



Munich Local Chamber

UPC_CFI_390/2023

Main proceedings

of the Court of First Instance of the Unified Patent Court issued on 13

September 2024

Headnotes

1. The protection sought as determined from the description and drawings can only be the subject matter of the patent claim if it is also expressed therein.
2. If several embodiments are presented in the description as being in accordance with the invention, the terms used in the patent claim are to be understood, in case of doubt, as meaning that all embodiments can be used to fulfil them.
3. An infringer of a patent within the meaning of the EPGÜ is anyone who acts as a manufacturer or supplier or gives the impression to the relevant public that they are the person who manufactures and/or distributes the goods in their own name and on their own account.
4. If a company infringes a patent, an order pursuant to Art. 63(1) sentence 2 EPC (order against intermediaries) may be considered 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, with registered office 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, with registered office at Unit 1, Regent Park Booth Drive, Park Farm Industrial Estate, Wellingborough, Northamptonshire, England, NN8 6GR, United Kingdom

represented by: Dr Tilman Müller

- hereinafter referred to as "Defendants" -

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 CASE:

GERMAN

HEARING:

2 JULY 2024

DECISION:

13 SEPTEMBER 2024

Facts

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

The patent in suit was granted under the title

"Wireless inductive power transfer"

on 20 June 2013, claiming priority from US application US 201261665989 P dated 29 June 2012 and priority from European application EP 13162077 dated 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 reads as follows 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 configuration 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 specifying at least one of the operating parameters and the power transmitter (101) responding with a message accepting or rejecting the at least one operating parameter.

In the German language version, the claim reads:

Power transmitter (101) for an inductive power transfer system, wherein the inductive power transfer system, based on modulation of a power signal, enables two-way communication between the power transmitter (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 forced 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 acknowledging (511) the request to enter a requested negotiation phase by transmitting an acknowledgement to the power receiver (105); wherein the confirmation is indicative of acceptance 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 performing (513) the requested negotiation phase, wherein a second set of power transmission operating parameters for the power transmitter (101) and the power receiver (105) is selected; wherein, when in the negotiation phase (513, 515), the power transmitter (101) is configured to determine the second set of power transmission 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 transmission operating parameters is specified, and the power transmitter (101) responds with a message in which the at least one power transmission operating parameter is accepted or rejected.

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

Defendants 2) to 4) are companies belonging to the Belkin Group, which has its headquarters in the USA. Defendant 3) is the parent company of the Belkin Group and is based in California. Defendant 2) is a German subsidiary of the Belkin Group 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 both directors of Defendant 4.

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

On 10 August 2019, the plaintiff filed a lawsuit against defendants 2) and 4) at the Regional Court of Düsseldorf for infringement of the German part of the patent in suit in Germany. In its judgment of 20 March 2023, the Regional Court of Düsseldorf dismissed the action (Case No. 4a O 49/22). On 18 April 2024, the Higher Regional Court of Düsseldorf dismissed the appeal against this judgment as inadmissible on the grounds that the appeal did not comply with the legally prescribed form (Ref. I-2 U 59/23).

The plaintiff 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.

The website "www.belkin.com" offers chargers for wireless charging of electronic devices (Exhibit BP 1d; contested embodiments). The contested embodiments are power transmitters for inductive power transfer to a power receiver, which meet the requirements of the "Extended Power Profile (EPP)" of the Qi standard and are certified as compatible with this standard. In accordance with the standard, the contested embodiments can receive a so-called configuration packet from the power receiver, which comprises a value referred to in the standard as "Neg" (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, consisting of one bit, can be either 0 or 1. If the bit is set to 0, the power transmitter skips the negotiation phase and immediately begins power transmission. If the bit is set to 1, the power transmitter sends an acknowledgement and proceeds to 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 on 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) EPGÜ.

The defendants 1), 5) and 6) are independently liable on the basis of their activities as managing directors or directors; despite being aware of the infringements, they did nothing to prevent them and deliberately failed to use the means available to them in their official capacity to prevent infringements of third-party property rights.

The plaintiff **requested**

A. that the defendants be ordered

I. to refrain from

Power transmitter for an inductive power transmission system

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, for the aforementioned purposes, either import or possess,

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

wherein the power transmitter comprises:

means for generating the power signal;

means for receiving a signal strength packet from the power receiver to initiate a forced configuration phase;

means for performing the forced configuration phase, wherein a first set of power transfer 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 power receiver;

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 acceptance or rejection of the request to enter the requested negotiation phase;

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

means for performing the requested negotiation phase, wherein a second set of power transmission 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 transmission operating parameters in a number of negotiation cycles, wherein in each negotiation cycle the power transmitter receives from the power receiver a message in which at least one of the power transmission operating parameters is specified, and the power transmitter receives a message from the power receiver in which at least one of the power transmission operating parameters is specified, and the power transmitter responds with a message in which the at least one power transmission operating parameter is accepted or rejected,

(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 affiliated companies.

- II. to recall the infringing products referred to in 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 it has committed the acts referred to in A.I. since 28 December 2016, specifying
 1. the origin and distribution channels of the products referred to in Section I, stating
 - a. the names and addresses of the suppliers and other previous owners, and

- b. the names and addresses of the commercial customers and the points of sale for which the products were intended;
2. the quantity of products delivered, received or ordered, as well as the prices paid for the products in question; 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 relevant purchase documents (namely invoices or, alternatively, delivery notes) must be submitted as evidence of the information provided, whereby details requiring confidentiality may be blacked out in the data subject to the obligation to provide information;

- IV. to pay the claimant an amount of EUR 119,000 as provisional damages.
- B. The defendants are obliged to compensate the plaintiff for all damages incurred and to be incurred as a result of the actions listed in section A.I. committed since 28 December 2016.
- C. The plaintiff is permitted, at the defendants' expense, to publicise and publish the decision in whole or in part in public media, in particular on the Internet.
- D. In the event of any breach of the orders under Section A, the respective defendant shall pay a penalty of up to EUR 100,000 for each day of breach of order A.I. up to EUR 50,000 for each day of breach of order A.II. up to EUR 10,000 for each day of violation of order A.III.
- E. The defendants shall bear the costs of the legal proceedings.
- F. The judgment is immediately enforceable. In the event that security is ordered, the plaintiff is permitted to provide this in the form of a bank or savings bank guarantee, and the amount of the security shall be

determined separately for the individual enforceable parts of the judgment, with the following individual amounts being proposed:

Injunction: EUR 1,500,000 Recall &

removal: EUR 400,000 Information:

EUR 100,000

Provisional damages: EUR 119,000

- G. The applications under A. I., II. and III. and under B. are made on the condition that all actions of defendants 2) and 4) and the legal consequences of such actions within the territory of the Federal Republic of Germany are excluded from the applications.

The defendants are of the opinion that the proceedings should be suspended pursuant to Rule 295(1) EPG-VerfO in conjunction with Articles 29 and 30 of the Brussels I Regulation due to the parallel nullity and infringement proceedings pending in Germany (BPatG, Ref. 4 Ni 40/22 (EP); Higher Regional Court of Düsseldorf, Ref. I-2 U 59/23). The application for suspension should be examined in priority to the actual substantive applications.

