments made by proponents of the amendment requirement

Although proponents of the amendment requirement argue that a change will lead to unintended and incorrect judicial determinations of claim scope, there is no credible evidence that courts have any difficulty in post-grant claim interpretation, even if there are discrepancies between the description and the claims. See, for example, the enclosed recent decision of the UPC local division (Hamburg) in AGFA NV v Gucci Sweden AB et al., which found in Headnote 3 that "*Specifications in the description that are not consistent with the granted claims cannot serve as a basis of a broad interpretation of a claim*".

It has been suggested that adaptation of the description should be required as some jurisdictions, notably Germany, do not refer to the file history of a patent on claim interpretation. However, the enclosed BGH X ZR 16/09 "Okklusionsvorrichtung" shows that even without consulting the file history, courts can interpret the claims when the description has not been fully adapted. In any case, basing a decision which has a profound impact on all European patents on practice in Germany would be disproportionate, especially as the UPC will ultimately be the exclusive forum for European patents covering Germany. In this connection it is relevant that the UPC Court of Appeal in Headnote 2 of the enclosed Order of 20 December 2024 in Alexion v Amgen referred to applicant's assertions during the grant proceedings in the context of claim interpretation.

Even if the concerns about the ability of courts to interpret the claims were valid, the fact is that the vast majority of European patents are never litigated. The time and costs involved in amending the description for every patent are neither proportionate nor justified. Nor is amendment of the description before the EPO necessarily helpful, as it normally takes place before the relevant issues have been identified during litigation proceedings.

Amendments to the description during prosecution

Finally, the EPC does not mandate amendments to the description based on claim amendments in any context, so IPO recommends that the requirement to amend the description be eliminated for examination and examination-appeal proceedings as well as opposition and opposition-appeal proceedings.

Conclusion

IPO therefore recommends that all three of the referred questions should be answered, as follows:

1. If the claims of a European patent are amended during opposition proceedings or opposition-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent, is it necessary, to

comply with the requirements of the EPC, to adapt the description to the amended claims so as to remove the inconsistency?

No, adaptation is not required by the EPC.

2. If the first question is answered in the affirmative, which requirement(s) of the EPC necessitate(s) such an adaptation?

No requirement of the EPC necessitates such an adaptation.

3. Would the answer to questions 1 and 2 be different if the claims of a European patent application are amended during examination proceedings or examination-appeal proceedings, and the amendment introduces an inconsistency between the amended claims and the description of the patent application?

No, the answers would be the same for examination and examination-appeal proceedings.

Thank you for considering our comments.

Sincerely,

John Cheek
IPO President

Enclosed:

Letter sent by IPO to the EPO in March 2023

UPC_CFI_278/2023 AGFA NV v Gucci Sweden AB et al.

BGH X ZR 16/09 "Okklusionsvorrichtung"

Order of 20 December 2024 in UPC_CoA_405/2024 Alexion v Amgen

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March 31, 2023

European Patent Office
80298 Munich
Germany

Via Email: patentlaw@epo.org

Re: Public online user consultation on the Guidelines

Dear European Patent Office:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments on the updated Guidelines for Examination in the EPO (Guidelines) published on the 1st of February 2023.

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO is grateful for this opportunity to share feedback. It provides the following general comments on the Guidelines review process, followed by specific comments on Section F-IV 4.3 of the Guidelines (which concerns description amendments). It hopes that our suggestions will be helpful to the EPO's continued efforts to improve the Guidelines.

Annual Revision of the Guidelines for Examination

IPO commends the EPO for seeking to regularly update and improve the Guidelines and, in particular, the ongoing efforts to increase both the clarity of the Guidelines and the consistency of their application. IPO has two suggestions regarding certain aspects of the current drafting and review process.

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IPO believes that, for further clarity and consistency, the Guidelines should only establish definitive positions when there is settled law. When the Guidelines seek to establish a definitive position on an aspect of examination which goes beyond settled law, changes to the Guidelines can lead to creation of new law as Examining/Opposition Divisions and Boards of Appeal are faced with disagreements between Examiners and Applicants/Proprietors/Opponents which may not have arisen otherwise. In addition, areas of the Guidelines that are more prescriptive than the case law allows are also prone to inconsistency in application by Examiners.

Also, IPO would suggest that the review process should ask for comments on the Guidelines before they enter into force. The current review process invites comments on each edition of the Guidelines after their entry into force. The current consultation concerns the 2023 edition of the Guidelines, which entered into force on 1 March 2023. IPO expects that allowing comment on Guidelines after they enter into force could make it more difficult for significant revisions to be made in light of user feedback. Furthermore, through the annual revision cycle, the subject edition of the Guidelines will have been in force by the time any such revisions are made. During that time, decisions are made on the basis of those Guidelines. Changing the timeline for comments could have a positive impact on consistency and clarity, both for users and for the Office.

In the following section, IPO outlines its concerns with the section of the Guidelines relating to description amendments, and highlights challenges associated with the application of the current Guidelines.

Guidelines on Description Amendments

In 2021, the Guidelines were updated to clarify the requirements relating to description amendments. Section F-IV 4.3 begins:

> "Any inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence."

This requirement for consistency between description and claims is not, *per se*, new. However, a number of additions were made to the Guidelines that suggest the EPO intended to take a much stricter approach than it previously had. By way of example, the following guidance was added:

> "Embodiments in the description which are no longer covered by the independent claims must be deleted (for example if the description comprises an alternative for at least one feature which is no longer covered by the amended claims) unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended claims. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated (T 1808/06).

> […] Merely changing the wording "invention" to "disclosure" and/or the wording "embodiment" to "example", "aspect" or similar is not sufficient to clearly state that this part of the description does not fall under the scope of the claimed invention. It has to be explicitly specified that this part of the description does not describe part of the claimed invention.
>
> Similarly, subject-matter in the description being excluded from patentability needs to be excised, reworded such that it does not fall under the exceptions to patentability or prominently marked as not being according to the claimed invention"

Legal & Procedural Developments

It is not clear that a stricter approach is consistent with the state of the law. The Boards of Appeal have had, and continue to hold, divergent views on the need for and required extent of description amendments. Even after the 2021 Guidelines were published, several BoA decisions have concluded that there is no legal basis for requiring strict correspondence between the allowed claims and the description. These include at least T 1989/18, T 2194/19 and T 1444/20.

Although later editions of the Guidelines have attempted to moderate the strictness of some of requirements found in the 2021 update, IPO believes that the Guidelines can still be, and sometimes are, interpreted to provide a strict approach to what is not yet a settled area of the law.

Applicants continue to experience widely divergent approaches from Examiners, with some Examiners requiring no or only very minor description amendments, and others mandating such significant amendments that whole pages of the description have to be deleted, including embodiments which, while not explicitly recited by the claims, still fall within their scope.

Procedural Certainty and Equitable Examination

Such inconsistent approaches create significant procedural uncertainty, both for applicants and for third parties seeking to interpret granted claims. To facilitate predictability and fairness amongst applicants, IPO suggests that the EPO should adopt a more consistent and more moderate approach to description amendments.

Under the current situation, for applicants, not knowing what the Examiner's approach will be makes it difficult to predict what kind of description amendments will be required. If multiple rounds of amendments are needed to reach agreement, even after the claims have been declared allowable, grant will be significantly delayed, and the enforceable life of the ensuing patent shortened as a result. This uncertainty also prevents applicants from being able to pursue efficient prosecution strategies. For example, an applicant may be more reluctant to make certain claim amendments out of concern that the Examiner might require very strict compliance between claims and description – which could in turn, again, delay grant.

For third parties, the inconsistent approach to description amendments by Examiners will make it impossible to know whether an embodiment has been deleted because it truly is not part of the invention, or because the patentee was required to make overly broad deletions from the description in order to get a notice of allowance.

In addition, continuing to try to enforce very strict, literal correspondence between description and claims puts applicants for European patents at a significant disadvantage, and not just because of the additional costs and time involved in navigating overly strict requirements, but because of the additional issues explained herein.

For the sake of procedural certainty, fairness amongst applicants, and clarity for third parties, we strongly believe that the EPO should adopt a more consistent and, importantly, a more moderate approach to description amendments, in line with other major patent-granting bodies.

Post-Grant Impact

The description is a critical part of any patent and will be used to interpret the claims during any post-grant validity or infringement actions. Importantly, the very fact of having made amendments to the description will also be used to infer meaning and limitations to the claims. Prosecution history estoppel is frequently used in litigation for the purposes of claim construction and to preclude a patentee from invoking the doctrine of equivalents to broaden the scope of their claims to cover subject matter ceded by the amendments. Critically, European prosecution history estoppel can be used in courts even outside of Europe, including in the U.S., as admissions by the patentee that limit claim scope interpretation.

Forcing an applicant to delete subject matter from the description because it doesn't explicitly appear in the claims can be used to:

- *Infer a lack of novelty or inventive step:* Since the Guidelines state that "subject-matter in the description being excluded from patentability needs to be excised," litigants will argue that amendments by the applicant were an admission of a lack of patentability;

- *Infer limitations to claim construction:* Since the Guidelines state that "embodiments in the description which are no longer covered by the independent claims must be deleted," litigants will argue that the applicant knowingly and intentionally limited the scope of their claims by deleting or "disclaiming" subject matter from the description. This will be especially problematic where the applicant is forced to make unduly broad deletions, including of embodiments that are in fact still within the scope of the claims;

- *Limit the use of the doctrine of equivalents*: Requiring strict compliance between description and claims will result in litigants arguing that strict compliance with the literal meaning of the claims was an essential requirement of the invention and that equivalents cannot therefore be deemed to infringe the claims.

An unduly strict approach to description amendments will put patentees who have obtained protection through the EPO at a severe disadvantage post-grant, not just in Europe but beyond, and could discourage applicants from using the EPO altogether.

Unique Requirement

To the best of IPO's knowledge, no other major jurisdiction has requirements for description amendments as strict or severe as those set out by the EPO Guidelines for Examination as interpreted and implemented by at least some Examiners. The resulting uncertainty, lack of fairness, and impact on enforcement impose an undue cost on the applicant and do not support the fundamental premises of patent protection. It makes the EPO a far less desirable route to protection and could result in applicants choosing other forums instead. A more consistent, more moderate approach would be beneficial for all.

Final Remarks

IPO believes that a renewed effort is needed to ensure that the Guidelines do not extend beyond settled case-law. In addition, IPO considers that a review process that allows draft changes to the Guidelines to be commented on before entry into force would improve the feedback and review process. Finally, IPO suggests that the EPO adopt a more consistent and more moderate approach to description amendments.

IPO thanks the EPO for its attention to IPO's comments submitted herein, and welcomes further dialogue and opportunity to provide additional comments.

Sincerely,

Karen Cochran
President

Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Hamburg - Local Division

UPC_CFI_278/2023

Final Order
of the Court of First Instance of the Unified Patent Court
delivered on 30/04/2025

HEADNOTES

1. Art. 32 (1) e) and 65 (1) UPCA allow to attack the patent in its entirety by means of a counterclaim, even though single claims are not a part of the infringement requests.

2. The definition of claimed features based on the principle that a patent may be used as its "own lexicon" is limited to those parts of the description that are related to the feature in question.

3. Specifications in the description that are not consistent with the granted claims cannot serve as a basis of a broad interpretation of a claim.

4. A counterclaimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in the oral hearing for the first time.

KEYWORDS

Art. 32 (1) e) and 65 (1) UPCA; Claim interpretation; Late filed validity attack, Rule 25 RoP

CLAIMANT

AGFA NV (Claimant) - Septestraat 27 - 2640 - Mortsel - BE	Represented by Kai Rüting

DEFENDANTS

1.	**Guccio Gucci S.p.A.** (Defendant) - Via Tornabuoni 73/r - 50123 - Florence - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
2.	**Marbella Pellami S.p.A.** (Defendant) - Via Marco Polo 91 - 56031 - Bientina - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
3.	**G Commerce Europe S.p.A.** (Defendant) - Via Don Lorenzo Perosi 6 - 50018 - Scandicci - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
4.	**Gucci Logistica S.p.A.** (Defendant) - Via Don Lorenzo Perosi 6 - 50018 - Scandicci - IT	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
5.	**GG Luxury Goods GmbH** (Defendant) - Unter den Linden 21 - 10117 - Berlin - DE	Statement of claim served on 09/09/2023 Represented by Dr. Benjamin Schröer
6.	**Gucci France SAS** (Defendant) - 7 Rue Leonce Reynaud - 75116 - Paris - FR	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
7.	**GG FRANCE SERVICES SAS** (Defendant) - 37 Rue de Bellechase - 75007 - Paris - FR	Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer
8.	**Gucci Belgium SA** (Defendant) - Boulevard de Waterloo 49 - 1000 - Bruxelles - BE	Statement of claim served on 13/09/2023 Represented by Dr. Benjamin Schröer

9. **Gucci Sweden AB** (Defendant) - Birger Jarlsgatan 1 - 11145 - Stockholm - SE — Statement of claim served on 19/09/2023 Represented by Dr. Benjamin Schröer

PATENT AT ISSUE

Patent no.	*Proprietor/s*
EP3388490	AGFA NV

LANGUAGE OF PROCEEDINGS
English

PANEL/DIVISION
Panel of the Local Division in Hamburg

DECIDING JUDGES
This decision is delivered by presiding judge Klepsch, the legally qualified judge and judge-rapporteur Dr. Schilling, the legally qualified judge Lignieres and the technically qualified judge Sarlin.

ORAL HEARING
13 February 2025

SHORT SUMMARY OF THE FACTS

The Claimant, AGFA NV (hereinafter "Agfa"), is a Belgium-based company that is specialized in i.a. the development and sale of industrial inkjet technology, such as inks and printers. Agfa is part of the Agfa-Gevaert Group.

The Defendants are nine different European companies belonging to the French conglomerate Kering, which is the parent company of several luxury brands including e.g. Gucci, Saint Laurent and Balenciaga (exhibit VB02). All defendants are hereinafter collectively referred to as "Defendants" or "Gucci".

The Claimant is the proprietor of the European Patent EP 3 388 490 B1 (following "the patent") with the title "Decorating Natural Leather" (Exhibit VB01). The patent was granted on 21 July 2021 and has an application date of 14 April 2017. No opposition has been filed against the patent and there are no prior or pending proceedings relating to the patent before the Unified Patent Court or any national court or authority.

The patent in suit is in force in Belgium, Germany, Spain, France, UK, Italy and Sweden. Agfa is the sole proprietor of the national designations of the patent (exhibit VB23).

The patent regards a manufacturing method for decorating natural leather with a decorative image and a decorated natural leather having a decorative image. It further regards the use of an achromatic colour different from black in a base coat that is on a crusted leather in combination

with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather.

The Patent has fifteen claims, of which claims 1, 3, 4, 5, 6, 7, 10, 12, 13 and 14 are deemed relevant to these proceedings by the Claimant.

Claim 1 relates to a manufacturing method for decorating natural leather with a decorative image.

Claim 1 reads as follows:

> A manufacturing method for decorating natural leather with a decorative image including the steps of:
> - applying on a crusted leather (45) a base coat (44) containing a pigment for providing an achromatic colour different from black;
> - inkjet printing a colour image (43) on the base coat (44)
>
> using one or more pigmented UV curable inkjet inks;
> - optionally applying a protective top coat (42) on the image (43); and
> - optionally applying a heat pressing or embossing step;
>
> wherein the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image.

Dependant claim 3 specifies that the pigment used for providing an achromatic colour is a white pigment. Dependant claim 4 relates to the base coat which includes a polymer or copolymer based on polyurethane. Dependant claim 5 specifies that 1-20 wt% of the total weight of the UV curable inkjet ink consists of polyfunctional monomers or oligomers. Dependant claim 6 specifies that 0-20% of the total weight of the UV curable inkjet ink consists of organic solvent or water. Dependant claim 7 specifies that a protective top coat is applied.

Independent claim 10 relates to the decorated leather having a decorative image.

Independent claim 10 reads as follows:

> A decorated natural leather having a decorative image and including, in order,
> a crusted leather (45);
> a base coat (44) containing a pigment for providing an achromatic colour different from black;
> a pigmented UV curable inkjet printed colour image (43);
> and a protective top coat (42),
> wherein the chromatic colour or the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image.

The parties agree that claim 10 contains an obvious error by reference to “the chromatic colour”. This feature was deleted during prosecution from claim 1 but accidentally not deleted in claim 10. It is undisputed that the skilled reader should only read “the achromatic colour different from black”.

Dependant claim 12 specifies that the surface of the pigment used for providing the achromatic colour is a white pigment. Dependant claim 13 relates to the base coat which includes a polymer or copolymer based on polyurethane.

Dependant claim 14 claims a leather article including the decorated natural leather according to any one of claims 10 to 13. The leather article must be selected from the group consisting of

footwear, furniture, upholstery, bags, luggage, gloves, belts, wallets, clothing, automotive leather seats, interior decoration, packaging, equestrian leather articles, books and stationary.

Independent claim 15 is a use-claim of an achromatic colour different from black in a base coat on a crusted leather.

Independent claim 15 reads as follows:

> Use of an achromatic colour different from black in a base coat on a crusted leather in combination with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather.

The Claimant saw several claims of the patent being infringed by Gucci's "Pikarar Collection". The Claimant had reached out to Gucci about a possible infringement of the patent in suit first in June 2022. An out-of-court solution could not be found.

With its statement of claim dated 15 August 2023, the Claimant sued the Defendants for patent infringement plus annex requests.

The Claimant relies on a direct infringement of claims 1, 3, 4, 5, 6, 7, 10, 12, 13 and 14 of the patent in suit. It considers the "Padlock Gucci animal print mini bag" (= Pikarar Padlock Bag) and the "Rhyton Sneaker with animal print" (= Pikarar Sneakers) infringing the patent. Further suspected infringement products are the "Gucci animal print zip card case" (= Pikarar Card Case), the "Gucci animal print mini tote bag" (= Pikarar Tote Bag) and the "Women's Gucci Jordaan animal print loafer" (= Pikarar loafers). These products are part of the "Pikarar Collection", a limited-edition collection designed by Gucci in collaboration with the US-based illustrator Angela Nguyen.

STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES

The Claimant requests with its Statement of Claim dated 15 August 2023:

> I. to order Gucci, under the forfeiture of a recurring penalty payment of EUR 250,000.00 to be imposed by the Court for each failure to comply with this order, immediately from the date of service of the judgment, to cease and desist from
>
> 1. making, offering, placing on the market, using, or importing or storing for those purposes in Belgium, Germany, France, Italy and/or Sweden
>
> decorated natural leathers obtained by a manufacturing method for decorating natural leather with a decorative image including the steps of:
>
> - applying on a crusted leather a base coat containing a pigment for providing an achromatic colour different from black;
> - inkjet printing a colour image on the base coat using one or more pigmented UV curable inkjet inks;
> - optionally applying a protective top coat on the image; and
> - optionally applying a heat pressing or embossing step;
>
> wherein the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image,
>
> *direct infringement of claim 1 of EP 3 388 490 B1*
>
> in particular, wherein the pigment used for providing the achromatic colour is a white pigment,

direct infringement of claim 3 of EP 3 388 490 B1

in particular, wherein the base coat includes a polymer or copolymer based on polyurethane,

direct infringement of claim 4 of EP 3 388 490 B1

in particular, wherein the one or more pigmented UV curable inkjet inks contain 1 to 20 wt% of polyfunctional monomers or oligomers based on the total weight of the pigmented UV curable inkjet ink,

direct infringement of claim 5 of EP 3 388 490 B1

in particular, wherein the one or more pigmented UV curable inkjet inks contain 0 to 20 wt% of organic solvent or water based on the total weight of the pigmented UV curable inkjet ink,

direct infringement of claim 6 of EP 3 388 490 B1

in particular, wherein a protective top coat is applied,

direct infringement of claim 7 of EP 3 388 490 B1

in particular the products “Padlock Gucci animal print mini bag” and “Rhyton Sneaker with animal print” as depicted below

as well as any other product with a decorated natural leather obtained by a manufacturing method with the above outlined steps;

2. making, offering, placing on the market, using or importing or storing for these purposes in Belgium, Germany, France, Italy and/or Sweden

decorated natural leathers having a decorative image and including, in order, a crusted leather; a base coat containing a pigment for providing an achromatic colour different from black; a pigmented UV curable inkjet printed colour image; and a protective top coat, wherein the chromatic colour or the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image,

direct infringement of claim 10 of EP 3 388 490 B1

in particular, wherein the surface of the pigment used for providing the achromatic colour is a white pigment,

direct infringement of claim 12 of EP 3 388 490 B1

in particular, wherein the base coat includes a polymer or copolymer based on polyurethane,

direct infringement of claim 13 of EP 3 388 490 B1

in particular the products “Padlock Gucci animal print mini bag” and “Rhyton Sneaker with animal print” as depicted below

as well as any other product with a decorated natural leather having a decorative image and fulfilling the above-mentioned characteristics;

3. making, offering, placing on the market, using or importing or storing for these purposes in Belgium, Germany, France, Italy and/or Sweden

leather articles including a decorated natural leather having a decorative image and including, in order, a crusted leather; a base coat containing a pigment for providing an achromatic colour different from black; a pigmented UV curable inkjet printed colour image; and a protective top coat, wherein the chromatic colour or the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image,

wherein the leather article is selected from the group consisting of footwear, furniture, upholstery, bags, luggage, gloves, belts, wallets, clothing, automotive leather seats, interior decoration, packaging, equestrian leather articles, books and/or stationary

direct infringement of claim 14 of EP 3 388 490 B1

in particular the products “Padlock Gucci animal print mini bag” and “Rhyton Sneaker with animal print” as depicted below

as well as any other footwear, furniture, upholstery, bags, luggage, gloves, belts, wallets, clothing, automotive leather seats, interior decoration, packaging, equestrian leather articles, books and/or stationary with a decorated natural leather having a decorative image according to the above characteristics;

II. to order Gucci, under the forfeiture of a recurring penalty payment of up to EUR 10,000 EUR to be imposed by the Court for each day of delay, within a period of 45 days from the date of service of the judgment referred to in Rule 118.8 of the Rules of Procedure, at their own expense, or a penalty of EUR 2,000 for each product with which this order is breached

1. to recall and permanently remove from the channels of distribution the products as specified in items I. 1.-3. above which have been placed on the market in Belgium, Germany, France, Italy and/or Sweden since 21 July 2021, to notify the third parties from whom the products are to be recalled that this Court has found that the respective product infringes the European patent EP 3 388 490 B1, with a binding undertaking by the respective Defendant to repay the purchase price already paid, if any, to reimburse the third parties for the costs incurred, to pay the transport, shipping and packaging costs incurred, to reimburse the customs and storage costs associated with the return of the products, and to take back the products;

2. to destroy the products as specified in items I. 1.-3. above and/or the materials and implements, in particular the decorated leather as specified in item I.1. and I.2, which are in Gucci's direct or indirect possession and/or ownership in Belgium, Germany, France, Italy and/or Sweden and to provide Agfa with proof of the destruction or, at their option, to hand them over to a bailiff to be appointed by Agfa for the purpose of destruction;

III. to order Gucci, under the forfeiture of a recurring penalty payment of up to EUR 2,000 EUR to be imposed by the Court for each day of delay, within a period of 45 days from the date of service of the judgment referred to in Rule 118.8 of the Rules of Procedure,

1. to provide Agfa in a list broken down by month of a calendar year and by infringing product and in an electronic form that can be analysed by a computer, with the relevant information on the infringing products as specified in items I.1.-3. above and the extent to which they (Gucci) have committed the acts specified in items I.1.-3. above, in order to be able to recall and destroy all infringing products on the market to identify their current or former owners and to calculate the damages, including Gucci's profit as from 21 July 2021, in particular by providing information on

a) the origin and distribution channels of the infringing products;

b) the quantities produced, manufactured, delivered, received or ordered, as well as the prices obtained for the infringing products; and

c) the identity of any third person involved in the production or distribution of the infringing products or in the use of the infringing process;

2. to lay open books to Agfa for proving the statements made according to item III. 1. by making them available for each month of a calendar year and for each infringing product and in an electronic form that can be analysed by a computer, in particular

a) evidence showing the numbers and dates of the products manufactured;

b) invoices - or, if unavailable, delivery bills - of each shipment, broken down by quantities offered, times offered, prices of goods offered, and type designations, and the names and addresses of the commercial recipients of the sales offers for all products sold or otherwise disposed of;

c) evidence of advertising carried out, broken down by advertising medium, its distribution, the distribution period and the distribution area; including evidence of such advertising activities;

d) the costs, broken down by individual cost factors and the profits made;

e) invoices - or, if unavailable, delivery bills - and corresponding statements of all costs expended upon which Gucci relies in calculating its profits;

the accuracy of which is verified and confirmed by a certified public accountant appointed by Agfa at the expense of Gucci, who shall be bound to secrecy vis-à-vis the Agfa with regard to the aforementioned information;

IV. to declare that Defendants individually and jointly have infringed the patent EP 3 388 490 B1 by committing the acts as specified in items I.1., 1.2 and I.3. above;

V. to declare that Defendants are individually and jointly liable to compensate Agfa for all damages that incurred and will incur due to the acts specified in item I.1., I.2 and I.3. above and committed since 21 July 2021, as to be specified separate damage proceedings;

VI. to order Gucci to pay the reasonable and proportionate legal costs of these proceedings and other expenses;

VII.to declare that

1. the orders according to item I.1, I.2. and I.3, and VI. are immediately enforceable notwithstanding any appeal,

2. the orders according to items II.1., II.2, II.3 and III.1. and III.2 are immediately enforceable after Agfa has notified the Court which part of these orders it intends to enforce, a certified translation of the orders in accordance with Rule 7.2, where applicable, into the official language of the Contracting Member State in which the enforcement shall take place has been provided by Agfa, and the said notice and, where applicable, the certified translation of the orders have been served on the respective Defendant by the Registry.

