Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Local Chamber Munich

UPC_CFI_390/2023

Main decision

of the Court of First Instance of the Unified Patent Court issued on

13 September 2024

Guiding principles:

1. The protective claim determined from the description and the drawings can only be the subject of the patent claim if it is also expressed in the claim.

2. If several embodiments are presented in the description as being in accordance with the invention, the terms used in the patent claim are, in case of doubt, to be understood in such a way that all embodiments can be used to fulfil them.

3. An infringer of a patent within the meaning of the UPCA is the person who appears as the manufacturer or supplier or gives the impression to the relevant public that he is the person who manufactures and/or sells the goods in his own name and for his own account.

4. If a company infringes a patent, an injunction pursuant to Art. 63 para. 1 sentence 2 UPCA (injunction against intermediaries) may be issued with regard to the organs of the company.

PLAINTIFF AND COUNTER-DEFENDANT

Koninklijke Philips N.V.,

represented by:
Dr Philipp Cepl, Dr Constanze Krenz, Dr Benedikt Hammerschmid, Dr Carl Prior

- hereinafter referred to as the "Plaintiff" -

DEFENDANTS AND COUNTERCLAIMANTS

1. **Stephen George Edrich,** Managing Director of Belkin GmbH, with registered office at Otto-Hahn-Str. 20, 85609 Aschheim, Germany
2. **Belkin GmbH,** legally represented by its Managing Director, Otto-Hahn-Str. 20, 85609 Aschheim, Germany
3. **Belkin International, Inc.,** legally represented by its Chief Executive Officer (CEO)55 Aviation Boulevard, Suite 180, El Segundo, California 90245, USA
4. **Belkin Limited,** legally represented by its directors, Unit 1, Regent Park Booth Drive, Park Farm Industrial Estate, Wellingborough, Northamptonshire, England, NN8 6GR, United Kingdom
5. **Cooper Marc Gary,** Director of Belkin Limited, trading at Unit 1, Regent Park Booth Drive, Park Farm Industrial Estate, Wellingborough, Northamptonshire, England, NN8 6GR, United Kingdom
6. **McKenna Paul John,** Director of Belkin Limited, whose registered office is at Unit 1, Re- gent Park Booth Drive, Park Farm Industrial Estate, Wellingborough, Northamptonshire,
   England, NN8 6GR, Great Britain

   represented by: Dr Tilman Müller

- hereinafter referred to as the "Defendant" -

PATENT IN SUIT

Patent no.	*Patent holder*
EP 2 867 997 B1	Koninklijke Philips N.V.

JUDGE

Presiding Judge	**Dr Matthias Zigann**
Legally qualified judge	**Edger Brinkman**
Technically qualified judge	**Dr Anders Hansson**
Rapporteur	**Tobias Pichlmaier**

LANGUAGE OF THE PROCEEDINGS:	GERMAN
NEGOTIATION:	2 JULY 2024
DECISION:	13 SEPTEMBER 2024

Facts of the case

The plaintiff is suing the defendants for infringement of the European patent EP 2 867 997 B1 (patent in suit).

The patent in suit was filed under the title

"Wireless inductive power transmission"

on 20 June 2013, claiming the priority of the US application US 201261665989 P of 29 June 2012 and the priority of the European application EP 13162077 of 3 April 2013 as international application PCT/IB2013/055073. The grant of the European patent was published on 28 December 2016.

Claim 20 of the patent in suit, asserted in the infringement action, is in the language in which the patent was granted (English):

> A power transmitter (101) for an inductive power transfer system, the inductive power transfer system supporting two-way communication between the power transmitter (101) and a power receiver (105) based on modulation of a power signal, the power transmitter comprising: means for generating the power signal; means for receiving a signal strength package from the power receiver (105) initiating a mandatory configuration phase; means for operating the mandatory config- uration phase (507) wherein a first set of power transfer operating parameters are selected for the power transmitter (101) and the power receiver (105); means for receiving a request to enter the requested negotiation phase from the power receiver (105); characterised in further comprising means for acknowledging (511) the request to enter a requested negotiation phase by transmitting an acknowledgement to the power receiver (105); the acknowledgement being indicative of an accept or rejection of the request to enter the requested negotiation phase; means for entering the requested negotiation phase in response to receiving the request to enter the requested negotiation phase; and means for operating (513) the requested negotiation phase wherein a second set of power transfer operating parameters are selected for the power transmitter (101) and the power receiver
> (105) ; wherein, when in the negotiation phase (513, 515), the power transmitter
> (101) is arranged to determine the second set of power transfer operating parameters in a number of negotiation cycles, each negotiation cycle comprising the

power transmitter (101) receiving from the power receiver (105) a message speci- fying at least one of the operating parameters and the power transmitter (101) re- sponding with a message accepting or rejecting the at least one operating param- eter.

In the German language version, the claim reads:

A power transmitter (101) for an inductive power transmission system, wherein the inductive power transmission system provides two-way communication between the power transmitter (101) and the power transmitter (101) based on modulation of a power signal.
(101) and a power receiver (105), wherein the power transmitter comprises: means for generating the power signal; means for receiving a signal strength packet from the power receiver (105) to initiate a mandatory configuration phase; means for performing the mandatory configuration phase (507), wherein a first set of power transmission operating parameters is selected for the power transmitter (101) and the power receiver (105); means for receiving a request to enter the requested negotiation phase from the power receiver (105); characterised in that it further comprises: means for confirming (511) the request to enter a requested negotiation phase by transmitting a confirmation to the service recipient (105); wherein the confirmation is indicative of an acceptance or rejection of the request to enter the requested negotiation phase; means for entering the requested negotiation phase in response to receipt of the request to enter the requested negotiation phase; and means for performing (513) the requested negotiation phase, wherein a second set of service transfer operating parameters for the service sender (101) and the service receiver (105) is indicative of an acceptance or rejection of the request to enter the requested negotiation phase.
(105) is selected; wherein, when in the negotiation phase (513, 515), the power transmitter (101) is arranged to determine the second set of power transfer operating parameters in a number of negotiation cycles, wherein in each negotiation cycle the power transmitter (101) receives a message from the power receiver (105) in which at least one of the power transfer operating parameters is specified and the power transmitter (101) responds with a message in which the at least one power transfer operating parameter is specified, in which at least one of the power transfer operating parameters is specified, and the power transmitter (101) responds with a message in which the at least one power transfer operating parameter is accepted or rejected.

The plaintiff is the registered proprietor of the patent in suit.

Defendants 2) to 4) are companies from the Belkin Group, which has its headquarters in the USA. Defendant 3) is the parent company of the Belkin Group and is headquartered in California. Defendant 2) is a German subsidiary and Defendant 4) is a British subsidiary of the Belkin Group. Defendant 1) is the managing director of defendant 2). He is also a director of defendant 4). Defendants 5) and 6) are each directors of defendant 4).

Defendant 2) filed an action for revocation against the patent in suit with the Federal Patent Court on 10 March 2022. The nullity action was dismissed in a judgement dated 12 July 2024 (Ref. 4 Ni 40/22 (EP)). The judgement is not final.

On 10 August 2019, the plaintiff brought an action against the defendants 2) and 4) before the Düsseldorf Regional Court for infringement of the German part of the patent in suit in Germany. By judgment of 20 March 2023, the Düsseldorf Regional Court dismissed the action (case no. 4a O 49/22). On 18 April 2024, the Düsseldorf Higher Regional Court dismissed the appeal against this judgement as inadmissible on the grounds that the notice of appeal did not comply with the legally prescribed form (case no. I-2 U 59/23).

The plaintiff has granted Renesas Electronic Corporation a licence to manufacture and distribute chips designed for inductive power transmission, whereby the licence also covers the manufacture and distribution of such chips by affiliated companies of Renesas Electronic Corporation.

Chargers for wireless charging of electronic devices are offered via the website "www.belkin.com" (Annex BP 1d; attacked embodiments). The challenged embodiments are power transmitters for inductive power transmission to a power receiver, which fulfil the requirements of the "Extended Power Profile (EPP)" of the Qi standard and are certified as compatible with this standard. According to the standard, the attacked embodiments can receive a so-called configuration packet from the power receiver, which comprises a value designated as "Neg" in the standard (Interface Standard, p. 94, section 5.2.3.7; see figure below).

Table 34. Message in a Configuration Packet

	b_7	b_6	b_5	b_4	b_3	b_2	b_1	b_0
B_0	Power Class		Maximum Power Value					
B_1	Reserved							
B_2	Prop	Reserved			ZERO	Count		
B_3	Window Size					Window Offset		
B_4	Neg	Polarity*	Depth*		Reserved			

This value, which consists of one bit, can be either 0 or 1. If the bit is set to 0, the power transmitter skips the negotiation phase and starts the power transmission immediately. If the bit is set to 1, the power transmitter sends an acknowledgement and enters the negotiation phase (see Interface Standard, p. 55, section 5.1.2.3).

The plaintiff claims that the devices for wireless charging of electronic devices offered via the website "www.belkin.com" infringe the patent in suit; the defendants are responsible for the infringing acts. The asserted claim for injunctive relief is based on Art. 64 EPC, Art. 25 (a), 63 (1) UPCA.

Independent liability of the defendants 1), 5) and 6) arises in each case from their activities as managing directors or directors; despite knowledge of the infringing acts, they did nothing against the infringement and deliberately failed to use the possibilities available to them by virtue of their office to prevent infringements of third-party property rights.

The plaintiff **has claimed,**

A. order the defendants to pay the costs,

I. to refrain from doing so,

Power transmitter for a system for inductive power transmission

in the Federal Republic of Germany (DE), Belgium (BE), France (FR), Finland (FI), Italy (IT), the Netherlands (NL), Austria (AT) and Sweden (SE), to offer, place on the market, use or either import or possess for the aforementioned purposes,

wherein the inductive power transmission system supports two-way communication between the power transmitter and a power receiver based on modulation of a power signal,

whereby the power transmitter includes the following:

Means for generating the power signal;

Means for receiving a signal strength packet from the service recipient to initiate a mandatory configuration phase;

Means for performing the mandatory configuration phase, wherein a first set of power transmission operating parameters is selected for the power transmitter and the power receiver;

Means for receiving a request to enter the requested negotiation phase from the service recipient;

characterised in that it further comprises:

Means for confirming the request to enter a requested negotiation phase by transmitting a confirmation to the service recipient; wherein the confirmation is indicative of an acceptance or rejection of the request to enter the requested negotiation phase;

means to enter the requested negotiation phase in response to receiving the request to enter the requested negotiation phase; and

means for performing the requested negotiation phase, wherein a second set of power transfer operating parameters is selected for the power transmitter and the power receiver; wherein, when in the negotiation phase, the power transmitter is arranged to determine the second set of power transfer operating parameters in a number of negotiation cycles, wherein in each negotiation cycle the power transmitter receives from the power receiver a message specifying at least one of the power transfer operating parameters, and the power transmitter responds with a message accepting or rejecting the at least one power transfer operating parameter,

(direct infringement of claim 20 of EP 2 867 997 B1)

if the power transmitter uses chips for inductive power transmission other than those manufactured and/or sold by Renesas Electronics Corporation or its affiliates.

II. to recall the infringing products pursuant to Section A.I. from the distribution channels at its own expense, to remove them permanently from the distribution channels and to destroy them;

III. to provide the plaintiff with information on the extent to which they have committed the acts described under A.I. since 28 December 2016, stating

1. the origin and distribution channels of the products referred to in point I, stating

a. the names and addresses of suppliers and other previous owners, and

b. the names and addresses of the commercial customers and the sales outlets for which the products were intended;

2. the quantity of products delivered, received or ordered and the prices paid for the products concerned; and

3. the identity of all third parties involved in the distribution of the products referred to in Section A.I,

whereby copies of the corresponding purchase documents (namely invoices, alternatively delivery notes) must be submitted as proof of the information, whereby details requiring confidentiality outside the data subject to disclosure may be blacked out;

IV. to pay the plaintiff an amount of EUR 119,000 as provisional damages.

B. The defendants are obliged to compensate the plaintiff for all damages that she has suffered and will suffer as a result of the acts listed under A.I. committed since 28 December 2016.