The infringement action should 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 further argue that the patent in suit should be declared invalid on the grounds of inadmissible extension compared to the documents originally filed, lack of feasibility and lack of patentability. The subject matter of the contested independent patent claims is inadmissibly extended in relation to the disclosure of the international application of 20 June 2013 and is not disclosed in the contested patent specification in such a clear and complete manner that a person skilled in the art could carry it out. The subject matter of the contested independent patent claims according to the contested patent is not new in relation to the prior art and is in any case not based on an inventive step. The plaintiff bases its submission on the following documents:

- D1: EP 2 712 051 A2
- D2: US 2010/0013319 A1

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

The defendants then **requested**

- I. that the proceedings be suspended in accordance with Rule 295(1) EPGVerfO in conjunction with Articles 29 and 30 EuG-VVO;
- II. to dismiss the action;
- III. as a counterclaim, that 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, whereby for the defendant and counterclaimant 2) (Belkin GmbH) the application is made with the proviso that the revocation is excluded with effect for the territory of the Federal Republic of Germany;
- IV. that the plaintiff be ordered to pay the costs of the legal proceedings, including the costs of the counterclaim;
- V. declare the judgment enforceable with regard to the costs, either immediately or, alternatively, against security (deposit or bank guarantee with a European bank).

The plaintiff has **requested that**

1. that the defendant's application for suspension of proceedings under R. 295 (I) VerfO in conjunction with Art. 29, 30 EuGVVO be rejected;
2. to dismiss the counterclaims for annulment of EP 2 867 997 with costs;

Alternatively to 2.:

3a. dismiss the counterclaims for revocation of EP 2 867 997 with costs, insofar as they exceed the scope of the patent in suit as set out in

- (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;

whereby the requests for amendment of the patent in suit are submitted in ascending order of numbering and as closed sets of claims;

3b. to grant the claims announced in the statement of claim for infringement of the patent against defendants 1) to 6), with the proviso that the wording of claim 20 reproduced on page 8f. in the claim under point A. I. is drafted in accordance with the auxiliary claim deemed legally valid by the Chamber.

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

The defendants have **requested** that

- I. that the action be dismissed insofar as a patent infringement based on claim 20 is sought in the form of auxiliary requests;

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

In their 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, in their written submission of 11 March 2024, the defendants submitted legal opinions on directors' and officers' liability in France, Italy, Sweden, the Netherlands and Austria (Annexes B 6a to B 6e).

Referring to this, the plaintiff objected to the new submission in the reply as being late and therefore **requested** in the rejoinder to the counterclaim for annulment that

1. to disregard the legal opinions submitted by the defendants in their written statement of 15 March 2024 in Annexes B 6a to B 6e and the defendants' arguments in this regard in the same written statement;
2. to disregard the citations US 7,671,559 B2 and WO 2012/049582 A1 submitted by the defendants in their written statement of 15 March 2024 in Annexes D7 and D8, as well as the defendants' arguments in this regard in the same written statement;

In the alternative to point 2:

- 3a. to allow the auxiliary requests 5 and 6 submitted with the present written statement in accordance with R. 30(2) VerfO; and
- 3b. dismiss the counterclaims for revocation of EP 2 867 997 with costs, insofar as they go beyond the wording of the patent in suit according to one of the auxiliary requests submitted with the reply and response 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)

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

The defendants responded to this with a rejoinder to the action for annulment and a reply to the application for amendment of the patent, requesting

1. that auxiliary requests 5 and 6 should not be admitted (request 3a from the counter-defendants' written statement of 11 April 2024);
2. alternatively, in the event that the request under point 1 is rejected, counterclaiming that 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, including in the version of auxiliary requests 5 and 6, whereby for the defendant and counterclaimant 2) (Belkin GmbH), the request is made with the proviso that the revocation is excluded with effect for the territory of the Federal Republic of Germany.
3. alternatively, in the event that the application under point 1 is rejected, to dismiss the action insofar as a patent infringement based on claim 20 is sought in the form of auxiliary requests 5 and 6;
4. not to allow the counter-defendant's submission on the sub-claims in the written statement of 11 April 2024;
5. in the alternative, in the event that the application pursuant to item 4 is rejected, to admit the following submission under item D. on the subclaims;
6. Reject the applications under 1 and 2 in the counter-defendant's written statement of 11 April 2024 are to be rejected;

7. not to take into account the late submission by the counter-defendant in the counter-defendant's written statement of 9 January 2024, section I, pp. 21–40, insofar as it refers to other countries such as Germany.

The defendants further **requested**

1. that the judgment of the Higher Regional Court of Düsseldorf, served on the defendants on 18 April 2024, ref. no. I- 2 U 59/23, be recognised in accordance with Art. 36(1), (3) of the Brussels I Regulation;
2. Alternatively, 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 for a preliminary ruling as to whether, in a case such as the present one, EU law is to be interpreted as meaning that the judgment of the Higher Regional Court of Düsseldorf, served on the defendants on 18 April 2024, Ref. I- 2 U 59/23, served on the defendant on 18 April 2024, is to be recognised in accordance with Article 36 of the Brussels I Regulation, with the result that the liability of defendants 1), 5) and 6) is in any case excluded.

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

Reasons

A.

The defendants' application for a stay of proceedings is rejected.

1. A stay of proceedings due to nullity proceedings pending in Germany is out of the question.

The defendants base their application for suspension on Article 30 of the Brussels I Regulation and consider suspension to be necessary in order to avoid conflicting decisions with regard to the German part of the patent in suit.

A first-instance decision by the Federal Patent Court concerning the German part of the patent in suit has now been issued. The grounds for the application for suspension set out in the statement of defence, namely that a decision by the Federal Patent Court was expected in the foreseeable future, are therefore no longer valid.

This means that there is, at most, a reason for suspension with regard to a possible decision by the Federal Court of Justice in the German nullity proceedings. Contrary to Rule 295(a) EPGVerfO, if the second defendant appeals against the judgment of the Federal Patent Court to the Federal Court of Justice, a decision by the Federal Court of Justice is not to be expected in the short term; the requirements of Rule 295(a) EPGVerfO are therefore not met.

A suspension pursuant to Rule 295(l) EPGVerfO, Art. 30(1) EuGVVO is also not appropriate, insofar as these are applicable at all alongside the specific Rule 295(a) EPGVerfO. Pursuant to Art. 32 EPGÜ, the EPG has exclusive jurisdiction for actions for revocation. In addition, the jurisdiction of the Federal Patent Court (BPatG) and the Federal Court of Justice (BGH) is limited to the German part of a European patent, whereas decisions of the EPO on the legal status of a European patent pursuant to Art. 34 EPC apply to the territory of all contracting member states for which the patent is effective.

2. Nor is it possible to suspend the proceedings on the grounds of parallel infringement proceedings pending in Germany.

In the infringement proceedings against defendants 2) and 4), the plaintiff's appeal was dismissed as inadmissible by decision of the Higher Regional Court of Düsseldorf on 18 April 2024. This means that no infringement proceedings are pending in Germany. The defendants do not assert – beyond the application under Article 36 of the Brussels I Regulation – that the legal force of the decision of the Higher Regional Court of Düsseldorf could preclude a decision in the present proceedings; a conflicting legal force with regard to defendants 2) and 4) is ruled out in view of the claim under section G.

B.

The patent in suit is legally valid in the form in which it was granted. The counterclaims for annulment of the patent in suit were therefore dismissed.

I. Expert

The person responsible for assessing the teaching of the patent is a graduate engineer in electrical engineering or a corresponding master's degree holder with practical experience in the field of inductive power transfer, in particular for charging secondary devices. The expert is also familiar with the content of the relevant standards, in particular the 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 transfer system, in particular based on the Qi specification applicable at the priority date, in which communication takes place between the energy transmitter and the power receiver in order to prepare and control the power transfer (patent in suit, paragraphs [0001] to [0008]).