The Defendants request with their Statement of Defence and Counterclaim for revocation dated 8 January 2024 in the version of the Reply to the Defence dated 28 June 2024:

I. The infringement action is dismissed.

II. The Claimant shall bear the costs of the infringement proceedings.

Counterclaiming:

III. The European Patent EP 3 388 490 is revoked in its entirety with effect to the territories of Belgium, France, Germany, Italy and Sweden.

IV. The Claimant shall bear the costs of the revocation proceedings.

Auxiliary requests:

V. by way of an auxiliary request, in case the Counterclaim for revocation is referred to the Central Division, to suspend the action for infringement until the final decision on the Counterclaim of revocation.

VI. in the event that the Claimant fails to take a step within the time limit foreseen in the Rules of Procedure or set by the Court or fails to appear at an oral hearing after having been duly summoned, to dismiss the action for infringement and revoke European Patent EP 3 388 490 in its entirety with effect to the territories of Contracting Member States in which EP 3 388 490 is in force by way of a decision by default (R. 355.1 RoP).

VII. dismiss the request for injunctive relief (item I.), the request for recall and removal from the channels of commerce and the request for destruction (item II.) and instead order the Defendants 1) to 9) to pay a compensation that is reasonable under the circumstances of the case and takes into account the economic value of a hypothetical license.

VIII. The orders requested by the Claimant, including, but not limited to, the requested injunction pursuant to item I., shall be enforceable only after a security has been given by the Claimant to the respective Defendant(s) as determined by the Court in accordance with R. 352 RoP.

The Claimant requests,

I. The Counterclaim for Revocation is dismissed.

II. The Counterclaimants and Defendants are to bear the legal costs of the Revocation Proceedings.

Auxiliary requests with its application to amend the patent dated 9 April 2024:

III. The European Patent EP3 388 490 B1 is upheld with effect to the territory of Belgium, France, Germany, Italy and Sweden according to any one of Auxiliary Requests 1 to 5 as considered valid by your court.

IV. For the rest, the counterclaim for revocation is dismissed.

V. The Counterclaimants and Defendants are to bear the legal costs of the Revocation Proceedings.

The Defendants request with their Defence to an application to amend a patent dated 28 June 2024:

I. The Application to Amend the Patent is inadmissible to the extent of auxiliary requests 2 and 5.

II. The European Patent EP 3 388 490 is revoked in its entirety also in view of the auxiliary requests 1 to 5 with effect to the territories of Belgium, France, Germany, Italy and Sweden.

III. In the alternative: The infringement action is dismissed to the extent that the claimant alleges infringement of the Patent-in-Suit as amended by the Auxiliary Requests.

IV. The Patentee shall bear the costs of the revocation proceedings.

POINTS AT ISSUE

The parties disagree on the interpretation of some terms of the feature “achromatic colour different from black of the base coat in the independent claims 1 and 10, and the question whether the claims allow an intermediate layer of (white) ink on the base coat. The Claimant clarified with its submission of 24 January 2025 regarding the interpretation of feature 1.1 that the claimed base coat must contain (not consist of) a pigment for providing an achromatic pigment different from black, which (in conjunction with feature 1.5.1) results in a base coat having an achromatic colour different from black. White, grey and black were achromatic colours and achromatic colours had no dominant hue, meaning that all wavelengths would be present in approximately equal amounts. Such a colour might be obtained, e.g., through the use of a white pigment such as titanium dioxide, but also by adding additional pigments for slightly altering the colour of the base coat.

The Claimant is of the opinion that adding a small amount of chromatic pigment to a large amount of achromatic pigment would generally still result in an achromatic base coat. It argues that the patent did not only seek protection for “perfect” achromatic colours or indistinguishable variants thereof. Rather, the patent also sought protection for base coats with a small amount of chromatic pigments, which include off-white or ivory white colour. The Claimant relies, in particular, on para [0029] and example 3 of the patent.

Para. [0021] of the patent reads as follows:

> A chromatic colour is any colour in which one particular wavelength or hue predominates. For example, blue and green are chromatic colours, while white, grey, and black are achromatic colours, as they have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours.

The Defendants interpret para [0021] of the patent in a way that it would teach that a colour is achromatic within the meaning of the patent if it had a flat spectral response or, if the spectral response was not perfectly flat, if the deviations from the perfectly flat spectrum were such that the difference between the colour in question and the nearest reference achromatic colour with a perfectly flat spectrum line would not be perceptible to the average observer. "Approximately equal amounts” meant according to the Defendants that a colour is achromatic, as long as the human eye could not perceive a difference to the nearest "perfect" achromatic colour. The nearest perfect achromatic colour was a colour where all wavelengths have the same reflection intensity.

They are of the opinion the ΔE94 metric could be used to determine how the human eye perceives colour differences. The skilled person understood that an objective and reproducible criterion was required based on which it could be determined whether all wavelengths were present in approximately equal amounts so that the colour difference was not perceptible to the average observer. This issue would lead the skilled person automatically to the option of using the ΔE94 metric.

The Defendants challenge the novelty and in parts the inventiveness of the inventions defined in the claims of the patent in suit, including claim 15, which is not asserted by the Claimant of being infringed.

The Defendants rely on their counterclaim for revocation on written pieces of prior art in exhibits HLAR 7, 8 and 9. They see these documents as being novelty destroying with respect to claim 1. They attack claim 10 on the grounds that the claimed process is not novel based on HLAR 9 and it is non-inventive based on a combination of documents HLAR 9 with HLAR 7 or of documents HLAR 9 with HLAR 8.

Furthermore, they raise the lack of novelty for independent claims 1, 10 and 15 based on the "Flora" products, which they claim to have marketed before the priority date. The Defendants also raise novelty or inventive step objections against all the dependent claims, based on the Flora products. They are of the opinion that all features of the claims 1, 3, 7, 8, 10 and 12-15 were disclosed by these products or that their features were available to the skilled person, by analysis. Regarding the method of claim 1 which is directed to applying at least two layers (base coat, colour image) to the leather in a specific order, the Defendants consider that the skilled person can deduce the order of the layers inter alia based on microscopy measurement and the skilled person can hence deduce the method steps from the measurements.

The Claimant considers the patent in suit to be novel and inventive. It contests the availability of the Flora products on the market before the priority date, and it contests that these products were successfully questioning the patentability of the patented claims and that, in addition, their features were detectable without the detailed own manufacturing knowledge of the Defendants.

The asserted patent infringement with the attacked embodiments of the "Pikarar collection" is disputed. As an auxiliary defence the Defendants rely on private prior use based on the Flora products.

GROUNDS FOR THE ORDER

The infringement action is admissible, but unfounded. The counterclaim for revocation is admissible, but not successful, either.

A. ADMISSIBILITY

Both, the infringement action and the counterclaim for revocation are admissible.

I.

The admissibility of the claim is formally undisputed. Even though the Defendants claim that Defendant 7) is completely unrelated to the present proceedings, they did not formally question the jurisdiction of the Court by means of a preliminary objection in this respect. According to R. 19.7 RoP, this shall be treated as a submission to the jurisdiction and competence of the Court and the competence of the Division chosen by the Claimant, namely the Local Division Hamburg.

II.

The counterclaim is admissible.

1.

The Defendants adjusted their counterclaim in their Reply to the Defence dated 28 June 2024 now citing the relevant countries, i.e. with effect to the territories of Belgium, France, Germany, Italy and Sweden.

2.

On request of the judge-rapporteur the parties exchanged arguments whether or not it is possible under the UPCA to attack an individual claim – here claim 15 – by means of a counterclaim even though it is not part of the infringement action and the Claimant does not seek an injunction on the basis of this individual claim of the patent at issue.

After considering the parties' arguments, the Court decides this question in favour of it being possible to attack the patent in its entirety by means of a counterclaim, even though single claims might not be a part of the infringement requests. The Defendants rightfully pointed out that in Art. 32(1)e) and 65(1) UPCA no distinction is made between asserted and unasserted patent claims,

but reference is made to the patent in its entirety. Therefore, already the wording of the relevant provisions clearly suggests that the revocation of the entire patent in dispute may be sought. In contrast, there is no provision in the UPC Rules of Procedure that limits the party bringing a counterclaim to the parts of the patent asserted against it by the Claimant in the infringement action, and no requirement that such party limits its action for revocation to what is asserted against it in the main infringement action (LD Paris, 04.07.2024 – UPC_CFI_230/2023, ACT_546446/2023, para. 9.2).

According to Art. 33(4) UPCA, a defendant of the infringement action is unable to bring a stand-alone revocation action against the same patent before the central division. Therefore, it must be possible for a Defendant to attack the patent in its entirety by way of a counterclaim for revocation, including those claims not asserted in the infringement action, since otherwise the non-asserted claims would be immune against a validity challenge by the Defendant.

It would also contradict the principle of procedural economy as well as of efficiency and cost-effectiveness in Article 41(3) UPCA would it not be possible to attack the patent in dispute in its entirety with the counterclaim for revocation.

3.

With auxiliary requests 1- 5 the Claimant seeks to limit the patent in suit. Auxiliary requests AR 1 – 5 are based on the claims as granted. Auxiliary request AR1 deletes an (apparent) mistake in claim 10 and deletes claim 15. Auxiliary requests AR2-AR5 further combine claim 1 with dependent claims. The admissibility of the auxiliary request is partly contested by the Defendants. As the condition for a decision on the auxiliary requests did not materialise (see below in sect. C.) this point does not need further elaboration.

By Order dated 19 December 2024, the Judge-Rapporteur concluded the written proceedings.

III.

The Panel admits the contested presentation of evidence by the Defendants with their Revocation Reply and the Amendment Defence dated 28 June 2024 (exhibits HLAR 29 to 44) and their Amendment Rejoinder dated 30 September 2024 (exhibits 47 and 48). The Panel, however, rejects all the pieces of evidence filed after the end of the written procedure: exhibits HLAR 47a, 49 – 51 filed by the Defendants and exhibit VB 51 (and its Appendixes 1 and 2) filed by the Claimant. The Panel executes its discretion, as indicated by the judge-rapporteur in the interim conference on 19 December 2024, to not dismiss the evidence presented by the Defendants in exhibits HLAR 29 to 48 as their presenation was a comprehensible reaction to the Claimant contesting facts. As the report HLAR 10 – submitted with the Counterclaim – already stated that there was evidence for the presence of parbenate, a typical photoinitiator, in the HP Ink used, but not in the final Flora product, the submission of exhibit HLAR 47 was also a reasonable reaction to the contesting by the Claimant. For the submissions of even further evidence HLAR 49 – 51 by the Defendants with their comments dated 24 January 2025 and of the corrected report HLAR 47a on 7 February 2025 after the interim conference on the other hand, the Defendants were lacking the necessary approval of the Court based on Rule 36 RoP. The judge-rapporteur did not invite the Defendants to provide even further evidence, thus HLAR 49 – 51 are rejected by the Panel as late filed. As an additional remark, HLAR 50a filed on 7 February 2025 has been filed to correct errors in HLAR 50 filed on 24 January 2025, even though HLAR 50 had been filed to fill the gap in HLAR 47. In addition, the Defendants have filed a corrected version HLAR47a of HLAR47 on 7 February 2025, therefore less than one week before the oral hearing and have admitted that its written brief of 24 January 2025 included an error.

B. THE PATENT IN SUIT

I.

The patent in suit relates to the manufacturing of decorated natural leather and leather articles therewith. The manufacturing of natural leather articles is well known and can generally be split up into five phases as shown by figure 1 of the patent. Natural leather has been decorated in the past by screen printing. However, screen printing is labour intensive and a large number of individual screens are required for each colour and for each size of print. This is costly and time-consuming, especially when personalization or customization is desired, para. [0003]. Digital printing technologies on finished leather have been investigated but many solutions on finished leather remain of inferior quality. Inkjet technologies from textile printing employing heat transfer paper have been explored for leather printing. However just like inkjet printing directly onto natural leather, it was found that a process of inkjet printing dye-based images onto a sheet of transfer paper and then transferring the images onto tanned leather by heat resulted in a quality unacceptable for many luxury leather products, para. [0004]. Light fading of dyes can be resolved by using pigmented inks, para. [0005]. Recently, high quality decorated leather has been obtained by a method of printing "into" tanned leather with pigmented inks, para. [0006]. A high image quality of printed leather is essential for luxury leather articles. In order to enhance colour brilliancy, often a white background is used, para. [0007]. One option is to use white leather, para. [0008]. However, the luxury appearance of a leather article is substantially decreased when a side of the printed white leather is viewable in the leather article or when perforations are present, for example for sewing leather pieces together or for providing aeration in e.g. leather car seats. Furthermore, the use of white leather generally does not help much to reduce colour inconsistencies or surface defects, para. [0009]. Another option for providing a white background is to use white inkjet inks. However, the application of white inkjet ink in amounts sufficient to mask surface defects and colour inconsistencies of the leather resulted in insufficient flexibility of the printed leather showing cracks in the printed image, para. [0010].

The patent describes as an objective that there is a need for manufacturing methods of decorated leather having high image quality and colour consistency, while not sacrificing inkjet printing reliability or physical properties like flexibility, para. [0011]. The above-mentioned problem is solved by a method according to claim 1. It is stated to have been surprisingly found that an inkjet printed leather exhibiting excellent flexibility, colour consistency and image quality could be obtained by using an achromatic colour different from black in a base coat (44) on a crusted leather (45) and combining it with a colour image (43) inkjet printed on the base coat for providing a decorative image to a natural leather. The word 'combining' is to be understood as that the colours in the decorative image are the result from the colours of the colour image and the colour of the base coat, para. [0013].

II. CLAIM CONSTRUCTION

Granted claim 1 of the patent in suit (EP 3 388 490 B1), can be divided into the following features (numbering following Defendants):

1.0	A manufacturing method for decorating natural leather with a decorative image including the steps of:
1.1	applying on a crusted leather (45) a base coat (44)

1.1.1 [the base coat (44)] containing a pigment for providing an achromatic colour different from black;

1.2 inkjet printing a colour image (43) on the base coat (44)

1.2.1 using one or more pigmented UV curable inkjet inks;

1.3 optionally applying a protective top coat (42) on the image (43); and

1.4 optionally applying a heat pressing or embossing step;

1.5 Wherein

1.5.1 the achromatic colour different from black of the base coat

1.5.2 and the inkjet printed colour image

1.5.3 are used in combination to provide the decorative image.

Granted claim 10 of the patent in suit (EP 3 388 490 B1), can be divided into the following features:

10.0 A decorated natural leather having a decorative image and including, in order,

10.1 a crusted leather (45);

10.2 a base coat (44) containing a pigment for providing an achromatic colour different from black;

10.3 a pigmented UV curable inkjet printed colour image (43);

10.4 and a protective top coat (42),

10.5 Wherein

10.5.1 the chromatic colour or the achromatic colour different from black of the base coat

10.5.2 and the inkjet printed colour image

10.5.3 are used in combination to provide the decorative image.

Granted claim 15 of the patent in suit (EP 3 388 490 B1), which is not part of the infringement action, can be divided into the following features:

15.0 Use of an achromatic colour different from black in a base coat on a crusted leather

15.1 in combination with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather.

III. PRINCIPLES OF INTERPRETATION

The Court relies on the following principles of interpretation of patent claims:

1.

The UPC Court of Appeal has adopted as standard for the interpretation of patent claims (decision dated 26.02.2024 – UPC_CoA_335/2023, App_576355/2023 - 10X Genomics and

Harvard/NanoString), that in accordance with Art. 69 of the Convention on the Grant of European Patents (EPC) and the Protocol on its Interpretation 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. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. However, 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. The patent claim is to be interpreted from the point of view of a person skilled in the art. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties. These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent. This follows from the function of the patent claims, which under the EPC serve to define the scope of protection of the patent under Art. 69 EPC and thus the rights of the patent proprietor in the designated Contracting States under Art. 64 EPC, taking into account the conditions for patentability under Art. 52 to 57 EPC.

2.

Art. 69 EPC and its Protocol require that the terms used in the claims must govern claim construction, on their own or in their claimed combination. They are not just the "starting point" for claim construction but the authoritative basis for determining the scope of protection. The description and the drawings are nevertheless always to be considered, even with seemingly clear claims; thus, a patent may be used as its "own lexicon" (CoA, 26.02.2024 – UPC_CoA_335/2023, Headnote 2 – NanoString v 10x Genomics; CD Munich, 16.07.2024 – UPC_CFI_14/2024, Headnote 1 – Regeneron v Amgen). The features of a claim have to be read in combination, as they must always be interpreted in the light of the claims as a whole (CoA, 13.05.2024 – UPC_CoA_1/2024, mn 29 – VusionGroup v Hanshow).

3.

The Panel agrees with the parties' (almost) concordant definition that the skilled person is an engineer in the field of printing technology specialized in the preparation and the processing of decorated leather articles, and experienced in the application of printing methods available for printing on leather. The skilled person has knowledge of inkjet printing and the colouring involved.

IV. FEATURE ANALYSIS

Claim 1 regards a manufacturing method for decorating natural leather with a decorative image. In particular the feature 1.1.1 *[the base coat (44)] containing a pigment for providing an achromatic colour different from black* and feature 1.2.1 requiring *inkjet printing a colour image on the base coat* of the granted claim 1 requires interpretation in accordance with the above-mentioned standards.

1.

The claimed manufacturing method includes the steps of applying a base coat on a crusted leather (feature 1.1).

The composition of the base coat in terms of its material is not limited in the claim. However, the patent teaches in para. [0043] that the base coat preferably includes a polymer or copolymer based on polyurethane, as this has been found to improve flexibility to the printed leather. The base coat preferably further includes a polyamide polymer or copolymer, as polyamide has been found to improve the compatibility with the crust leather and to improve the strength of the base

coat. The comparative example 1 examines the use of a white inkjet printed on the layer that does not correspond to the base coat.

The term "crusted leather" or "crust leather" describes a leather that has been tanned and crusted, but not finished, para. [0016]. The manufacturing of natural leather articles is well known and is generally split up into five phases, para. [0002]: preparation, tanning, crusting, finishing and manufacturing of the leather article. According to claim 1, the base coat is applied on a crusted leather, which is achieved after the third step. The crusted leather has therefore generally undergone the following phases: During the preparation (1st phase), the skin was removed from the animal and pre-treated for the tanning (pre-treatment can involve processes such as unhairing). During the tanning (2nd phase), the protein of the rawhide or skin was converted into a stable material that will not putrefy; chrome is most frequently used as a tanning agent. The following crusting phase (3rd phase) often includes processes such as stripping, fat liquoring, dyeing, whitening, physical softening, and buffing.

2.

At the centre of the dispute is the interpretation of feature 1.1.1

> [the base coat (44)] containing a pigment for providing an achromatic colour different from black;

This feature defines the base coat as containing a pigment for providing an achromatic colour different from black.

a)

As a starting point it has to be interpreted whether the term “achromatic” refers to the pigment or the base coat as a whole, in other words, if it is sufficient that the base coat *contains* an achromatic pigment different from black or if it does require the base coat as a whole to have an achromatic colour different from black. The Court construes this feature in the sense of the latter meaning and the parties have finally agreed with this interpretation. The Patent explains in para. [0021] that a chromatic colour is any colour in which one particular wavelength or hue predominates. For example, blue and green are chromatic colours, while white, grey, and black are achromatic colours, as they have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours. Preferably a white pigment is used (see par. [0025]), such as titanium dioxide, zinc oxide, calcium carbonate (par. [0051]). According to para. [0025] a white basecoat not only masks colour inconsistencies and some surface defects in the surface of the crusted leather, but also increases the colour gamut. The colour gamut represents the number of different colours that can be produced with a certain inkjet ink set. An enlarged colour gamut enhances the luxury effect of leather as photographic image quality can be obtained, and also has economic benefits in that less complex inkjet printers can be used that are printing with an inkjet ink set containing fewer inkjet inks. Both parties interpret the feature correctly in a way that it requires that the final base coat colour is achromatic and different from black. Both parties rightfully acknowledge that the word “achromatic” refers to the result of the added pigment(s), which is to provide an achromatic colour to the base coat as a whole. Therefore, the basecoat as a whole has to have an achromatic colour.

This is supported by the meaning of claim 1 as a whole, including feature 1.5.1 of the patent in suit:

> “the achromatic colour different from black of the base coat”

As the features of a claim have to be read in combination and must always be interpreted in the light of the claims as a whole, feature 1.5.1 confirms the understanding that the base coat as a whole must have an achromatic colour different from black.

This is further supported by the fact, that during the granting proceedings, the Claimant deleted "chromatic colour" from the wording of original claim 1, and in particular in the part corresponding to feature 1.5.1:

Claim 1. A manufacturing method for decorating natural leather with a decorative image including the steps of:
– applying on a crusted leather (45) a base coat (44) containing a pigment for providing ~~a chromatic colour or~~ an achromatic colour different from black;
– inkjet printing a colour image (43) on the base coat (44) using one or more pigmented UV curable inkjet inks;
– optionally applying a protective top coat (42) on the image (43); and
– optionally applying a heat pressing or embossing step;
wherein ~~the chromatic colour or~~ the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image.

Figure 1: Excerpt from Claimant's submission of amended claims dated 24 September 2019, filed as Exhibit HL 15.

b)

Secondly, the term "achromatic" has to be defined. The Court construes the feature "achromatic" according to the definition given in the description in para. [0021] of the patent based on the principle that a patent may be used as its "own lexicon" (for instance, UPC_CFI_14/2023, 16.07. 2024, CD Munich, Regeneron v Amgen).

aa)

Para [0021] of the patent gives a definition of what it considers an achromatic base coat:

> [0021] A chromatic colour is any colour in which one particular wavelength or hue predominates. For example, blue and green are chromatic colours, while white, grey, and black are achromatic colours, as they have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours. [*Emphasis added by the Court]*

Hence, the patent defines achromatic colours as colours that have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours. Achromatic and chromatic colours are mutually exclusive as chromatic colours have a dominant hue, i.e. were one particular wavelength predominates. Black, though being considered achromatic, is explicitly excluded in the wording of the feature.

bb)

With regard to the dispute between the parties over the term "approximately" in the text section cited above, the Court finds that para. [0021] teaches that a colour was achromatic within the meaning of the patent if it had a more or less flat spectral response in the visible range. The teaching that all wavelengths being present in "approximately" equal amounts gives the user a tolerance related to the limited perception of the human eye to detect colour nuances, which is mentioned in para [0027]. Thus, a colour can be achromatic within the scope of the patent if the spectral response was not perfectly flat, but if the deviations from the perfectly flat spectrum were such that the difference between the colour in question and the reference achromatic colour – white or grey – with a perfectly flat spectrum line was not perceptible to the average observer.

cc)

The patent, however, does not link the tolerance given by the wording “approximately” to ΔE94 measurements.

The discussion of the ΔE94-measurement in the patent description relates to colour differences in general, and with regard to colour differences between the surface of the leather and the inkjet printed colour. Thus, the ΔE94 measurement is not part of the teaching of the patent regarding the definition of the term “achromatic”.

The ΔE94 measurement is discussed in the patent in para. [0027] and [0028]:

> [0027] ΔE94 is a metric for understanding how the human eye perceives colour differences. For a ΔE94 ≤ 1,0, no colour difference is perceptible by human eyes. For the present invention, two colours are considered to be similar if the ΔE94 is smaller than 10.0, preferably smaller than 5.0 and most preferably smaller than 2.0.
>
> [0028] The calculation of ΔE94 is well known to the skilled person and is, for example discussed in handbooks like Colour Engineering. Edited by GREEN, Phil, et al. John Wiley and Sons LTD, 2002. ISBN 0471486884. and BERNS, Roy S., Principles of Color Technology. 3rd edition. John Wiley and Sons LTD, 2000.