C. The plaintiff is authorised, at the defendant's expense, to announce and publish the decision in whole or in part in public media, in particular on the internet.

D. In the event of any violation of the orders under section A., the respective defendant shall pay to the court a penalty payment of up to EUR 100,000 for each day of violation of order A.I. up to EUR 50,000 for each day of violation of order A.II. up to EUR 10,000 for each day of violation of order A.III.

E. Orders the defendants to pay the costs.

F. The judgement is immediately enforceable. In the event that security is ordered, the plaintiff is authorised to provide this also in the form of a bank or savings bank guarantee, and the amount of the security is to be determined by the court.

separately for the individual enforceable parts of the judgement, whereby the following individual amounts are proposed:

Omission: EUR 1,500,000 Recall &

removal: EUR 400,000 Information:

EUR 100,000

Provisional damages: EUR 119,000

G. The motions under A. I., II. and III. as well as under B. are made with the proviso that all acts of the defendants under 2) and 4) as well as the legal consequences of such acts in the territory of the Federal Republic of Germany are excluded from the motions.

The defendants are of the opinion that the proceedings are not admissible pursuant to Rule 295 (1) EPG- VerfO in conjunction with Art. 29 (30) EuGVVO. Art. 29, 30 Brussels I Regulation due to the parallel nullity and infringement proceedings pending in Germany (BPatG, Ref. 4 Ni 40/22 (EP); OLG Düsseldorf, Ref. I-2 U 59/23). The application for suspension should be examined with priority over the actual substantive applications.

The infringement action was to be dismissed as unfounded due to the lack of realisation of features 20.6 and 20.6.1 of claim 20 of the patent in suit.

The defendants are also of the opinion that the patent in suit should be declared invalid due to the grounds of invalidity of the impermissible extension compared to the documents originally filed, the lack of practicability and the lack of patentability. The subject-matter of the contested independent patent claims was inadmissibly extended compared to the disclosure of the international application of 20 June 2013 and was not disclosed in the patent specification in dispute so clearly and completely that a person skilled in the art could carry it out. The subject matter of the contested independent patent claims according to the patent in suit is not new compared to the prior art and is in any case not based on an inventive step. The plaintiff bases its arguments on the following documents:

- D1: EP 2 712 051 A2

- D2: US 2010/0013319 A1

- D3: EP 2 793 355 A1
- D4: Qi standard in version 1.0
- D5: "Modelling Analysis of Wireless Power Transmission System", Koulian Jiang and Jingwen Zhao
- D6: US 2010/0083012 A1

The defendants then **filed a complaint,**

I. to stay the proceedings pursuant to Rule 295 (1) UPC Regulation in conjunction with Art. Art. 29, 30 Brussels I Regulation;

II. dismiss the action;

III. The European patent EP 2 867 997 be declared invalid with effect for the Contracting Member States Germany, Belgium, France, Finland, Italy, the Netherlands, Austria and Sweden, with the application being made on behalf of the defendant and counterclaimant 2) (Belkin GmbH) subject to the proviso that the declaration of invalidity with effect for the territory of the Federal Republic of Germany is excluded;

IV. order the applicant to pay the costs of the proceedings, including the costs of the appeal;

V. declare the judgement enforceable immediately on account of the costs, alternatively against security (deposit or bank guarantee with a European bank).

The plaintiff **has responded** to this**,**

1. Dismiss the defendant's application for a stay of proceedings pursuant to R. 295 (l) of the Brussels Convention in conjunction with Art. Art. 29, 30 Brussels I Regulation;

2. dismiss the counterclaims for annulment of EP 2 867 997 with costs;

in the alternative to 2:

3a. dismiss the counterclaims for a declaration of invalidity of EP 2 867 997 with costs, insofar as they go beyond the version of the patent in suit according to

(i) Auxiliary request 1 - submitted as Annex HA 1 and in German translation as Annex HA 1a;

(ii) Auxiliary request 2 - submitted as Annex HA 2 and in German translation as Annex HA 2a;

(iii) Auxiliary request 3 - submitted as Annex HA 3 and in German translation as Annex HA 3a;

(iv) Auxiliary request 4 - submitted as Annex HA 4 and in German translation as Annex HA 4a;

The requests for amendment of the patent in suit are submitted in the order of their numbering (ascending) and as closed sets of requests;

3b. to grant the requests announced in the statement of claim for infringement of the patent in suit against the defendants 1) to 6) with the proviso that the wording of claim 20 reproduced there on page 8 et seq. in the request under A. I. is drafted in accordance with the auxiliary request considered by the Chamber to be legally valid.

The plaintiff is of the opinion that the subject matter of the patent in suit in the granted version does not go beyond the documents originally filed, is so clearly and completely disclosed that a person skilled in the art can carry it out, is new compared to the prior art and is also based on an inventive step. Furthermore, the subject matter of the patent in suit was patentable at least in one of the defended versions according to the auxiliary requests filed.

The defendants have **responded** to this,

I. the action must also be dismissed insofar as patent infringement is sought on the basis of claim 20 in the form of the auxiliary requests;

II. counterclaiming that the European patent EP 2 867 997 be declared invalid in its entirety with effect for the Contracting Member States Germany, Belgium, France, Finland, Italy, the Netherlands, Austria and Sweden, also in the version of auxiliary requests 1 to 4, whereby the request is made for the defendant and counterclaimant 2) (Belkin GmbH) with the proviso that the declaration of invalidity with effect for the territory of the Federal Republic of Germany is excluded.

In the reply to the counterclaim, the defendants based the lack of inventive step on further citations (D7: US 7,671,559 B2; D8: WO 2012/049582 A1); D8 was submitted with regard to the auxiliary requests made by the plaintiff. In addition, the defendants submitted legal opinions on directors' and officers' liability in France, Italy, Sweden, the Netherlands and Austria (Annexes B 6a to B 6e) in a submission dated 11 March 2024.

With reference to this, the plaintiff criticised the new submission in the reply as being late and therefore **responded** to the action for annulment in the duplicate,

1. to disregard the legal opinions in Annexes B 6a to B 6e submitted by the defendants in their statement of 15 March 2024 and the defendants' submission in this regard in the same statement;

2. to disregard the citations US 7,671,559 B2 and WO 2012/049582 A1 in Annexes D7 and D8 submitted by the defendants in their pleading of 15 March 2024 and the defendants' submission in this regard in the same pleading;

in the alternative to point 2:

3a. to allow auxiliary requests 5 and 6 submitted with the present pleading pursuant to Rule 30(2) of the Rules of Procedure, and

3b. dismiss the counterclaims for revocation of EP 2 867 997 with costs insofar as they concern the version of the patent in suit according to one of the auxiliary requests submitted with the reply and rejoinder to the counterclaim for revocation of the patent in suit and according to

(v) Auxiliary request 5 - submitted as Annex BP HA 5 (German translation as Annex BP HA 5a)

(vi) Auxiliary request 6 - submitted as Annex BP HA 6 (German translation as Annex BP HA 6a)

Both auxiliary request 5 and auxiliary request 6 for amendment of the patent in suit are submitted as a closed set of claims in the ascending order of the numbering of the auxiliary requests.

The defendants r e s p o n d e d to this with a reply to the action for revocation and **a** reply to the application for amendment of the patent,

1. not to admit auxiliary requests 5 and 6 (request 3a from the statement of the counter-defendant dated 11 April 2024);

2. in the alternative, in the event that the request under 1. In the alternative, in the event that the application under 1. is rejected, the European patent EP 2 867 997 is to be declared invalid in its entirety with effect for the Contracting Member States Germany, Belgium, France, Finland, Italy, the Netherlands, Austria and Sweden, also in the form of auxiliary requests 5 and 6, whereby the application is made for the defendant and counterclaimant under 2) (Belkin GmbH) with the proviso that the declaration of invalidity with effect for the territory of the Federal Republic of Germany is excluded.

3. likewise, in the alternative, in the event that the application pursuant to No. 1 is rejected, to dismiss the action also insofar as patent infringement on the basis of claim 20 in the form of auxiliary claims 5 and 6 is sought;

4. not to admit the counter-defendant's submission on the sub-claims in the statement of 11 April 2024;

5. in the alternative, in the event that the application is rejected pursuant to item 4, to allow the following submission under item D. on the sub-claims;

6. the applications under 1. and 2. from the statement of the counter-defendant dated
11 April 2024 to be rejected;

7. not to take into account the late submission of the counter-defendant in the counter-defendant's statement of 9 January 2024, there No. I., p. 21 - p. 40, insofar as it refers to other countries such as Germany.

The defendants have further **claimed**,

1. to recognise the judgment of the Düsseldorf Higher Regional Court, served on the defendant on 18 April 2024, case no. I- 2 U 59/23, pursuant to Art. 36 (1), (3) Brussels I Regulation;

2. in the alternative, in the event that the court does not wish to recognise the decision, to refer the question to the Court of Justice of the European Union by way of preliminary ruling proceedings as to whether, in a case such as the present one, Union law must be interpreted to the effect that the judgment of the Düsseldorf Higher Regional Court, served on the defendant on 18 April 2024, case no. I- 2 U 59/23, must be recognised pursuant to Art. 36 Brussels I Regulation, with the consequence that the liability of the defendants 1), 5) and 6) is excluded in any event.

For further details of the facts and the dispute, reference is made to the written submissions exchanged between the parties, including annexes, and to their submissions at the hearing on 2 July 2024.

Reasons

A.

The defendant's application for suspension is rejected.

1. A stay of proceedings due to pending nullity proceedings in Germany cannot be considered.

   In support of their request for a stay, the defendants invoke Art. 30 Brussels I Regulation and consider a stay to be necessary in order to avoid contradictory decisions with regard to the German part of the patent in suit.

   A first-instance decision by the Federal Patent Court regarding the German part of the patent in suit has now been issued. The grounds for the application for a stay in the statement of defence that a decision by the Federal Patent Court is to be expected in the foreseeable future are therefore outdated.

   Thus, a reason for a stay exists at most with regard to a possible decision of the Federal Court of Justice in the German nullity proceedings. Pursuant to Rule 295 (a) UPC Rules of Procedure, in the event that the defendant 2) appeals against the judgement of the Federal Patent Court to the Federal Court of Justice, a decision of the Federal Court of Justice is also not to be expected in the short term; the requirements of Rule 295 (a) UPC Rules of Procedure are therefore not met.

   A stay pursuant to Rule 295 (l) UPC Rules of Procedure, Art. 30 (1) Brussels I Regulation is also not appropriate - insofar as these are applicable at all in addition to the special Rule 295 (a) UPC Rules of Procedure. According to Art. 32 UPCA, the UPC has exclusive jurisdiction for actions for a declaration of invalidity. In addition, the jurisdiction of the Federal Patent Court and the Federal Supreme Court is limited to the German part of a European patent, whereas decisions of the UPC on the legal status of a European patent under Art. 34 UPCA apply to the territory of all contracting member states for which the patent has effect.

2. A stay of proceedings due to parallel infringement proceedings pending in Germany is also out of the question.

   In the infringement proceedings against the defendants 2) and 4), the plaintiff's appeal was dismissed as inadmissible by decision of the Düsseldorf Higher Regional Court on 18 April 2024. This means that there are no longer any infringement proceedings pending in Germany. The defendants do not assert - beyond the application pursuant to Art. 36 Brussels I Regulation - that the res judicata effect of the decision of the Higher Regional Court of Düsseldorf could prevent a decision in the present proceedings; a conflicting res judicata effect with regard to defendants 2) and 4) is excluded in view of the application under G.