The inductive power transmission serves 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 (paras. [0010], [0011], [0029], [0061] to [0063], [0135]) and communication is only possible unidirectionally from the power receiver to the power transmitter (paras. [0013] to [0016]), even though attempts at bidirectional communication have already been made (paras. [0017], [0031]).

Until now, all service providers or service transmitters had to be able to meet all requirements of any service recipients. This approach hindered or prevented further development, as it led to a loss of backward compatibility (paras. [0030], [0033]).

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

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

1. Patent claims

According to the patent in suit, the task is to be solved by a system for inductive power or energy transfer according to patent claim 19 and a power or energy transmitter according to patent claim 20. Only patent claim 20 is asserted in the infringement action.

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 configured to generate a wireless power signal for the power receiver (105), and
 - 19.2.1 the inductive power transfer system is configured 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 configured to initiate a mandatory configuration phase by transmitting a signal strength packet to the power transmitter (101);
- 19.4 the power transmitter (101) and the power receiver (105) are configured to perform the mandatory configuration phase (505, 507), wherein
 - 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 power receiver (105) is configured to transmit a request to enter a requested negotiation phase;

characterised in that

- 19.6 the power transmitter (101) is configured to confirm the request to enter the requested negotiation phase by transmitting an acknowledgement to the power receiver (105),
 - 19.6.1 wherein the confirmation indicates an acceptance or rejection of the request to enter the requested negotiation phase;
- 19.7 the service sender (101) is configured to enter the requested negotiation phase in response to receiving the request to enter the requested negotiation phase;
- 19.8 the power receiver (105) is configured to enter the requested negotiation phase in response to receiving the acknowledgement from the power transmitter (101) if the acknowledgement indicates acceptance of the request to enter the requested negotiation phase;
- 19.9 the power receiver and the power transmitter are configured 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 transmission operating parameters is selected for the power transmitter (101) and the power receiver (105); wherein,
- 19.9.2 in each negotiation cycle, the power receiver (105) transmits 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.

Claim 20:

- 20.1 Power transmitter (101) for an inductive power transfer system,
 - 20.1.1 wherein the inductive power transfer system supports two-way communication between the power transmitter (101) and a power receiver (105) based on modulation of a power signal, wherein the power transmitter comprises:
 - 20.2 means for generating the power signal;
 - 20.3 means for receiving a signal strength packet from the power receiver (105) to initiate a forced configuration phase;
 - 20.4 means for performing the forced 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 negotiation phase from the power receiver (105); characterised in that it further comprises:
 - 20.6 means for acknowledging (511) the request to enter a requested negotiation phase by transmitting an acknowledgement to the power receiver (105);
 - 20.6.1 wherein the confirmation indicates acceptance or rejection of the request to enter the requested negotiation phase;
 - 20.7 means for entering the requested negotiation phase in response to receiving 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 transmission operating parameters in a number of negotiation cycles,
- 20.8.2 wherein, in each negotiation cycle, the power transmitter (101) receives a message from the power receiver (105) specifying at least one of the power transmission operating parameters, and the power transmitter (101) responds with a message in which the at least one power transmission operating parameter is accepted or rejected.

2. Interpretation

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

From the perspective of the expert interpreting the patent claim, this is not only the starting point, but also 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 drawings must always be consulted as aids to the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim. However, this does not mean that the patent claim serves merely as a guideline and that its subject matter also extends to what, after examination of the description and drawings, represents the patent proprietor's protection requirements (UPC_CoA_335/2023). As stated in the Protocol to Art. 69 EPC, when interpreting a patent claim, a balance must be struck between adequate legal certainty for third parties and adequate protection for the patent proprietor.

The skilled person reads the patent claim in a manner 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, for example, EPO, decision of 6.

March 2001, Ref. T 190/99). The same applies to the description and 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 protection sought as determined from the description and drawings can only be the subject of the patent claim if it is also expressed therein.

On this basis, the skilled person understands patent claim 20 as follows:

- a. For the patented system for inductive power transmission from a power transmitter ("charging station") to a power receiver ("terminal device"), a power transmitter with the following characteristics is required:
 - aa. On the one hand, the patented power transmitter should be able to perform the configuration phase described in features 20.3 to 20.4.1 and already known from the Qi standard applicable at the priority date. According to the wording of the claim, this phase must be carried out by the power transmitter when it receives a signal strength packet from a power receiver, which initiates the configuration phase. 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 serves to configure the power transmitter using the parameters transmitted by the receiver.
 - bb. The patented power transmitter, on the other hand, should be able to carry out the **negotiation phase** described in features 20.5 to 20.8.2.
- (1.) According to the Qi specification applicable at the priority date, the configuration phase is followed by the power transfer phase. However, according to the patent, contrary to the Qi specification applicable at the priority date, the configuration phase may 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 support the

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

- (2.) Whereas the Qi specification applicable at the priority date only provides for unidirectional communication from the power receiver to the power transmitter, power transmitters according to the patent 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 negotiation phase according to the patent takes place through **bidirectional communication** between both devices.
- (3.) Features 20.5, 20.6 and 20.6.1 describe the means that must be available to the power transmitter in order 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 by means of a **request** to enter the negotiation phase; consequently, the service sender requires a means of receiving this request (feature 20.5). Before the negotiation phase can be entered, the service provider must accept the request to enter the negotiation phase from the service recipient by means of bidirectional communication ("acceptance", feature 20.6.1 of the patent in suit). In this way (request and acceptance), the service recipient and service provider "agree" to enter the negotiation phase.

(4.) Since this process involves two-way communication, the service recipient sends a request to the service provider and the service provider sends an acceptance to the service recipient if the negotiation phase is to be entered into. Such acceptance of the request to enter into the requested negotiation phase is transmitted to the service recipient by means of a confirmation, as specified in the claim.

In the grant procedure referred to by the defendants (for consideration of the grant procedure in the interpretation, see order of the Munich Local Chamber of 20 December 2023; UPC_CFI_292/2023), based on the original wording of the version applied for,

"...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);..."

there was clearly a need for clarification with regard to patentability, insofar as the corresponding feature ("...to acknowledge the request... by transmitting an acknowledgement...") was understood to mean that the power transmitter merely confirms receipt of the request. However, the originally submitted application documents (submitted as Annex B3) state:

If the power transmitter 101 supports negotiation, it acknowledges receipt 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 following the configuration phase and before the power transfer phase would otherwise begin. The power transmitter 101 then proceeds to enter the negotiation 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 should clarify that not only is the receipt of the request confirmed, but that the request is also answered in terms of content (acceptance or rejection). In a letter dated 10 February 2014, the applicant stated the following to the EPO in this regard:

It is noted that, as clarified in the claims submitted herewith, 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 parameter settings).

In doing so, it has made it clear that, according to the patent, it is not just a matter of *confirming receipt* ("... solution is not merely to confirm receipt of messages..."), but of responding to the request in accordance with the specifications in the originally submitted application documents.

(5.) The wording of feature 20.6.1 thus clarifies that a mere confirmation of receipt by the power transmitter does not correspond to the teaching of the patent. However, the wording of feature 20.6.1 has apparently given rise to a new problem of understanding:

(a.) The service recipient's request to conduct a negotiation phase may also be rejected by the service provider. 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 claim-compliant confirmation of the request to enter into the negotiation phase is also possible in the form of a rejection of this request.