Para. [0027] defining ΔE94 value is to be understood in context with para. [0026]:

> [0026] Another advantage of including a white pigment in the basecoat is obtained in combination with a dyed crusted leather. The thickness of the white basecoat is generally less than 50 µm or even less than 30 or 20 µm and not viewable by the naked eye from the side of the inkjet printed leather as in Figure 2. If the crusted leather was dyed to have a certain background colour for the decorative image, then this background colour is no longer viewable as the white base coat is on top of the crusted leather. However, this can be easily restored by inkjet printing a similar colour as background colour on the white basecoat where necessary. Therefore, in a preferred embodiment of the manufacturing method, the surface of the crusted leather and a part of the colour image have a similar colour. A similar colour means that if the dyed crusted leather has a surface with, for example, a black, brown, red, green or blue colour that a part of the inkjet printed colour image also has a colour selected of respectively a black, brown, red, green and blue colour. In a preferred embodiment, the colour difference between the surface of the dyed crusted leather and the corresponding part in the inkjet printed colour image is minimized using ΔE94as metric. [*Emphasis added by the Court*]

The Court sees this matter indeed not being related to the definition of “achromatic” given in [0021]. ΔE94 is introduced when it is sought to restore the colour of the dyed crusted leather by inkjet printing a similar colour as background colour on the white basecoat where necessary. It is explained that in this embodiment, the colour difference between the surface of the dyed crusted leather and the corresponding part in the inkjet printed colour image is minimized using ΔE94 as metric. It is the reason why, in the following paragraph ΔE94 is defined, with the criteria applied for the notion of “similar”. In addition, the Court remarks that the difference between two colours and the borderline between achromatic and chromatic are completely different notions. Indeed, grey is a colour different from white, whereas both are achromatic. Therefore, there is no reason to deviate from the definition of “achromatic” given at para [0021] being colours that “have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours.” White is a typical example.

c)

According to this interpretation an *ivory* base coat is not within the scope of the patent. It is key to address this question within the claim construction as it is important for any assessment of the scope of the patent by the skilled person, in particular, where the patented method begins and where it ends.

aa)

Feature 1.1.1 refers to achromatic colours and not to a white colour, which is an important difference. Despite the fact, that the patent sees white, grey, and black as achromatic colours, it is clear to the person skilled in the art that not all white or grey tones fulfil the patent's definition of achromatic, which requires to "have no dominant hue, meaning that all wavelengths are present in approximately equal amounts within those colours" (para [0021]). This makes clear that not all whitish colours are within the scope of granted claim 1. Contrary to the Claimant's position, nothing hints in the patent description in the direction of the Hunter handbook and its broad interpretation of "white". The Claimant asserted based on Hunter that a white colour would be generally recognized when almost all wavelengths show 50% or more reflection, in approximately equal amounts, across the wavelengths of the visible spectrum. It claimed that this was common general knowledge of the skilled person, as e.g. explained in the colour handbook "The measurement of appearance" by R.S. Hunter from 1975 ("Hunter"; Exhibit VB37, p. 155):

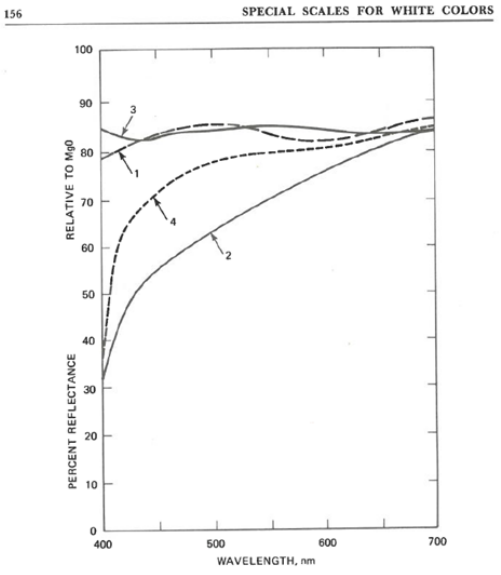
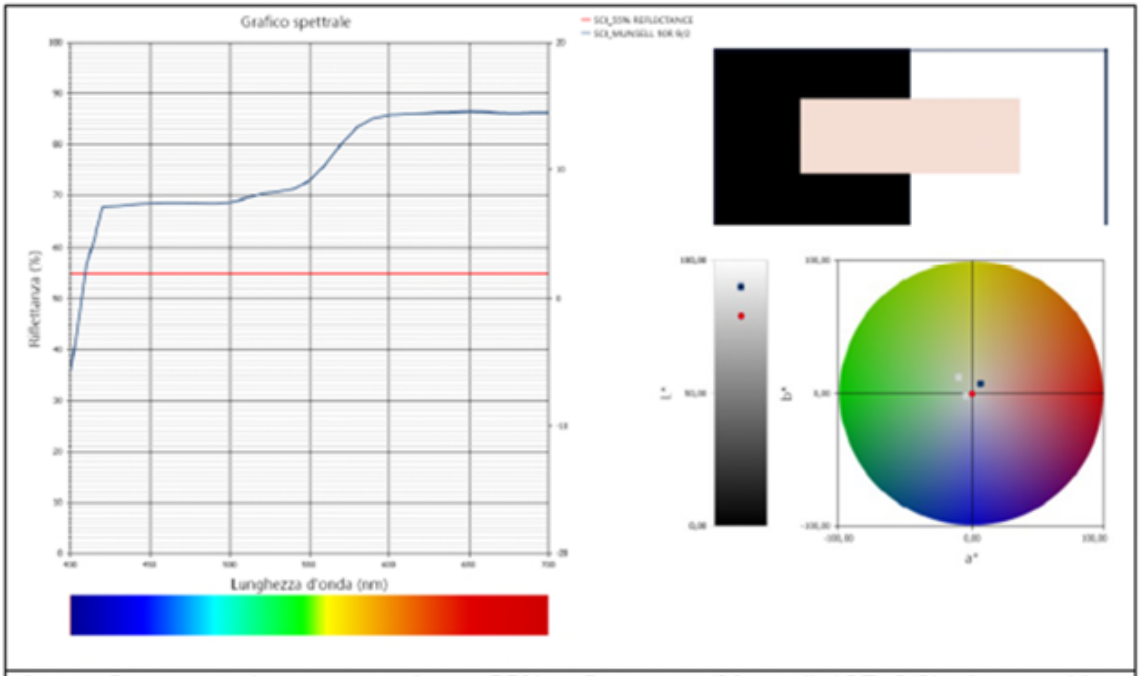


Figure 10.1. Spectrophotometric curves for four white surfaces: (1) cotton broadcloth; (2) newsprint paper; (3) porcelain enamel; (4) interior paint.

According to the Claimant there were many shades of white and grey as shown by the Hunter handbook. However, he definition in para. [0021] in fact rules out the Claimant's assertation based on Hunter, that a white colour would be generally recognized when almost all wavelengths showed 50% or more reflection. The starting point of the patent is a different one, in fact, as it discloses, as stated above, that the wavelengths have to be in "approximately equal amounts, across the wavelengths" of the visible spectrum. That means, a 50% threshold is not a relevant criterion. Still, the teaching of all wavelengths being present in "approximately" equal amounts gives the user a tolerance related to the limited perception of the human eye to detect colour nuances, which is mentioned in para [0027], cited above. The Defendants have additionally shown (comp. Rejoinder to the Reply to the Statement of Defense, p. 36) that a colour that reflects more than 50 % throughout the visible spectrum is not necessarily white:



A non-flat spectral response above 55% reflectance (Munsell 10R 9/2), the resulting colour on white and black contrast and its positioning in the CIELab diagram (see blue dot).

bb)

While it is true that [0029] describes an embodiment with achromatic *and* chromatic pigments in the base coat to provide an off-white or pale clay colour, this can no longer be considered being part of the scope of granted claim 1. Para. [0029] reads as follows:

> [0029] In a third aspect of the invention, the base coat (44) contains both a pigment for providing a chromatic colour and a pigment for providing an achromatic colour different from black. For example, one could compose a base coat containing a white pigment and one or more colour pigments to provide e.g. an off-white or a pale clay colour necessary in the decorative image. In doing so, a combination of the advantages of the first and second aspects of the invention is obtained to a certain degree, such as an improved flexibility and an enlarged colour gamut. [*Emphasis added by the Court*]

As the Defendants – and without the necessity of taking the prosecution history in all aspects into account – undisputedly stated that the Claimant deleted the term "chromatic colour" from claim 1 in order to distinguish it from US 2010/233441A1. As a consequence, the embodiment described in para. [0029] has fallen out of the granted claim 1, because it would have led to a chromatic colour in the sense of the patent. The same applies for example 3, which is clearly no longer a part of the invention as the base coat would be "pale yellow" and therefore cannot be achromatic, either. The unchanged remainder of para. [0029] apparently is a mistake like the similar one in claim 10. The inconsistency is also evident in other parts of the description. There are several passages mentioning "chromatic" in the specification of the patent that should have been deleted: page 3, line 56 in the first definition of the invention and page 6 lines 17 and 45. It is immediately apparent that the specification is not consistent with the granted claims. Comparing the clear wording of claim 1 and the description there is no basis for the skilled person to assume that ivory could be covered by the claim. This is because he or she clearly understands the teaching that the colour of the base coat cannot reach the point of having a dominant hue, like ivory, because then not all wavelengths would be present in approximately equal amounts. Chromatic and achromatic colours are mutually exclusive, and a colour only similar to achromatic is not achromatic. However,

regardless of para [0029] being outside the scope of the patent, even when considered otherwise para. [0029] could not (and does not) override the clear definition given in para. [0021] due to the necessity of legal certainty.

cc)

The Claimant's further argument that ivory would best transport the luxury look and feel of a leather product, is not supported by the description of the patent. The Claimant referred to para. [0003] which stated that leather was perceived as a luxury good. It is of the opinion that for this luxury look and feel, often 'warmer' shades of white were desirable. However, the latter is not supported by the patent. In fact, the patent in suit does not offer anything on the asserted luxury feel of an ivory coloured leather instead of a "cold" white leather. The purpose of the patent is to mask colour inconsistencies and surface defects in the surface of the crusted leather, and to increase the colour spectrum as taught in para. [0025] of the patent. According to para. [0013] it was "surprisingly" found that an inkjet printed leather exhibiting excellent flexibility, colour consistency and image quality could be obtained by using an achromatic colour different from black in a base coat (44) on a crusted leather (45). However, nothing in the description teaches something about warm or cold colours.

Serving the aim of decorated leather having high image quality and colour consistency, while not sacrificing inkjet printing reliability or physical properties like flexibility [0011], the person skilled in the art understands that the desired colour spectrum of the decorative image is the largest if the base coat is plain achromatic white as this provides for the largest colour range or scale (gamut) possible without using too much ink. The skilled person is led to this understanding by taking para. [0007] into consideration which refers to the known standards that in order to enhance colour brilliancy, often a white background is used. The patent discussed as one option to use white leather [0008]. But the patent wanted to offer an alternative to dyed white leather. It also wanted to offer an alternative to using white inkjet inks for providing a white background [0010]. The presented and claimed alternative is an achromatic base coat – at best in the achromatic white spectrum – and an achromatic grey base coat, even though that might be a less advantageous choice for the colour gamut.

This understanding by the person skilled in the art is confirmed by para. [0026] which deals with a preferred embodiment where the leather and the image have a similar colour, separated by a thin white base coat.

3.

Features 1.2 and 1.2.1

> inkjet printing a colour image (43) on the base coat (44)
>
> using one or more pigmented UV curable inkjet inks;

require the colour image being printed directly on the base coat using UV curable inks.

a)

The patent teaches in para [0041] that the colour image may comprise one or more colours:

> [0041] The decorative image may consist of a single colour or it may include multiple colours such as black, white, cyan, magenta, yellow, red, orange, violet, blue, green and brown.

On the one hand, this does not foresee an intermediate layer between the base coat and the colour image as this could prevent the base coat from participating into the creation of the coloured image according to features 1.5 – 1.5.3 (see below). It is convincing that the pigmented base coat

masking all defects allows that the image can be printed immediately on the base coat, thereby avoiding a disadvantageous inkjet printed underlayer. Para [0160] teaches that there is a trade-off between image quality and flexibility (comp. also para. [0138]) and an additional intermediate layer has disadvantages in terms of flexibility. On the other hand, the description shows that the coloured image itself can consist of multiple layers, thus including a white base layer within the colour image as the known printing technology using one or more print heads, para [0084], or a multi-pass printing mode is that the UV curable inkjet ink is cured in consecutive passes, para. [0090]. In this respect an intermediate white ink layer could be present as it could be defined being a part of the colour image forming the decorative image (together with the base coat) – and the colour image thus still being printed "on" the base coat. A distinction between the "white intermediate ink layer" and the "printed colour image" is not demanded, as both are applied consecutively in the same manufacturing step of applying the colour image. The "surprising" findings of the inventor cited in para [0013] refer to the fact that it is possible to use inkjet printing and to combine it with an achromatic colour different from black in a base coat (44), but not the dropping of any multiple-layer printing or the absence of a white ink layer. Improved flexibility is not claimed by itself.

b)

The one or more used inkjet ink(s) must be UV curable inks. The Patent explains in par. [0073] and [0074] that such inkjet inks contain polymerizable compounds (monomers or oligomers) as well as one or more photo initiators, which allow UV curing. Furthermore, the inks may contain a co-initiator and additives (par. [0080] and [0082]). This feature is clear.

4.

Features 1.3 and 1.4 are both optional features and regard further manufacturing steps of applying a top coat on the image (feature 1.3) and applying a heat pressing or embossing step (feature 1.4). The features are clear and undisputed.

5.

Features 1.5 – 1.5.3

1.5.1 the achromatic colour different from black of the base coat

1.5.2 and the inkjet printed colour image

1.5.3 are used in combination to provide the decorative image

teach that the colour of the base coat and the inkjet printed colour image are used in combination to provide the decorative image. The Patent defines that the word "combining" is to be understood as that the colours in the decorative image are the result of the colours of the colour image and the colour of the base coat (par. [0013]). This allows for two ways of colour combination: One option is that the colour of the base coat itself can be visible in the decorative image as part of the image. The other option is that the colour of the base coat influences the perceived colour of the printed colour image, and enhances the colour gamut of the decorative image (par. [0025]).

VI.

Claim 10 protects a decorated natural leather obtained by way of the manufacturing method of claim 1. It claims a decorated natural leather which is characterized by the same features, formulated as device or product features, with the presence of a protective top coat that is mandatory. Hence, the features of claim 10 are to be interpreted in the same way as the features of claim 1. The parties share this opinion. Nevertheless, the Court remarks that claim 10 does not specify that the pigmented UV curable inkjet printed colour image (43) is inkjet printed on the base coat.

VII.

Claim 15, of which an infringement is not asserted by the Claimant, constitutes an independent use-claim that regards the *use* of an achromatic colour different from black in a base coat on a crusted leather (feature 15.0). Reference can be made to the interpretation set out above as neither party has discussed the interpretation of claim 15 in detail. In particular, the Defendants consider that claim 15 has essentially the same features as claim 1 and that the features of claim 15 correspond to features 1.1/1.1.1, 1.2/1.2.1 and feature group 1.5.

It has to be noted, though, that claim 15 differs from 1 and 10 as the word "pigment" is not used, which, again, leads to the interpretation that the base coat as a whole must have an achromatic colour, because it reads as follows: "use of an achromatic colour different from black in a base coat". According to feature 15.1, the achromatic colour in the base coat is used in combination with an inkjet printed colour image on the base coat for providing a decorative image to a natural leather. When compared to claims 1 and 10, claim feature 15.1 is furthermore missing the features "UV curable" and "pigmented", thus, any type of inkjet ink could fulfil feature 15.1.

As a reaction to the counterclaim the Claimant requested as an auxiliary request to delete claim 15 as a whole (exhibit VB-R04A).

C. Counterclaim for Revocation

In light of the construction of the features of the granted claims 1, 10 and 15 as established above, in particular of feature 1.1.1. (above sect. B. IV. 2.), none of the written pieces of prior art are novelty destroying (following under sect. C. I., II. and III.). To the extend the Defendants attacked the presence of an inventive step in their written submissions, granted claims 1 and 10 also prove to be inventive (following under sect. C. IV.).

Regardless of the disputed availability of the Flora products on the market before the priority date, and the detectability of their features, the Flora products are neither novelty destroying (following under sect. C. V.) nor cast doubts over the presence of an inventive step (following under sect. C. VI.).

I. Novelty of claim 1 over written prior art

1. General

In order to be considered part of the state of the art (Art. 54 (1) EPC), an invention must be found clearly integrally, directly and unambiguously in one single piece of prior art and in its existing form, it must be identical in its constitutive elements, in the same form, with the same arrangement and the same features (LD Munich, 31.07.2024 – UPC_CFI_233/2023, ACT_547520/2023, p. 21). For lack of novelty to be found, each and every feature of the claimed subject-matter must be derivable directly and unambiguously from one single prior art document. This question must be answered from the vantage point of the notional skilled person, taking into account this person´s common general knowledge at the publication date of the cited document in the case of prior art cited under Art. 54(2) EPC(LD Düsseldorf, 28.01.2025 – UPC_CFI_335/2023, ACT_578607/2023, p. 46).

For the purposes of assessing novelty it is not relevant which problem is solved by a prior art document as long as the problem is not a feature of the claim or construed as such. Relevant is a feature-by-feature comparison of a claim with the teaching of a document of the prior art showing that all features are disclosed in combination by said prior art document. The decisive point is whether a prior art document discloses a composition that contains all the ingredients required for falling within the ambit of the claim. If such composition is described, for example, in an

individualized form in an example of a prior art document, this is sufficient to deny novelty (LD Düsseldorf, 28.01.2025 – UPC_CFI_335/2023, ACT_578607/2023, p. 46; CD Munich, 17.10.2024 – UPC_CFI_252/2023, ACT_551180/2023, p. 33). Nevertheless, in assessing novelty, it is not possible to combine different passages or embodiments of a document, except if the corresponding combination is derivable directly and unambiguously by the skilled person reading this document.

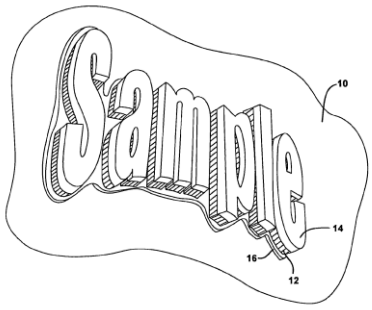
2. Lack of novelty of claim 1 based on Document HLAR 7 (US 7,891,799 B2)

Based on these requirements the Defendants' attack on the novelty of the patent in suit based on the US-patent US 7,891,799 B2 (HLAR7), published on 22 February 2011, remains unsuccessful.

a)

HLAR7 regards a multi-phase system for ink jet printing a metallic effect onto a substrate having any of a rough of uneven surface. Feature 1.0 - *A manufacturing method for decorating natural leather with a decorative image including the steps of* - can be generally seen as disclosed in the section cited by the Defendants (col. 4, lines 8 to 14) which teaches "leather" as one of many possible substrates (comp. also claim 13 of HLAR 7). This could mean artificial or natural leather. But as leather is cited as an example of rough, coarse or uneven surfaces, the natural reading of the skilled person of the term "leather" in this context would be leather in the sense of natural leather. Crusting a leather is an essential step before the application of a base coat onto leather and the skilled person therefore understands that the described processing must be applied to crusted leather (comp. HLAR 5, p. 5). The Court therefore concludes that for the skilled person reading HLAR7, "leather" implicitly means „crusted natural leather".

The document furthermore teaches the use of an undercoat layer that can optionally be printed on the substrate prior to applying the first ink jet ink in col. 1 lines 57ff. and shown in figure 2 of HLAR7, wherein first an undercoat layer (16) then a reflective coating layer (12) and then a protective coating layer (14) are applied to the substrate (10)



b)

The document discloses that "in various embodiments" the said undercoat layer may be substantially colourless, in other substantially opaque or comprise a pigment or dye (col. 1, lines 62 ff.). Finally, it discloses in order to enhance embodiments printing to a substrate having a dark colour it may be advantageous in some embodiments to provide an undercoat having a white or other light pigment (col. 1, lines 67 ff.). Also col. 4 refers to the undercoat, which is taught to be substantially colourless or may include one or more colorant, such as dyes, pigments, and mixtures thereof (col. 4, lines 50 ff.; see also. claim 11 and 12 of HLAR 7). The document discloses to increase the metallic effect by making the undercoat white such that transmitted light is scattered back through the metallic coating. This white undercoat might be obtained by titanium dioxide (col. 4, lines 60 ff.). Thus, the document shows the use of a white undercoat as one option (out of many).

Nevertheless, col. 4 lines 55-65 is advantageous for a dark coloured substrate. The Court shares the view of the Defendants that this teaching is not disclosed directly and unambiguously for the specific case of leather that has not as a general feature a particularly dark colour.

Moreover, the Defendants referred to col. 4 lines 37-39 teaching that "In various embodiments, the layer may be jetted onto the substrate as an inkjet formulation using a standard inkjet printing head." The Court considers that an inkjet printed layer does not correspond to a base coat according to the patent. Even though, col. 4 lines 31-33 specify that the undercoat composition may be deposited as a layer on a substrate by any suitable method that can apply a continuous layer, there is no clear and unambiguously teaching that the embodiment of col. 4 lines 60-65 applies i) to a natural leather and ii) to an undercoat which is not an inkjet printed layer. In fact the passage in col. 4 lines 60-65

> "The metallic effect may be increased in this regard by making the undercoat white such that transmitted light is scattered back through the metallic coating. This white undercoat may be obtained, for example, by using titanium dioxide dispersed with a suitable dispersion in a UV Matrix."

is the only one mentioning a white colour for the undercoat and is neither connected to a natural leather nor to an undercoat which is not an inkjet printed layer. In addition, as the Claimant rightfully pointed out, adding a small amount of any chromatic pigment or mixtures of pigments to an achromatic pigment might be crossing the boundaries of an achromatic base coat as defined in the patent. Without any further indication the skilled person has no reason to evaluate whether this composition in HLAR 7 would lead to an achromatic ("white") base coat, excluding chromatic whitish tones, and certainly would not lead to achromatic grey tones. The document does not disclose anything about the range of whites, the differentiation between chromatic and achromatic (white-)colours and their boundaries in terms of wavelengths.

It has to be born in mind that the use of a white background or material in general was already cited by the patent as being state of the art in order to enhance colour brilliancy, one option being to use white leather, para [0007] and 0008]. Against this background, the patent in suit wanted to offer an alternative to dyed white leather or to using white inkjet inks for providing a white background [0010]. Therefore, it remains doubtful whether the patented solution using an achromatic base coat (excluding black) is clearly and unambiguously disclosed in the cited sections of HLAR 7. In the end, the person skilled in the art would need the patent in suit and its description to come to the patented teaching and the presented idea to use an achromatic base coat, where all wavelengths are reflected in approximately equal amounts, within the vast range of achromatic and chromatic white colours in order to apply a base coat containing a pigment for providing an achromatic colour (different from black) onto leather.

c)

According to HLAR 7, the reflective coating layer is provided by powders and/or nanoparticles of a metallic material (cf.HLAR 7, col. 5, lines 25 to 33). Such a reflective coating layer, which is formed when the metallic material is deposited on a substrate, is a metal layer/metalliclayer. However, the skilled person is well aware that metallic materials can have a colour and thus would enable a colour image in the meaning of the patent in suit.

Additionally, UV curable ink is disclosed for the undercoat and one of the link layers like feature 1.2.1 - *using one or more pigmented UV curable inkjet ink*. A UV curable first inkjet ink is used to print the colour image colour image ("smooth reflective coating layer"), col. 7, lines 50 to 58 of HLAR 7. However, this disclosure is one that must be selected from a list of possible curing methods and is not the preferred curing method, as depending on the substrate thermal curing would be preferred.

d)

As a result, this document cannot be considered to contain a clear and unambiguous disclosure of all features of claim 1 in combination (and neither of claims 10 or 15), as regarding the other

features, the person skilled in the art still would have to make several selections to arrive at the subject matter of claim 1 of the patent in suit. HLAR 7 does not disclose a composition that contains all the ingredients required for falling within the ambit of the claim, neither as a preferred embodiment nor in an individualized form in an example.

3. Lack of novelty based on document HLAR 8 (JP 2010-185054 A 2010.8.26)

Claim 1 of the patent in suit is novel with regard to document HLAR 8, which is a Japanese patent application, published on 26 August 2010 (publication number 2010-185054A; translation available in HLAR8a). Despite addressing a whitish base coat, it does not disclose an achromatic base coat in the meaning of feature 1.1.1.

a)

HLAR 8 relates to printed leather objects according to feature 1.0 of claim 1 of the patent in suit. It describes as the problem that the known printed leather object has a configuration in which at least three layers of a base coat layer, an ink accommodating layer, and a top coat layer are provided on a leather surface which leads to the problem that the manufacturing process becomes complex and flexibility is insufficient due to an increase in the thickness of the entire laminate [0004]. It proposes as solution a base coat layer comprising leather and a cationic fatty acid condensate and a binder resin formed on the leather's surface and a top coat layer formed on the base coat layer such that an image based on ultraviolet curable ink is formed without providing an ink receiving layer on the base coat layer, para. [0005].

HLAR 8 discloses in para. [0007] the processing steps of leather and in particular re-tanning, dyeing and greasing of leather, which clearly includes crusted leather. HLAR 8 states that the tanning process irreversibly changes "skin" to "leather", hence, a natural leather must have at least undergone the tanning process.

b)

Against the background that feature 1.1.1. of claim 1 of the patent in suit requires that the final base coat colour is achromatic the document HLAR 8 is not novelty destroying. The fact that the document discloses a base coat composition containing a white pigment in the example in paragraph [0031], only leads the skilled person to the conclusion that the base coat *contains* an achromatic pigment:

> "[0031] (2) As shown in Table 2 in the preparation of the base coat layer forming composition,
>
> • a total of 877 parts of pigment (Clariant product Neosan 2000 White: 92.32 parts, Neosan 2000 Black: 0.82 parts, Neosan 2000 Yellow 01: 6.58 parts, Neosan 2000 Bordeaux: 0.25 parts, Neosan 2000 Blue: 0.03 parts) […]"

As the document does not make any statements on the overall colour of the base coat, the person skilled in the art does not draw the conclusion to the base coat resulting in an achromatic colour. On the contrary, the passage in para [0031] shows a yellow portion with 6,58 parts, resulting in a chromatic colour, thus feature 1.1.1 is not disclosed in HLAR8a and so is not features 1.5.1. to 1.5.3.

c)

Nothing else can be drawn from the coloured piece of leather presented by the Defendants first time in the oral hearing with the – contested – assertion that it was made in accordance with the passage in para [0031] of HLAR 8. The introduction of this physical evidence after the closure of the written procedure and the closure of the interim procedure only in the oral hearing, which was objected by the Claimant, was undoubtedly late filed and missed the necessary permission by the

Court according to R. 36 RoP. As the judge-rapporteur had explained to the parties in the interim conference the procedure to present physical evidence in the oral hearing demands that it is filed in advance and needs the observance of a special workflow in the CMS asking for permission (see ORD_64525/2024 in App 64523/2024, dated 20.12.2024). Whereas the Defendants put this procedure into practice with regard to pieces of the attacked embodiments and the Flora bags, they did nothing alike regarding said piece of leather. Hence, the panel dismissed the introduction of this evidence in the oral hearing.