B.

The patent in suit is legally valid in the granted version. The counterclaims for a declaration of invalidity of the patent in suit were therefore to be dismissed.

I. Specialist

The person responsible for assessing the patent-compliant teaching is a graduate engineer in electrical engineering or a corresponding master's degree with practical experience in the field of inductive power transmission, in particular for charging secondary devices. The person skilled in the art is also familiar with the content of the relevant standards, in particular Qi specifications 1.0 (July 2010), 1.0.1 (October
2010) and 1.1 (March 2012).

II. Subject matter of the patent in suit

The invention relates to an inductive power or power transmission system, in particular based on the Qi specification applicable at the time of priority, in which communication takes place between the power transmitter and the power receiver in order to prepare and control the power transmission (patent in suit, paragraphs [0001] to [0008]).

Inductive power transmission is used to charge the batteries of a portable and mobile device (e.g. mobile phone, tablet, media player) or to supply them directly with energy (Para. [0002]).

The patent in suit further explains that there are various problems with the known solutions according to the Qi specifications (versions 1.0 and 1.1), in particular that the power or power transmission is limited to 5 W (para. [0010], [0011], [0029], [0061] to [0063], [0135]) and communication is only possible unidirectionally from the power or power receiver to the power or power transmitter (para. [0013] to [0016]), even if there have already been attempts at bidirectional communication (para. [0017], [0031]).

Until now, all service or service transmitters had to be able to fulfil all requirements by any service or service recipient. This approach impedes or prevents further development, as it leads to a loss of backward compatibility (para. [0030], [0033]).

It is desirable to achieve extended functionality, greater flexibility, easier implementation, improved backward compatibility and improved performance (para. [0029] and [0039]).

Accordingly, the patent in suit formulates the task of mitigating, reducing or eliminating one or more of the described disadvantages individually or in any combination (para. [0040]).

1. Patent claims

According to the patent in suit, the problem is to be solved by a system for inductive power or power transmission according to patent claim 19 and a power or power transmitter according to patent claim 20. In the context of the infringement action, only patent claim 20 is asserted.

Patent claims 19 and 20 can be structured as follows: Claim

19:

19.1 System for inductive power transmission, comprising a transmitter (101) and a power receiver, wherein

19.2 the power transmitter (101) is arranged to generate a wireless power signal for the power receiver (105), and

19.2.1 the inductive power transmission system is arranged to support two-way communication between the power transmitter (101) and the power receiver (105) based on modulation of the power signal, and wherein

19.3 the power receiver (105) is set up such that it initiates a mandatory confi guration phase by transmitting a signal strength packet to the power transmitter (101);

19.4 the power transmitter (101) and the power receiver (105) are set up to perform the mandatory configuration phase (505, 507), whereby

19.4.1 a first set of power transmission operating parameters is selected for the power transmitter (101) and the power receiver (105);

19.5 the service recipient (105) is set up to transmit a request to enter a requested negotiation phase;

characterised in that

19.6 the power transmitter (101) is set up such that it confirms the request to enter the requested negotiation phase by transmitting a confirmation to the power receiver (105),

19.6.1 where the confirmation indicates an acceptance or rejection of the request to enter the requested negotiation phase;

19.7 the power transmitter (101) is arranged to enter the requested negotiation phase in response to receiving the request to enter the requested negotiation phase;

19.8 the service recipient (105) is arranged to enter the requested negotiation phase in response to receiving the confirmation from the service sender (101) when the confirmation indicates an acceptance of the request to enter the requested negotiation phase;

19.9 the power receiver and the power transmitter are arranged to determine a second set of power transfer operating parameters by performing the requested negotiation phase (513,515); wherein

19.9.1 the requested negotiation phase is performed (515), wherein a second set of power transfer operating parameters is selected for the power sender (101) and the power receiver (105); wherein,

19.9.2 in each negotiation cycle, the power receiver (105) transmits a message in which at least one of the power transfer operating parameters is specified, and the power transmitter (101) responds with a message in which the at least one power transfer operating parameter is accepted or rejected.

Claim 20:

20.1 Power transmitter (101) for a system for inductive power transmission,

20.1.1 wherein the inductive power transmission system supports two-way communication between the power transmitter (101) and a power receiver (105) based on modulation of a power signal, the power transmitter comprising:

20.2 Means for generating the power signal;

20.3 Means for receiving a signal strength packet from the service recipient (105) to initiate a mandatory configuration phase;

20.4 Means for carrying out the mandatory configuration phase (507), wherein

20.4.1 a first set of power transmission operating parameters is selected for the power transmitter (101) and the power receiver (105);

20.5 Means for receiving a request to enter the requested action phase from the service recipient (105); characterised in that it further comprises:

20.6 Means for confirming (511) the request to enter a requested negotiation phase by transmitting a confirmation to the service recipient (105);

20.6.1 where the confirmation indicates an acceptance or rejection of the request to enter the requested negotiation phase;

20.7 means to enter the requested negotiation phase in response to receipt of the request to enter the requested negotiation phase; and

20.8 Means for performing (513) the requested negotiation phase, wherein a second set of power transfer operating parameters is selected for the power transmitter (101) and the power receiver (105);

20.8.1 wherein, when in the negotiation phase (513, 515), the power transmitter (101) is arranged to determine the second set of power transfer operating parameters in a number of negotiation cycles,

20.8.2 wherein in each negotiation cycle the power transmitter (101) receives from the power receiver (105) a message specifying at least one of the power transfer operating parameters, and the power transmitter (101) responds with a message accepting or rejecting the at least one power transfer operating parameter.

2. Interpretation

Claim 20 of the patent in suit is to be interpreted as follows:

When interpreting the patent claim from the point of view of a person skilled in the art, the claim is not only the starting point, but the decisive basis for determining the scope of protection of a European patent. The interpretation of a patent claim does not depend solely on its exact wording in the linguistic sense; rather, the description and the drawings must always be taken into account as explanatory aids for the interpretation of the patent claim and not only be used to resolve any ambiguities in the patent claim. However, this does not mean that the patent claim merely serves as a guideline and that its subject-matter also extends to that which, after examination of the description and the drawings, appears to be protected by the patent proprietor (UPC_CoA_335/2023). As set out in the Protocol to Art. 69 EPC, when interpreting a patent claim, a balance must be struck between appropriate legal certainty for third parties and adequate protection for the patent proprietor.

The skilled person reads the claim in a way that is technically meaningful and takes into account the entire disclosure of the patent. Claims are read with a willingness to understand them in context ("...with a mind willing to understand...", see e.g. EPO, decision of 6 June 2010, EPO, decision of 6 June 2010, EPO, decision of 6 June 2010, EPO, EPO, EPO, EPO, EPO, EPO.

March 2001, Ref. T 190/99). The same applies to the description and the drawings, whereby their purpose must be taken into account, namely to describe or illustrate the basic concept of a claimed invention by means of detailed examples.

However, the request for protection determined from the description and the drawings can only be the subject of the patent claim if it is also expressed in the claim.

Based on this, the skilled person understands claim 20 as follows:

a. The patented system for inductive power transmission from a power transmitter ("charging station") to a power receiver ("end device") requires a power transmitter with the following characteristics:

aa. On the one hand, the patented power transmitter is intended to fulfil the functions described in features 20.3 to
20.4.1 and already known from the Qi standard applicable at the time of priority. According to the wording of the claim, this phase must be carried out "mandatorily" by the power transmitter when it receives a signal strength packet from a power receiver, with which the configuration phase is initiated; in the configuration phase initiated in this way, a set of power transmission operating parameters is then selected for the power transmitter and the power receiver. The configuration phase is used to configure the power transmitter using the parameters transmitted by the receiver.

bb. On the other hand, the patented power transmitter should be able to carry out the **negotiation phase** described in features 20.5 to 20.8.2.

(1.) According to the Qi specification valid at the time of priority, the configuration phase is followed by the power transfer phase. However, in contrast to the Qi specification valid at the time of priority, the configuration phase can also be followed by a negotiation phase before the power transfer phase takes place. During such a negotiation phase, further parameters can be agreed between the power transmitter and the power receiver, provided that both fulfil the Qi specification.

support the relevant functions with these parameters. According to the description, this is intended to further develop the Qi standard so that corresponding systems perform more than is defined by the Qi specification applicable at the time of priority ("enhanced functionality"; see, for example, paragraph [0120] of the patent in suit). This can be, for example, a higher power level for power transmission (see paragraphs [0160] and [0161] of the patent in suit, in which the example is chosen that a power level of 10 W instead of 5 W is requested) or parameters for communication (see paragraphs [0158] and [0159] of the patent in suit).

(2.) While the Qi specification in force at the priority date only provides for unidirectional communication from the power receiver to the power transmitter, patent-compliant power transmitters must support two-way communication between the power transmitter and a power receiver (feature 20.1.1 of the patent in suit), because entry into the patent-compliant negotiation phase takes place through **bidirectional communication** between the two devices.

(3.) Features 20.5, 20.6 and 20.6.1 describe the means that must be available to the service sender in order to be able to enter this negotiation phase. According to the patented system, the negotiation phase is preceded by a phase in which the negotiation phase is initiated.

The negotiation phase is **initiated** by the service recipient through a **request** to enter the negotiation phase; consequently, the service sender requires means to receive this request (feature 20.5). Before the negotiation phase can be entered, the service sender must accept the request to enter the negotiation phase ("**acceptance**", feature 20.6.1 of the patent-in-suit) by means of bidirectional communication with the service recipient. In this way (request and acceptance), the service recipient and the service sender "agree" to enter the negotiation phase.

(4.) Since this process is a two-way communication, the service sender receives a request from the service recipient and the service recipient receives an acceptance from the service sender if the negotiation phase is to be entered into. Such an acceptance of the request to enter the requested negotiation phase is transmitted to the service recipient by means of a confirmation.

In the grant proceedings to which the defendants referred (for consideration of the grant proceedings in the interpretation, see the order of the Local Division Munich of 20 December 2023; UPC_CFI_292/2023), based on the original wording of the version applied for, there were

> "...the power receiver (105) is arranged to transmit a request to enter a requested negotiation phase;
> the power transmitter (101) is arranged to acknowledge the request to enter the requested negotiation phase by transmitting an acknowledgement to the power receiver (105);..."

The patentability of the request apparently required clarification insofar as the corresponding feature ("...to acknowledge the request... by transmitting an acknowledgement...") was understood to mean that the power transmitter merely acknowledged receipt of the request. However, the originally submitted application documents (submitted as Annex B3) state:

> "If the power transmitter 101 supports negotiation, it acknowledges the reception of the request and accepts the request by sending an accept message. This acknowledge/accept message may in some embodiments be transmitted following the configuration phase, i.e. in the time interval follow- ing the configuration phase and before the power transfer phase would oth- erwise begin. The power transmitter 101 then proceeds to enter the negotia- tion phase. If the power receiver 105 receives the accept messages within a certain time, it also proceeds to the negotiation phase (p. 33, lines 11-17).
>
> If the power receiver 105 requests the negotiation phase, but the power transmitter 101 does not support the negotiation phase, the power transmitter 101 acknowledges the reception of the request and informs the power

> receiver 105 of the rejection of the request by sending a reject message (p. 33, lines 22-26).

The wording in feature 20.6.1 was intended to clarify that the receipt of the request is not only confirmed, but that the request is also answered in terms of content (acceptance or rejection). In a letter dated 10 February 2014, the applicant declared this to the EPO:

> "It is noted that, as clarified in the herewith submitted claims, the Applicant's solution is not merely to confirm receipt of messages. Rather, in the Applicant's invention of the amended claims, it is made clear that the messages are to accept or reject the requests from the power receiver (respectively the request to enter the negotiation phase and the requests for specific parame- ter settings)."