With regard to feature 20.6.1, the parties dispute whether service providers that always confirm requests to enter the requested negotiation phase with an acceptance are also compliant with the claim.

(b.) Interpretation of the plaintiff

The applicant interprets feature group 20.6 to mean that even a service transmitter that *a/ways* responds to the request with acceptance and never with rejection is compliant. This follows, on the one hand, from the fact that the conjunction "or" in feature 20.6.1 expresses various alternatives, one of which is general acceptance; 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 further considers that, according to the patent, the request could also be rejected by mere inaction on the part of the power transmitter; in this context, the applicant refers to paragraph [0173] of the description, which mentions the case where a power transmitter according to the claim may decide not to respond to a request from the power receiver to enter the negotiation phase, but instead select a fallback to the energy and data transfer strategy according to Qi specification version 1 (para. [0173]: "Further, if the power receiver does not receive 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. Similarly, the transmitter may be a recent one that does support a negotiation phase, but may elect to fall back to a version 1 power transmission strategy (and associated communication strategy)."). This also expresses a rejection

the power receiver's request to enter the negotiation phase.

(c.) Interpretation of the defendant

The defendants, on the other hand, understand feature group 20.6 to mean that a patented power transmitter sends a confirmation in response to the request, whereby either acceptance or rejection can be declared. According to the wording of the claim, it would not be in accordance with the claim if acceptance were generally declared with every confirmation, because then the possibility of rejection provided for in the claim would not exist. In this regard, the defendants also refer to paragraph [0173] of the patent in suit, which describes the requirement for rejection. In the defendants' understanding, mere inactivity is also not a confirmation in accordance with the claim, since confirmation containing rejection of the request 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 Regional Court of Düsseldorf also interpreted claim 20 of the patent in suit in this way.

(d.) Interpretation by the Regional Court of Düsseldorf

In the cited decision, the Regional Court of Düsseldorf, referring to the wording of the claim, takes the view that, according to feature group 6, the performance transmitter *must be able* to indicate both acceptance and rejection with the confirmation to be transmitted; A restriction to the effect that the service transmitter must only be able to accept or reject does not result from the conjunction "or" in feature

20.6.1. Nor does paragraph [0046] indicate that it is sufficient for a service transmitter to be able to transmit only acceptance in accordance with the claim. For example, rejection may be necessary if it resorts to another version of the service transmission, as described in paragraph [0173].

(e.) Interpretation by the Federal Patent Court

The Federal Patent Court understands the patent in suit to mean that an energy transmitter according to the contested patent is designed to be able to reject a negotiation request – depending on the situation – by means of a corresponding negative response. The Federal Patent Court apparently concludes this from feature 20.6.1, which was newly added to the original claim version and according to which a confirmation can indicate not only acceptance but also rejection.

(f.) Interpretation by the Local Chamber

From the perspective of the Local Chamber, two questions arise in connection with the interpretation of feature 20.6.1. The first is whether, from the perspective of the skilled person, the description of the patent in suit also describes a configuration in which a declaration of acceptance is always sent to the service recipient as confirmation of the service provider's request.

If the skilled person answers this first question in the affirmative, the further question arises as to whether this configuration is also expressed in the wording of the claim.

(aa.) The Local Chamber answers the first question in the affirmative. Paragraph [0046], which is already found in the section "Summary of the invention", describes a configuration in which a declaration of acceptance is always sent to the service recipient as confirmation of the service provider's response to a corresponding request.

The description in this paragraph reiterates that the negotiation phase is optional, i.e. it does not have to be carried out. 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, according to paragraph [0046] it may be mandatory for new types of devices to support this phase. Paragraph [0046] 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."

In this constellation, the negotiation phase is therefore optional insofar as its implementation depends on the wishes of the power receiver ("...if desired by the power receiver."). If the power receiver wishes to enter the negotiation phase, i.e. exercises its option by sending a corresponding request to the power transmitter, the power transmitter is obliged ("mandatory") under paragraph [0046] to comply with this request ("... mandatory support ... may be required in order to enable power receivers to enter this phase if requested.") However, in order to enter the negotiation phase at the request and demand of the power receiver, a declaration of acceptance by the power transmitter is required. In the view of the Local Chamber, paragraph [0046] thus describes a constellation in which **a declaration of acceptance is always** transmitted to the power receiver as confirmation of the power transmitter's response to a corresponding request, thereby enabling the negotiation phase to be entered.

The constellation described in paragraph [0046] thus also corresponds to the objective of the patent in suit, which is to create the possibility of conducting a negotiation phase in accordance with the patent (see paragraph [0041] of the patent in suit) as a further development of the Qi standard existing at the priority date.

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

According to Article 69(1) EPC, the scope of protection of a patent is determined by the patent claims. In order to make this determination, the technical meaning to be attributed to the wording of the patent claim from the perspective of a person skilled in the art must first be established, taking into account the description and drawings. In doing so, 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 explanations in the description and the illustrations 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 parts 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 to be understood, in case of doubt, as meaning that all embodiments can be used to fulfil them.

An interpretation according to which the embodiment described in paragraph [0046] does not fall under the patent claim is not absolutely excluded. However, it would only be considered if other possible interpretations, which at least lead to the inclusion of some of the embodiments, are necessarily ruled out or if sufficiently clear indications can be inferred from the patent claim that something is actually claimed that deviates from the description.

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

Reading claim 20 of the patent in suit in context reveals the patented function of the means described in feature 20.6:

Claim 20 describes means whose purpose is to generate the performance signal. It also describes means whose purpose is to initiate the mandatory configuration phase. It describes means whose purpose is to carry out the mandatory configuration phase. Finally, feature group 20.6 describes means whose purpose is to initiate the start of a negotiation phase between the receiver and the transmitter. Finally, feature 20.7 describes means for actually entering the initiated negotiation phase. The function of the described means is therefore clearly to enable the execution of certain phases or

preparatory processes for such phases, such as initiating the negotiation phase.

A functional interpretation based on the wording means that, according to feature 20.6, the following must be present in accordance with the claim: (1) means for receiving a request to enter into the negotiation phase and (2.) means for confirming the request must be present, 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 power transmitter's response to the power receiver's request can therefore be "yes" or "no". This primarily expresses that – as was still unclear according to the original wording of the claim – it is not sufficient for the service sender to merely confirm receipt of the request; the service recipient must also receive a response ("yes" or "no") to indicate ("being indicative") whether the negotiation phase will actually be 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 provider to accept the request.

The question now is whether a power transmitter that meets the requirements must also be able to reject a request 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), or whether the wording of feature 20.6 also includes embodiments that always accept requests from power receivers to enter the negotiation phase, i.e. do not provide for rejection.

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

From a technical point of view, with regard to the stated objective of the patent in suit (enabling entry into a negotiation phase), the Local Chamber cannot justify that a service provider operating in accordance with the patent 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; This was also correctly established by the Regional Court of Düsseldorf, which therefore assumed that a power transmitter that only transmits rejections is not patent-compliant. In contrast, paragraph [0046] describes the optimal implementation of the objective of the patent in suit: a power transmitter that always complies with a request to enter the negotiation phase.