4. Lack of novelty based on HLAR 9 (US 7,520,601 B2)

Claim 1 remains novel with regard to the US patent US 7,520,601 B2, that was granted on 21 April 2009.

a)

HLAR9 regards a printing process for ink-jet printing a radiation curable image on a substrate. It aims at a printing process wherein the resolution of an image can be accurately controlled on a wide variety of ink-receivers and whereby the image exhibits a high glossiness [col. 3, lines 6 ff].

Leather is disclosed as one of many possible substrates [col. 5 lines 47-52]. However, this can mean artificial or natural leather. Contrary to HLAR7, there is no mentioning of a rough or coarse surface. Thus, natural leather is not unambiguously and clearly disclosed, and the skilled person has no reason (and no incentive) to consider treatment procedures typically applied to leather being meant by HLAR 9, hence would not consider crusted leather being part of its teaching.

b)

HLAR 9 discloses in col. 7, lines 52 to 54, a "radiation-curable liquid layer [that] may further contain a colorant or a white pigment such as titanium oxide, although preferably the layer is a clear liquid layer" (see also claim 7: "*The printing process according to claim 1, wherein said radiation curable liquid layer is a white liquid layer*"; whereas claim 6 discloses a clear liquid layer). Apart from the fact, that a liquid layer cannot be seen as a base coat, HLAR 9 does not disclose feature 1.2 – *inkjet printing a colour image (43) on the base coat (44).* This isbecause the ink jet ink is not jetted onto but instead *into* the radiation curable liquid layer in step b) of the printing process of HLAR9 (see claim 1 "b) jetting a first radiation curable ink-jet ink droplet into said radiation curable liquid layer"). The next step c) consists in "curing said radiation curable liquid layer containing said radiation curable ink-jet ink droplet. This argument is further underlined by figures 1b and 1c of HLAR 9:

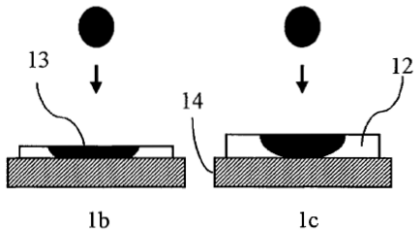


Figure 6: Figures 1b and 1c of HLAR9.

Claim 1 of HLAR 9 as well as the figures 1b and 1c describe and show that the ink is jetted into the liquid layer, therefore there is no step corresponding "inkjet printing a colour image on the base coat" (feature 1.2 of the patent). In addition, that means that the base coat and the ink printing do not in combination form the decorative image in the meaning of features 1.5.1 – 1.5.3 as the base coat and ink are no longer separate layers, but a single layer.

II. NOVELTY OF CLAIM 10 OVER WRITTEN PRIOR ART

Claim 10 of the patent in suit is a product claim comprising similar features as claim 1. Additionally, to the features of claim 1, the decorated natural leather of claim 10 requires a protective top coat as a mandatory feature. This means, the validity of claim 10 has to be evaluated in the same way as novelty of claim 1. Claim 10 is novel for the same reasons as claim 1. In order to avoid repetition reference can be made to the discussion of novelty regarding claim 1 stated above.

While the Defendants initially argued that with the Patentee's assumed broad claim construction, HLAR 9 disclosed all features of claim 1 and therefore would also disclose features 10.0 to 10.3 and 10.5 to 10.5.3 of claim 10, the Court does not follow this broad claim construction (see above under sect. B. IV. 2.), and the Claimant has clarified that it did not either. Therefore, HLAR 9 is not novelty destroying,

III. NOVELTY OF CLAIM 15

Regarding claim 15, the Defendants did not submit a specific reasoning and referred to their attacks of claims 1 and 10. The subject matter of claim 15 is novel over HLAR7, HLAR8 and HLAR9 for the same reasons and laid out regarding claim 1.

Claim 15 differs from the other independent claims 1 and 10 in that the word "pigment" is not used. Since the word "pigment" is missing in claim 15, it is clear that the term "achromatic" refers to the colour of the base coat as a whole. Furthermore, claim 15 does not require that the inkjet ink for printing the colour image is UV-curable and pigmented. Despite these missing features none of the documents disclose the combination of the achromatic base coat with the ink – even though not necessarily being UV-curable – in the formation of the decorative image. Reference can be made to the discussion regarding claim 1 above to avoid repetition.

IV. INVENTIVE STEP

According to Article 56 EPC, an invention is considered to involve an inventive step if it is not obvious to a person skilled in the art from the prior art. A possible starting point in prior art is realistic if its teaching would have been of interest to a skilled person who, at the priority date of the patent at issue, was seeking to develop a similar product or method to that disclosed in the prior art which thus has a similar underlying problem as the claimed invention (CD Munich, 17.10.2024 – UPC_CFI_252/2023, ACT_551180/2023). The assessment of the inventive step requires comparing the claimed subject-matter as interpreted with the prior art, whether it would have been obvious to a person skilled in the art, starting from a disclosure in the prior art that is considered to be a realistic starting point, to arrive at the claimed solution in view of the underlying problem (comp. LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024; LD Paris, 04.07.2024 – UPC_CFI_230/2023, ACT_546446/2023; CD Paris, 21.01.2025 - UPC_CFI 311/2023, ACT 571745/2023; CD Munich, 17.10.2024 – UPC_CFI_252/2023 , ACT_551180/2023). If it was not obvious to arrive at this solution, the claimed subject-matter fulfils the requirements of Article 56 EPC. This is the case here.

1. Claim 1

The Defendants had not raised the issue of a lack of inventive step for the independent claim 1 in their written submission with regard to written prior art, apart from the question whether HLAR 7 or HLAR 9 disclose the use of crusted leather.

a)

Only regarding this individual question, the Defendants referred to the general knowledge of the skilled person and/or that he or she would combine two documents. They consider that the crusting of leather was typical knowledge of the person skilled in the field of printing technology specialized in the preparation and the processing of decorated leather articles and he or she could take that knowledge from other documents, like HLAR 5 (Reply to the Defence to the Counterclaim, para 50) or HLAR 7 (Reply to the Defence to the Counterclaim, para 77). This means that apart from the individual question of "crusted leather" the Defendants did not attack claim 1 based on lacking inventive step in their written submissions. Even if one were to assume that using crusted leather would not be inventive with respect to HLAR 7 and HLAR 9, the skilled person would still not come to the patented solution with these two documents. As stated above, HLAR 7 lacks a disclosure to use a white colour for an undercoat to a natural leather and where the undercoat is not an inkjet printed layer. HLAR 9 would still not disclose feature 1.2 – *inkjet printing a colour image (43) on the base coat (44),* because the ink jet ink is not jetted onto but instead *into* the radiation curable liquid layer

b)

Any further inventive step attacks based on HLAR 7, HLAR 8 and/or HLAR 9 insinuated in the oral hearing were dismissed by the Court as it contradicted with the general principle that the parties are under an obligation to set out their full case as early as possible (Preamble 'RoP', para. 7, last sentence) and Rule 25 RoP. An inventive step attack brought up in the oral hearing for the first time is late-filed.

aa)

Rule 25 RoP states that a counterclaim statement for revocation shall contain i.a. (b) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the defendant's proposed claim construction; (c) an indication of the facts relied on; (d) the evidence relied on, where available, and an indication of any further evidence which will be offered in support. This legal framework introduces the so-called 'front loaded' procedural system whereby a party is required to concretely elaborate his arguments and evidence in his first written pleading. The rationale behind these provisions is to ensure that the other party is aware of the factual elements and grounds upon which the claim against it is based, as well as the evidence available, thereby enabling the other party to prepare an adequate defence, and, at the same time, to expedite the proceedings. This is one of the primary objectives of the Court, which would be undermined if a counterclaimant were permitted to gradually introduce new factual circumstances, new legal arguments, or new evidence into the proceeding (CD Paris, 21.01.2025 - UPC_CFI 311/2023, ACT 571745/2023 para. 21).

bb)

Consequently, a counterclaimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in the oral hearing (LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024; even stricter. CD Paris, 27.11.2024 – UPC_CFI_308/2023, para 27). The formulation of a new inventive step attack in the oral hearing has to be seen as an amendment of the counterclaim pursuant to R. 263 RoP, which would require admission by the Court. This amendment has been rejected pursuant to R. 263 (2)(a), (b) RoP – or at least as late-filed in accordance with R. 9.2 RoP – as the Defendants should have raised this attack with due care in the counterclaim rejoinder at the latest (comp. LD Düsseldorf, 07.03.2025 – UPC_CFI_459/2023, ACT_590302/2024).

Also, taking the circumstances of the present proceeding into account, there was no reason to wait with an inventive step attack against claim 1 based on HLAR 7 or HLAR 9 until the oral hearing, which was making it impossible for the other party (and the Court) to prepare.

2. Claim 10

The Defendants brought forward an inventive step attack in their written submissions based on document HLAR 9 (US 7,520,601 B2) against claim 10. This attack remains unsuccessful.

a)

Based on the claim construction of feature 1.2 the document HLAR 9 is no suitable basis to successfully question the inventive step of claim 10. This is regardless whether a skilled person would know protective top coats, for example from HLAR 7 (cf. col. 6, lines 58 to 63 of HLAR 7) or from HLAR 8 (cf. para. [0023] of HLAR 8a) and would according to the Defendants then apply a protective top coat on top of the colour image of HLAR 9. Still, as stated above, HLAR 9 does not disclose that the colour image is to be printed onto an (achromatic) base coat. The document does not lead to a base coat and the ink printing forming *in combination* the decorative image in the meaning of features 1.5.1 – 1.5.3 as base coat and ink are no longer separate layers. In this respect reference can be made to the discussion with respect to claim 1 in the light of HLAR 9, which shows that the colour image is jetted *into* the base coat (cf. claim 1 of HLAR9), not onto.

b)

Claim 10 is inventive in light of a combination of document HLAR 9 with HLAR 7 or of document HLAR 9 with HLAR 8.

aa)

The Defendants argue that the objective technical problem of feature 10.4 – and a protective top coat (42) – was that the top coat protects the underlying colour image. They are of the opinion that the documents HLAR 7 and HLAR 8 disclosed this feature. On the search to protect the colour image of HLAR 9, the skilled person would become aware of HLAR 7 and HLAR 8 as both documents were also directed to printing a colour image on a base coat. According to the Defendants HLAR 7 disclosed that a protective coating layer should be applied. As the name suggests, this layer protected the other layers against external influences. In addition, also HLAR 8 disclosed that the top coat protects the leather product from damage (wear) in para. [0019] of HLAR 8a.

bb)

This inventive step attack remains unsuccessful. Even by applying a top coat on the last layer of HLAR 9, the skilled person does not arrive to the claimed invention. Indeed, HLAR 9 does not describe inkjet printing a colour image on a base coat (feature 1.2 of the patent), nor that a base coat and the ink printing are used in combination to form the decorative image in the meaning of features 1.5.1 – 1.5.3 as the base coat and ink are no longer separate layers, but a single layer. The skilled person has no hint to change the solution proposed by HLAR9 that implements jetting a first radiation curable ink-jet ink droplet into said radiation curable liquid layer. Indeed, even a combination with HLAR 7 or HLAR 8 would not lead the skilled person clearly and unambiguously to utilize a UV curable inks to print an image on an achromatic base coat and to combine them together to form the decorative image according to the solution of the patent in suit.

The same applies for a combination with HLAR 8 as this would not give an incentive to separate the base coat and the ink layers. Furthermore, it does not lead to the idea to use an achromatic base coat, as HLAR 8 shows in para [0031] yellow with 6,58 parts, resulting in a chromatic colour.

3. Dependant claims

As the independent claims remain novel and inventive with respect to the attacks formulated by the Defendants the same applies to the dependent claims 2 to 8 and 11 to 14.

V. NOVELTY OVER PUBLIC PRIOR USE

The independent claims 1, 10 and 15 are novel also with respect of public prior use by the Flora products. The same applies to the dependant claims 2 to 8 and 11 to 14.

1.

As a measure of defence, the Defendants have the burden of proof that the Flora products were publicly available on the market in 2017 before the priority date of the patent.

a)

The Defendants met this requirement with their submissions of an excerpt of the worldwide direct sales data (HLAR21), receipts (HLAR14), a table showing the website traffic of the website with the Flora Bag (HLAR15) and other publications such as excerpts from an editorial and from fashion magazines (HLAR16), two witness statements, one regarding the sales data (HLAR17) and one regarding the manufacturing process (HLAR19). Already this evidence provided leaves little room for doubt that the Flora products were on sale prior to the filing of the patent in suit.

b)

The additional evidence provided by the Defendants with submission 28 June 2024 regarding a purchase of a Flora Wallet (with the original sales receipt) from a second-hand store (exhibits HLAR 37 – 41), which was admitted by the Court (see above in sct. A. III.), strengthens the position of the Defendants'. Regardless of the admittance of this evidence, it has to be pointed out that it is not relevant for a public prior use defence whether the pieces of prior art consisted of bags, wallets and loafers or one of them or all of them. Therefore, the Claimant's criticism is negligible that the physical and chemical analyses were carried out on *one* specific Flora Bag and *one* specific Flora Loafer. However, as discussed in the next section this question is not relevant for the outcome of the decision.

2.

The Court is convinced that all Flora products comprise a chromatic, ivory-coloured base coat, which means that the Flora products are not showing all features of claim 1, especially not feature 1.1.1.

a)

The Court sides with the Claimant's argumentation (comp. Revocation Rejoinder, para 94) that, all presented evidence relating to the Flora products taken into account, the Defendants' test reports failed to show the presence of an achromatic base coat in the meaning of the patent. Against the background of the definition provided by the patent in para [0021] a colour is achromatic if there is no dominant hue, which means that all wavelengths are present in approximately equal amounts. Therefore, it is neither sufficient to prove that the base coat is containing a white pigment, like titanium dioxide, nor to measure a chroma C*-value.

Added to this, the Claimant's assumption is correct due to the fact that the Claimant did not contest the Defendants' assertion in the Counterclaim for revocation in para 289 ff., that the resulting colour of the base coat is ivory (para 289). The Claimant criticized that the Defendants' analyses of the prior use products would not represent a technical teaching that the skilled person could derive from the Flora products without hindsight. But, the Defendants themselves showed

that the base coat of the Flora products, e.g. like the Flora Wallet, is *ivory* (comp. Position "3" of Sample C, cf. Figure 3 of HLAR 31). As the claim does not only require adding an achromatic pigment, it is not sufficient that the base coat is containing titanium dioxide. In fact, the Defendants proved that in the base coat of the Flora Wallet titanium dioxide TiO_2 was used to provide as they themselves claim (in combination with other pigments) an ivory colour of the base coat (cf. Figure 3 of HLAR 31). As defined above, ivory is a chromatic colour and thus not within the scope of feature 1.1.1., rendering the Flora products not be novelty destroying.

b)

The same applies to the Flora Loafer. Despite the fact, that the Defendants stated that the chroma C* of the base coat of the Flora Loafers amounts to 11.45, which was smaller than the chroma C*=13.65 of the base coat of the Pikarar Padlock Bag, for which the Patentee argued an alleged infringement of the patent, the Defendants have not proven that the Flora Loafer comprises an achromatic base coat. Also in this regard, the burden of proof lies with the Defendants. The Court sides with the Claimant that it is not sufficient to fulfil the burden of proof by referring to a particular deviation from the chroma C* value to establish whether a colour that is printed on leather is achromatic in the meaning of the patent (Revocation Rejoinder, para. 12). For the definition in the patent in suit in its para. [0021] the sole measurement are the wavelength and an assessment whether they are present in approximately equal amounts, like the Defendants did with the alleged infringing objects. Therefore, it is not decisive that the skilled person most likely would not assume that a colour with a chroma C* value that high is achromatic, anyway.

c)

According to the above, the Court can leave open the highly contested question whether or not the Flora products enabled the skilled person –or a team of experts to carry out the necessary analyses – to detect the use of UV curable ink and if this information could be considered to be available to the public (by reference to Article 54(2) EPC, defining the state of the art). As the base coats of the Flora products are not achromatic it is not decisive whether the Defendants have satisfied their obligations with regard to the burden of proof as they rely on in-house knowledge regarding the inks used as this might not be public knowledge and not necessarily in the domain of an engineer specialized in the preparation and the processing of decorated leather articles. The problem circles around the point that the skilled person probably did not know which inks were used and therefore did not know what to look for. As the Flora products consist of a chromatic base coat these questions can remain unanswered.

3.

For the same reasons laid out above the Flora products are not novelty destroying with respect to claims 10 and/or the dependent claims. This also applies to claim 15, which is not even requiring UV curable inks, thus any type of inkjet ink could fulfil feature 15.1, but requires the use of an achromatic colour in a base coat. The same applies to the inventive step attacks against the dependent claims 2, 5, 6, 9 and 11 (Counterclaim for Revocation, para. 300 ff.)

VI. INVENTIVE STEP OVER PUBLIC PRIOR USE

The independent claims 1, 10 and 15 are inventive with respect of public prior use as the Defendants did not challenge the inventive step with regard to the independent claims based on the Flora products.

1.

Even though the Defendants stated in para 363 of the Counterclaim for Revocation regarding the Flora Loafers that the "independent claims and the dependent claims lack novelty or an inventive

step over the Flora Loafers because the Flora Loafers were manufactured essentially the same way", they did not elaborate an inventive step attack against the independent claims based on the Flora products, and in particular did not address the (a)chromaticity question with respect to inventive step. The Defendants stated in order to "avoid unnecessary repetition" not go into all the individual features and claims in detail, but to refer to the argumentation for the Flora Bag, which could in their view be applied 1:1 to the Flora Loafers. The argumentation for the Flora Bag, however, did not content any inventive step attack against claim 1 – apart from the question whether crusted leather was disclosed in combination with HLAR 5 (para. 272 ff.) and the use of pigmented UV curable ink (para. 286), discussed above. It neither entailed an inventive step attack against claim 10 nor claim 15 based on these products. The questions of a non-inventive use of crusted leather and/or pigmented UV curable ink are not of relevance with regard to the non-disclosure of an achromatic base coat in the Flora products.

2.

Any possible further inventive step attacks based on the Flora products insinuated in the oral hearing were dismissed by the Court as it contradicted with the general principle that the parties are under an obligation to set out their full case as early as possible (Preamble 'RoP', para. 7, last sentence) and Rule 25 RoP. An inventive step attack brought up in the oral hearing for the first time is late-filed (comp. above under sect. C. IV. 1. b])

Also with respect of the circumstances of the present proceeding, there was no reason to wait with an inventive step attack against claim 1 based on the Flora products until the oral hearing, that was making it impossible for the other party (and the Court) to prepare. Therefore, the Panel cannot consider the Defendants' oral argument that the Flora products would render it obvious to the skilled person to use a white base coat based on the teaching of document HLAR 7. It can be left unanswered why and if the skilled person would have had an incentive to solve a (which?) problem going from the Flora products to combine it with a white (not necessarily achromatic) undercoat from HLAR 7. It does not need further elaboration by the Court if doing so would really obviously have lead the skilled person to the solution of an achromatic ("white") base coat, excluding chromatic whitish tones, but including achromatic grey tones (comp. above under C. sect. I. 2. b).

3.

With the outcome that the independent claims are inventive, the inventive step attacks based on the Flora products with regard to the dependent claims 2, 5, 6, 9 and 11 are lacking relevance to the decision.

VII. AUXILIARY REQUESTS

As the patent is found valid the condition for the Claimant's auxiliary requests did not materialise rendering it unnecessary to discuss the auxiliary requests.

D. INFRINGEMENT

The infringement action is not successful on the merits. The Court finds that the attacked embodiments do not make use of all features of claim 1, as their base coats are not achromatic and thus not fulfilling feature 1.1.1. (following under sect. D. I). While the Pikarar Loafers' chromatic base coat is the closest to achromatic, the Claimant did not prove that the Defendants used UV curable ink for them (following under sect. D. II). Therefore, the Court does not need to answer the question whether feature 1.2 can be seen as utilized as some of the attacked embodiments comprise an intermediate white ink layer (following under sect. III.). The same

applies for the other claims the Claimant sees as infringed (following under sect. IV.). The private prior use defence is therefore not of importance to the outcome of the decision

I.

The Claimant relies on an infringement of claims 1, 3, 4, 5, 6, 7, 10, 12, 13 and 14 of the patent in suit. Infringement of the granted claims 2, 8, 9, 11 and 15 is not claimed. It considers the "Padlock Gucci animal print mini bag" (=Pikarar Padlock Bag) and the "Rhyton Sneaker with animal print" (=Pikarar Sneakers) infringing the patent. Further suspected infringement products are the "Gucci animal print zip card case" (=Pikarar Card Case), the "Gucci animal print mini tote bag" (=Pikarar Tote Bag) and the "Women's Gucci Jordaan animal print loafer" (=Pikarar loafers).

The Claimant did not prove that the attacked embodiments comprise an achromatic base coat.

1.

Whereas it is undisputed that the claimant showed the presence of titanium in the base coat of the Pikarar Bag and Sneakers and concluded that titanium dioxide, a white pigment, is present in their base coats, it is disputed that their base coats are achromatic. The Claimant cannot be supported in its argument that as these products were also marketed/offered by the Defendants as "white printed leather" and "ivory printed leather" – which in the Claimant's view is a shade of white – the wording in the Defendants' offering would establish infringement already as offering was an independent infringing act under Art. 25 UPCA. The Claimant neglects in this respect that the mentioning of "white printed leather" and "ivory printed leather" are commercial descriptions and do not correspond to a technical feature of the products (VB 32). It goes without saying, that for establishing a patent infringement the actual attacked embodiments have to be patent infringing, which is making use of the patented solution, which requires the examination of the product itself.

2.

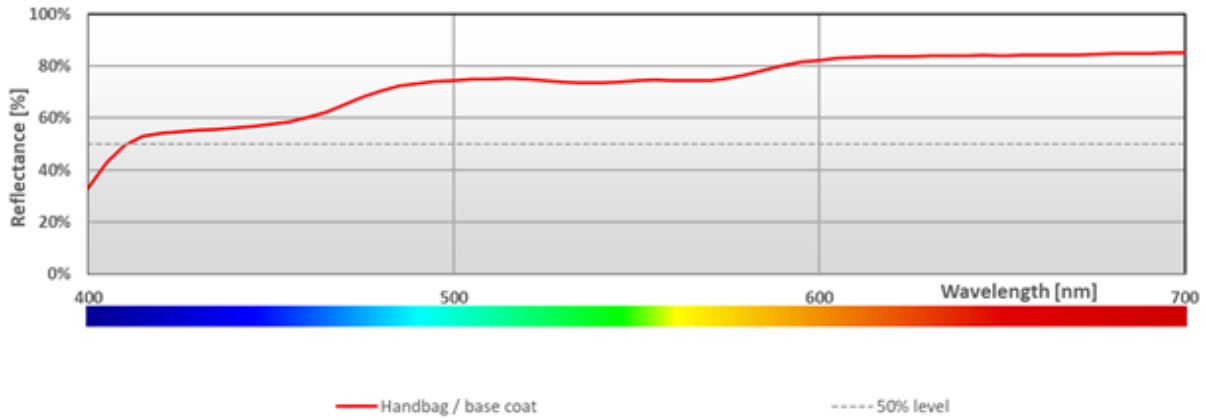
Neither the Claimant's own measurements nor the ones provided by the Defendants that the Claimant adopted prove that the attacked embodiments have an achromatic base coat.

a)

Feature 1.1.1. (in conjunction with feature 1.5.1) requires an achromatic base coat (excluding black), which demands according to the definition in para. [0021] that the colour of the base coat has no dominant colour or spectrum areas (hue), meaning that all wavelengths are present in approximately equal amounts. Contrary to the Claimant's assertion the approximal equal presence of all wavelengths cannot be decided by simply looking at the colour of the attacked embodiments. In fact, this has to be assessed by means of a spectral response. Based on the definition of the patent, a colour is achromatic if a spectral response shows approximately equal reflectance throughout the spectral response, and not, as the Claimant asserted to show an overall reflectance of above 50% throughout the spectral response (see above B. IV. 2.). Even though under real life conditions, perfectly flat spectra will rarely be observed, the teaching of approximately equal amounts gives the user a tolerance relating to the limited perception of the human eye to detect colour nuances, which is mentioned in para. [0027]. This definition is met if the colour features a perfectly flat spectrum or, if the spectrum is not perfectly flat, if the deviations from the perfectly flat spectrum are such that the difference between the colour in question and the nearest reference achromatic colour with a perfectly flat spectrum line is not perceptible to the average human observer.

b)

The Claimant, who bears the burden of proof for the infringement provided own wavelength measurements solely for the Pikarar Padlock Bag, and claims the other diagrams to be similar:



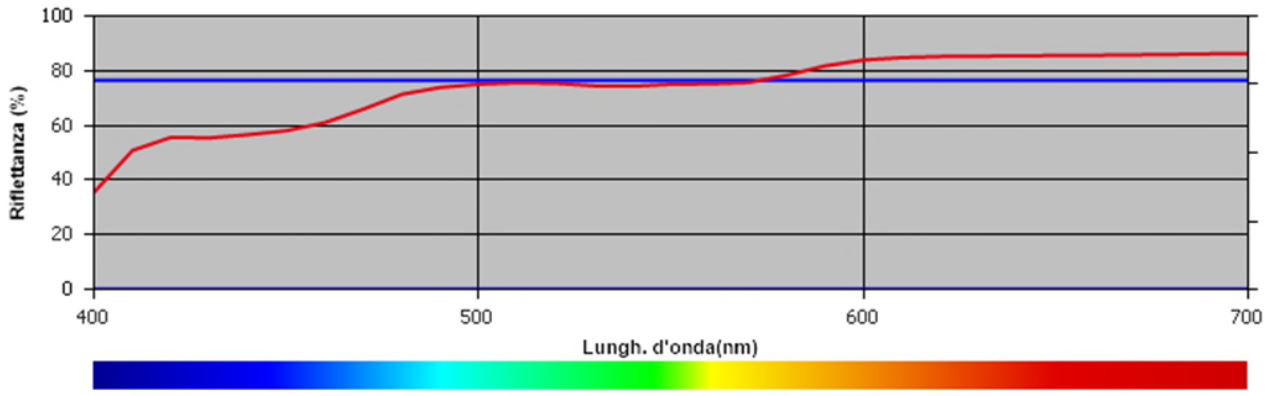
Spectral response of the base coat of the Pikarar Bags, Claimants Reply to the SoD, para 57ff.