It has thus expressed that, in accordance with the patent, it is not merely a matter of an *acknowledgement of receipt* ("... solution is not merely to confirm receipt of mes- sages..."), but of a response to the request in accordance with the details in the originally filed application documents.

(5.) The wording of feature 20.6.1 makes it clear that a mere acknowledgement of receipt by the service sender does not correspond to the doctrine of the patent. However, the wording of feature 20.6.1 has obviously created a new problem of understanding:

(a.) The request of the service recipient to carry out a negotiation phase can also be rejected by the service sender. This is already apparent from the original application documents (see above; "reject message") and also from feature 20.6.1 of the patent-in-suit, which provides that a confirmation of the request to enter the negotiation phase in accordance with the request is also possible in the form of a rejection of this request.

With regard to feature 20.6.1, the parties dispute whether performance senders are also in line with the requirements, which always confirm the requirements for entering the required negotiation phase with an acceptance.

(b.) Interpretation of the plaintiff

The plaintiff interprets feature group 20.6 to mean that a service sender who *always* responds to the request with an acceptance and never with a rejection is also compliant. This follows on the one hand from the fact that the conjunction "or" in feature 20.6.1 expresses various alternatives, with general acceptance being one of these alternatives; this possibility is also found in paragraph [0046] of the description of the patent in suit. Paragraph [0046] reads (bold and underlining added):

> "The requested negotiation phase may be an optional phase. Specifically, it need not be supported by all devices as power transfer operation may in many embodiments be possible using only the mandatory configuration phase. In some embodiments, it may also be optional between negotiation phase capable devices, and may possibly only be entered if desired by the power receiver. **Although the negotiation phase will be optional, it may be mandatory that new devices support it. For example, mandatory support by all power transmitters that are compliant with Qi specification versions that include the negotiation phase may be required in order to enable power receivers to enter this phase if requested**."

The applicant is further of the opinion that a rejection of the request can also be effected in accordance with the patent by mere inactivity of the power transmitter; in this context, the applicant refers to paragraph [0173] of the description, which mentions the case in which a claimant power transmitter may decide not to respond to a request from the power receiver to enter the negotiation phase, but selects a fallback to the power and data transmission strategy according to Qi specification version 1 (para. [0173]: "Further, if the power receiver does not re- ceive any accept or reject message within a certain time (response time which the transmitter should meet), the receiver may assume that the power transmitter does not support power negotiation and it proceeds to the power transfer phase. Also similarly, the transmitter may be a recent one which does support a negotiation phase, but may elect to fall back to a version 1 power transmission strategy (and associated communication strategy)."). This would also be a rejection

The request of the service recipient to enter the negotiation phase is expressed in the form of a

(c.) Interpretation of the defendant

In contrast, the defendants understand feature group 20.6 to mean that a patent-compliant service sender sends a confirmation in response to the request, whereby either an acceptance or a rejection can be declared with this confirmation. According to the wording of the claim, it is not in accordance with the claim if an acceptance is generally declared with each confirmation, because then the possibility of rejection provided for in the claim is not given. In this respect, the defendants also refer to paragraph [0173] of the patent in suit, in which the requirement of a rejection is described. According to the defendants, mere inactivity is also not a confirmation in accordance with the claim, since the confirmation containing the rejection of the claim must also be active in accordance with feature group 20.6. Feature 20.6.11 follows the same claim system and semantics as feature 20.8.2. The Düsseldorf Regional Court also interpreted claim 20 of the patent-in-suit in this way.

(d.) Interpretation of the Düsseldorf Regional Court

In the cited decision, the Düsseldorf Regional Court, referring to the wording of the claim, is of the opinion that the service sender *must* be able to indicate both an acceptance and a rejection with the confirmation to be transmitted in accordance with the group of notes 6*;* a restriction to the effect that the service sender must only be able to accept or reject alternatively does not arise from the conjunction "or" in feature
20.6.1 Nor does it follow from paragraph [0046] that it is sufficient for a service sender to be able only to transmit an acceptance. For example, a rejection may be necessary if he resorts to another version of the transfer of benefits, as described in paragraph [0173].

(e.) Interpretation of the Federal Patent Court

The Federal Patent Court understands the patent-in-suit to mean that an energy transmitter in accordance with the patent-in-suit is set up to be able to reject a negotiation request - depending on the situation - by a corresponding negative response. The Federal Patent Court apparently concludes this from the newly included feature 20.6.1 compared to the original version of the claim, according to which a confirmation can indicate not only an acceptance but also a rejection.

(f.) Interpretation of the local chamber

From the point of view of the Local Board, two questions arise in connection with the interpretation of feature 20.6.1. The first is whether, in the view of the skilled person, the description of the patent in suit also describes a constellation in which a declaration of acceptance is always transmitted to the recipient of the service as confirmation by the sender of the service in response to a corresponding request.

If the expert answers this first question in the affirmative, the next question is whether this constellation is also reflected in the wording of the claim.

(aa.) The Local Board answers the first question in the affirmative. In paragraph [0046], which can already be found in the section "Summary of the invention", a constellation is described in which a declaration of acceptance is always transmitted to the recipient of the service as confirmation of the sender of the service in response to a corresponding request.

In this paragraph, the description again states that the negotiation phase is optional, i.e. it is not mandatory. One of the reasons given in paragraph [0046] is that the negotiation phase should only be carried out at the request of a service recipient. Although the negotiation phase is actually optional, paragraph [0046] states that it may be mandatory for new devices to support this phase. Paragraph [0046] then defines such mandatory support in its last sentence as follows:

> "... mandatory support by all power transmitters ... may be required in order to enable power receivers to enter this [negotiation] phase if requested."

The negotiation phase is therefore optional in this constellation insofar as its implementation depends on the wishes of the power receiver ("...if desired by the power receiver."). If the power receiver wishes the negotiation phase to be carried out, i.e. makes use of its option by sending a corresponding request to the power sender, it is mandatory for the power sender to comply with this request ("... mandatory support ... may be required in order to enable power receivers to enter this phase if requested.") in accordance with paragraph [0046]. However, in order to enter the negotiation phase at the request and demand of the power receiver, a declaration of acceptance by the power sender is required. From the point of view of the local chamber, paragraph [0046] thus describes a constellation in which **a declaration of acceptance is always** sent to the power receiver as a confirmation of the power sender in response to a corresponding request, thereby enabling entry into the negotiation phase.

Thus, the constellation described in paragraph [0046] also corresponds to the objective of the patent-in-suit to create the possibility of carrying out a patent-compliant negotiation phase (see paragraph [0041] of the patent-in-suit) in further development of the Qi standard existing at the time of priority.

(bb.) This raises the further question of whether the embodiment described in paragraph [0046] is also expressed in the wording of the claim. This question must be answered by interpreting the patent claim.

According to Art. 69(1) EPC, the scope of protection of a patent is determined by the patent claims. In order for this determination to be made, the technical meaning to be attributed to the wording of the patent claim from the point of view of a person skilled in the art must first be determined, taking into account the description and drawings. The patent specification must be read in a meaningful context and, in case of doubt, the patent claim must be understood in such a way that there are no contradictions with the statements in the description and the pictorial representations in the drawings. However, a patent claim may not be interpreted in accordance with a broader description if the description is not reflected in the patent claim. If and to the extent that the teaching of the patent claim is consistent with the description

and the drawings cannot be reconciled and an irresolvable contradiction remains, those elements of the description that are not reflected in the patent claim may not be used to determine the subject matter of the patent. In this respect, the patent claim takes precedence over the description. If several embodiments are presented in the description as being in accordance with the invention, the terms used in the patent claim are, in case of doubt, to be understood in such a way that all embodiments can be used to fulfil them.

An interpretation according to which the embodiment example described in paragraph [0046] is not covered by the patent claim is not ruled out per se. However, it could only be considered if other possible interpretations leading to the inclusion of at least a part of the embodiments are necessarily ruled out or if the patent claim provides sufficiently clear indications that something is actually claimed which deviates from the description.

Claim 20 of the patent in suit indicates sufficiently clearly in its feature 20.6.1 that the embodiment described in paragraph [0046] is also intended to be covered; the procedure described in paragraph [0046] is also found in paragraphs [0133], [0137] and [0171].

If claim 20 of the patent in suit is read in context, the function of the means described in feature 20.6 in accordance with the patent becomes apparent:

In claim 20, means are described, the purpose of which is to generate the power signal. Means are further described, the purpose of which is to initiate the mandatory configuration phase. Means are described, the purpose of which is to perform the mandatory configuration phase. Finally, means are described in feature group 20.6, the purpose of which is to initiate entry into a negotiation phase between receiver and sender. Finally, feature 20.7 describes means for actually entering the initiated negotiation phase. The function of the described means is therefore recognisably to facilitate the execution of certain phases or such phases.

The aim is to facilitate preparatory processes such as the initiation of the negotiation phase.

A function-oriented interpretation based on the wording means that, according to feature 20.6, there must be (1) means for receiving a request to enter the negotiation phase and (2) means for confirming the request, whereby the service sender not only declares with the confirmation that it has received the request, but also whether it accepts or rejects it. The response of the service sender to the request of the service recipient can therefore be "yes" or "no". This primarily expresses that it is not sufficient - which was still unclear according to the original wording of the claim - for the service sender to merely confirm receipt of the request; the service recipient should also receive a response ("yes" or "no") to indicate ("being indicative") whether the negotiation phase is actually being entered into. This also corresponds to feature 20.7, according to which the request of the service recipient is not yet a sufficient condition for entering the negotiation phase; the means for entering the negotiation phase mentioned in feature 20.7 are only activated after an autonomous decision by the service sender to accept the request.

The question now is whether, in view of the objective of the patent and the core of the invention (enabling entry into the negotiation phase in order to achieve a higher charging capacity, for example), a claim-compliant power transmitter *must* also be able to reject a request, or whether the wording of feature 20.6 also includes embodiments that always accept requests from power recipients to enter the negotiation phase, i.e. do not provide for rejection.

From a linguistic point of view, the subordinate clause "Transfer of a confirmation, ... whereby the confirmation is indicative of an acceptance or rejection" can easily be understood to mean that the answer (confirmation) can alternatively be "yes" or "no". The fact that the answer according to the wording of the feature
20.6 *must* also be able to read "No" is difficult to justify from a purely linguistic point of view.

From a technical point of view, in view of the declared objective of the patent in suit (enabling entry into a negotiation phase), it cannot be justified from the point of view of the local chamber that a patent-compliant performance transmitter must also be able to reject a request to enter the negotiation phase. After all, the aim is to enable entry into this phase and not to prevent it; the Düsseldorf Regional Court also correctly determined this and therefore assumed that a service sender that only transmits rejecting confirmations is not patent-compliant. In contrast, paragraph [0046] describes the optimal realisation of the objective of the patent in suit: A performance transmitter that always complies with a request to enter the negotiation phase.

If this possibility were to be excluded as not falling under claim 20 of the patent-in-suit, only a service sender would remain as a claim that must also be able to respond negatively to a request. However, the description gives no indication that such a negative decision by the sender *must* also be possible in the initiation phase. In particular, this does not result from paragraphs [0172] and [0173]. Two of the three service broadcasters described there do not conduct a negotiation phase at all, nor do they have the means to conduct one. The third power transmitter does have the means to conduct a negotiation phase, but decides not to conduct one, whereby it communicates this fact in accordance with the communication strategy of the prior art, namely not at all. He simply remains silent. These examples are therefore not in line with the prior art. Accordingly, at the end of paragraph [0173] there is an apt summary of the examples given:

> "In all these cases, the system goes directly from the identification and configuration phase to the power transfer phase...."