If this possibility were not to be excluded as claim 20 of the patent in suit, only a service transmitter that must also be able to respond negatively to a request would remain in accordance with the claim. However, the description does not provide any indication that such a negative decision by the transmitter *must* also be possible in the initiation phase. In particular, this is not apparent from paragraphs [0172] and [0173]. Two of the three power transmitters described there do not carry out a negotiation phase at all, nor do they have the means to do so. The third power transmitter does have the means to conduct a negotiation phase, but decides not to do so, communicating this fact in accordance with the communication strategy from the prior art, namely not at all. It simply remains silent. These are therefore not examples of implementation in accordance with the claim. Accordingly, the end of paragraph [0173] contains an apt summary of the examples listed:

"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 the means to conduct a

conduct a negotiation phase. However, in comparison to the previously known power transmitters, they have the means to reject a corresponding request to enter the negotiation phase. Previous power transmitters did not respond to such requests. Consequently, such power transmitters are not patent-compliant 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 power transmitters do not support the negotiation phase and therefore do not respond to corresponding requests and, on the other hand, those in which the new power transmitters, although they could support the negotiation phase, resort to a transmission strategy of version 1 of the Qi standard and the associated communication strategy. As stated in sentence 2 of paragraph [0173], the communication strategy of the previous power transmitters was not to respond to requests to enter the negotiation phase, either positively or negatively. Neither of these responses is clearly in line with the requirements.

Therefore, paragraphs [0172] and [0173] do not provide any technical justification for requiring a rejection statement for a power transmitter equipped in accordance with claim 20, because such a declaration is not made if a power transmitter of an older design (versions 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, rejection of a request is not necessary.

Contrary to the statements of the Regional Court of Düsseldorf, paragraph [0173] cannot be used to justify that a power transmitter must be able to indicate both acceptance and rejection. Nor does the Regional Court of Düsseldorf explain how the embodiment described in paragraph [0046] is related to the constellations described in paragraph [0173], which do not concern the entry into the negotiation phase as described in the patent. Based on the patent specification and in view of the objective of the patent, there is 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.

Nor does anything else arise from the wording of feature 20.8.2. Here, too, there is an "or" link in connection with a positive ("accepting") or negative ("rejecting") response from the power transmitter. 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 transmitter during the negotiation phase to a specified request for a particular operating parameter.

In addition, the core of the invention lies precisely in the fact that the power transmitter and power receiver can, if possible, enter into a (bidirectional) negotiation phase in order to achieve (in particular) higher power. This objective is even achieved in an optimal manner in the case of a power transmitter that always agrees to enter into this phase of negotiations. According to the defendant's interpretation, such an embodiment would be excluded from patent protection and could be used without any consideration in return. This is not adequate protection within the meaning of the Interpretation Protocol, especially since it is clear from the description that entering into this negotiation phase may be mandatory (paragraph [0046]). This also ensures adequate legal certainty for third parties, as a third party cannot reasonably assume that the hard coding of the confirmation ("acceptance") falls outside the scope of protection of the patent claim.

In view of the above, it can be assumed that a service provider who transmits a confirmation with an acceptance in response to every request is a possible embodiment according to claim 20 of the patent in suit. No other interpretation can be made for claim 19 of the patent in suit.

III. Legal status of the patent in suit

The grounds asserted by the defendants for the invalidity of the patent in suit are not valid.

1. Disclosure of origin

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

The statement that the confirmation by the service provider "indicates" ("being indicative") the acceptance or rejection of the request to enter the negotiation phase (features 19.6.1, 20.6.1) does not, in the opinion of the skilled person, go beyond the understanding of the originally filed documents.

The original documents state that the confirmation 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)."). Thus, the skilled person has understood from the original documents that the acknowledgement can be made either by a separate message or by a message that primarily has other content and merely implies the acknowledgement. In view of this, the wording "being indicative" is permissible.

2. Feasibility

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

Taking into account the understanding of a person skilled in the art that the independent patent claims only protect power transmitters that are capable of entering into a negotiation phase according to the invention, whereby they expressly accept or reject a corresponding request

rejecting a corresponding request, the person skilled in the art is able to reproduce the protected methods and devices without having to be inventive themselves.

3. Patentability

The subject matter of the patent in suit is protectable.

a. Novelty of the patent in suit over D1

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

D1 relates to a transmitter and a receiver in a wireless power transmission system. D1 does not explicitly or implicitly indicate that communication between the transmitter and receiver is based on modulation of the power signal; thus, feature 20.1.1 of the patent in suit is not disclosed in D1 (see also Federal Patent Court, judgment of 12 July 2024, p. 40).

D1 merely states that the two communication units communicate with each other via a wired or wireless connection. This alone does not directly and unambiguously indicate communication in which information is modulated onto a power signal (see also Federal Patent Court, judgment of 12 July 2024, p. 40).

The defendants' assertions regarding modulation of the power signal, which were 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 refer to D2 and D6 in this respect, this constitutes a combination with other documents that is inadmissible in the context of the novelty examination, but does not constitute evidence of general technical knowledge (see, for example, EPO, decision of 23 January 2018; Ref. T 2074/14). Insofar as the defendants derive the disclosure of a communication based on 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: D1 indisputably states in its description that the WLAN standard IEEE 802.15.4 is used for data communication; that corresponding interfaces for this standard are not shown in a schematic drawing of D1

does not constitute a disclosure of *another* type of data communication (in this case: based on modulation of the power signal); such a disclosure does not result directly from the drawing. Insofar as the defendants refer to paragraph [0178] of D1 ("...the transmitter increases the output power to enable the receiver to communicate with the transmitter...") and thus argue that this speaks in favour of data communication by means of modulation of the power signal, this also does not lead to success. Paragraph [0178] does refer to an increase in power to enable communication. However, it does not refer to modulation of the power signal. Nor did the defendants argue 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 are already apparent from the prior art.

- bb. In view of the corresponding features 20.1.1 and 19.1.1, the patentability of the subject-matter of patent claim 19 cannot be assessed differently from that of patent claim 20 in relation to publication D1.

b. [Novelty of the patent in suit over D2](#)

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

The defendants are of the opinion that feature 20.5 of the patent in suit is disclosed by 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 provider; the defendants refer in particular to paragraphs [0232] and [0233] of D2 in this regard. In the defendants' view, the start of 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 according to the patent. Accordingly, according to the teaching of D2, the setup frame contains

"communication condition information", which determines whether further operating parameters can be negotiated. According to the teaching of D2, the setup frame therefore already contains the operating parameters to be negotiated (statement of defence, p. 54). In a next step, the power transmitter checks the transmitted setup frame, whereby it can confirm it in order to enter the requested negotiation phase (statement of defence, p. 56). After entering the negotiation phase, the power receiver creates a start frame and transmits it to the power transmitter. The power transmitter then sends the start command for power transmission. Figure 15 of D2 shows the sequence of this "setup phase" of D2, in which "setup frames" are exchanged, first from the power receiver to the power transmitter (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 negotiation phase as described in the patent. According to the patent, the negotiation phase is preceded by a separate "request phase" which serves to clarify between the sender and receiver whether the negotiation phase will be 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 from the sender after positive verification of the setup frame and the parameters transmitted with it, a signal to enter a negotiation phase is not sent, but rather the request with regard to the desired operating parameters is complied with. A negotiation phase does not take place afterwards. Rather, as the Federal Patent Court correctly states, power transmission begins afterwards.