aa)

The spectral responses provided by the Claimant regarding the Pikarar Bags however show that not all wavelengths are present in approximately equal amounts. In fact, there is a clear emphasis in the yellow-red spectrum. The spectral response of the base coat of the Pikarar Bags – even neglecting the slope near 400 nm as it is undisputed a typical spectral feature of coloured materials, especially when using organic and/or TiO_2 pigments in a polymeric binder – range from below 60% in the blue area above 420 nm to more than 80% in the orange/red area. A difference of 20 percentage points cannot be considered approximately equal in the meaning of the patent. It shows that the deviations from a perfectly flat spectrum are significant and that the wavelengths are not present in approximately equal amounts. The fact that the reflectance is throughout the full spectra above 50% is not a relevant criterion as the starting point of the patent is a different one, and a colour that reflects more than 50 % throughout the visible spectrum is neither necessarily white, nor achromatic.

bb)

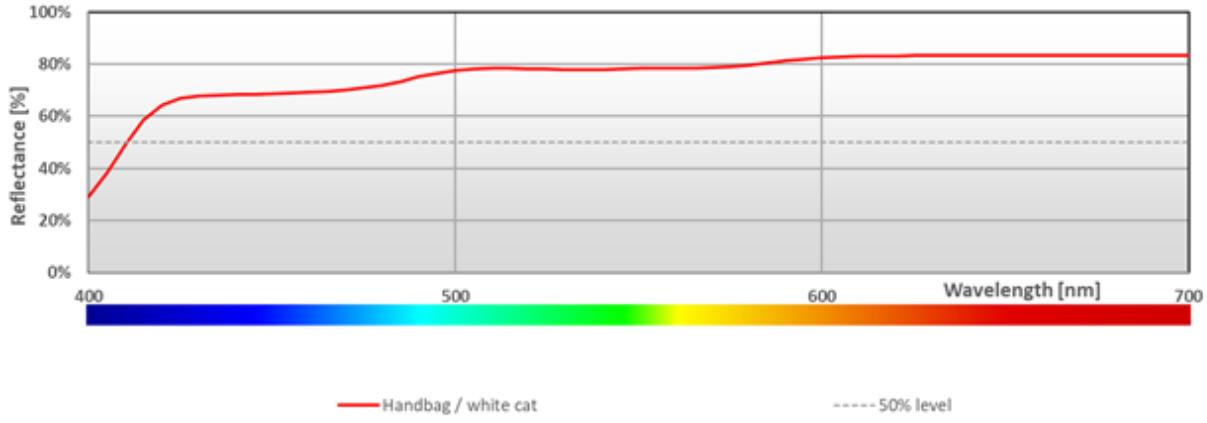
The spectral responses provided by the Claimant are in line with the Defendants' spectral response in exhibit HL20 for the Pikarar Padlog Bag confirming significant deviations from a perfectly flat curve:



c)

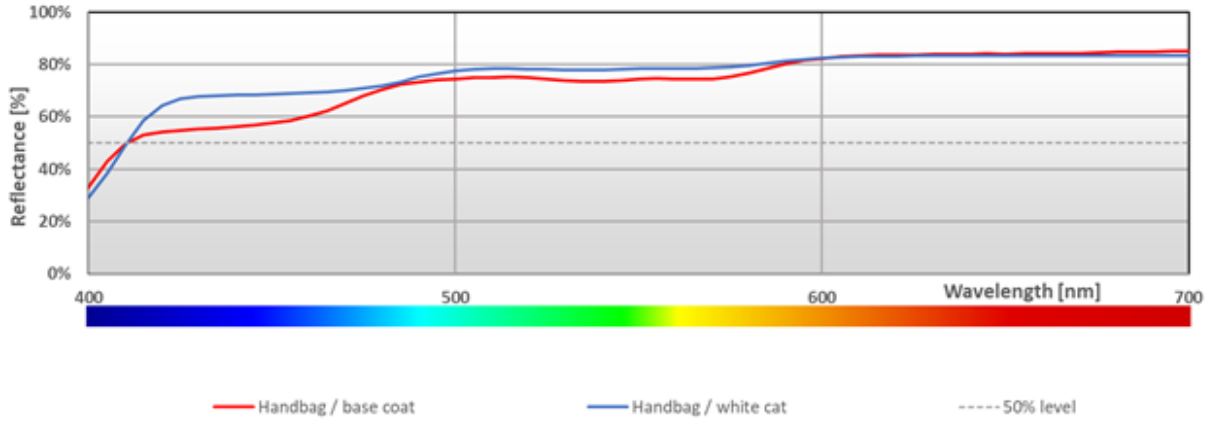
The comparison of this spectral response with the one of an inkjet-printed white part of the colour image provided by the Claimant is unsuitable to prove the opposite.

Firstly, there are significant differences between both responses looking at the spectral response of the white inkjet-part:



(Spectral response of white inkjet ink Claimants Reply to the SoD, para 60)

The spectral response of the white inkjet-part still deviates from a perfectly flat spectrum as it ranges from almost 70% in the blue area above 420 nm to just below 80% in the green-yellow area to slightly more than 80% in the orange/red area, despite the fact that the difference is significantly smaller as of around 10 percentage points. This can be clearly seen in the Claimant's own overlay of the spectral responses (the red line being the base coat and the blue line being the white inkjet-part):



(Overlay of the spectral responses in Claimants Reply to the SoD, para 62)

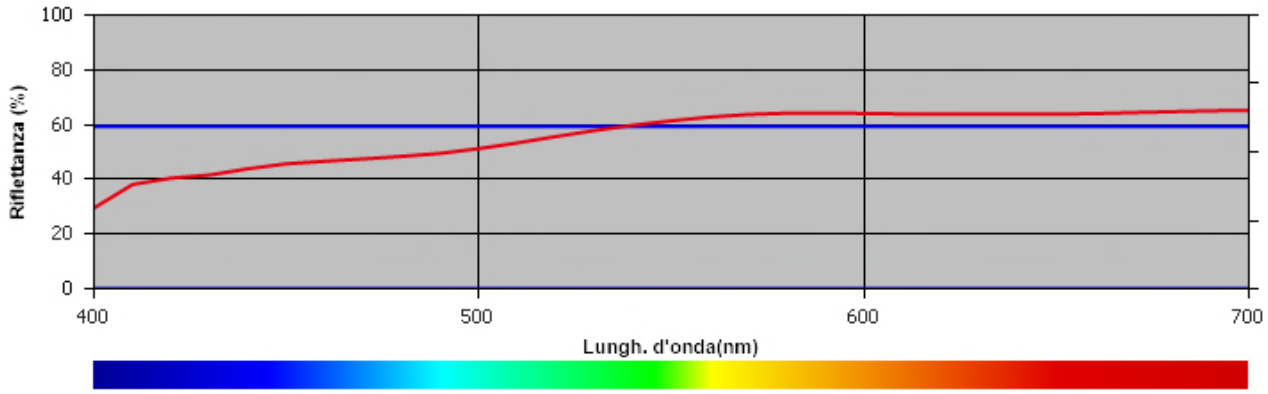
Secondly, this spectral response does not provide a pure white inkjet printing, but consists of a layer of white pigmented inkjet ink that was printed *on top* of the pigmented base coat. The Claimant concedes that the white ink layer does not fully mask the colour of the underlying achromatic base coat due to the limited opacity of white inkjet ink in combination with its thickness, so that the bright perception of the white ink in terms of its reflection is achieved in combination with the achromatic base coat that lies below it (see also [redacted] Declaration, para. 6.9). This means that as the ivory-coloured base coat still contributes to the spectral response, this comparison is unsuitable to prove an achromaticity of the base coat.

d)

Regarding the other attacked embodiments, the Claimant referred to the spectral responses carried out on behalf of the Defendants (exhibits HL21 and HL22), no infringement can be established, either.

aa)

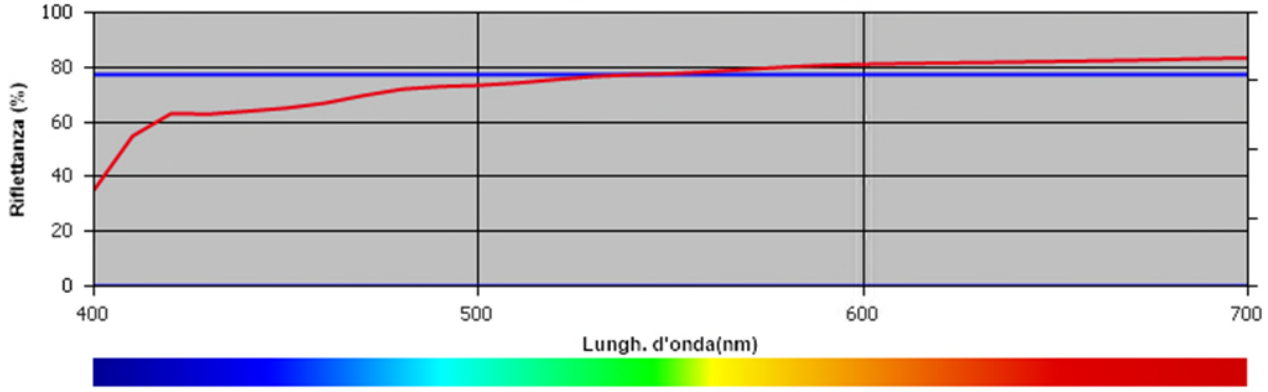
In the present case, the spectral responses of the Pikarar Sneakers show similar significant deviations from a perfectly flat spectrum and their base coat can thus not be considered achromatic:



Comp. para. 7.2 of Exhibit HL21 for the Pikarar Sneakers

bb)

When it comes to the Pikarar Loafers the curve is flatter, but still nowhere near a perfectly flat spectrum, with the spectrum in the light blue area reflecting around 70% and in the red area the spectrum above 80%:



Comp. para. 7.2 of Exhibit HL22 for the Pikarar Loafers

3.

The Court does not support the Claimant's position that in addition to the objective assessment, a subjective assessment of the colour by a trained expert could support the conclusion that a colour is perceived by the human observer as achromatic and that this would exactly be what Dr. [redacted] did with the attacked products, making it irrelevant to linger on the precise cut-off point of achromaticity. On the contrary, the Court sides with the Defendants that to the human eye the Pikarar products have a yellowish, ivory-coloured base coat (like the leather pieces shown in the Defendants' SoD, para 155 ff.). In this regard the Claimant's employee Dr. [redacted] does not provide more than his personal view. Furthermore, Dr. [redacted] apparently relied on a criterion – the 50% threshold – that is not part of the teaching of the patent itself.

4.

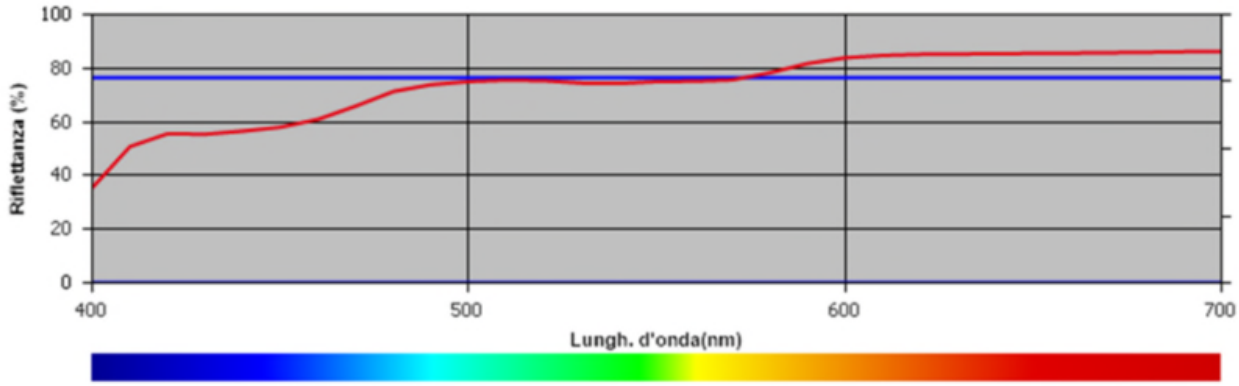
As an additional countercheck, regardless of the fact that the C*-value is not part of the patent's definition of the term achromatic, the Court sides with the Defendants that a person skilled in the art would not likely consider colours with (chroma) C*-values as high as those of the attacked

products to be achromatic. The Defendants have proven that the higher the C*-value, the more chromatic is the colour (comp. expert opinion [redacted] exhibit HL56, p. 4). Despite the Claimant's criticism that the chroma C* is a colour coordinate which is measured from a theoretical point and despite the Claimant having opposed the calculation, this can as a countercheck further confirm that the wavelengths in the Flora products are not present in approximately equal amounts.

a)

The Defendants claim that according to the Test Report Pikarar Padlock Bag (Exhibit HL 20), the base coat of the Pikarar Padlock Bag's leather showed a marked chromaticity (C* = 13.65) with a yellow dominant wavelength (576.40 nm), as reproduced here below (red spectrum). Compared to the nearest achromatic colour (blue spectrum), i.e., the achromatic colour with the same L* value but with the a* and b* set to zero, the colour difference of the sample, expressed as ΔE94, is as high as 13.65:

7.2 Spectral response

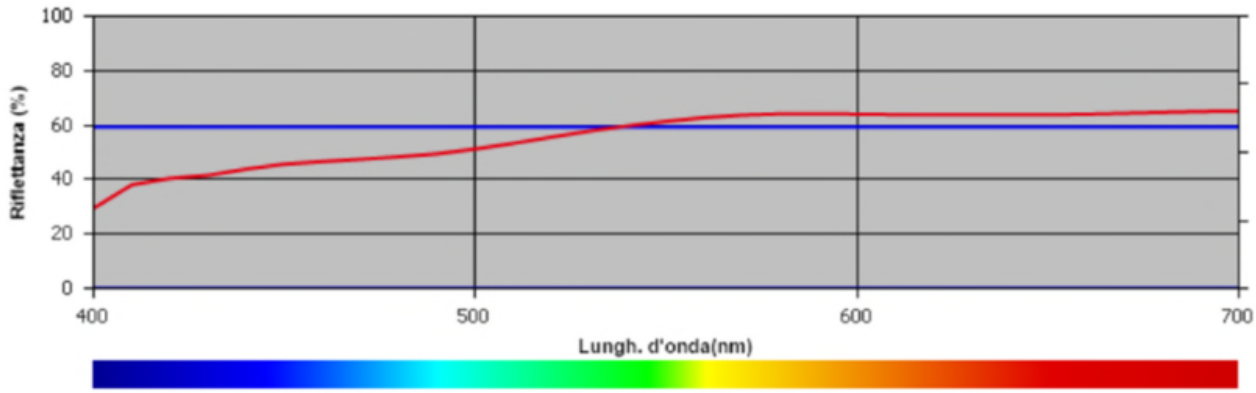


7.4.2 Chromaticity values

Absolute measurements (sample)		*Colour difference calculation*			
L*	90,12	*Theorethical achromatic reference*		*Colour difference*	
a*	0,00	L*	90,12	ΔL*	0
b*	13,65	a*	0	Δa*	0,00
C*	13,65	b*	0	Δb*	13,65
h*	90,02°	C*	0	ΔC*	13,65
Dominant λ	576,40 nm	h*	0	Δh*	90,02°
				ΔE_{94} (1)	13,65 (*)

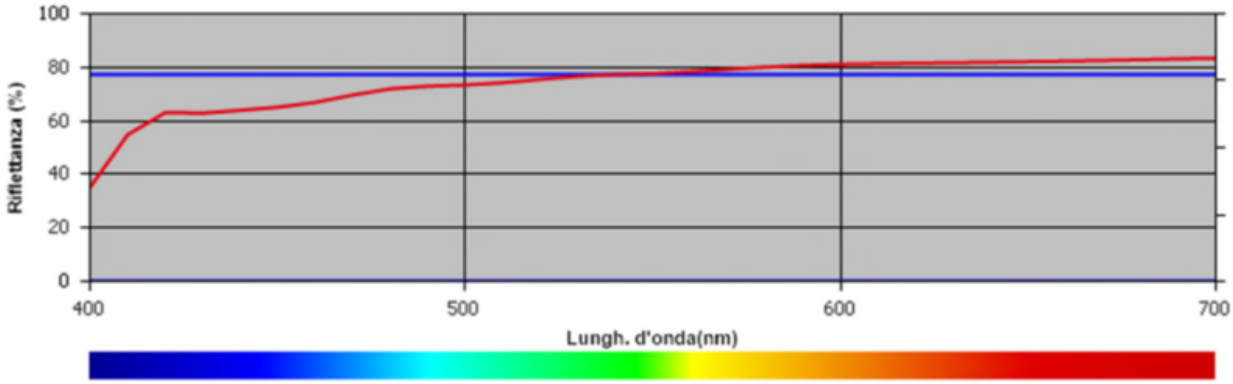
They claim that according to the Test Report Pikarar Sneakers (Exhibit HL 21), the base coat of the Pikarar Sneakers' leather showed a marked chromaticity (C* = 14.51) with a reddish-yellow dominant wavelength (575,95 nm), as reproduced here below (red spectrum). Compared to the nearest achromatic colour (blue spectrum), the colour difference of the sample, expressed as ΔE94, is as high as 14.51.

7.2 Spectral response



They further claim that according to the Test Report Pikarar Loafers (Exhibit HL 22), the base coat of the Pikarar Loafers' leather showed a marked chromaticity (C* = 9.46) with a reddish-yellow dominant wavelength (575,42 nm), as reproduced below. Compared to the nearest achromatic colour, the colour difference of the sample, expressed as ΔE94, is as high as 9,.46:

7.2 Spectral response



7.4.2 Chromaticity values

Absolute measurements (sample)		*Colour difference calculation*			
L*	90,50	*Theorethical achromatic reference*		*Colour difference*	
a*	-0,19	L*	90,50	ΔL*	0
b*	9,46	a*	0	Δa*	-0,19
C*	9,46	b*	0	Δb*	9,46
h*	91,17°	C*	0	ΔC*	9,46
Dominant λ	575,42 nm	h*	0	Δh*	91,17°
				ΔE_{94} (1)	9,46 (*)

Finally, they claim that according to the Test Report Pikarar Tote Bag (Exhibit HL 60), the base coat of the Pikarar Tote Bag's leather showed a chroma value (C*) of 13.70. Compared to the nearest achromatic colour (red spectrum), i.e., the achromatic colour with the same L* value but with the a* and b* set to zero, the colour difference of the sample, expressed as ΔE 94, is as high as 13.70.

b)

Despite the reservations stated above these measurements further confirm the already established finding that the wavelengths in the Flora products are not present in approximately equal amounts and their base coats thus not achromatic.

II.

The Claimant did not prove that the Pikarar Loafers were made using UV curable inks according to feature 1.2.1. Therefore, regardless of the categorization of the Loafers' base coat, their offering by the Defendants on the relevant markets does not justify the requested injunction.

As a general rule the burden of proof regarding infringement lies with the Claimant. In the Statement of Claim, the Claimant analysed the Pikarar Padlock Bag and Sneakers via FTIR. The claimant argues that the FTIR analysis of the black ink shows signals that can be assigned to a polyacrylic material, typically obtained via UV curing. Furthermore, pyrolysis GC-MS results show the presence of photoinitiators and (UV curable) monomers such as tetrahydrofurfuryl acrylate (THFFA) and N-vinyl caprolactam (VCL), which were specifically mentioned in paragraphs [0110] and [0111] of the patent in suit. However, the Claimant did not examine the Pikarar Loafers.

Regarding the Pikarar Loafers the Defendants have denied that the leather skins used to manufacture them have been printed *using one or more pigmented UV curable inkjet inks* within the meaning of feature 1.2.1. In fact, they have stated to have used a different technology than the rest of the attacked embodiments, namely the so called "latex inks", here having used the HP Latex R2000 Printer. Latex inks would not cure, harden or "freeze" under the influence of UV light (exhibit HL 35). The Defendants have substantiated this assertion with a written testimony and an expert report (exhibits HL 34/34a and HL 36). As the Claimant refrained from presenting further, if not to say: any, evidence regarding the asserted use of UV curable inks in the Loafers the Court inevitably has to side with the Defendants regarding this matter. Contrary to the Claimant's position, the fact that all the evidence might probably be in the Defendants' domain, this does by no means limit or reverse the burden of proof. In fact, the Claimant would have been able to counterevidence the Defendants' substantiated assertion as the Claimant itself had been able to show the use of UV curable inks for the Pikarar Padlock Bag and Sneakers via FTIR.

III.

Based on the previous findings the Court can leave open the largely debated question, whether feature 1.2 and feature group 1.5 can be seen as utilized as some of the attacked embodiments comprise an intermediate white ink layer.

1.

As far as the Claimant did not dispute that the Pikarar Padlock Bag, Pikarar Tote Bag and Pikarar Card Case all have an intermediate white ink layer on top of the base coat, apart from certain areas of the Pikarar Padlock Bag, it is disputed whether feature 1.2 – inkjet printing a colour image (43) on the base coat (44) – is realized. As explained above, feature 1.2 generally does not foresee an intermediate layer between base coat and the colour image, where and if this would prevent the base coat from participating in the creation of the coloured image according to features 1.5 – 1.5.3. Therefore, any step in the manufacturing method which results in an intermediate layer between the base coat and the colour image in these cases is consequently out of the scope of claim 1. However, in cases where and if the base coat still is able to influence the colour perception of the final decorative image – as the Claimant indicated in its comparison of this spectral response with the one of an inkjet-printed white part of the colour image (see above sect. D. I. 2. c) – such a manufacturing process would still be covered by claim 1. The Claimant has stated with the afore

mentioned comparison that the white ink layer does not fully mask the colour of the underlying achromatic base coat due to the limited opacity of white inkjet ink in combination with its thickness, so that the bright perception of the white ink in terms of its reflection is achieved in combination with the achromatic base coat that lies below it (see also [redacted] Declaration, para. 6.9). This would mean that as the ivory-coloured base coat still contributes to the spectral response, thus fulfilling feature 1.2. As said before, this point is not decisive and therefore does not need more elaboration by the Court.

2.

The same applies regarding features 1.5 to 1.5.3 – the achromatic colour different from black of the base coat and the inkjet printed colour image are used in combination to provide the decorative image. These features are fulfilled in those products, where the base coat itself is visible throughout the decorative image, i.e. in the green and pink bears on the Pikarar Padlock Bag, where the intermediate white ink layer is missing, as the whole image in combination with the base coat form the decorative image. Again, there is no necessity of elaborating this question and the evidence provided, including partly confidential declarations, by the parties.

IV.

The same applies to the asserted infringement of claim 10. Claim 10 protects a decorated natural leather obtained by way of the manufacturing method of claim 1. Hence, any infringement of claim 10 requires the same findings as an infringement of claim 1. As feature 1.1.1 is not fulfilled by the Pikarar products, because the base coat colour is ivory and not a perfect achromatic colour, the same applies to feature 10.2. Regarding the Loafers the Court cannot find the use of feature 10.3. As the independent claims 1 and 10 are not infringed an infringement of the dependant claims is ruled out.

The private prior use defence as an auxiliary defence is not relevant, when infringement is not established in the first place.

E. Conclusion

In light of the above, the infringement action and its annex requests are to be dismissed without further consideration regarding proportionality under Article 63(1) of the UPCA.

Nevertheless, a decision on the invalidity counterclaim must be issued.

In the context of the decision on costs, the Local Division has considered that the Claimant has been fully unsuccessful with regard to the claims in the infringement action, but that the Defendants have been equally unsuccessful with their counterclaim for revocation. The Claimant has stated the amount in dispute of the infringement action to be EUR 1 million. The Defendants did not object to this. The amount in dispute of the invalidity counterclaim is increased by up to 50 per cent in accordance with item I. 2. b) (2) (ii) of the 'Guidelines of the Administrative Committee for Determining Court Fees and the Ceiling for Recoverable Costs of 24 April 2023' (see Art. 36(3) UPCA, R. 370.6 RoP). Thus, the counterclaim is to be valued at 1.5 million euros and the proceedings as a whole at 2.5 million euros.

DECISION

I. The infringement action is dismissed.

II. The counterclaim for revocation is dismissed.

III. The Claimant shall bear 40% and the Defendants shall bear 60% of the costs of the proceedings.

IV. The value of the proceedings is set in total at € 2.500.000, of which € 1 Mio is attributable to the infringement action and € 1.5 Mio to the counterclaim for revocation.