In detail:

The power transmitters described in paragraph [0172] are those described in paragraph [0137]. Although these power transmitters were manufactured with knowledge of the invention, they do not have means to

negotiation phase. Compared to the previously known performance broadcasters, however, they have the means to reject a corresponding request to enter the negotiation phase. The existing performance transmitters have not responded to such requests. Consequently, such performance transmitters are not patentable because they do not have the means to conduct the negotiation phase.

The processes described in paragraph [0173] are, on the one hand, those in which the service senders do not support the negotiation phase and therefore do not respond to corresponding requests at all and, on the other hand, those in which the novel service senders, although they could support the negotiation phase, fall back on a transmission strategy of version 1 of the Qi standard and the associated communication strategy. As sentence 2 of paragraph [0173] states, the communication strategy of the previous power transmitters consisted of not responding to requests to enter the negotiation phase, either positively or negatively. This is recognisably not up to standard.

Paragraphs [0172] and [0173] cannot therefore provide any technical justification for requiring a rejection declaration for a power transmitter equipped according to claim 20, because such a declaration is neither made if a power transmitter of an older design (version 1.0 and 1.1) does not support the negotiation phase anyway, nor if a power transmitter of a newer design uses the transmission strategy of an older version in which there is no negotiation phase. In both cases, the rejection of a request is not necessary.

Thus, contrary to the statements of the Regional Court of Düsseldorf, paragraph [0173] cannot be used to justify that a service sender must be able to indicate both an acceptance and a rejection. The Düsseldorf Regional Court also does not explain how the embodiment described in paragraph [0046] is at all related to the constellations described in paragraph [0173], which do not relate to the entry into the negotiation phase in accordance with the patent. On the basis of the patent specification and in view of the objective of the patent, no other

There is no apparent technical reason why a power transmitter *must* be able to respond to a request with a rejection. Although this may be useful in individual cases, which is why this possibility has been included in the patent claim, it is not necessary or functionally intended according to the patent in suit.

Nothing else results from the formulation of feature 20.8.2. Here, too, there is an "or" link in connection with a positive ("accepting") or negative ("rejecting") response from the service sender. However, this feature is not only formulated differently from feature 20.6.1 ("message in which the at least one power transmission operating parameter is accepted or rejected"), but also relates to a different function within the claim, namely the response of the power sender in the negotiation phase to a specified request for a particular operating parameter.

Added to this is the following: The core of the invention consists precisely in the fact that the service provider and the service recipient can, if possible, enter into a (bidirectional) negotiation phase in order to achieve (in particular) a higher performance. This objective is even optimally realised in the case of a service sender that always declares its willingness to enter into this phase of negotiations. According to the defendant's interpretation, precisely such an embodiment would be excluded from patent protection and could be used without any counter-performance. This is not adequate protection within the meaning of the interpretative protocol, especially since it is clear from the description that entry into this negotiation phase may be mandatory (paragraph [0046]). This also ensures adequate legal certainty for third parties, because a third party cannot reasonably assume that the hard-coding of the confirmation ("assumption") leads out of the scope of protection of the patent claim.

After all, it must be assumed that a performance transmitter which transmits a confirmation with an acceptance in response to each request is a possible form of implementation in accordance with claim 20 of the patent in suit. There is no other interpretation for claim 19 of the patent in suit.

III. Legal validity of the patent in suit

The grounds asserted by the defendants for invalidity of the patent in suit do not apply.

1. Original revelation

Contrary to the defendant's view, the subject matter of the patent in suit does not go beyond the content of the original application.

The statement that the confirmation of the service sender "indicates" the acceptance or rejection of the request to enter the negotiation phase ("being indicative") (features 19.6.1, 20.6.1) does not go beyond the understanding of the originally submitted documents in the view of the specialist.

The original documentation states that the acknowledgement by the power transmitter does not have to be a separate message, but can also be part of another message (page 10, lines 1 to 4: "The acknowledgement by the power transmitter may be a simple one bit acknowledgement, and/or may be part of a message comprising other information. In some embodiments, redundancy may be introduced to the acknowledgement, e.g. using error correcting coding (such as a simple repetition code)."). The specialist has thus taken from the original documents that the acknowledgement can be provided both by a separate message and by a message that primarily has a different content and only implies the acknowledgement. In view of this, the wording "being indicative" is permissible.

2. Feasibility

The invention is disclosed so clearly and completely in the patent in suit that the skilled person can carry it out. The patent-in-suit provides the skilled person with a complete and reworkable solution.

Taking into account the understanding of a person skilled in the art, according to which only those power transmitters are protected by the independent patent claims which are capable of entering into a negotiation phase according to the invention, whereby they expressly accept or refuse a corresponding request.

the skilled person is able to rework the protected processes and devices without having to become inventive himself.

3. Patentability

The subject matter of the patent in suit is eligible for protection.

a. Novelty of the patent in suit compared to D1

aa. The subject matter of the granted patent claim 20 is new compared to D1.

D1 relates to a transmitter and a receiver in a wireless power transmission system. It is neither explicitly nor implicitly apparent from D1 that the communication between transmitter and receiver is based on a modulation of the power signal; thus, feature 20.1.1 of the patent in suit is not disclosed in D1 (likewise BPatG, judgment of 12 July 2024, p. 40).

For the two communication units, the D1 merely states that they communicate with each other by wire or wirelessly. This alone does not directly and clearly indicate a communication in which information is modulated onto a power signal (also BPatG, judgment of 12 July 2024, p. 40).

The statements on a modulation of the power signal alleged by the defendants, but not explained in detail, are not found in D1. Insofar as the defendants refer to general technical knowledge with regard to feature 20.1.1 and in this respect refer to D2 and D6, this is an inadmissible combination with other documents in the context of the novelty test, but no evidence of general technical knowledge (see, for example, EPO, decision of 23 January 2018; file no. T 2074/14). Insofar as the defendants derive the disclosure of a communication based on a modulation of the power signal in D1 from the fact that no separate communication interfaces are shown in Figure 1 of D1, this is equally unconvincing: In its description, D1 indisputably states that the WLAN standard IEEE 802.15.4 is used for data communication; the fact that corresponding interfaces for this standard are not shown in a schematic drawing of D1 is not convincing.

does not constitute a disclosure of a *different* type of data communication (here: on the basis of modulation of the power signal); such a disclosure is not directly apparent from the drawing. Insofar as the defendants finally refer to paragraph [0178] of D1 ("...the transmitter increases the output power to enable the receiver to communicate with the transmitter...") and argue that this speaks in favour of data communication by means of modulation of the power signal, this does not lead to success either. Paragraph [0178] does refer to an increase in power to enable communication. However, there is no mention of modulation of the power signal. The defendants have also not argued that increased power is required to modulate the power signal.

In view of the above findings, it was not necessary to examine whether the features of claim 20 of the patent in suit otherwise already resulted from the prior art.

bb. The patentability of the subject-matter of patent claim 19 is not to be assessed differently from that of patent claim 20 in view of the corresponding features 20.1.1 and 19.1.1 in relation to document D1.

b. Novelty of the patent in suit compared to D2

D2 also relates to a transmitter and a receiver in a wireless power transmission system. Not all features of claim 20 of the patent in suit are disclosed in D2 either; at least features 20.5 to 20.8.2, which relate to the "negotiation phase" in accordance with the patent, are not disclosed in D2 in accordance with the patent.

The defendants are of the opinion that the teaching of D2, according to which a setup frame is created by the service recipient in the "setup phase" (para. [0193] of D2) and then transmitted to the service transmitter, discloses feature 20.5 of the patent in suit; the defendants refer in this respect in particular to paragraphs [0232] and [0233] of D2. From the defendants' point of view, entry into the negotiation phase (sending the request in accordance with feature 20.6 of the patent in suit) can also take place during the configuration phase in accordance with the patent. Accordingly, according to the teaching of D2, the setup frame contains

"communication condition information", which is used to determine whether further operating parameters can be negotiated. According to the D2 doctrine, the setup frame therefore already contains the operating parameters to be negotiated (statement of defence, p. 54). In a next step, the service sender checks the transmitted setup frame and can confirm it in order to enter the requested negotiation phase (Statement of defence, p. 56). After entering the negotiation phase, the service recipient creates a start frame and transmits it to the service sender. The service sender then sends the start command for the service transfer. Figure 15 of D2 shows the sequence of this "setup phase" of D2, whereby "setup frames" are exchanged, firstly from the service recipient to the service sender (Fig. 15, steps S28 → S8) and then vice versa (Fig. 15, steps S10
→ S29).

However, this exchange of "setup frames" shown in D2 does not correspond to the patent-compliant sequence of the negotiation phase. According to the patent, the negotiation phase is preceded by an independent "request phase", which serves to clarify between sender and receiver whether the negotiation phase is entered into at all. This feature is missing in D2, in which the service recipient immediately sends a frame (setup frame) containing the desired operating parameters and the sender checks the frame and thus the desired operating parameters. With the confirmation of the sender after a positive check of the setup frame and the parameters transmitted with it, a signal is therefore not sent to enter a negotiation phase, but the request is fulfilled with regard to the desired operating parameters. A negotiation phase then no longer takes place. Rather, as the Federal Patent Court correctly states, the transfer of performance begins thereafter.

In view of the above findings, it was not necessary to examine whether the features of claim 20 of the patent in suit otherwise already resulted from the prior art.

The patentability of the subject-matter of patent claim 19 is not to be judged differently from that of patent claim 20 in view of the corresponding features.

c. Novelty of the patent in suit compared to the D3

D3 also relates to a transmitter and a receiver in a system for inductive power transmission. However, not all features of claim 20 of the patent in suit are disclosed in D3 either.

According to the defendant's submission, it cannot be inferred from document D3 that the service sender confirms the service recipient's enquiry and transmits this confirmation to the recipient. Rather, the sender terminates the power transmission and returns to the configuration phase, in which the receiver informs the sender - without further "negotiation" - of its operating parameters. This is clearly not a confirmation of the requirement within the meaning of feature 20.6 of the patent in suit (as here BPatG, judgment of 12 July 2024). A patent-compliant negotiation phase is also not described in D3.

In view of the above findings, it was not necessary to examine whether the features of claim 20 of the patent in suit otherwise already resulted from the prior art.

The patentability of the subject-matter of claim 19 is not to be judged differently from that of claim 20 in view of the corresponding features.

d. Novelty of the patent in suit compared to D6

D6 also relates to a transmitter and a receiver in a system for inductive power transmission. However, not all features of claim 20 of the patent in suit are disclosed in D6 either.

The defendants submit that the power supply device disclosed in the D6 comprises means for receiving a request ("enumeration information") to enter a requested negotiation phase ("operating

mode 1250" or "stand-by run mode 1250") from the power receiving device; this can be seen from paragraphs [0112], [0117] and Fig. 12 of D6. The "enumeration information" received during the configuration phase ("enumeration mode") is intended to enter the negotiation phase.

Paragraph [0112] of D6 shows that the power receiving device transmits enumeration information to the power supply device via the inductive connection and - correspondingly - the power supply device transmits *its* enumeration information. The defendants thus consider claim features 20.5 and 20.6 to be disclosed. The local division cannot recognise that the transmission of the receiving device in question is a request to enter a negotiation phase. Confirmation of the request to enter such a negotiation phase by the power transmitter transmitting its own information to the receiving device is also not recognisable, since the transmission of its own information does not constitute a response to the information transmitted by the receiving device.

In view of the above findings, it was not necessary to examine whether the features of claim 20 of the patent in suit otherwise already resulted from the prior art.

The patentability of the subject-matter of patent claim 19 is not to be judged differently from that of patent claim 20 in view of the corresponding features.

4. Inventive activity

Insofar as the defendants argue that the patent in suit lacks inventive step on the basis of D4 (Qi standard in its version 1.0), the Local Court does not agree.