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

In view of the matching features compared to this publication, the patentability of the subject matter of patent claim 19 is to be assessed in the same way as that of patent claim 20.

c. [Novelty of the patent in suit over D3](#)

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

According to the defendant's submission, it cannot be inferred from publication D3 that the power transmitter confirms the power receiver's request and transmits this confirmation to the receiver. Rather, the transmitter terminates the power transmission and returns to the configuration phase, in which the receiver communicates its operating parameters to the transmitter without further "negotiation". This clearly does not constitute confirmation of the request within the meaning of feature 20.6 of the patent in suit (as in BPatG, judgment of 12 July 2024). Nor does D3 describe a negotiation phase in accordance with the patent.

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

In view of the matching features compared to this publication, the patentability of the subject matter of patent claim 19 is to be assessed in the same way as that of patent claim 20.

d. [Novelty of the patent in suit over D6](#)

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

The defendants argue that the power supply device disclosed in 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 is apparent 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 states 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 therefore consider claim features 20.5 and 20.6 to be disclosed. The Local Chamber cannot recognise that the transmission in question by the receiving device constitutes a request to enter into a negotiation phase. Nor can confirmation of the request to enter into such a negotiation phase be established by the fact that the power transmitter transmits its own information to the receiving device, 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 are already apparent from the prior art.

In view of the matching features compared to this publication, the patentability of the subject matter of patent claim 19 is to be assessed in the same way as that of patent claim 20.

4. Inventive step

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

In particular, the defendants fail to convince the Local Chamber with their assertion that a person skilled in the art who is confronted with the problem described in Chapter 5.1 of D4, namely to implement the service recipient's request

to renegotiate the power transfer agreement into a system for inductive power transfer, would provide corresponding confirmation messages within the meaning of the patent in suit. Neither D4 nor the other citations submitted (D2, D5, D6), which may be relevant for the assessment of inventive step, describe the patented system relating to the entry into a negotiation phase and its implementation.

IV. Late submission of citation D7

Insofar as the defendants based their actions for annulment on D7 for the first time in their 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 justify the lack of inventive step with regard to the granted version in the context of the counterclaim, constitutes an extension of the counterclaim for revocation, because the submission is based – extending the previous submission – on a further citation and thus new factual submissions. This constitutes an extension of the counterclaim within the meaning of Rule 263 EPGVerfO. The defendants have not submitted any arguments which, under Rule 263.2 EPGVerfO, could justify the admission of this extension of the counterclaim for revocation despite the delay. The extension of the counterclaim was therefore not admissible.

V. Requests for amendment of the patent in suit

Since the counterclaims were unsuccessful, there was no longer any need to decide on the requests for amendment of the patent.

C.

The infringement action is largely well-founded.

I. Patent infringement

The contested embodiments implement all the features of claim 20 of the patent in suit. This constitutes patent infringement.

1. Claim fulfilment

The contested embodiments implement all features of claim 20 of the patent in suit.

The defendants counter the accusation of patent infringement by arguing that, based on a correct interpretation of the claim, the contested embodiments do not implement the technical teaching of claim 20. The Qi standard version 1.2.4 cited by the plaintiff does not stipulate that power transmitters must be able to respond to requests from power receivers to enter the requested negotiation phase with a rejection 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 features 20.6 and 20.6.1 are implemented.

According to section 5.1.2.3, the Qi standard stipulates that when a configuration packet with a value of 1 in the Neg field is received, the power transmitter sends an acknowledgement response and then enters the negotiation phase. This acknowledgement response transmits a confirmation within the meaning of feature group 20.6 of claim 20 of the patent in suit. The fact that the contested embodiments can also respond to requests from power receivers with rejecting confirmations is not necessary according to the correct interpretation of the patent claim (for interpretation, see B.II.2. above).

2. Passive legitimacy

Defendants 2), 3) and 4) are passively legitimised as infringers and can therefore be held liable under Articles 63, 64, 67 and 68 EPGÜ. Although defendants 1), 5) and 6) are not themselves infringers, they can be held liable as intermediaries under Article 63(1) sentence 2 EPC.

a. Action against infringers

Under Articles 63, 64, 67 and 68 EPCU, orders and injunctions may be issued against the infringer.

The provisions of the Convention on the determination of patent infringement, the legal consequences of patent infringement and the debtor of claims and measures are to be interpreted autonomously, i.e. without recourse to national law, in accordance with Union law (see LK Düsseldorf, order of 6 September 2024, UPC_CFI 166/2024. 1st guiding principle). The term "infringer" is a term under Union law which originates from the Directive on the enforcement of intellectual property rights (2004/48/EC). According to its Article 1, this Directive also applies to patent law. The term "infringer" under Articles 63 et seq. EPGÜ must therefore be interpreted in accordance with the principle of the primacy and observance of EU law (Article 20 EPGÜ) and the binding decisions of the ECJ in this regard (Article 21 EPGÜ).

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

Furthermore, the ECJ has ruled that the use of signs identical or similar to trademarks in sales offers is exclusively carried out by those who act as sellers or give the impression to the relevant public that they are the ones who distribute the goods in their own name and on their own account. Accordingly, a service provider does not itself use a sign identical or similar to a third party's trademark if the service it provides is not comparable in nature to a service intended to promote the distribution of goods bearing that sign and does not imply that a connection is established between that service and the sign, because the service provider in question does not appear before the consumer, which excludes any conceptual connection between its services and the sign in question (ECJ C-148/21, C-184/21 – Christian Louboutin v Amazon Europe Core Sàrl and others).

In view of the uniform European legal framework for the enforcement of intellectual property rights and the similarity of the acts of use with regard to products protected by patent law or bearing a trademark, there is no reason not to apply the case law of the ECJ on the concept of an infringer in trademark law to patent law as well. According to this, an infringer within the meaning of Articles 25 and 26 EPCU is anyone who actively carries out the acts of use in question themselves. Legal persons may also be considered as infringers.

b. Instigators and accomplices

Whether, beyond this, based on a dynamic interpretation of the Convention on the basis of legal principles generally recognised in the Contracting States or on the basis of national provisions applicable in individual cases, the defendants in 1), 5) and 6) can also be held liable for participation in the infringement (e.g. incitement or aiding and abetting) under Article 63(1) sentence 1 EPCU can be left open in the present case; the plaintiff has failed to present specific facts to this effect that and how defendants 1), 5) and 6) participated in the patent-infringing acts of defendant 2) and

4) intentionally participated in the patent-infringing acts of the second defendant (by inciting or aiding and abetting them). Incitement or aiding and abetting is a mandatory element of the offence in all variants. The plaintiff has only argued in general terms that the first,

5) and 6) are managing directors or directors of defendants 2) and 4) and are liable as infringers due to their position.

c. Claims as an intermediary

However, recourse as an intermediary pursuant to Art. 63(1) sentence 2 EPGÜ may be considered.

aa. General requirements

According to its wording, the prerequisite for issuing an order pursuant to Article 63(1) sentence 2 EPGÜ is that the party against whom the claim is made

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

Furthermore, the possibility of issuing an order against the intermediary implies that the intermediary must be able to influence the infringement at all and, in the best case, be able to terminate the use. Art. 63(1) sentence 2 EPCU does not stipulate any further requirements for claiming against an intermediary, such as a breach of duty of care.

bb. Concept of intermediary

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

"it must be established that he offers a service that is suitable for use 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 et al. v Delta Center a. s., on Article 11 of Directive 2004/48/EC)

The nature of such a service is not further specified in Article 63(1) sentence 2 EPGÜ – unlike, for example, in Regulation (EU) 2022/2065, 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 (in this case: a patent).