DETAILS OF THE DECISION

Action Number: ACT 561734/2024
UPC number: UPC_CFI_278/2023
Action type: Infringement Action
Related proceedings: CC 309, 313, 315, 316, 319, 320, 321, 323/2024
Related proceedings type: Counterclaim for revocation
Related proceedings: APP_19083/2024
Related proceedings type: Application to amend a patent

SIGNATURES

Sabine Maria Klepsch
Digital unterschrieben von Sabine Maria Klepsch
Datum: 2025.04.29 15:44:32 +02'00'

Presiding judge Klepsch

Stefan Schilling
Digital unterschrieben von Stefan Schilling
Datum: 2025.04.29 10:14:48 +02'00'

Legally qualified judge and judge-rapporteur Dr. Schilling

Camille Lignières
Date : 2025.04.29 13:30:04 +02'00'

Legally qualified judge Lignieres

Laure, Véronique Sarlin
Digitally signed by Laure, Véronique Sarlin
Date: 2025.04.29 13:13:14 +02'00'

Technically qualified judge Sarlin

Carolin Bauch
Digital unterschrieben von Carolin Bauch
Datum: 2025.04.29 15:51:22 +02'00'

for the Registry

INFORMATION ON APPEAL

An appeal against the present decision may be filed by any party which has been unsuccessful, in whole or in part, with its requests, within two months of notification of the decision at the Court of Appeal (Art. 73 (1) UPCA, R. 220.1 (a), 224.1 (a) RoP).

INFORMATION ON ENFORCEMENT

A certified copy of the enforceable decision will be issued by the Assistant Registrar at the request of the enforcing party (Art. 82 UPCA, Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP).

INSTRUCTION TO THE SUB-REGISTRY

Based on the final value of the case (see IV. of the operational part of the Decision) the Counterclaimant has to be asked to increase its cost deposit to the Court.

This decision was announced in public session on 30 April 2025

Stefan Schilling

Digital unterschrieben von Stefan Schilling
Datum: 2025.04.30 11:12:51 +02'00'

Legally qualified judge Dr. Schilling

BUNDESGERICHTSHOF

IM NAMEN DES VOLKES

URTEIL

X ZR 16/09

Verkündet am:
10. Mai 2011
Wermes
Justizamtsinspektor
als Urkundsbeamter
der Geschäftsstelle

in dem Rechtsstreit

Nachschlagewerk: ja
BGHZ: ja
BGHR: ja

Okklusionsvorrichtung

EPÜ Art. 69

a) Bei Widersprüchen zwischen den Patentansprüchen und der Beschreibung sind solche Bestandteile der Beschreibung, die in den Patentansprüchen keinen Niederschlag gefunden haben, grundsätzlich nicht in den Patentschutz einbezogen. Die Beschreibung darf nur insoweit berücksichtigt werden, als sie sich als Erläuterung des Gegenstands des Patentanspruchs lesen lässt.

b) Offenbart die Beschreibung mehrere Möglichkeiten, wie eine bestimmte technische Wirkung erzielt werden kann, ist jedoch nur eine dieser Möglichkeiten in den Patentanspruch aufgenommen worden, begründet die Benutzung einer der übrigen Möglichkeiten regelmäßig keine Verletzung des Patents mit äquivalenten Mitteln.

BGH, Urteil vom 10. Mai 2011 - X ZR 16/09 - OLG Düsseldorf
LG Düsseldorf

Der X. Zivilsenat des Bundesgerichtshofs hat auf die mündliche Verhandlung vom 10. Mai 2011 durch den Vorsitzenden Richter Prof. Dr. Meier-Beck, den Richter Keukenschrijver, die Richterin Mühlens, den Richter Dr. Grabinski und die Richterin Schuster

für Recht erkannt:

Auf die Rechtsmittel der Beklagten zu 1 werden das am 22. Dezember 2008 verkündete Urteil des 2. Zivilsenats des Oberlandesgerichts Düsseldorf aufgehoben und das am 31. Juli 2007 verkündete Urteil der 4b-Zivilkammer des Landgerichts Düsseldorf abgeändert, soweit zum Nachteil der Beklagten zu 1 erkannt worden ist.

Die Klage wird - auch im Umfang der Klageerweiterung in der Berufungsinstanz - abgewiesen.

Von den Gerichtskosten und den außergerichtlichen Kosten der Klägerin in erster und zweiter Instanz tragen der Beklagte zu 2 ein Achtel und die Klägerin sieben Achtel. Die Beklagte zu 1 wird von allen Kosten freigestellt. Die Klägerin trägt die Kosten des Revisionsverfahrens sowie die außergerichtlichen Kosten der Beklagten zu 1 in erster und zweiter Instanz. Von den außergerichtlichen Kosten der Beklagten zu 3 und 4 in erster Instanz trägt die Klägerin 15%. Im Übrigen tragen die Parteien ihre außergerichtlichen Kosten selbst.

Von Rechts wegen

Tatbestand:

1 Die Klägerin ist seit 2006 eingetragene Inhaberin des auch mit Wirkung für die Bundesrepublik Deutschland erteilten, am 10. Juli 1995 international angemeldeten europäischen Patents 808 138 (Klagepatents), das eine Intravaskulär-Okklusionsvorrichtung und ein Verfahren zu deren Herstellung betrifft.

2 Die mit der Klage geltend gemachten Patentansprüche 1 und 16 lauten in der Verfahrenssprache Englisch und in der deutschen Übersetzung der Patentschrift:

> "1. A collapsible medical device (60) comprising a metal fabric formed of braided strands, the device (60) having a collapsed configuration for delivery through a channel in a patient's, and has a generally dumbbell-shaped expanded configuration with two expanded diameter portions (64) separated by a reduced diameter portion (62) formed between opposed ends of the device, characterized in that clamps (15) are adapted to clamp the strands at the opposed ends of the device.
>
> 16. A method of forming a medical device according to any one of the preceding claims, the method comprising the steps of
>
> (a) providing a metal fabric formed of a plurality of braided strands, the strands being formed of a metal which can be heat treated to substantially set a desired shape;
>
> (b) deforming the metal fabric to generally conform to an internal wall surface of a moulding element;
>
> (c) heat treating the metal fabric in contact with the surface of the moulding element at an elevated temperature, the temperature and the duration of the heat treatment being sufficient to substantially set the shape of the fabric in its deformed state;

(d) removing the metal fabric from contact with the moulding element and

(e) clamping the opposite ends of the strands of the device with clamps."

"1. Kollabierbare medizinische Vorrichtung (60), umfassend ein aus geflochtenen Metalllitzen gebildetes Metallgewebe, wobei die Vorrichtung (60) eine kollabierte Konfiguration zur Zuführung durch einen Kanal in einem Patienten hat und eine allgemein hantelförmige entfaltete Konfiguration mit zwei Teilen mit erweitertem Durchmesser (64) hat, die durch einen zwischen entgegengesetzten Enden der Vorrichtung gebildeten Teil mit reduziertem Durchmesser (62) getrennt sind, dadurch gekennzeichnet, dass die Klemmen (15) zum Festklemmen der Litzen an den entgegengesetzten Enden der Vorrichtungen ausgeführt sind.

16. Verfahren zum Herstellen einer medizinischen Vorrichtung nach einem der vorhergehenden Ansprüche, wobei das Verfahren die folgenden Schritte umfasst:

(a) Bereitstellen eines Metallgewebes, das aus einer Mehrzahl von geflochtenen Litzen gebildet ist, wobei die Litzen aus einem Metall hergestellt werden, das wärmebehandelt werden kann, um im Wesentlichen eine gewünschte Form festzulegen;

(b) Verformen des Metallgewebes, damit es allgemein einer inneren Wandfläche eines Formelements entspricht;

(c) Wärmebehandeln des Metallgewebes in Kontakt mit der Oberfläche des Formelements bei einer erhöhten Temperatur, wobei die Temperatur und die Dauer der Wärmebehandlung ausreichen, um die Form des Gewebes in seinem verformten Zustand im Wesentlichen festzulegen;

(d) Entfernen des Metallgewebes aus dem Kontakt mit dem Formelement und

(e) Festklemmen der entgegengesetzten Enden der Litzen der Vorrichtung mit Klemmen."

3 Die Beklagte zu 1, deren Geschäfte der Beklagte zu 2 geführt hat, vertreibt unter der Bezeichnung "F. O. " ein Verschlussimplantat zur Behandlung von Septumdefekten aus einem Metallgewebe, dessen (in der deutschen Übersetzung des Patentanspruchs als Litzen bezeichnete) Drähte aus einer Nickel-Titan-Legierung (Nitinol) bestehen. Die Drähte werden um etwa 180° umgeschlagen, wodurch die Drahtenden sämtlich am proximalen Ende der fertigen Vorrichtung zu liegen kommen. Nach einer formgebenden Wärmebehandlung wird über das Drahtbündelende eine Nitinolmuffe geschoben. Das Drahtbündel wird am proximalen Ende der Muffe abgeschnitten und ein Endabschnitt mit der Muffe verschweißt.

4 Die Klägerin hat deswegen die Beklagten zu 1 und 2 sowie die Beklagte zu 3 und deren Geschäftsführer, den Beklagten zu 4, wegen wortlautgemäßer, jedenfalls aber äquivalenter Verletzung des Klagepatents auf Unterlassung, Rechnungslegung, Vernichtung und Feststellung der Schadensersatzpflicht in Anspruch genommen. Das Landgericht hat im Wesentlichen antragsgemäß erkannt.

5 Im Berufungsverfahren hat die Klägerin im Weg der Anschlussberufung die Klage gegenüber den Beklagten zu 1 und 2 auf eine weitere Ausführungsform erweitert. Sie hat außerdem die Beklagten zu 1 und 2 auch aus einem deutschen Gebrauchsmuster und einem weiteren europäischen Patents in Anspruch genommen, insoweit die Klage jedoch wieder zurückgenommen.

6 Das Berufungsgericht hat die Berufung der Beklagten zurückgewiesen und auch der Anschlussberufung entsprochen (OLG Düsseldorf, InstGE 10, 248).

7 Mit ihrer vom Senat zugelassenen Revision verfolgt die Beklagte zu 1 (im Folgenden auch: Beklagte) ihr Klageabweisungsbegehren in vollem Umfang weiter.

Entscheidungsgründe:

8 Die zulässige Revision führt zur Aufhebung des angefochtenen Urteils und unter Abänderung der erstinstanzlichen Entscheidung zur Abweisung der gegen die Beklagte zu 1 gerichteten Klage.

9 I. Das Berufungsgericht hat dem Klagepatent das technische Problem entnommen, eine kollabierbare medizinische Vorrichtung, insbesondere eine solche, mit der Blutgefäße eines Patienten verschlossen werden können (Embolisationsvorrichtung), zur Verfügung zu stellen, die präzise in ein Gefäß eingesetzt und am Ort ihres Einsatzes ohne Schwierigkeiten entfaltet werden kann.

10 Das Berufungsgericht hat Patentanspruch 1 des Klagepatents wie folgt gegliedert:

1. Kollabierbare medizinische Vorrichtung, die ein Metallgewebe umfasst.
2. Das Metallgewebe ist aus geflochtenen Metalllitzen (in der Verfahrenssprache: *braided metal strands*) gebildet.
3. Die Vorrichtung hat

a. eine kollabierte Konfiguration zur Zuführung durch einen Kanal in einem Patienten und
b. eine allgemeine hantelförmige entfaltete Konfiguration.

4. Die allgemein hantelförmige (entfaltete) Konfiguration hat
   a. zwei Teile mit erweitertem Durchmesser, die
   b. durch einen Teil mit reduziertem Durchmesser getrennt sind, der zwischen entgegengesetzten Enden der Vorrichtung gebildet ist;
5. Klemmen zum Festklemmen der Litzen (*clamps … to clamp the strands*) sind an den entgegengesetzten Enden der Vorrichtung ausgeführt.

11 Eine Ausführungsform zeigt Figur 5A des Klagepatents:

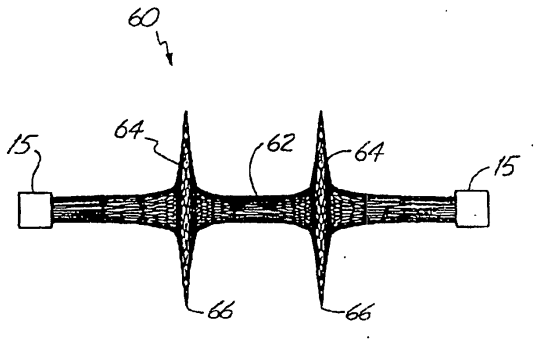


Fig. 5A

12 II. Die Beklagte zu 1 hat nach den Feststellungen des Berufungsgerichts die angegriffenen Ausführungsformen FigullaPFO (Patent Foramen Ovale)-Occluder und FigullaASD-Occluder, katheterbasierte Verschlussimplantate zur Behandlung von Atriumseptumdefekten (Vorhofscheidewanddefekten), nämlich Perforationen der Herzscheidewand, gefertigt, auf einem Kongress in

Frankfurt am Main vorgestellt, im Internet beworben und in den Verkehr gebracht (Abbildungen im Berufungsurteil S. 11 bis 13). Die Litzen bestehen dabei aus einstückigen Nitinoldrähten, die um etwa 180° umgeschlagen werden, wodurch die Litzenenden zusammen mit den in fertigem Zustand ohnehin dort positionierten Litzenenden sämtlich am späteren proximalen Ende der Vorrichtung und nicht an deren entgegengesetzten Enden zu liegen kommen. Diese ersten Ausführungsformen weisen einen Ring aus Nitinol (einer Nickel-Titan-Legierung mit "Formgedächtnis") auf, mit dem ein definierter proximaler Endabschnitt verschweißt oder verschmolzen wird; an dem Nitinolring wird eine Stahlmuffe mit Innengewinde befestigt, um ein Einschrauben eines Führungsdrahts zu ermöglichen. Die zweite Ausführungsform verzichtet auf den Nitinolring, die Stahlmuffe wird unmittelbar auf das zuvor verschweißte Ende des Drahtbündels aufgesetzt.

13 III. Das Berufungsgericht hat mit dem Landgericht angenommen, die angegriffene Ausführungsform I entspreche wortlautgemäß der technischen Lehre des Patentanspruchs 1. Die Verwirklichung der Merkmale 2 bis 4b des Sachanspruchs werde von den Beklagten mit Recht nicht in Abrede gestellt. Die Vorrichtungen seien auch kollabierbare Vorrichtungen im Sinn des Merkmals 1; auf Embolisationsvorrichtungen sei der Gegenstand des Patentanspruchs 1 nicht beschränkt. Auch aus der Hantelform der geschützten Vorrichtung ergebe sich keine Einschränkung des Einsatzbereichs der Vorrichtung; diese könne auch zur Behandlung von Septumdefekten verwendbar sein. Das Berufungsgericht hat dabei angenommen, dass die erfindungsgemäße Vorrichtung in der kollabierten Form etwa mit Hilfe eines Katheters in ein Gefäß des Patienten eingeführt werden könne; werde sie aus dem distalen Ende des Katheters entlassen, könne sie eine definiert entfaltete Form einnehmen, die es gewährleiste, dass sie sich nicht unbeabsichtigt vom Einsatzort entfernen könne. Die Vorrich-

tung werde innerhalb des zu verschließenden Gefäßes so positioniert, dass ihre Achse generell mit derjenigen des Blutgefäßes übereinstimme. Die besondere Hantelform der entfalteten Konfiguration begrenze dabei die Möglichkeit, dass sich die Verschlussvorrichtung gegenüber der Gefäßachse im Winkel verdrehe. Dies lässt keinen Rechtsfehler erkennen und wird auch von der Revision nicht beanstandet.

14 Ebenso sei das Merkmal 5 verwirklicht. Mit der erstmals in der Berufungsinstanz aufgestellten Behauptung, zur festen Verbindung der Drähte diene nicht die Nitinolmuffe, die keine Klemmwirkung entfalte, sondern die Plasmaschweißverbindung der Drahtenden mit der Muffe, könnten die Beklagten nicht gehört werden. Erfolglos bleibe schließlich das Vorbringen der Beklagten, dass die angegriffene Vorrichtung die Drähte nur an einem Ende der Vorrichtung zusammenführe. Dies entspreche noch dem technischen Wortsinn des Merkmals 5, denn der in der Patentbeschreibung hervorgehobene, erfindungsgemäß durch das Vorsehen von Klemmen angestrebte Schutz der Litzen gegen ein Ausfasern einzelner Drahtenden und ihr Zurückkehren in die ungeflochtene Position erscheine nur dort notwendig, wo ein abgeschnittenes freies Ende vorliege, das ausfasern könne. Die Klagepatentschrift beschreibe (Abs. 27/28 der Beschreibung), dass auch aus einem flachen Gewebe, wie es in Figur 1B dargestellt sei, erfindungsgemäße Verschlussvorrichtungen durch Umschlagen der vier Enden des Gewebestücks nach oben hergestellt werden könnten. Die sich nach dem Festklemmen bildende leere Tasche brauche dann nur am oberen "Rand" zusammengeklammert zu werden. Zwar lehre das Klagepatent bei philologischer Betrachtung mehrere Klemmen und schreibe darüber hinaus vor, mit diesen Klemmen die Litzen an den entgegengesetzten Enden der Vorrichtung, also sowohl am proximalen als auch am distalen Ende, festzuklemmen. Bei diesem rein sprachlichen Verständnis bleibe der Fachmann jedoch nicht

stehen. Er sehe, dass die Klemmen dem Bündeln der Litzen dienten, und zwar unabhängig davon, ob die Litzen in gestrecktem Zustand belassen oder ihre Enden durch Umbiegen übereinander gelegt seien, denn dadurch hörten die beiden Litzenenden nicht auf zu existieren. Der Fachmann werde deshalb davon ausgehen, dass Patentanspruch 1 in seinem technischen Sinngehalt auch Ausführungen umfasse, bei denen beide Litzenenden übereinander gelegt und nur an einem Ende der Vorrichtung gebündelt seien. Aus Absatz 27 der Beschreibung in Verbindung mit Figur 1B ergebe sich, dass die Herstellung eines Okkluders aus einem flachen Gewebestück durch Umschlagen erfasst sein solle, bei der nur eine Klemme erforderlich sei. In dieser Ausführungsvariante ergebe es mit Rücksicht auf die Funktion der Klemmen nur einen technischen Sinn, Klemmen dort anzubringen, wo überhaupt freie Litzenenden vorhanden seien. Der im Patentanspruch verwendete Plural "Klemmen" stehe dem nicht entgegen, denn der Fachmann begreife die Formulierung vor dem Hintergrund des in Absatz 27 erläuterten Ausführungsbeispiels als Gattungsbezeichnung. Dieser Auslegung stehe auch nicht entgegen, dass auch Merkmal 4 auf die entgegengesetzten Enden der Vorrichtung Bezug nehme und dort eindeutig das proximale und das distale Ende der Vorrichtung selbst gemeint seien. Denn in Merkmal 4 gehe es um die Bestimmung der Lage des mittleren Teils der Vorrichtung mit reduziertem Durchmesser. Fehl gehe auch der durch die Entscheidung der Rechtbank Den Haag im niederländischen Verletzungsverfahren untermauerte Einwand der Beklagten, der Anmelder habe im Erteilungsverfahren auf Patentschutz für Ausführungsformen nach Absatz 27 verzichtet, weil die Erteilungsakten grundsätzlich kein zulässiges Auslegungsmaterial seien. Der Fachmann, dem sich aus der Patentschrift nicht erschließe, dass - wie die Beklagten meinten - Teile der Beschreibung hätten gestrichen werden müssen, werde die betreffenden Textstellen als Erläuterung des geschützten Gegen-

stands verstehen und versuchen, sie in einen sinnvollen Gesamtzusammenhang zu bringen, bei dem sich Widersprüche nicht ergäben.

15 Hinsichtlich der mit der Anschlussberufung eingeführten zweiten Ausführungsform gälten dieselben Erwägungen. Ein Unterschied zur Ausführungsform I bestehe lediglich darin, dass die Drahtenden ohne Nitinolring verschweißt seien und auf die verschweißten Enden eine Stahlhülse zur Verbindung mit einem Führungsdraht aufgeschoben werde. Für die Stahlhülse gelte wie für die Nitinolhülse der ersten Ausführungsform, dass sie die Drahtenden aufnehme und schon dadurch zusammenhalte.

16 IV. Diese Ausführungen halten der revisionsrechtlichen Nachprüfung nicht in vollem Umfang stand.

17 Dabei kann für die Prüfung einer wortsinngemäßen Patentbenutzung zugunsten der Klägerin unterstellt werden, dass die von der Beklagten vertriebenen Vorrichtungen eine Klemme im Sinn des Merkmals 5 des Patentanspruchs 1 des Klagepatents nach der Gliederung des Berufungsurteils aufweisen, mit der die Drahtenden geklemmt werden.

18 Merkmal 5 verlangt weiter an den entgegengesetzten Enden der Vorrichtung angebrachte Klemmen (*"clamps (15) are adapted to clamp the strands at the opposed ends of the device"*). Diesem Erfordernis entspricht eine einzige, an einem Ende der Vorrichtung angebrachte Klemme nicht.

19 Zwar sagt weder der Begriff "Klemmen" *(clamps)* noch der Begriff "Enden" *(ends)* für sich genommen etwas darüber aus, wie viele von ihnen vorhan-

den sein müssen; grundsätzlich ist auch eine Auslegung dahin denkbar, dass es sich um Gattungsbegriffe handelt, wie dies das Berufungsgericht im Ansatz zutreffend gesehen hat. Das Berufungsgericht hat aber nicht hinreichend berücksichtigt, dass mit der Formulierung "*at the opposed ends of the device*" eine Festlegung dahin getroffen ist, dass Klemmen an den entgegengesetzten Enden der Vorrichtung angebracht werden sollen, und dass damit notwendigerweise zwei Klemmen vorhanden sein müssen, wie dies auch die englischen (vgl. das Urteil des High Court vom 31. Juli 2009 - [2009] EWHC 2013 (Ch) Rn. 68 ff., 72, 76, 77 und das Urteil des Court of Appeal vom 22. Juni 2010 - [2010] EWCA Civ 702 Rn. 48 ff.) und niederländischen Gerichte (Urteil der Rechtbank Den Haag ('s-Gravenhage) vom 29. Oktober 2008 - 2992367/HA ZA 07-3614 Rn. 4.2, 4.3; Urteil des Gerechtshof Den Haag ('s-Gravenhage) vom 19. Oktober 2010 - 200.020.925/01) gesehen haben.

20 Die entgegengesetzten Enden der Vorrichtung werden, wie das Berufungsgericht nicht verkennt, bereits in Merkmal 4 b erwähnt und können dort nicht anders als wörtlich verstanden werden. Die Annahme des Berufungsgerichts, die entgegengesetzten Enden seien in Merkmal 4 b anders zu verstehen als in Merkmal 5, findet weder im Patentanspruch noch in der Beschreibung eine Stütze.

21 Das Berufungsgericht hat sich insoweit maßgeblich von der Überlegung leiten lassen, dass von Patentanspruch 1 auch Ausführungsformen umfasst seien, bei denen die Drähte durch Umbiegen übereinander gelegt und deshalb nur an einem Ende der Vorrichtung gebündelt seien, weswegen Patentanspruch 16 auch auf ein Festklemmen der entgegengesetzten Enden der Litzen und nicht der Vorrichtung abstelle. Zwar kann sich diese Begründung auf die Erwähnung einer durch Umschlagen herzustellenden "leeren Tasche" ("*the*

fabric can be inverted upon itself to form a recess or depression and the fabric can be clamped about this recess to form an empty pocket ... before the fabric is cut") in Absatz 27 der Beschreibung des Klagepatents (in der maßgeblichen Verfahrenssprache) stützen. Dieser Rückgriff auf die Beschreibung vermag die Auslegung durch das Berufungsgericht jedoch nicht zu tragen:

22 Die Erwägung des Berufungsgerichts, einer Klemme bedürfe es erkennbar nur dort, wo Drahtenden zu klemmen seien, geht, wie die Revision mit Recht rügt, daran vorbei, dass sich nach Patentanspruch 1 an beiden Enden der Vorrichtung Drahtenden befinden, die zusammengeklemmt werden können und geklemmt werden müssen, um ein Ausfasern zu vermeiden. Eine Ausführungsform, bei der es auf einer Seite an solchen Drahtenden fehlt, kann daher nicht dazu herangezogen werden, entgegen dem klaren Wortlaut des Patentanspruchs ein Festklemmen sämtlicher Litzen an ein und demselben Ende der Vorrichtung statt an den entgegengesetzten als wortsinngemäße Verwirklichung der erfindungsgemäßen Lehre anzusehen.