In particular, the defendants are not able to convince the Local Board with the assertion that a professional who is confronted with the problem, based on Chapter 5.1 of D4, would not be able to fulfil the beneficiary's request.

after renegotiation of the power transfer agreement into a system for inductive power transfer, would provide for corresponding confirmation messages within the meaning of the patent in suit. Neither in D4 nor in the other citations submitted (D2, D5, D6), which may be relevant for the assessment of inventive step, is the patent-appropriate system concerning the entry into a negotiation phase and its implementation provided.

IV. Late submission of citation D7

Insofar as the defendants also based their actions for annulment on D7 for the first time in the reply to the counterclaim, this submission was late and was not admissible.

The introduction of a further citation with the reply to the counterclaim, which is intended to substantiate the lack of inventive step with regard to the granted version in the context of the counterclaim, constitutes an extension of the nullity counterclaim, because the submission - extending the previous submission - is based on a further citation and thus a new factual submission. This constitutes an extension of the counterclaim within the meaning of Rule 263 EPG-VerfO. The defendants have not submitted anything that could justify the admission of this extension of the counterclaim for annulment under Rule 263.2 of the UPC Rules of Procedure despite the delay. The extension of the counterclaim was therefore not admissible.

V. Requests for amendment of the patent in suit

As the counterclaims were unsuccessful, there was no longer any need to decide on the applications to amend the patent.

C.

The action for infringement is largely well-founded.

I. Patent infringement

The accused embodiments realise all the features of claim 20 of the patent in suit. This constitutes a patent infringement.

1. Realisation of claims

The challenged embodiments realise all the features of claim 20 of the patent in suit.

The defendants argue against the allegation of patent infringement that, if the claim is correctly interpreted, the technical teaching of claim 20 is not realised by the attacked embodiments. The Qi standard of version 1.2.4 cited by the plaintiff does not provide that service transmitters must be able to respond to requests from service recipients to enter the requested negotiation phase with a rejected confirmation message. Contrary to the plaintiff's view, it cannot therefore be inferred from the Qi standard, which the defendant's devices comply with, that characteristics 20.6 and 20.6.1 are fulfilled.

According to section 5.1.2.3, the Qi standard specifies that the power transmitter sends an acknowledge response upon receipt of a configuration packet with a value of 1 in the neg field and then enters the negotiation phase. With this acknowledge response, an acknowledgement within the meaning of feature group 20.6 of claim 20 of the patent in suit is transmitted. If the patent claim is correctly interpreted, it is not necessary that the challenged embodiments can also respond to requests from service recipients with rejecting acknowledgements (for interpretation, see B.II.2. above).

2. Passive legitimisation

Defendants 2), 3) and 4) have passive legitimacy as infringers and can therefore be sued under Articles 63, 64, 67 and 68 UPCA. Although the defendants 1), 5) and 6) are not infringers themselves, they can be held liable as intermediaries pursuant to Art. 63 para. 1 sentence 2 UPCA.

a. Utilisation as infringer

According to Art. 63, 64, 67 and 68 UPCA, injunctions and orders can be issued against the infringer.

Provisions of the Convention for determining a patent infringement, the legal consequences of a patent infringement and the debtor of claims and measures are to be interpreted autonomously, i.e. without recourse to national law, in compliance with Union law (see LK Düsseldorf, order of 6 September 2024, UPC_CFI 166/2024. 1st guiding principle). The term "infringer" is a concept under EU law that goes back to the Directive on the Enforcement of Intellectual Property Rights (2004/48/EC). According to its Art. 1, this directive also applies to patent law. The term "infringer" according to Art. 63 et seq. UPCA must therefore be interpreted in accordance with the principle of primacy and respect for Union law (Art. 20 UPCA) and the binding decisions of the ECJ in this respect (Art. 21 UPCA).

An infringer is anyone who *uses* a patent contrary to Art. 25 or Art. 26 UPCA without the consent of the patent proprietor. In a decision relating to trade mark law (C-148/21, C-184/21 - Christian Louboutin v Amazon Europe Core Sàrl et al.), the Grand Chamber clarified that the term "use" in its ordinary meaning presupposes active behaviour and direct or indirect control over the act of use, because only the person who directly or indirectly has control over the act of use is actually in a position to terminate the use and thus comply with the prohibition; the ECJ expressly described the offering and placing of goods on the market as active acts in this context.

Furthermore, the ECJ has held that the use of signs identical with or similar to trade marks in offers for sale is made exclusively by the person who acts as the seller or gives the impression to the relevant public that he is the person who sells the goods in his own name and for his own account. Accordingly, a service provider does not itself use a sign identical with or similar to another person's trade mark if the service it provides is not similar in nature to a service intended to promote the sale of goods bearing that sign and does not imply that there is a link between that service and the trade mark, that a link is established between that service and the sign because the service provider in question does not appear to the consumer, which precludes any likelihood of association between its services and the sign in question (CJEU C-148/21, C-184/21 - Christian Louboutin v Amazon Europe Core Sàrl and Others).a.).

In view of the uniform European legal framework for the enforcement of intellectual property rights and the similarity of acts of use with regard to products protected by patent or trade mark law, there is no reason not to apply the case law of the ECJ on the concept of infringer in trade mark law to patent law as well. Accordingly, an infringer within the meaning of Art. 25 and 26 UPCA is anyone who actively carries out the acts of use in question. This also includes legal persons.

b. Instigators and accomplices

Whether, in addition, on the basis of a dynamic interpretation of the Agreement on the basis of legal principles generally recognised in the Contracting Member States or on the basis of national provisions applicable in individual cases, the defendants 1), 5) and 6) can also be held liable for participation in the infringement (such as instigation or aiding and abetting) under Art. 63 (1) sentence 1 UPCA can be claimed in the present case; in this respect, there is no concrete factual submission by the plaintiff that and how the defendants 1), 5) and 6) participated in patent infringing acts of the defendants 2) and 6).

4) have intentionally participated (instigated or assisted) in the offence. Intent to instigate or assist is a mandatory element of the offence in all variants. The plaintiff has only stated in general terms that the defendants 1),
5) and 6) are managing directors or directors of the defendants 2) and 4) and are liable as an infringer due to their position.

c. Utilisation as an intermediary

However, utilisation as an intermediary pursuant to Art. 63 para. 1 sentence 2 UPCA is possible.

aa. General requirements

According to the wording of Art. 63 para. 1 sentence 2 UPCA, the prerequisite for issuing an injunction is that the person claimed

- is not the infringer, or that a role as infringer cannot be proven, but is an intermediary,
- as such provides a service that is used by the infringer to infringe a patent.

Furthermore, the possibility of issuing an injunction against the intermediary means that the intermediary must be able to influence the infringing event in the first place, or at best be able to terminate the use. Art. 63 para. 1 sentence 2 UPCA does not stipulate any further requirements for the use of an intermediary, such as the breach of duties of care.

bb. Concept of the intermediary

In order for an economic operator to qualify as an "intermediary" within the meaning of Art. 63 para. 1 sentence 2 UPCA,

> "it must be established that he offers a service which is likely to be used by another person to infringe one or more intellectual property rights, without it being necessary for him to have a special relationship with that person or those persons." (ECJ, C-494/15 - Tommy Hilfiger Licensing LLC and Others v Delta Centre a. s., on Article 11 of Directive 2004/48/EC)

The nature of such a service is not further specified in Art. 63 para. 1 sentence 2 UPCA - unlike in Regulation (EU) 2022/2065, for example, which specifically mentions intermediary services (e.g. hosting services and online platforms); the only decisive factor is that the service can be used to infringe an intellectual property right (here: patent).

Accordingly, the ECJ ruled in case C-494/15 that a tenant of market halls who sublets the various sales areas located in these halls to traders, some of whom use their stand to sell counterfeit branded products, also falls under the concept of intermediary within the meaning of Art. 11 sentence 3 of Directive 2004/48/EC.

The term "intermediary" (in the English language version of the UPCA "intermediary") is therefore not limited to providers of intermediary services within the meaning of Regulation (EU) 2022/2065. The decisive factor in the context of Art. 63 UPCA (Art. 11 Directive 2004/48/EC) is that the intermediary does not use the subject matter of the patent itself, but merely offers a service that is used to infringe and thereby creates a precondition for the infringer to be able to carry out its patent infringing act (see also Ohly, ZUM 2015, 308; Sonn- tag in Bopp/Kircher, Handbuch Europäischer Patentprozess, 2nd edition 2023, Sec. 13 para. 114 f. on the concept of intermediary).

From the case law of the ECJ, according to which it is not necessary for the intermediary to be the infringer

"...cultivates a special relationship"

the local chamber concludes that a special relationship - such as the relationship between a managing director and the company he manages - does not prevent qualification as an intermediary. It is also clear from the case law of the ECJ that the term "service" at least means that the party providing it carries out a specific activity in return for remuneration (ECJ, C-47/14 - Holterman Ferho Exploitatie ua/Spies von Büllesheim, on Regulation (EC) No 44/2001). Consequently, the activity of a managing director is to be categorised as the "provision of services" "insofar as the characteristic obligation of the managing director is to provide services".

legal relationship between the managing director and the company implies the performance of a certain activity in return for remuneration". The characteristic performance of a managing director is the management of the company's business; the managing director is therefore in a position to (co-)determine the entrepreneurial activities.

The activity of the intermediary does not have to be visible to the purchaser of the infringing product; the intermediary does not have to appear to the customer. This is illustrated by the case decided by the ECJ, which involved a lessor of retail space.

On this basis, a natural person who acts as managing director of a company that commits acts of use that infringe a patent can be considered an intermediary within the meaning of Art. 11 sentence 3 of Directive 2004/48/EC and Art. 63 para. 1 sentence 2 UPCA. In accordance with the case law of the ECJ on Art. 11 of Directive 2004/48/EC, this also corresponds to the objective of Art. 63 para. 1 sentence 2 UPCA to ensure legal protection also through injunctions against persons who are not themselves infringers, but who are in a position to prevent infringements due to a service provided by them in the context of the infringement and used by the infringer. The service provided to the company by a managing director gives the company the ability to act and thus creates a prerequisite for the company to be able to carry out its patent infringing act; the service provided by a managing director in this way has a significantly higher risk propensity with regard to possible infringing acts than the activity of the lessor of market stands; for this reason, too, it is in the sense of Art. 63 para. 1 sentence 2 UPCA to qualify a managing director as a possible intermediary. This also applies in the case of a multi-member management body of a patent-infringing company for members of the management body whose primary area of responsibility does not lie in manufacturing and/or distribution, but for example in the area of finance or human resources. This is because such members of the management body generally also provide services for the infringing company,

which cannot be eliminated without eliminating the specific patent-infringing acts.

Contrary to the view of the defendant, this view is not contradicted by any concurring deviating assessment of the national legal systems of the Member States. In this respect, there is no consistent principle according to which the liability of corporate bodies is excluded in the case of infringements of the company's rights in the external relationship. For example, under German law, the legal representative of a company that manufactures a patent-infringing product or places it on the domestic market for the first time is liable for damages if it fails to take all possible and reasonable measures to set up and control the company's business activities in such a way that no technical property rights of third parties are infringed (BGH GRUR 2016, 257 - Glasfasern II).

On this basis, the following applies to the defendants in the present proceedings:

d. Passive legitimisation of the defendant 4)

Defendant 4) offered the products in dispute.

Defendant 4) has admitted that it is responsible for the sales activities of the defendant ("Bel- kin") via the German website "www.belkin.com/de". It is also generally active as a sales unit in the EU, including in relation to wholesalers such as Amazon or MediaMarktSaturn, which in turn sell Belkin products to end customers. In contrast, there is no online store on the Dutch, Italian and French websites; here, reference is only made to some retailers who sell the defendant's products. Defendant 4) therefore does not itself offer any products for sale via the aforementioned websites. It is not within the sphere of influence of the defendant 4) whether and in what way the suppliers referred to on the websites actually offer and supply the attacked embodiments. However, it is defendant 4) that operates as the central sales unit of the Belkin Group in the EU (duplicate, p. 25); sales activities in the Member States relied upon are therefore attributable to defendant 4).