Accordingly, in Case C-494/15, the ECJ ruled that a tenant of market halls who sublets the various sales areas in these halls to traders, some of whom use their stalls to sell counterfeit branded goods, also falls within the definition of an intermediary within the meaning of Article 11(3) of Directive 2004/48/EC.

The term "intermediary" (in the English version of the EPGÜ) is therefore not limited to providers of intermediary services within the meaning of Regulation (EU) 2022/2065. In the context of Article 63 EPC (Article 11 Directive 2004/48/EC), the decisive factor is that the intermediary does not use the subject matter of the patent itself, but merely offers a service that is used for infringement and thereby creates a prerequisite for the infringer to be able to carry out its patent-infringing activity (see also Ohly, ZUM 2015, 308; Sonntag in Bopp/Kircher, Handbuch Europäischer Patentprozess, 2nd edition 2023, § 13 marginal no. 114 f. on the concept of an intermediary).

According to the case law of the ECJ, it is not necessary for the intermediary to

"...maintains a special relationship"

the Local Chamber concludes that a special relationship – such as that between a managing director and the company he manages – does not preclude qualification as an intermediary. It further follows from the case law of the ECJ that the term "service" means at least that the party providing it performs a specific activity for remuneration (ECJ, C-47/14 – Holterman Ferho Exploitatie and others v Spies von Büllenheim, on Regulation (EC) No 44/2001). Consequently, the activity of a managing director is to be classified as "provision of services" "insofar as the characteristic obligation of the

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

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

On this basis, a natural person who acts as the managing director of a company that commits acts of patent infringement may be considered an intermediary within the meaning of Article 11(3) of Directive 2004/48/EC and Article 63(1)(2) of the EPC. In accordance with the case law of the ECJ on Article 11 of Directive 2004/48/EC, this also corresponds to the objective of Article 63(1) sentence 2 EPCU, which is to ensure legal protection, including through injunctions, against persons who are not themselves infringers but who are in a position to prevent infringements on the basis of a service they have provided in the context of the infringement and which is used by the infringer. The service provided by a managing director to the company gives the company the ability to act and thus creates a prerequisite for the company to be able to carry out its patent-infringing activity; the service provided by a managing director in this way has a significantly higher risk of infringement than the activity of a market stall landlord; this is another reason why it is appropriate within the meaning of Article 63(1) sentence 2 EPGÜ to qualify a managing director as a possible intermediary. This also applies in the case of a multi-member management board of a patent-infringing company to members of the management board whose primary area of responsibility is not in production and/or sales, but, for example, in finance or human resources. This is because such members of the management board also generally provide services for the patent-infringing company.

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

Contrary to the defendant's view, this interpretation is not contradicted by any consistent deviating assessment in the national legal systems of the Member States. There is no consistent principle according to which organ liability is excluded in the case of legal infringements by the company in its external relations. For example, under German law, the legal representative of a company that manufactures a patent-infringing product or markets it domestically for the first time is liable for damages if he fails to take all possible and reasonable measures to organise and control the company's business activities in such a way that no third-party technical property rights are infringed (BGH GRUR 2016, 257 – Glasfasern II).

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

d. [Passive legitimacy of the fourth defendant](#)

Defendant 4) offered the products at issue in the dispute.

The fourth defendant admitted to being responsible for the sales activities of the defendant ("Belkin") via the German website "www.belkin.com/de". It also stated that it generally operates as a sales unit within the EU, including in relation to wholesalers such as Amazon and MediaMarktSaturn, which in turn distribute Belkin products to end customers. However, there is no online store on the Dutch, Italian and French websites; these merely refer to a few retailers who stock the defendant's products. The fourth defendant therefore does not itself offer any products for sale via the aforementioned websites. It is not within the sphere of influence of the fourth defendant whether and in what manner the suppliers referred to on the websites actually offer and deliver the contested embodiments. However, it is the fourth defendant that operates as the central sales unit of the Belkin Group in the EU (reply, p. 25); sales activities in the Member States asserted are therefore attributable to the fourth defendant.

The plaintiff has undisputedly argued that the product information on the contested embodiments shows that these are marketed in Germany, France, the Netherlands, Italy and Sweden. If the fourth defendant operates – as it itself claims – as the central sales unit of the Belkin Group in the EU and is therefore, according to the EU declaration of conformity (Exhibit BP 10), the "EU Authorised Representative" and issues warranty statements for the contested embodiments, then it is the fourth defendant that is responsible for the acts of use in question (offering, placing on the market, using and either importing or possessing for the aforementioned purposes).

The ruling of the Higher Regional Court of Düsseldorf (Ref. I- 2 U 59/23) concerns actions of the fourth defendant in Germany. According to claim G., these are expressly excluded from the decision of the local chamber. The Higher Regional Court of Düsseldorf did not rule on actions outside the territory of the Federal Republic of Germany.

e. [Passive legitimacy of the second defendant](#)

The plaintiff has also demonstrated acts of use by the second defendant within the territory of the EPG outside Germany.

According to the imprint for the website "www.bel-kin.com/de", the second defendant is responsible for undisputed distribution activities in Germany. The plaintiff deduces acts of use outside Germany from the fact that the activities of individually named employees of the second defendant

2) are not limited to Germany, but even expressly concern distribution in the EU; this applies, for example, to Mr Foglia, who, as "Head of Amazon Channel EU" at the second defendant, was responsible for maintaining business relations with Amazon – an undisputed EU-wide distributor of the products in dispute. Insofar as the second defendant claims not to be "primarily responsible" (whatever that means) for sales to retailers such as Amazon and to have been merely the (formal) employer of Belkin employees based in Germany, it argues

This does not absolve them of responsibility: the second defendant itself distributed the contested designs in Germany; Furthermore, employees working for the second defendant – and not for other companies in 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 judgment of the Higher Regional Court of Düsseldorf (Ref. I- 2 U 59/23) concerns actions of the second defendant in Germany. According to claim G., these are expressly excluded from the decision of the local chamber. The Higher Regional Court of Düsseldorf did not rule on actions outside the territory of the Federal Republic of Germany.

f. **Passive legitimacy of the third defendant**

The court is also convinced that the third defendant is responsible for the acts of use that are the subject of the dispute.

The EU declaration of conformity for the contested products, which is a prerequisite for marketability in the EU, was issued on behalf of the third defendant. The defendant is also the owner of the domain www.bel-kin.de, through which the contested products are undisputedly sold directly, at least in Germany. Defendant 3) is also mentioned in the product-related 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 affiliated companies, unless expressly stated otherwise below. ..."

Insofar as the defendants have requested that the judgment of the Higher Regional Court of Düsseldorf (Ref. I- 2 U 59/23) be recognised in accordance with Art. 36 (1), (3) of the Brussels I Regulation, as this would also exclude the liability of the third defendant for an infringement of the German part of the patent in suit, the Local Chamber does not agree. The

The Higher Regional Court of Düsseldorf did not have to rule on any infringements by the third defendant in Germany, meaning that there is no need for recognition.

g. Passive legitimacy of the first defendant

- aa.** The plaintiff has not demonstrated any acts of use by the first defendant within the meaning of the case law of the European Court of Justice. The first defendant has neither acted as a seller of its own products nor has it given the impression in trade that it is the party distributing the products in dispute in its own name and on its own account.
- bb.** However, due to his position as managing director of the second defendant and director of the fourth defendant, the first defendant has the opportunity to influence the fortunes of the second and fourth defendants and can therefore be held liable as an intermediary pursuant to Article 63(1) sentence 2 EPGÜ.