23 Nach der Vorgabe in Art. 69 Abs. 1 Satz 1 EPÜ wird der Schutzbereich eines Patents durch die Patentansprüche bestimmt. Damit diese Bestimmung so erfolgen kann, dass die Ziele des Artikels 1 des Auslegungsprotokolls erreicht werden, ist zunächst unter Berücksichtigung von Beschreibung und Zeichnungen der technische Sinngehalt zu ermitteln, der dem Wortlaut des Patentanspruchs aus fachmännischer Sicht beizumessen ist. Zwar ist ein buchstäbliches Verständnis der Patentansprüche nicht zur Erfassung des geschützten Gegenstands geeignet, andererseits darf der Schutzgegenstand aber auch nicht durch Verallgemeinerung konkreter, im Anspruch angegebener Lösungsmittel erweitert werden (vgl. Ballhaus/Sikinger, GRUR 1986, 337, 341). Insbesondere darf ein engerer Patentanspruch nicht nach Maßgabe einer weiter ge-

fassten Beschreibung interpretiert werden. Der Patentanspruch hat vielmehr Vorrang gegenüber der Beschreibung (BGH, Urteile vom 7. September 2004 - X ZR 255/01, BGHZ 160, 204, 209 = GRUR 2004, 1023 - bodenseitige Vereinzelungseinrichtung; vom 13. Februar 2007 - X ZR 74/05, BGHZ 171, 120 = GRUR 2007, 410 - Kettenradanordnung I; vom 17. April 2007 - X ZR 72/05, BGHZ 172, 88, 97 = GRUR 2007, 778, 779 - Ziehmaschinenzugeinheit I; vom 4. Februar 2010 - Xa ZR 36/08, GRUR 2010, 602 - Gelenkanordnung). Was in den Patentansprüchen keinen Niederschlag gefunden hat, kann nicht unter den Schutz des Patents fallen. Die Beschreibung und die Zeichnungen sind zwar nach Art. 69 Abs. 1 Satz 2 EPÜ zur Auslegung der Patentansprüche heranzuziehen, da diese der Erläuterung der Patentansprüche dienen. Beschreibung und Zeichnungen sind mithin heranzuziehen, um den Sinngehalt des Patentanspruchs zu ermitteln. Ihre Heranziehung darf aber weder zu einer inhaltlichen Erweiterung noch zu einer sachlichen Einengung des durch den Wortsinn des Patentanspruchs festgelegten Gegenstands führen (BGH, aaO - bodenseitige Vereinzelungseinrichtung; BGH, aaO - Ziehmaschinenzugeinheit I; BGH, aaO - Gelenkanordnung). Lassen sich die technische Lehre der Beschreibung und die technische Lehre des Patentanspruchs nicht in Einklang bringen, ist der Patentanspruch maßgeblich (vgl. schon BGH, Urteile vom 29. November 1988 - X ZR 63/87, BGHZ 106, 84, 93 f. = GRUR 1989, 205, 208 - Schwermetalloxidationskatalysator; vom 16. Juni 1987 - X ZR 51/86, BGHZ 101, 159 = GRUR 1987, 794 - Antivirusmittel). Bei Widersprüchen zwischen Patentansprüchen und Beschreibung sind solche Bestandteile der Beschreibung, die in den Patentansprüchen keinen Niederschlag gefunden haben, grundsätzlich nicht in den Patentschutz einbezogen. Die Beschreibung darf somit nur insoweit berücksichtigt werden, als sie sich als Erläuterung des Gegenstands des Patentanspruchs lesen lässt.

24 Auch die Überlegung, dass die Fachwelt grundsätzlich bestrebt ist, die Patentschrift in einem sinnvollen Zusammenhang zu lesen und ihren Gesamtinhalt im Zweifel so zu verstehen, dass sich Widersprüche nicht ergeben (vgl. BGH, Beschluss vom 8. Juli 2008 - X ZB 13/06, GRUR 2008, 887 - Momentanpol II; Urteil vom 31. März 2009 - X ZR 95/05, BGHZ 180, 215 = GRUR 2009, 653 - Straßenbaumaschine), führt hier nicht zu einer Einbeziehung der insoweit übereinstimmenden angegriffenen Ausführungsformen in den Gegenstand des Patentanspruchs 1 des Klagepatents. Dieser Grundsatz wird nämlich durch den Vorrang des Patentanspruchs eingegrenzt. Kann, wie hier, der Wortlaut des Patentanspruchs mit einer Beschreibungsstelle nicht in Einklang gebracht werden, kann die Beschreibung nicht zur "Korrektur" des Patentanspruchs herangezogen werden; andernfalls würde gegen den Grundsatz des Vorrangs des Patentanspruchs verstoßen.

25 Relevante Widersprüche zwischen Beschreibung und Patentansprüchen sind, was die Lage der Klemmen an den entgegengesetzten Enden betrifft, allerdings zu verneinen. Die Beschreibungsstelle, auf die sich das Berufungsgericht gestützt hat (Abs. 27), lässt sich nicht ohne Weiteres mit Patentanspruch 1 in Verbindung bringen. Sie besagt nämlich lediglich, dass bei Verwendung eines flachen Gewebes entsprechend der Figur 1B des Klagepatents als Ausgangsmaterial dieses umgeklappt und geklammert werden kann, um eine "leere Tasche" (*an empty pocket*) zu bilden, bevor es zugeschnitten wird (*before the fabric is cut*). In dieser unklaren Passage wird nicht ausgeführt, ob und inwiefern sich aus der Tasche eine praktisch brauchbare allgemein hantelförmige Konfiguration herstellen lässt, wie sie Gegenstand von Patentanspruch 1 ist (Merkmal 4); das Berufungsgericht hat auch ausdrücklich offen gelassen, ob dies möglich ist. Die Textpassage schließt zudem unmittelbar an Absatz 26 an, in dem nichtpatentgemäße Formen der Fixierung der Drahtenden erörtert wer-

den. Damit betrifft sie ersichtlich schon kein Ausführungsbeispiel der erfindungsgemäßen Vorrichtung, sondern beschreibt nicht mehr als einen möglichen Arbeitsschritt beim Herstellungsvorgang und nicht das fertige patentgemäße Erzeugnis. Damit kann die Beschreibungsstelle, auf die sich das Berufungsgericht gestützt hat, aber nicht die Grundlage für eine den Wortsinn des Patentanspruchs korrigierende Auslegung des Patentanspruchs bilden. Es kann daher auch hier unerörtert bleiben, ob es der Grundsatz, dass nicht auf Vorgänge im Erteilungsverfahren zurückgegriffen werden darf, die im Patent keinen Niederschlag gefunden haben (BGH, Urteil vom 12. März 2002 - X ZR 43/01, BGHZ 150, 161 = GRUR 2002, 511 - Kunststoffrohrteil), auch verbietet, auf Patentveröffentlichungen wie die amtlich veröffentlichte Patentanmeldung oder frühere Fassungen der später etwa im Einspruchsverfahren oder im Beschränkungsverfahren geänderten Patentschrift zurückzugreifen, wenn sich der Gehalt der maßgeblichen Fassung der Patentschrift erst aus einem Vergleich mit diesen erschließt und damit zu einem Niederschlag auch in dieser geführt hat (vgl. hierzu schon BGH, Urteil vom 4. Februar 2010 - Xa ZR 36/08, GRUR 2010, 602 Rn. 33 - Gelenkanordnung).

26 Da es mithin jedenfalls an Klemmen an den entgegengesetzten Enden der Vorrichtung fehlt, ist eine wortsinngemäße Verletzung zu verneinen. Die abweichende Betrachtung des Berufungsgerichts führt zur Einbeziehung einer Unterkombination in den Patentschutz. Dies ist, wie der Senat bereits wiederholt ausgeführt hat, nicht statthaft (BGH, Urteil vom 31. Mai 2007 - X ZR 172/04, BGHZ 172, 298 = GRUR 2007, 1059 - Zerfallszeitmessgerät; BGHZ 180, 215 = GRUR 2009, 653 - Straßenbaumaschine).

27 V. Das Berufungsurteil ist mithin aufzuheben. Einer Zurückverweisung der Sache an das Berufungsgericht bedarf es nicht, da der Senat in der Sache

selbst entscheiden kann. Die Klage gegen die Beklagte zu 1 erweist sich als unbegründet, da die angegriffenen Ausführungsformen die erfindungsgemäße Lehre auch nicht mit äquivalenten Mitteln verwirklichen und daher nicht in den Schutzbereich des Klagepatents fallen.

28 1. Für die Prüfung der geltend gemachten, vom Berufungsgericht folgerichtig nicht erörterten Patentverletzung mit äquivalenten Mittel kann zugunsten der Klägerin unterstellt werden, dass die Ausgestaltung der angegriffenen Ausführungsformen, bei denen nur eine einzige Klemme vorhanden ist, die sämtliche Drähte an einem (dem proximalen) Ende der Vorrichtung zusammenhält, während das andere Ende der Vorrichtung auf Grund der dort umgeschlagenen Drähte verschlossen ist, mit zwar abgewandelten, aber objektiv gleichwirkenden Mitteln dasselbe Problem löst wie der in Patentanspruch 1 unter Schutz gestellte Gegenstand, bei dem die Klemmen an den entgegengesetzten Enden der Vorrichtung ausgeführt sind, und dass der Fachmann, wie die Klägerin in ihrem Schriftsatz vom 15. April 2011 noch einmal eingehend dargelegt hat, durch seine Fachkenntnisse dazu befähigt ist, die abgewandelten Mittel als gleichwirkend aufzufinden (Senat, Urteil vom 12. März 2002 - X ZR 168/00, BGHZ 150, 149, 154 = GRUR 2002, 515 - Schneidmesser I).

29 2. Zu verneinen ist dagegen, dass die Überlegungen, die der Fachmann hierzu anstellen muss, am Sinngehalt der im Patentanspruch unter Schutz gestellten technischen Lehre orientiert sind. Die abweichende Ausführung mit ihren abgewandelten Mitteln ist daher aus fachmännischer Sicht nicht als gleichwertig in Betracht zu ziehen (vgl. u.a. Senat, Urteile vom 12. März 2002 - X ZR 168/00, BGHZ 150, 149, 154 - Schneidmesser I und vom 14. Dezember 2010 - X ZR 193/03, GRUR 2011, 313 Rn. 35 - Crimpwerkzeug IV). Zu dieser rechtlichen Beurteilung, zu der der Bundesgerichtshof als Revisionsge-

richt berufen ist, bedarf es keiner Zurückverweisung der Sache an das Berufungsgericht.

30 Eine Aussage darüber, ob eine vom Wortsinn des Patentanspruchs abweichende Ausführung in den Schutzbereich eines Patents fällt, kann zwar regelmäßig nur dann getroffen werden, wenn sich der Tatrichter mit den betreffenden Fragen befasst hat. Denn bei der Gleichwirkung handelt es sich um eine Frage, deren Beantwortung tatrichterlicher Feststellungen bedarf, die in der Revisionsinstanz nicht nachgeholt werden können (BGH, Urteile vom 22. November 2005 - X ZR 81/01, GRUR 2006, 313 Rn. 22 - Stapeltrockner und vom 17. April 2007, GRUR 2007, 959 Rn. 28 - Pumpeinrichtung). Dies liegt aber daran, dass der Tatrichter gegebenenfalls keinen Anlass hatte, Feststellungen zu einer vom Wortsinn des Patentanspruchs abweichenden, indessen gleichwohl die technische Wirkung der Erfindung erzielenden Ausgestaltung der angegriffenen Ausführungsform zu treffen. Insoweit kann jedoch im Streitfall auf die Feststellungen zur tatsächlichen Beschaffenheit der angegriffenen Ausführungsform zurückgegriffen werden, die das Berufungsgericht als wortsinngemäße Benutzung gewertet hat und auf die auch die Klägerin die von ihr hilfsweise geltend gemachte äquivalente Verletzung stützt.

31 Die Gleichwertigkeit des abweichenden Mittels ist hingegen eine Rechtsfrage, die der revisionsrechtlichen Prüfung zugänglich ist. Sie hängt zwar in der Regel entscheidend ebenfalls von den in der Tatsacheninstanz zu klärenden tatsächlichen Grundlagen ab (BGH, Urteile vom 22. November 2005, aaO Rn. 23 - Stapeltrockner und vom 14. Dezember 2010, aaO Rn. 36 - Crimpwerkzeug IV). Das schließt jedoch nach § 563 Abs. 3 ZPO nicht aus, dass sie vom Revisionsgericht unmittelbar entschieden werden kann, wenn diejenigen tatsächlichen Feststellungen, die die Annahme einer äquivalenten Verletzung gegebenenfalls tragen könnten, bereits getroffen sind und weitere Feststellungen nicht zu erwarten sind (BGH, Urteile vom 4. Februar 2010 - Xa ZR 36/08, aaO - Gelenkanordnung und vom 14. Dezember 2010, aaO Rn. 34 ff. - Crimpwerkzeug IV). So liegt der Fall hier.

32 Das Berufungsgericht ist davon ausgegangen, dass die "Litzen" entweder in gestrecktem Zustand belassen werden oder ihre Enden - gleichwirkend - durch Umbiegen übereinander gelegt und dann nur an einem Ende der Vorrichtung gebündelt werden können. Daran schließt sich die weitere Überlegung an, dass es in diesem Fall nicht erforderlich ist, zwei Klemmen zu verwenden, sondern dass beide Enden mit einer einzigen Klemme erfasst und zusammengehalten werden können. Die eine, sämtliche Litzenenden erfassende Klemme wird danach als Ersatzmittel für die zwei Klemmen angesehen, die nach dem Wortlaut des Patentanspruchs die Litzen einerseits am proximalen, andererseits am distalen Ende zusammenklemmen. Auf dieser Grundlage verficht auch die Klägerin eine gleichwertige Benutzung des Klagepatents.

33 Diese Überlegung ist schon in ihrem Ausgangspunkt nicht am Patentanspruch orientiert. Das Klagepatent (auch der Patentanspruch, der ein aus geflochtenen Metalllitzen gebildetes Metallgewebe verlangt, Merkmal 2) verknüpft

die geschützte Vorrichtung eng mit dem Herstellungsverfahren. Welche Varianten der erfindungsgemäßen Vorrichtung aus fachmännischer Sicht aufgrund von am Patentanspruch orientierten Überlegungen als gleichwertig in Erwägung zu ziehen sind, lässt sich deshalb nicht unabhängig von der Frage beantworten, ob und wie sich eine solche geänderte Ausführungsform einfach und kostengünstig so herstellen lässt, wie dies das Klagepatent für die dem Wortsinn des Patentanspruchs entsprechende Ausführung der Vorrichtung lehrt, nämlich in Form des in Figur 1A gezeigten Flechtschlauchs (wie er im Übrigen auch von der von der Klägerin herangezogenen japanischen Gebrauchsmusterveröffentlichung Hei 04-47415 verwendet wird). Demgegenüber hat die Überlegung, die Litzen könnten auch um 180° umgebogen werden, so dass alle Litzenenden an demselben Ende der Vorrichtung liegen, schon deshalb keine Grundlage im Patentanspruch, weil nicht erkennbar ist, wozu eine derartige Ausgestaltung bei der Bereitstellung eines (schlauchförmigen) Metallgewebes dienen sollte, aus dem sich eine Vorrichtung mit den Merkmalen 3 bis 5, d.h. mit freien, jeweils mit einer Klemme zusammen zu haltenden Drahtenden an beiden Enden der Vorrichtung, formen lässt.

34 Die Funktion der Klemmen an den entgegengesetzten Enden der Vorrichtung erschöpft sich nicht darin, dort die Drahtenden durch Klemmwirkung zusammenzuhalten. Vielmehr soll die Vorrichtung an beiden Enden geschlossen werden, indem das Metallgewebe gehindert wird, sich aufzulösen (Abs. 25 der Beschreibung). Die Erwägung der Klägerin, die technische Lehre des Klagepatents werde nicht verlassen, wenn auf Grund des in der Patentschrift offenbarten Herstellens der patentgemäßen Vorrichtung (scil. aus einem flachen Metallgewebe bzw. einer daraus geformten "leeren Tasche") oder auch nach Umschlagen eines Schlauchgewebes nach dem Vorbild der japanischen Gebrauchsmusterveröffentlichung ein offenes Drahtende nur noch auf einer

Seite vorliege und dann auch nur dort eine Klemme zum Einsatz komme, während das andere Ende durch das ausdrücklich beschriebene Umschlagen des Gewebes verschlossen sei, und der Fachmann werde eine abweichende Ausgestaltung, bei der das eine Ende durch Umschlagen und das andere Ende durch Vorsehen von Klemmen geschlossen werde, als an der technischen Lehre des Merkmals 5 orientiert ansehen, greift daher zu kurz. Denn der Patentanspruch begnügt sich weder mit der Anforderung, die offenen Drahtenden klemmend zusammenzuhalten, noch mit der Anforderung, beide offenen Enden der Vorrichtung zu verschließen, sondern verlangt, dass der Verschluss an diesen beiden Enden der Vorrichtung in der Weise ausgeführt wird, dass dort die (Enden der) Drähte mittels Klemmen festgeklemmt werden. Er trifft damit eine Auswahl aus den in Absatz 26 der Beschreibung erwähnten vielfältigen Möglichkeiten, die Enden der gewünschten Gewebelänge "alternativ" (durch Löten, Hartlöten, Schweißen oder auf andere Weise) zu fixieren.

35 Bei der Prüfung der Orientierung am Patentanspruch, die Voraussetzung der Einbeziehung einer als gleichwirkend auffindbaren Abwandlung der wortsinngemäßen Lehre in den Schutzbereich des Patents ist, darf dies nicht außer Betracht bleiben. Orientierung am Patentanspruch setzt voraus, dass der Patentanspruch in allen seinen Merkmalen nicht nur den Ausgangspunkt, sondern die maßgebliche Grundlage für die Überlegungen des Fachmanns bildet (BGH, Urteil vom 29. November 1988 - X ZR 63/87, BGHZ 106, 84, 90 f. = GRUR 1989, 205 - Schwermetalloxidationskatalysator; Urteil vom 12. März 2002 - X ZR 168/00, BGHZ 150, 149, 154 = GRUR 2002, 515 - Schneidmesser I). Trifft der Patentanspruch eine Auswahlentscheidung zwischen verschiedenen Möglichkeiten, eine technische Wirkung zu erzielen, müssen die fachmännischen Überlegungen zu möglichen Abwandlungen gerade auch mit dieser Auswahlentscheidung in Einklang stehen. Nur solche fachmännischen Überlegun-

gen sind daher auch im Streitfall an der durch den Patentanspruch geschützten technische Lehre orientiert, die auch der Auswahlentscheidung des Patentanspruchs Rechnung tragen, an beiden Enden der Vorrichtung die Drähte mittels einer Klemme durch eine Klemmverbindung zusammenzuhalten. Ebenso wenig wie das im Patentanspruch vorgesehene Klemmen an beiden Enden der Vorrichtung durch eine Schweiß- oder sonstige Verbindung ersetzt werden darf, die vom Klagepatent zwar offenbart, aber nicht beansprucht wird, darf an einem Ende der Vorrichtung die Klemmverbindung durch eine andere Verbindungsform ersetzt werden. Eine solche andere Verbindungsform stellt es aber - wie auch die Klägerin ihren Überlegungen zur Gleichwertigkeit zugrunde legt - dar, wenn die Verbindung der Drähte am distalen Ende der Vorrichtung durch das Umschlagen des Gewebes erfolgt.

36 Entgegen der Auffassung des englischen Berufungsgerichts, das gemeint hat, die "Schneidmesser-Fragen" enthielten nichts, was der dritten der in Improver v. Remington ([1990] FSR 181) von J. Hoffmann als Teil seiner Wiedergabe von Lord Diplocks Auslegungsansatz in Catnic gestellten Fragen entspreche (aaO Rn. 28 f.), führt somit die Prüfung der Orientierung am Patentanspruch zum Ausschluss einer Ausführungsform aus dem Schutzbereich des Patents, die zwar offenbart oder für den Fachmann jedenfalls auffindbar sein mag, von der der Leser der Patentschrift aber annehmen muss, dass sie - aus welchen Gründen auch immer - nicht unter Schutz gestellt werden sollte (vgl. BGH, aaO, 159 - Schneidmesser I).

37 VI. Die Kostenentscheidung beruht auf § 91 Abs. 1, § 100 Abs. 1 ZPO.

Meier-Beck Keukenschrijver Mühlens

Grabinski Schuster

Vorinstanzen:
LG Düsseldorf, Entscheidung vom 31.07.2007 - 4b O 297/06 -
OLG Düsseldorf, Entscheidung vom 22.12.2008 - I-2 U 65/07 -

Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Appeal n°:
UPC_CoA_405/2024
APL_40553/2024

FINAL ORDER

of the Court of Appeal of the Unified Patent Court
concerning an application for provisional measures
issued on 20 December 2024

HEADNOTE

1. A linguistic error, a spelling mistake or any other inaccuracy in a patent claim can only be corrected by way of interpretation of the patent claim if the existence of an error and the precise way to correct it are sufficiently certain to the average skilled person on the basis of the patent claim, taking into account the description and the drawings and using common general knowledge.

2. The patent claim must be interpreted from the perspective of the person skilled in the art. The applicant's assertions during the grant proceedings, and in particular the TBA's endorsement thereof, can be seen as an indication of the view of the person skilled in the art at the filing date.

APPELLANT (APPLICANT IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

Alexion Pharmaceuticals, Inc.
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hereinafter: Alexion,

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hereinafter: Amgen,

represented by attorneys-at-law Prof. Dr. Tilman Müller-Stoy, Dr. Tobias Wuttke and Dr. Dominik Woll and patent attorneys Dr. Axel Berger and Dr. Markus Ackermann (Bardehle Pagenberg) and attorney-at-law Tim Harris (Osborne Clark)

PATENT AT ISSUE
EP 3167888

PANEL AND DECIDING JUDGES
Panel 1a:
Klaus Grabinski, president of the Court of Appeal
Peter Blok, legally qualified judge and judge-rapporteur
Emmanuel Gougé, legally qualified judge
Eric Enderlin, technically qualified judge
Anna Hedberg, technically qualified judge

LANGUAGE OF THE PROCEEDINGS

English

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- □ Orders of the Court of First Instance of the Unified Patent Court, Local Division Hamburg dated 26 June 2024 (without grounds) and 17 July 2024 (with grounds).
- □ Numbers attributed by the Court of First Instance:
  UPC_CFI_124/2024
  ACT_13886/2024
  ORD_38032/2024

DATE OF THE ORAL HEARING:

4 November 2024

FACTS AND REQUESTS OF THE PARTIES

Alexion

1. Alexion is the parent company of the Alexion group, a global pharmaceutical company. Alexion and its affiliated companies market a range of pharmaceuticals for the treatment of rare diseases. These include Soliris®, a biopharmaceutical drug which is authorised for treatment of the following rare diseases:
   - paroxysmal nocturnal hemoglobinuria (hereinafter: PNH),
   - atypical hemolytic uremic syndrome (hereinafter: aHUS),
   - refractory generalized myasthenia gravis (hereinafter: gMC), and
   - neuromyelitis optica spectrum disorders (hereinafter: NMOSD).

   The active ingredient in Soliris® is a recombinant humanized monoclonal antibody, which was given the International Non-proprietary Name (INN) “eculizumab” in 2002.

2. Eculizumab was covered by a patent family held by Alexion for a class of antibodies, including US 6 355 245 (exhibit FBD 14, hereinafter: Evans) and EP 0 758 904 with the priority date of 2 May 1994, and by a supplementary protection certificate. The supplementary protection certificate expired in April 2020.

3. In 1999, Alexion entered eculizumab in the Chemical Abstract Service (hereinafter: CAS) database Registry, which discloses information on chemical substances. Alexion entered the wrong sequence in the CAS database. The sequence was corrected in 2009.

4. Alexion is the proprietor of European Patent 3 167 888 B1 for “treatment of paroxysmal nocturnal hemoglobinuria by an inhibitor of complement” (hereinafter: the patent at issue).

The patent at issue

5. The patent at issue is a divisional application of the European patent application 2 359 834 A1 (hereinafter: EP 834), which is a divisional application of the European patent application 2 001 490 A1 (hereinafter: EP 490) which was filed as the international patent application WO 2007/106585. The patent application underlying the patent at issue was published on 17 May 2017. WO 2007/106585 was filed on 15 March 2007. It claims the priority of US 783070 P which was filed on 15 March 2006. The grant of the patent was published on 1 May 2024. Unitary effect was granted by the decision of the European Patent Office (hereinafter: EPO) of 13 May 2024. On 2 May 2024, Samsung Bioepis NL B.V. (hereinafter: Samsung) filed an opposition against the grant of the patent at issue.

6. The patent at issue claims an antibody which is described as suitable for use as an inhibitor of a component of the immune system called "Complement component 5" (hereinafter: C5). According to the description, the claimed antibody binds to C5 and thereby prevents the cleavage of C5 into its fragments C5a and C5b, which is the beginning of an immune response. The claimed antibody is described as suitable for use in the treatment of, for example, PNH, a life-threatening blood disease whereby the patient's own immune system destroys erythrocytes (red blood cells). The red blood cells of these patients lack the protective proteins which are required to prevent an attack by C5.

7. Advantageous C5-binding monoclonal antibodies were known on the priority date of the patent at issue. For example, Evans, cited in paragraph [0064] of the patent at issue, discloses such antibodies. The description of the patent at issue names the preferred whole antibody which Evans discloses "eculizumab" (par. [0064]).

8. The relevant claims of the patent at issue read as follows:

    1. An antibody that binds C5 comprising a heavy chain consisting of SEQ ID NO:2 and a light chain consisting of SEQ ID NO:4.

    2. A pharmaceutical composition comprising the antibody of claim 1.

9. Par. [0134] of the description of the patent at issue shows the amino acid sequences SEQ ID NO:2 and SEQ ID NO:4. Under the heading "SEQ ID NO: 4 – Eculizumab Light chain" it presents the following sequence of 236 amino acids:

MDMRVPAQLLGLLLLWLRGARCDIQMTQSPSSLSASVGDRVTITCGASENIYGAL
NWYQQKPGKAPKLLIYGATNLADGVPSRFSGSGSGTDFTLTISSLQPEDFATYYCQ
NVLNTPLTFGQGTKVEIKRTVAAPSVFIFPPSDEQLKSGTASVVCLLNNFYPREAKV
QWKVDNALQSGNSQESVTEQDSKDSTYSLSSTLTLSKADYEKHKVYACEVTHQG
LSSPVTKSFNRGEC

10. The SEQ ID NO: 4 sequence shown in par. [0134] of the patent at issue is not identical to the sequence of the light chain disclosed in the corrected CAS database entry for eculizumab in 2009. SEQ ID NO: 4 has 22 extra amino acids at the beginning of the sequence (the N-terminus).

11. In the examination proceedings of the patent at issue, the Technical Board of Appeal (hereinafter: TBA) rejected Alexion's main request (TBA 21 September 2023, T 1515/20). In this request, the feature SEQ ID NO:4 of claim 1 was replaced by the sequence extending from amino acids 23 to 236 of SEQ ID NO:4. According to the TBA, such a claim did not constitute an allowable correction under Rule 139 of the Implementing Regulations to the Convention on the Grant of European Patents (hereinafter: EPC Rules) and introduced added matter within the meaning of Art. 76(1) and 123(2) of the Convention on the Grant of European Patents (European Patent Convention, hereinafter: EPC). The TBA ordered the Examining Division to grant the patent on the basis of auxiliary request 5, which is the patent at issue in its current form. In the interpretation of the TBA, feature SEQ ID NO:4 includes the 22 extra amino acids. The TBA examined the claimed subject matter on the basis of this interpretation and concluded it is novel, involves an inventive step and is sufficiently disclosed.