The plaintiff has undisputedly submitted that the product information on the contested designs shows that they are distributed in Germany, France, the Netherlands, Italy and Sweden. If the defendant 4) - as it itself submits - operates as the central sales unit of the Belkin Group in the EU and is accordingly the "EU Authorised Representative" according to the EU Declaration of Conformity (Annex BP 10) and issues guarantee declarations for the attacked embodiments, it is the defendant 4) which is responsible for the acts of use in question (offering, placing on the market, using and either importing or possessing for the purposes mentioned).

The judgement of the Düsseldorf Higher Regional Court (case no. I- 2 U 59/23) concerns actions of the defendant 4) in Germany. These are expressly excluded from the judgement of the local division in accordance with claim G. The Higher Regional Court of Düsseldorf did not rule on actions outside the territory of the Federal Republic of Germany.

e. Passive legitimisation of the defendant 2)

The plaintiff has also demonstrated acts of use in the territory of the UPC outside Germany for defendant 2).

According to the imprint, the defendant 2) is responsible for the website "www.bel- kin.com/en" and thus for undisputed acts of distribution in Germany. The plaintiff derives acts of use outside of Germany from the fact that the activities of individually named employees of the defendant are not authorised.
2) is not limited to Germany, but even expressly concerns distribution in the EU; this applies, for example, to Mr Foglia, who, as "Head of Amazon Channel EU" at Defendant 2), was responsible for maintaining business relations with Amazon - an undisputed EU-wide distributor of the products at issue. Insofar as Defendant 2) claims that it was not "originally responsible" (whatever this is supposed to mean) for the distribution to dealers such as Amazon and that it was merely the (formal) employer of Belkin employees based in Germany, the following is not true

This does not relieve the defendant of its responsibility: Defendant 2) itself distributed the contested designs in Germany; furthermore, employees working for defendant 2) - and not for other companies of the Belkin Group - were responsible for business relations with dealers who indisputably distributed the contested designs in the EPG territory (and not only in Germany).

The judgement of the Düsseldorf Higher Regional Court (case no. I- 2 U 59/23) concerns actions of the defendant 2) in Germany. These are expressly excluded from the decision of the local division in accordance with claim number G. The Düsseldorf Higher Regional Court did not rule on actions outside the territory of the Federal Republic of Germany.

f. Passive legitimisation of the defendant 3)

The court is also convinced that the defendant 3) is responsible for the disputed acts of use.

The EU Declaration of Conformity for the contested products, which is the prerequisite for marketability in the EU, was issued in the name of defendant 3). The defendant is also the owner of the domain www.bel- kin.de, through which the attacked products are indisputably marketed directly, at least in Germany. Defendant 3) is also named in the product-related general terms and conditions as follows:

> "...The terms and conditions set out in this document (General Terms and Conditions) apply to all aspects of the legal relationship between you as the end user of a Belkin product (Product) and us (hereinafter also referred to as we), **Belkin International, Inc.** or one of our affiliates, unless expressly stated otherwise below. ..."

Insofar as the defendants have requested that the judgment of the Düsseldorf Higher Regional Court (Case I- 2 U 59/23) be recognised pursuant to Art. 36 (1), (3) Brussels I Regulation, as this has the consequence that the defendant 3) is also not liable for an infringement of the German part of the patent in suit, the Local Division does not follow this. The

Düsseldorf Higher Regional Court did not have to rule on any acts of infringement by the defendant 3) in Germany, so that there is no need for recognition.

g. Passive legitimisation of the defendant 1)

aa. The plaintiff has not shown that the defendant (1) has carried out its own acts of use within the meaning of the case law of the ECJ. Defendant 1) has neither acted as a seller of its own products nor has it given the impression to the public that it is the one selling the products at issue in its own name and for its own account.

bb. However, the defendant 1) can be claimed as an intermediary pursuant to Art. 63 para. 1 sentence 2 UPCA due to the possibility of influencing the fate of the defendants 2) and 4) by virtue of his function as manager of the defendant 2) and director of the defendant 4).

As managing director and director, he is responsible in relation to the defendants 2) and

4) provided services which led to the infringement of the patent in suit by the defendants.

2) and 4) were claimed. In doing so, he created a prerequisite for the defendants 2) and 4) to be able to carry out their patent-infringing actions at all. As managing director of Defendant 2) and director of Defendant 4), Defendant 2) could and can also influence the infringement by issuing corresponding instructions to his subordinate employees.

The limitations laid down in the national legal systems regarding the liability of organs of legal persons, such as the requirement of a breach of duties of care, have only been reflected in the UPCA to the extent that intermediaries are only liable for omission, but not for damages. Therefore, the parties' submissions on the further conditions for claims existing under the law of the various member states, in particular any due diligence requirements, are not relevant. It is up to the Member States to determine in detail the conditions for the use of an intermediary within the meaning of Art. 11 sentence 3 of Directive 2004/48/EC.

and thus left to the UPCA for its scope of application; the requirements arise autonomously and directly from Art. 63 para. 1 sentence 2 UPCA. Unlike other provisions of the UPCA (see, for example, Art. 68 para. 1 UPCA) or corresponding liability rules in the law of the member states, Art. 63 para. 1 sentence 2 UPCA does not require a breach of due diligence or the fulfilment of other factual requirements.

cc. Insofar as the plaintiff has assessed the defendant 1) as the infringer and formulated its claim accordingly, this is harmless with regard to an injunction against the defendant 1) on the basis of its capacity as an intermediary.

Pursuant to Art. 63 (1) UPCA, the plaintiff has applied for an injunction against the defendant 1) prohibiting him from continuing the infringement. The Local Division also considers this application to include, as a minus, the request to issue an injunction against the defendant 1) prohibiting him from continuing his services as managing director of the defendant 1).
2) or director of the defendant 4) in such a way that the defendants 2) and 4) are able to continue infringing the patent in suit. Such an understanding of the application for injunctive relief directed against defendant 1) already results from the fact that the plaintiff made it clear in the statement of claim that the subject of the application for injunctive relief in the case of defendant 1) is his activity (or inactivity) as managing director of defendant 2) and director of defendant 4). It has thus clearly expressed its request for injunctive relief for all parties to the proceedings.

dd. The defendant's application for recognition of the judgement of the Higher Regional Court of Düsseldorf (case no. I- 2 U 59/23) pursuant to Art. 36 (1), (3) Brussels I Regulation is to be rejected with regard to the defendant.
1) with regard to the actions of the defendants 2) and 4) outside the territory of the Federal Republic of Germany. The effect of the judgement that can be recognised pursuant to Art. 36 Brussels I Regulation is geographically limited to the Federal Republic of Germany.

h. Passive legitimisation of the defendant under 5)

aa. With regard to defendant 5), the plaintiff has not demonstrated its own acts of use within the meaning of the case law of the ECJ. Defendant 5) has neither acted as a seller of his own products nor has he given the impression to the public that he is the person who sells the products at issue in his own name and for his own account.

bb. However, the defendant 5) can be claimed as an intermediary pursuant to Art. 63 para. 1 sentence 2 UPCA due to the possibility of influencing the fate of the defendant 4) by virtue of his function as director of the defendant 4).

As director, he provided services in relation to defendant 4) which were used by defendant 4) to infringe the patent in suit. In doing so, he created a prerequisite for the defendant to
4) was able to carry out its patent-infringing acts at all. As director of defendant 4), defendant 5) could and can also influence the infringing behaviour by issuing corresponding instructions to his subordinate employees.

The limitations laid down in the national legal systems regarding the liability of organs of legal persons, such as the requirement of a breach of duties of care, have only been reflected in the UPCA to the extent that intermediaries are only liable for omission, but not for damages. Therefore, the parties' submissions on the further conditions for claims existing under the law of the various member states, in particular any due diligence requirements, are not relevant. The detailed formulation of the conditions for the use of an intermediary within the meaning of Art. 11 sentence 3 of Directive 2004/48/EC is left to the Member States and thus to the UPCA for its scope of application; the conditions arise autonomously and directly from Art. 63 para. 1 sentence 2 UPCA. Unlike other provisions of the UPCA, Art. 63 para. 1 sentence 2 UPCA does not require a breach of due diligence or the fulfilment of other factual requirements.

(see, for example, Art. 68 para. 1 UPCA) or corresponding liability rules in the law of the member states - is not a prerequisite.

cc. Insofar as the plaintiff has assessed the defendant 5) as the infringer and formulated its claim accordingly, this is harmless with regard to an injunction against the defendant 5) on the basis of its capacity as an intermediary.

Pursuant to Art. 63 (1) UPCA, the plaintiff has requested that an injunction be issued against the defendant 5) prohibiting him from continuing the infringement. The Local Board considers this request to also include, as a minus, the request to issue an injunction against defendant 5) prohibiting him from continuing to provide his services as director of defendant 4) in such a way that defendant 4) is able to continue infringing the patent in suit. Such an understanding of the application for injunctive relief directed against the defendant 5) already results from the fact that the plaintiff has made it clear in the statement of grounds that the subject of the application for injunctive relief in the case of the defendant 5) is his activity (or inactivity) as director of the defendant 4). It has thus clearly expressed its request for an injunction for all parties to the proceedings.

dd. The defendant's application for recognition of the judgement of the Higher Regional Court of Düsseldorf (case no. I- 2 U 59/23) pursuant to Art. 36 (1), (3) Brussels I Regulation is to be rejected with regard to the defendant.
5) with regard to the actions of the defendant 4) outside the territory of the Federal Republic of Germany. The recognisable effect of the judgment pursuant to Art. 36 Brussels I Regulation is geographically limited to the Federal Republic of Germany.

i. Passive legitimisation of the defendant 6)

aa. With regard to defendant 6), the plaintiff has not demonstrated its own acts of use within the meaning of the case law of the ECJ. Defendant 6) has neither acted as a seller of his own products nor has he given the impression to the public that he is the person who sells the products at issue in his own name and for his own account.

bb. However, the defendant 6) can be claimed as an intermediary pursuant to Art. 63 para. 1 sentence 2 UPCA due to the possibility of influencing the fate of the defendant 4) by virtue of his function as director of the defendant 4).

As director, he provided services in relation to defendant 4) which were used by defendant 4) to infringe the patent in suit. In doing so, he created a prerequisite for the defendant to
4) was able to carry out its patent-infringing acts at all. As director of defendant 4), defendant 6) could and can also influence the infringing behaviour by issuing corresponding instructions to his subordinate employees.

The limitations laid down in the national legal systems regarding the liability of organs of legal persons, such as the requirement of a breach of duties of care, have only been reflected in the UPCA to the extent that intermediaries are only liable for omission, but not for damages. Therefore, the parties' submissions on the further conditions for claims existing under the law of the various member states, in particular any due diligence requirements, are not relevant. The detailed formulation of the conditions for the use of an intermediary within the meaning of Art. 11 sentence 3 of Directive 2004/48/EC is left to the Member States and thus to the UPCA for its scope of application; the conditions arise autonomously and directly from Art. 63 para. 1 sentence 2 UPCA. Unlike other provisions of the UPCA (see, for example, Art. 68 para. 1 UPCA) or corresponding liability rules in the law of the member states, Art. 63 para. 1 sentence 2 UPCA does not require a breach of due diligence or the fulfilment of other factual requirements.

cc. Insofar as the plaintiff has assessed the defendant 6) as the infringer and formulated its claim accordingly, this is not detrimental with regard to an injunction against the defendant 6) in its capacity as an intermediary.