Amgen

12. Amgen is a part of the pharmaceutical group Amgen. Since July 2023, Amgen has placed BEKEMV® (hereinafter: the contested product), a biosimilar product of Soliris® containing the monoclonal antibody eculizumab, on the market of several Contracting Member States of the UPC. BEKEMV ® is currently approved for the European market in the embodiment "300 mg Concentrate for solution for infusion" for PNH.

Related proceedings

13. In Germany, a subsidiary of Alexion conducted preliminary injunction proceedings against Amgen based on market exclusivity rights for the indications aHUS, gMC and NMOSD under Regulation (EC) 141/2000 on orphan medicinal products. The preliminary injunction granted by the Munich Regional Court, was overturned by the Munich Higher Regional Court.

The first instance proceedings

14. Alexion lodged an application for provisional measures against Amgen with the Hamburg Local Division of the Court of First Instance, requesting that the Court order that Amgen, in summary:
    I. cease and desist from infringing claim 2 of the patent at issue;
    II. pay a penalty of € 250,000 for each individual breach of the order under I.;
    III. surrender the infringing products; and
    IV. pay the costs of the proceedings.

15. Amgen requested that the Court, in summary, 1) dismiss the application, 2) order that Alexion bear all legal costs and expenses incurred by Amgen and 3) order that the order is immediately enforceable.

16. By an order without grounds dated 26 June 2024 (hereinafter: the impugned order), the Court of First Instance dismissed Alexion's application, ordered Alexion to pay the costs of the proceedings and set the value of the dispute at € 100,000,000. The grounds of the order were delivered on 17 July 2024. The reasoning of the Court of First Instance can be summarized as follows:
    - The Court is convinced with a sufficient degree of certainty that the patent at issue is infringed by the offer and distribution of the contested product. On summary examination, the contested product makes direct and literal use of the technical teaching of claim 2 of the patent at issue;
    - Claim 2 protects a pharmaceutical composition comprising an antibody with a light chain of SEQ ID No. 4 without the first 22 amino acids;
    - The skilled person would have recognized that the sequence ID NO: 4 of the light chain is not correctly reproduced. The skilled person interpreting patent claim 2 using their general knowledge would have seen that the amino acid sequence at the N-terminus of the SEQ ID NO: 4 shows typical features of a signal peptide. A comparison with the sequence of eculizumab in the CAS database and/or alternatively a search with SignalP would have led the skilled person to the exact length of the signal peptide;
    - This view is supported by technical and functional considerations. On the one hand, the skilled person would have difficulties in producing a corresponding antibody with the signal peptide. If, on the other hand, he were able to produce such an unusual antibody, he would have recognised that it has no binding capacity for C5;
    - This understanding is consistent with the description of the patent at issue. The specification of the patent at issue refers to eculizumab more than 100 times, also making clear that eculizumab is a highly preferred embodiment of the patent at issue;
    - The parts of the grant history of the patent at issue cited by the parties do not shed any new light on this interpretation and are not inconsistent with the Court's interpretation;

- The validity of the patent at issue is not certain to the extent required for the ordering of provisional measures;
- When assessing the likelihood of validity, the Court not only needs to consider the likelihood of invalidity based on its own assessment, but also needs to take into account the likelihood of an invalidity decision on the patent at issue by the EPO. In general, the Court's own assessment and the EPO's decision on the validity of the patent should not differ, as both legal bodies apply the same legal standard. There might be a difference, when the Court interprets a patent claim differently than the EPO, so that the validity arguments are inevitably different;
- Irrespective of the question of whether the Court considers the patent at issue to be valid in light of Amgen's arguments concerning the validity of the patent at issue, it is the opinion of the Court that it is reasonably likely that the EPO will revoke the patent due to lack of sufficient disclosure under Art. 83 EPC;
- The TBA was of the opinion that, based on a literal understanding of claim 2, the patent at issue protects an antibody with the light chain SEQ ID NO: 4. Attempts by Alexion to obtain protection for an antibody consisting of a light chain with SEQ ID NO: 4 without the 22 N-terminus amino acids were expressly rejected. That means that the TBA only approved the "unusual" antibody with a light chain including the 22 N-terminus amino acids. For this antibody, the TBA accepted the assertion of Alexion that "the position of the three respective CDR sequences in SEQ ID NO: 4, which are instrumental for the specific binding properties required by the claim, is sufficiently distanced from the N-terminal signal peptide to dissuade the skilled person from having doubts that this longer light chain would also bind to C5 as required by claim 1". On this assumption, the TBA concluded that the claimed antibody is sufficiently disclosed in the patent at issue.
- However, this assumption can no longer be upheld in the present litigation as Alexion itself is of the opinion that an antibody with the complete SEQ ID NO: 4, i.e. in the presence of the signal peptide, is not functional. On that basis, the technical teaching according to the patent might not be sufficiently disclosed and would likely be revoked by the opposition division. Accordingly, based on the TBA's claim construction and the applicant's own submissions and evidence in these proceedings, there is a substantial probability that granted claim 2 will be regarded as non-patentable by the EPO;
- All attempts by Alexion to correct SEQ ID NO: 4 or to convince the EPO that SEQ ID NO: 4 has to be interpreted without the signal peptide sequence were dismissed. The TBA has also considered several claim requests in family members of the patent in suit, which related to eculizumab as such, but decided that such claims are insufficiently disclosed. Taking all these elements into account, the Court is not at all convinced that the Opposition Division of the EPO will share the opinion of the Court on the question of claim construction and may decide that the patent is invalid;
- The application for provisional measures must therefore be dismissed: an infringement of the patent at issue can be established by the Court; however, it cannot be established to the necessary degree of certainty that the patent at issue is valid.

17. Alexion lodged an appeal against the impugned order. In its amended statement of appeal and statement of grounds of appeal, Alexion submitted the following requests:

Main request

I. The impugned order is revoked;
II. The application for provisional measures is remitted to the panel of the Court of First Instance to which it was previously assigned;
III. Amgen is ordered to pay the costs of the appeal;

Alternative request

I. the impugned order is revoked;
II. Amgen is ordered to cease and desist from infringing claim 2 of the patent at issue;
III. Amgen is ordered to pay a penalty of € 250,000 for each individual breach of the order under II.;
IV. Amgen is ordered to surrender the infringing products;
V. Amgen is ordered to pay the costs of the proceedings.

18. In addition, Alexion requested expedition of the appeal pursuant to Rule 9.3(b) of the Rules of Procedure of the Unified Patent Court (hereinafter: RoP). By order of 30 July 2024, the Court of Appeal rejected this request.

19. The grounds of the appeal can be summarized as follows:
- The Court of First Instance erred when making its decision dependent on a potentially deviating decision that the Opposition Division of the EPO may give in the future, and in basing its assessment on the prediction that the EPO will not follow the claim construction of the Court of First Instance;
- The Court of First Instance also erred in assuming that the Opposition Division might consider the patent at issue to be insufficiently disclosed in future proceedings. The Opposition Division will adopt the same claim construction as the Court of First Instance;
- If the Court of Appeal agrees with Alexion that the Court of First Instance should not have refused the application for provisional measures on conjecture regarding a future decision of the EPO, it should refer the case back to the Court of First Instance. The Court of First Instance has already fully heard detailed arguments on all aspects of validity. In addition, proceeding this way will ensure that Alexion is protected as soon as possible against the continuing infringements.

20. Amgen responded to the appeal, requesting that the Court of Appeal reject the appeal and order Alexion to pay the costs of the appeal proceedings. The reasons can be summarized as follows:
- The main request that Alexion submitted in its amended statement of appeal is inadmissible, because i) it isolates a specific legal question out of the overall legal assessment by the Court

of First Instance, and ii) is a partial withdrawal of the appeal which Alexion initially brought without any limitation;
- Alexion's request to refer the case back to the Court of First Instance for decision is unfounded;
- The Court of First Instance correctly found that the validity of the patent at issue is insufficiently certain;
- The Court of First Instance was entitled to consider the likely decision of the Opposition Division;
- The Court of First Instance correctly inferred the Opposition Division's likely decision on validity;
- The Court of First Instance was correct to find that the EPO would reach the same conclusion on claim construction despite the evidence submitted by Alexion;
- The Court of First Instance was correct to find that the EPO will maintain its position on claim construction;
- The Court of First Instance's claim construction is legally flawed. The clear wording of the claim covers an antibody with the first 22 amino acids of SEQ ID NO:4. The skilled person would not have disregarded precisely amino acids 1-22 of SEQ ID NO:4. The Court of First Instance has prioritized the intended success of the invention over a proper assessment of the skilled person's interpretation of the claims. The Court of First Instance should have taken into account the prosecution history when deciding on claim construction;
- Based on a correct claim construction the Court of First Instance would have found that the patent at issue is not infringed;
- The Court of First Instance failed to recognize that the validity of the patent at issue is not sufficiently certain, irrespective which claim construction the Court of Appeal adopts. The subject-matter of the patent at issue is not enabled, is not novel and does not involve inventive step;
- In addition, the Court of First Instance would have had to dismiss the application in view of interests of Amgen that outweigh the interests of Alexion.

GROUNDS FOR THE ORDER

Subject matter of the appeal

21. Pursuant to R. 222.1 RoP, the subject matter of the appeal is constituted by the requests, facts, evidence and arguments submitted by the parties under R. 221, 225, 226, 236 and 238 RoP, thus including the facts, evidence and arguments submitted by the respondent in the Statement of response.

22. During the oral hearing, Alexion withdrew its main request. The Court of Appeal will therefore only decide on Alexion's alternative request.

23. As the Court of Appeal will consider below, Alexion's alternative request, for revocation of the impugned order and for the grant of provisional measures, must be dismissed on the basis of the facts, evidence and arguments concerning the interpretation and insufficient disclosure of claims 1 and 2 of the patent at issue which Amgen submitted in the Statement of response. The Court of Appeal may therefore leave open whether Alexion's complaints against the impugned order are well-founded.

Claim interpretation

24. The person skilled in the art is a person having a degree in molecular biology and several years of experience in the field of antibody engineering.

25. In this case, the common general knowledge of the person skilled in the art should be considered at the filing date of the patent at issue (15 March 2007), as it is not disputed that the priority claim is not valid.

26. From the perspective of the person skilled in the art, claim 2 protects a pharmaceutical composition comprising an antibody that comprises two structural elements (a heavy chain consisting of SEQ ID NO:2 and a light chain consisting of SEQ ID NO:4) and that, by virtue of these elements, has the ability to bind C5.

27. This understanding is supported by the patent specification, which must always be taken into account when interpreting a patent claim. Par. [0020] mentions that "in certain embodiments, the antibody that binds C5 or an active antibody fragment thereof comprises a heavy and a light chain, wherein the heavy chain consists of SEQ ID NO: 2 and the light chain consists of SEQ ID NO: 4".

28. There is no indication in the patent specification that a part of the light chain can or should be excluded from the SEQ ID NO:4 as defined in par. [0134].

29. These findings are not put into question by the Court of First Instance. Nevertheless, the Court of First Instance interprets claim 2 as excluding the first 22 amino acids of SEQ ID NO:4. Its understanding of claim 2 is based on the assumption that at the relevant date of the patent at issue, the average skilled person would have recognized that the sequence SEQ ID NO:4 is not correctly reproduced, as such person would have realised that the start sequence at the N-terminus has typical features of a signal peptide (impugned order, section II.2.b)). In addition, the average skilled person would have been able to determine the precise length of the signal peptide sequence, as SEQ ID NO:4 is identified in par. [0134] of the patent specification as "Eculizumab light chain". When trying to resolve their initial suspicion that SEQ ID.:NO 4 is erroneous, the average skilled person would have verified the sequence in the CAS database entry for Eculizumab, irrespective of the fact that the sequence of the light chain SEQ ID NO:4 in CAS and the patent differs by one further amino acid. This point of view is supported by the

opinions of Prof. [redacted] (exhibit FBD8), who also refers to Lehninger's textbook on the Principles of Biochemistry (exhibit FBD38a), and Prof. [redacted] (exhibit FBD37).

30. In contrast to these findings of the Court of First Instance, the TBA in its decision of 21 September 2023 rejected Alexion's request to grant the patent with claim 1 excluding the first 22 amino acids of SEQ ID NO:4 (see T 1515/20, par. 2: "… a light chain consisting of residues 23 to 236 of SEQ ID NO: 4"). It based its decision on settled case law of the EPO Boards of Appeal according to which in the case of a proposed amendment under Art. 123(2) EPC or a correction under Rule 139 EPC, it must be established that

    a. It is obvious that the application as filed contains an error which is so obvious that the average skilled person has no doubt that this information is not correct and cannot be meant to read as such. Accordingly, it must be obvious that an error is present and has to be objectively recognisable by the average skilled person using common general knowledge; and
    b. The average skilled person using common general knowledge would directly and unequivocally ascertain the precise proposed correction. The correction of the error should be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (T 1515/20, par. 6).

31. According to the TBA, it was common knowledge that antibodies are secreted proteins produced from precursor light chain and heavy chain polypeptides in cells, which precursors each comprise a signal peptide and a mature polypeptide. The signal peptides are cleaved off in the endoplasmic reticulum of the expressing cell and the mature polypeptide then folds to form the mature protein (T 1515/20, par. 7).

32. However, the TBA was not of the opinion that the statement in the application of "a light chain variable region consisting of SEQ ID NO: 4" and "SEQ ID NO: 4 – Eculizumab Light Chain" constituted such an obvious error that a person skilled in the art would have no doubt that this information is incorrect.

33. The Court of First Instance did not ignore these findings of the TBA. The Court of First Instance, however, stated that the interpretation of a patent claim is not dependent on a no doubt requirement. Rather, the average skilled person, taking the purpose of every patent claim into account, to provide the person skilled in the art with a technical teaching which, if carried out, leads to the intended success of the invention, would recognize that the claimed antibody with the included signal peptide in the light chain SEQ ID NO: 4 is not able to bind to C5. The contrary was asserted by the applicant during the granting procedure without providing any evidence. However, in the present proceedings it is undisputed between the parties that the light chain SEQ ID NO: 4 is not able to bind to C5. The average skilled person would therefore try to interpret the claim in such a way that it leads to the intended success of the invention, in

the case at hand the ability to bind C5 and function as a drug. This includes recognising typical features of a signal peptide sequence at the N-Terminus of SEQ ID NO: 4.

34. These considerations of the Court of First Instance are legally flawed.

35. The patent claim is the decisive basis for determining the protective scope of the European patent and the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim (Court of Appeal 26 February 2024, UPC_CoA_335/2023 App_576355/2023, *NanoString/10x*, p. 26). A linguistic error, a spelling mistake or any other inaccuracy in a patent claim can only be corrected by way of interpretation of the patent claim if the existence of an error and the precise way to correct it are sufficiently certain to the average skilled person on the basis of the patent claim, taking into account the description and the drawings and using common general knowledge.

36. This standard combines adequate protection for the patent proprietor, as it allows the proprietor to correct a linguistic error, a spelling mistake or any other inaccuracy in a patent claim by way of interpretation of the patent claim, with a reasonable degree of legal certainty for third parties, as a correction is only possible if the error and the correction are sufficiently certain to the average skilled person. It is a rather strict standard since an error as such implies some legal uncertainty for third parties.

37. In the present case, the existence of an error and the way to correct it are not sufficiently certain to the average skilled person.

38. The Court of Appeal concurs with the TBA that there are no arguments as to why the average skilled person, in the context of claim interpretation, would be prima facie alerted and consequently prompted to consider and analyse the corresponding sequence in order to determine the presence of particular functional parts/compounds in the unannotated amino acid sequence (T 1515/20, par. 10). Alexion failed to submit such arguments. Alexion refers to the statements of its experts Dr. [redacted] (exhibits FBD 17A, FBD 17B and FBD 17C), Prof. [redacted] (exhibit FBD 37), Prof. [redacted] (exhibit FBD 38) and Prof. [redacted] (exhibit FBD 39) and the expert statement of Prof. [redacted] which Samsung filed in parallel proceedings (submitted in these proceedings by Alexion as exhibit FBD 40), but these statements also do not provide any reasons why the average skilled person would analyse the sequence. The experts were not asked to provide such reasons. Instead, they were presented with statements informing them of the presence of a signal peptide of 22 amino acids in SEQ ID NO: 4 and/or were asked questions that presuppose that the average skilled person would analyse the sequence, such as the question “whether the skilled person could recognize that the sequence of amino acids 1-22 in the light chain SEQ ID NO:4 […] is a so-called signal sequence” (declaration of Prof. [redacted] FBD 37, par. 3).

39. The Court of Appeal also concurs with the TBA in its finding that, even when inspecting the sequence of SEQ ID NO: 4, the average skilled person would not immediately have recognised that the depicted sequence of SEQ ID NO: 4 constituted an error. Instead, the average skilled person could, at most, be caused to doubt that the sequence depicted is the sequence it purports to represent (T 1515/20, par. 11). Alexion's submissions fail to call these findings into question. Alexion argues, on the basis of the expert statements of Dr. [redacted] Prof. [redacted] Prof. [redacted] and Prof. [redacted] (exhibits FBD 17A-C and 37-39), that the average skilled person analysing the light chain SEQ ID NO:4 would have recognised features typical of a signal peptide. However, even if this were the case, the average skilled person would not know whether these amino acids in SEQ ID NO: 4 were an error rather than an unusual part of an antibody.

40. Alexion argues that the average skilled person would consider the inclusion of a signal peptide in the sequence of SEQ ID NO: 4 to be an error, because such person would have known that signal peptides are cleaved off during the production of antibodies by the ordinary cell-based methods. Alexion referred in this context to the expert opinions of Dr. [redacted] (exhibit FBD 17A-C) and Prof. [redacted] (exhibit FBD 38) and to the findings of the TBA in the granting proceedings (T 1515/20, par. 7). On the other hand, Amgen argued, on the basis of the expert statement of Prof. [redacted] (exhibit FBD 40), that the skilled person would be aware of a number of alternative production methods, including the use of E. coli cells as described in Chen (exhibit 2 to FBD 40), which do not result in the cleavage of signal peptides. These alternative approaches may be non-routine for antibody production and may require a significant research effort, as Prof. [redacted] acknowledges. However, patent claim 2 is not limited to pharmaceutical compositions comprising antibodies produced by routine methods. Par. [0074] of the description even expressly states that the production of the antibody by any particular method is *not* required. Furthermore, assuming that the average skilled person would recognise that the first amino acids of sequence of SEQ ID NO: 4 resemble those of a signal peptide, the average skilled person may be aware that unusual production methods are required. Knowledge of the ineffectiveness of routine production methods is therefore not sufficient.

41. Equally insufficient is Alexion's argument, based on the statements of Prof. [redacted] (exhibit FBD 38) and Prof. [redacted] (exhibit FBD 40), that the average skilled person would know that an antibody comprising a light chain consisting of SEQ ID NO:4, including the first 22 amino acids, would "highly likely" not bind C5 due to the presence of hydrophobic amino acids. This submission itself implies that the skilled person would not rule out that the antibody could bind C5 and that he would therefore leave open the possibility that there is no error in SEQ ID NO:4.

42. Moreover, in the proceedings before the TBA, Alexion submitted that the position of the three respective CDR sequences in SEQ ID NO:4 is sufficiently distant from the N-terminal signal peptide to dissuade the skilled person from doubting that this longer light chain would also

bind to C5 as required by the patent claims. This argument was accepted by the TBA, which accordingly concluded that the claimed antibody was sufficiently disclosed in the patent (T 1515/20, par. 35 and 36). This confirms that it is not sufficiently certain for the average skilled person that the longer light chain was an error.

43. The Court of First Instance took the view that Alexion's aforementioned assertions in the proceedings before the TBA must not be considered as Alexion abandoned them and, now in the proceedings before the Court, takes the view that an antibody with the complete SEQ ID NO: 4, including the first 22 amino acids, is not functional. However, this view ignores the fact that the patent claim must be interpreted from the perspective of the person skilled in the art. Alexion's assertion during the grant proceedings, and in particular the TBA's endorsement thereof, can be seen as an indication of the view of the person skilled in the art at the filing date.

44. The fact that the description of the patent at issue makes numerous references to eculizumab, confirms rather than alters this assessment. Alexion argues that the average skilled person would assume that the claimed antibody is the antibody called eculizumab, which according to the description has been used successfully in clinical trials and therefore must be producible in a reliable and economically meaningful manner. However, the description discusses eculizumab in the background art section (par. [0003]) and expressly presents it as an antibody that was known in the prior art (par. [0064]). This is consistent with the average skilled person's common general knowledge that eculizumab was known for years, had gone through clinical trials and was even entered in the CAS database. This is a strong indication to the average skilled person that the patent at issue claims an antibody other than the eculizumab antibodies of the prior art, including the one used in the clinical trials. Secondly, if the average skilled person nevertheless assumed that the patent at issue claims the same antibody, consulting the CAS database for eculizumab would not help to check the accuracy of the sequence. It is common ground that on the filing date of the patent at issue, the CAS database contained an incorrect sequence for eculizumab, with more than 100 additional amino acids. The skilled person would thus find out that the patent at issue claims an antibody other than the antibody known as eculizumab.

45. In addition, it is not sufficiently certain for the average skilled person that the alleged error must be corrected by deleting exactly 22 amino acids from the sequence of SEQ ID NO: 4. Alexion argues that the average skilled person would know the length of the signal peptide. However, its own expert states that the typical length of a signal peptide varies between 13 and 36 amino acids (expert statement of Prof. [redacted] exhibit FBD 38, p. 3). Alexion failed to demonstrate that the average skilled person would know, on the basis of their common general knowledge, that in this case the length is exactly 22 amino acids. The experts argue that the average skilled person would expect a signal peptide of 22 amino acids on the basis of various criteria or their "intuitive assessment", but all assume that the skilled person would

consult a catalogue or database for confirmation. The Court of Appeal can leave open the question of whether the average skilled person, in the context of claim interpretation, can be expected to consult catalogues and databases to check how a perceived error in the claim should be corrected. Even if the average skilled person would do so, it would not be sufficiently certain that the signal peptide consists of 22 amino acids for the following reasons.

46. Alexion refers to Dr. [redacted] catalogue of known signal peptide sequences (Annex D to exhibit FBD 17A), which discloses a sequence identical to the first 22 amino acids of SEQ ID NO: 4. To find this sequence the skilled person would have to search specifically for information on kappa light chains of subgroup I. Alexion failed to demonstrate that the patent discloses that the sequence of SEQ ID NO: 4 comprises a kappa light chain of this subgroup or that this was common general knowledge. Alexion refers to publications by Thomas (Thomas et. al., 'Inhibition of complement activity by humanized anti-C5 antibody and single chain Fv', exhibit FBD 22) and Evans, but does not argue that these publications are part of the common general knowledge and does not show that these publications disclose the specific subgroup. Moreover, even within the relevant subgroup, Kabat discloses signal peptides of different lengths.

47. In addition, Alexion refers to the SignalP and NCBI BlastP databases. However, if the skilled person were to use these databases, he would at best obtain information of statistical relevance, such as a 95,9% probability that the cleavage site is between position 22 and 23 (exhibit FBD 18a). This is not a sufficient degree of certainty, as these statistics still leave open a significant possibility that the signal peptide is of a different length and that thus confirmation by experiments is required. Alexion – correctly – did not argue that the result of such experiments may be taken into account in the context of claim interpretation.

Conclusion

48. It follows that claim 2 must be interpreted as meaning that the claimed pharmaceutical composition comprises an antibody comprising a light chain consisting of SEQ ID NO: 4 including the first 22 amino acids. Based on this claim interpretation, it is more likely than not that the subject matter of claim 2 is insufficiently disclosed within the meaning of Art. 83 EPC. As noted by the Court of First Instance, Alexion itself and its expert Prof. [redacted] have stated that an antibody with the complete SEQ ID NO: 4 does not bind C5 and is not suitable for formulation as a pharmaceutical composition and used as a drug. Therefore, there is not a sufficient degree of certainty that claim 2 of the patent at issue is valid. The decision of the Court of First Instance to dismiss Alexion's application for provisional measures, and to order Alexion to pay the costs of the proceedings, was therefore correct. The Court of Appeal will reject the appeal.

49. As the unsuccessful party, Alexion must bear the costs of the appeal proceedings.

ORDER

I. The appeal is rejected;

II. Alexion is required to bear the costs of the appeal proceedings.

This order was issued on 20 December 2024.

Klaus Grabinski President of the Court of Appeal	KLAUS STEFAN MARTIN Grabinski Digitally signed by KLAUS STEFAN MARTIN Grabinski Date: 2024.12.20 08:15:28 +01'00'
Peter Blok Legally qualified judge and judge-rapporteur	Peter Hendrik Blok Digitally signed by Peter Hendrik Blok Date: 2024.12.20 09:25:58 +01'00'
Emmanuel Gougé Legally qualified judge	EMMANUEL, LUCIEN, RENÉ GOUGÉ Digitally signed by EMMANUEL, LUCIEN, RENÉ GOUGÉ Date: 2024.12.19 19:33:44 +01'00'
Eric Enderlin Technically qualified judge	Eric, André Enderlin Signature numérique de Eric, André Enderlin Date : 2024.12.19 19:20:22 +01'00'
Anna Hedberg Technically qualified judge	Anna Hedberg Digitally signed by Anna Hedberg Date: 2024.12.19 14:36:30 +01'00'