Pursuant to Art. 63 (1) UPCA, the plaintiff has requested that an injunction be issued against the defendant 6) prohibiting him from continuing the infringement. The Local Board considers this request to also include, as a minus, the request to issue an injunction against the defendant 6) prohibiting him from continuing to provide his services as director of the defendant 4) in such a way that the defendant 4) is able to continue infringing the patent in suit. Such an understanding of the application for injunctive relief directed against the defendant 6) already results from the fact that the plaintiff has made it clear in the statement of grounds that the subject of the application for injunctive relief in the case of the defendant 6) is his activity (or inactivity) as director of the defendant 4). It has thus clearly expressed its request for an injunction for all parties to the proceedings.

dd. The defendant's application for recognition of the judgement of the Higher Regional Court of Düsseldorf (case no. I- 2 U 59/23) pursuant to Art. 36 (1), (3) Brussels I Regulation is to be rejected with regard to the defendant.
6) with regard to the actions of the defendant 4) outside the territory of the Federal Republic of Germany. The recognisable effect of the judgment pursuant to Art. 36 Brussels I Regulation is geographically limited to the Federal Republic of Germany.

II. Injunction request

The claim for injunctive relief asserted in claim A.I. is based on Art. 64 EPC, Art. 25 (a), 63 (1) sentence 1 UPCA. Reasons for a restriction or refusal of an injunction against the defendants are not asserted and are not otherwise apparent.

In view of the limited liability of the defendants 1), 5) and 6) as co-defendants, the judgement must be limited accordingly; this is - as explained above (points C.I.2.f.cc., C.I.2.g.cc. and C.I.2.h.cc.) - implicitly contained as a minus in the plaintiff's more comprehensive claim. The claim must be dismissed to the extent of the surplus.

Furthermore, the action must be dismissed to the extent that the liability as an intermediary is due to the actions of the defendants 2) and 4) with regard to the

Federal Republic of Germany.

Germany are affected. This is because the judgement of the Düsseldorf Regional Court is legally binding in this respect.

III. Request for recall, removal from distribution channels and destruction

The claims asserted with the application A.II. can only be asserted against an infringer, not also against an intermediary, and find their basis in Art. 64 EPC, Art. 64 para. 2 lit. (b), lit. (d) and lit. (e) UPCA. In this respect, however, there are also no claims against the defendants 2), 3) and 4) in the present case.

There are no indications that the recall and removal from the distribution channels could be proportionate (Art. 64 para. 4 UPCA). The same applies to destruction.

IV. Application for determination of liability for damages

The plaintiff has a claim for damages pursuant to Art. 64 EPC in conjunction with Art. 68 UPCA against the defendants. Art. 68 UPCA against the defendants 2), 3) and 4).

They have in any case negligently infringed the patent in suit and are therefore obliged to pay damages to the plaintiff with regard to the acts committed since 28 December 2016, the date of publication of the grant. This is because those who carry out infringing acts themselves must observe third-party industrial property rights and take reasonable precautions not to infringe them. The defendants 2), 3) and 4) have not submitted anything relevant in this regard. The reference to the judgement of the Düsseldorf Regional Court does not exculpate them. On the one hand, the judgement only concerns the German part of the claim and only the defendants 2) and 4); on the other hand, it is generally known that judgements of a German infringement court of first instance are subject to appeal and thus to review and possibly annulment. The defendants 2), 3) and 4) could therefore not rely on this alone. Moreover, the res judicata nature of this judgement has no influence on these proceedings because claims against defendants 2) and 4) relating to the territory of the Federal Republic of Germany have been excluded from the application.

Liability for damages on the part of the other defendants is out of the question because, as explained above, intermediaries are not liable for damages.

Since the plaintiff cannot quantify the claim for damages without information from the defendant through no fault of its own, the plaintiff has a legitimate interest in its determination.

V. Request for information

A corresponding claim of the plaintiff against the defendants 2), 3) and 4) arises from Art. 67 para. 1 UPCA, R. 191 VerfO.

VI. Application for provisional award of damages

According to R. 119 VerfO, the court may award provisional damages to the successful party, which should at least cover their anticipated costs for the damages and compensation proceedings.

The plaintiff estimates the corresponding costs based on an assumed value in dispute of at least 1 million euros for the higher proceedings in accordance with the court's fee table as follows:

- Court costs EUR 7,000,

- Costs of legal representation EUR 112,000.

The defendants have not contested this. The cost estimate is plausible and is therefore not objected to by the local chamber.

VII. Request for publication of the decision

The plaintiff's right to publication of the court's decision arises from Art. 80 UPCA. The plaintiff must comply with the General Data Protection Regulation when publishing the decision.

VIII. penalty payment

In the event of non-compliance with the orders under claim A., repeated penalty payments may be imposed on the defendants (Art. 63 (2) UPCA, R. 354.3 VerfO). The amounts proposed by the plaintiff are necessary to ensure compliance with the court orders. They also reflect the economic damage that the plaintiff could suffer if the defendants do not comply with the law. The defendants have not objected to this.

D.

The decision on costs follows from Art. 69 UPCA, R. 118.5 RP.

The action is unsuccessful with regard to subsequent claims against the defendants 1), 5) and 6). The nullity counterclaims are completely unsuccessful. The Chamber assesses the partial victory of the plaintiff with the infringement action at 5/6.

E.

Direct enforceability results from Art. 82 UPCA.

A security deposit or bank guarantee was not required.

The application for the provision of security requires a substantiated presentation of facts about the financial situation of the other party that give rise to justified concerns of a risk of insolvency or indications of a lack of assets (cf.
e.g. LK München, order of 23 April 2024, UPC_CFI 514/2024; RK Nordisch- Balitsch, order of 20 August 2024, UPC_CFI_380/2023; LK Düsseldorf, order of 6 September 2024; UPC_CFI_166/2024). In the case of a wealthy party, anticipated difficulties in enforcement may also justify the ordering of a security deposit.

Neither has been submitted or is otherwise apparent in the present case. The plaintiff based in the contracting state of the Netherlands appears to be sufficiently wealthy.

For the reasons set out above, the Presiding Judge Dr Zigann, the legally qualified Judge Brinkman, the technically qualified Judge Dr Hansson and the Judge-Rapporteur Pichlmaier hereby give the following ruling

Decision

A. The defendants' motions to stay the proceedings are dismissed.

B. The defendants 2), 3) and 4) are sentenced,

I. to refrain from doing so,

Power transmitter for a system for inductive power transmission

in the Federal Republic of Germany (DE), Belgium (BE), France (FR), Finland (FI), Italy (IT), the Netherlands (NL), Austria (AT) and Sweden (SE), to offer, place on the market, use or either import or possess for the aforementioned purposes,

wherein the inductive power transmission system supports two-way communication between the power transmitter and a power receiver based on modulation of a power signal,

whereby the power transmitter includes the following:

Means for generating the power signal;

Means for receiving a signal strength packet from the service recipient to initiate a mandatory configuration phase;

Means for performing the mandatory configuration phase, wherein a first set of power transmission operating parameters is selected for the power transmitter and the power receiver;

Means for receiving a request to enter the requested negotiation phase from the service recipient;

characterised in that it further comprises:

Means for confirming the request to enter a requested negotiation phase by transmitting a confirmation to the beneficiary; the confirmation being indicative of an acceptance or rejection of the request to enter the requested negotiation phase;

means to enter the requested negotiation phase in response to receiving the request to enter the requested negotiation phase; and

means for performing the requested negotiation phase, wherein a second set of power transfer operating parameters is selected for the power transmitter and the power receiver; wherein, when in the negotiation phase, the power transmitter is arranged to determine the second set of power transfer operating parameters in a number of negotiation cycles, wherein in each negotiation cycle the power transmitter receives from the power receiver a message specifying at least one of the power transfer operating parameters, and the power transmitter responds with a message accepting or rejecting the at least one power transfer operating parameter,

(direct infringement of claim 20 of EP 2 867 997 B1)

if the power transmitter uses chips for inductive power transmission other than those manufactured and/or sold by Renesas Electronics Corporation or its affiliates.

II. to provide the plaintiff with information on the extent to which they have committed the acts described under B.I. since 28 December 2016, stating

1. the origin and distribution channels of the products mentioned under B.I., stating

a. the names and addresses of suppliers and other previous owners, and

b. the names and addresses of the commercial customers and the sales outlets for which the products were intended;

2. the quantity of products delivered, received or ordered and the prices paid for the products concerned; and

3. the identity of all third parties involved in the distribution of the products mentioned in section B.I,

whereby copies of the corresponding purchase documents (namely invoices, alternatively delivery notes) must be submitted as proof of the information, whereby details requiring confidentiality outside the data subject to disclosure may be blacked out;

III. to pay the plaintiff an amount of EUR 119,000 as provisional damages.

C. Defendants 2), 3) and 4) are obliged to compensate the plaintiff for all damages that she has suffered and will suffer as a result of the acts listed under B.I. committed since 28 December 2016.

D. Defendants 1), 5) and 6) are ordered to refrain from exercising their services as managing directors or directors of defendants 2) and 4) in such a way that the acts listed under B.I are carried out by defendants 2) and 4) outside the territory of the Federal Republic of Germany.

E. All acts of the defendants 2) and 4) as well as the legal consequences of such acts in the territory of the Federal Republic of Germany and all liability as an intermediary in relation to such acts are excluded from the decision under B. I., II. and III. as well as C. and D..

F. The plaintiff is authorised to announce and publish the decision in whole or in part in public media, in particular on the internet, at the defendant's expense. The General Data Protection Regulation must be observed.

G. For the rest, the action for infringement of the patent in suit is dismissed.

H. In the event of any violation of the orders pursuant to sections B.I and D, the respective defendants shall pay a penalty payment of up to EUR 100,000 to the court for each day of violation; in the event of violations of the orders pursuant to section B.II, the penalty payment shall be up to EUR 50,000 for each day of violation.

I. The counterclaims for revocation of the patent in suit are dismissed.

Admission of the defendants' rebuttal D7 submitted by the defendants in their statement of 15 March 2024 and the defendants' submissions in this regard is rejected.

J. The costs of the legal dispute will be distributed as follows:

The defendants shall bear the costs of the proceedings (costs of the action and the counterclaim) with the exception of 1/6 of the costs of the action, which shall be borne by the plaintiff.

K. The judgement is provisionally enforceable for the plaintiff without the provision of security.

INFORMATION ON THE APPOINTMENT

An appeal against this decision may be lodged with the Court of Appeal within two months of notification of the decision by any party whose requests have been wholly or partially unsuccessful (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RP).

INFORMATION ON ENFORCEMENT (ART. 82 EPGÜ, ART. ART. 37(2) EPGS, R. 118.8, 158.2, 354, 355.4 VERFO):

A certified copy of the enforceable judgement is issued by the Deputy Registrar at the request of the enforcing party, R. 69 RegR.

DETAILS OF THE DECISION

UPC number:	UPC_CFI_390/2023
Action for infringement:	ACT_583273/2023
Counterclaims for revocation:	CC_584891/2023

Requests for amendment of the patent:

App_13896/2024

Munich, 13 September 2024

Dr Zigann Presiding Judge	Matthias ZIGANN Digitally signed by Matthias ZIGANN Date: 2024.09.11 15:19:10 +02'00'
Brinkman Legally qualified judge	Edger Frank BRINKMAN Digitally signed by Edger Frank BRINKMAN Date: 2024.09.11 15:19:42 +02'00'
Pichlmaier Rapporteur	Tobias Günther Pichlmaier Digital signed by Tobias Günther Pichlmaier Date: 2024.09.11 14:50:24 +02'00'
Dr Hansson Technically qualified judge	Anders Max Hansson Digital signed by Anders Max Hansson Date: 2024.09.11 15:18:28 +02'00'
For the Deputy Chancellor	Catrin Meyer Digitally signed by Catrin Meyer Date: 2024.09.12 11:02:31 +02'00'