As managing director and director, he has, in relation to the second defendant and 4) provided services that infringed the patent asserted by the defendants 2) and 4) to infringe the patent in suit. In doing so, he created a prerequisite for defendants 2) and 4) to be able to carry out their patent-infringing activities in the first place. As managing director of defendant 2) and director of defendant 4), defendant 2) was and is able to influence the infringement by issuing appropriate instructions to his subordinate employees.

The restrictions laid down in national legal systems concerning the liability of organs of legal persons, such as the requirement of a breach of duty of care, are only reflected in the EPGÜ insofar as intermediaries are only liable for injunctive relief, but not for damages. Therefore, the parties' arguments regarding the additional requirements for claims existing in the law of the various Member States, in particular any requirements of due diligence, are not relevant. The details of the requirements for bringing a claim against an intermediary within the meaning of Article 11(3) of Directive 2004/48/EC remain a matter for the Member States.

and thus leaves its scope of application to the EPGÜ; the prerequisites arise autonomously and directly from Art. 63(1) sentence 2 EPGÜ. Unlike other provisions of the EPC (see, for example, Article 68(1) EPC) or corresponding liability rules in the law of the Member States, Article 63(1) sentence 2 EPC does not require a breach of duty of care or the fulfilment of other factual requirements.

- cc. Insofar as the plaintiff has assessed the first defendant as an infringer and formulated its claim accordingly, this is irrelevant with regard to an injunction against the first defendant on the basis of its status as an intermediary.

The applicant has requested, pursuant to Article 63(1) of the EPC, that an order be issued against the first defendant prohibiting him from continuing the infringement. The Local Chamber considers this request to also include a request for an order to be issued against the first defendant prohibiting him from performing his duties as managing director of the defendant.

2) and Director of Defendant 4) in such a way that Defendants 2) and 4) are able to continue infringing the patent in suit. Such an understanding of the injunction sought against the first defendant already follows from the fact that the plaintiff made it clear in the statement of claim that the subject matter of the injunction sought in the case of the first defendant is his activity (or inactivity) as managing director of the second defendant and director of the fourth defendant. In doing so, it clearly expressed its request for an injunction for all parties to the proceedings.

- dd. The defendant's application for recognition of the judgment of the Higher Regional Court of Düsseldorf (Ref. I- 2 U 59/23) pursuant to Art. 36 (1), (3) EuGVVO is, with regard to the defendant,

1) with regard to the actions of defendants 2) and 4) outside the territory of the Federal Republic of Germany. The effect of the judgment, which is recognisable under Article 36 of the Brussels I Regulation, is limited to the territory of the Federal Republic of Germany.

h. Passive legitimacy of the fifth defendant

- aa.** The plaintiff has not demonstrated that the fifth defendant has used the trademark itself within the meaning of the case law of the European Court of Justice. The fifth defendant has neither acted as a seller of its own products nor has it given the impression in trade that it is the party distributing the products in dispute in its own name and on its own account.
- bb.** However, due to his position as director of Defendant 4), Defendant 5) has the ability to influence the actions of Defendant 4) and can therefore be held liable as an intermediary pursuant to Art. 63(1) sentence 2 EPC.

As a director, he provided services to the fourth defendant which were used by the fourth defendant to infringe the patent in suit. In doing so, he created the conditions that enabled the fourth defendant

4) to carry out its patent-infringing activities in the first place. As a director of the fourth defendant, the fifth defendant was and is able to influence the infringement by issuing appropriate instructions to his subordinate employees.

The restrictions laid down in national legal systems concerning the liability of organs of legal persons, such as the requirement of a breach of duty of care, are only reflected in the EPGÜ insofar as intermediaries are only liable for injunctive relief, but not for damages. Therefore, the parties' arguments regarding the additional requirements for claims existing in the law of the various Member States, in particular any duty of care requirements, are not relevant. The details of the conditions for bringing an action against an intermediary within the meaning of Article 11, third sentence, of Directive 2004/48/EC are left to the Member States and thus, for its scope of application, to the EPGÜ; the conditions arise autonomously and directly from Article 63(1), second sentence, EPGÜ. Unlike other provisions of the EPGÜ

(see, for example, Article 68(1) of the EPC) or corresponding liability rules in the law of the Member States.

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

The plaintiff has requested, pursuant to Article 63(1) EPC, that an order be issued against the fifth defendant prohibiting him from continuing the infringement. The Local Chamber considers this application to also include an application for an injunction against the fifth defendant prohibiting him from continuing to perform his duties as director of the fourth defendant in such a way that the fourth defendant is able to continue infringing the patent in suit. Such an understanding of the injunction application against the fifth defendant already follows from the fact that the plaintiff made it clear in the statement of claim that the subject matter of the injunction application in the case of the fifth defendant is his activity (or inactivity) as director of the fourth defendant. In doing so, it clearly expressed its request for an injunction for all parties to the proceedings.

- dd. The defendant's application for recognition of the judgment of the Higher Regional Court of Düsseldorf (Ref. I- 2 U 59/23) pursuant to Art. 36(1), (3) of the Brussels I Regulation is to be dismissed with regard to the defendant
5) with regard to the actions of the fourth defendant outside the territory of the Federal Republic of Germany. The effect of the judgment, which is recognisable under Article 36 of the Brussels I Regulation, is limited in geographical terms to the Federal Republic of Germany.

- i. **Passive legitimacy of the sixth defendant**

- aa. The plaintiff has not demonstrated its own acts of use within the meaning of the case law of the European Court of Justice with regard to the sixth defendant. The sixth defendant has neither acted as a seller of its own products nor has it given the impression in trade that it is the party distributing the products in dispute in its own name and on its own account.

- bb.** However, due to his position as director of the sixth defendant and his ability to influence the fortunes of the fourth defendant, the sixth defendant can be held liable as an intermediary pursuant to Article 63(1) sentence 2 EPGÜ.

As director, he provided services to defendant 4) that were used by defendant 4) to infringe the patent in suit. In doing so, he created the conditions that enabled defendant 4) to

4) to carry out its patent-infringing activities in the first place. As director of defendant 4), defendant 6) was and is able to influence the infringement by issuing appropriate instructions to his subordinate employees.

The restrictions laid down in national legal systems concerning the liability of organs of legal persons, such as the requirement of a breach of duty of care, are only reflected in the EPGÜ insofar as intermediaries are only liable for injunctive relief, but not for damages. Therefore, the parties' arguments regarding the additional requirements for claims existing in the law of the various Member States, in particular any duty of care requirements, are not relevant. The details of the conditions for bringing an action against an intermediary within the meaning of Article 11, third sentence, of Directive 2004/48/EC are left to the Member States and thus, for its scope of application, to the EPC; the conditions arise autonomously and directly from Article 63(1), second sentence, of the EPC. Unlike other provisions of the EPGÜ (see, for example, Article 68(1) EPGÜ) or corresponding liability rules in the law of the Member States, Article 63(1) sentence 2 EPGÜ does not require a breach of due diligence or the fulfilment of other factual requirements.

- cc.** Insofar as the claimant has assessed the sixth defendant as an infringer and formulated its claim accordingly, this is harmless with regard to an injunction against the sixth defendant in its capacity as an intermediary.

The plaintiff has requested, pursuant to Article 63(1) EPC, that an order be issued against the sixth defendant prohibiting him from continuing the infringement. The Local Chamber considers this application to also include a request to issue an injunction against the sixth defendant prohibiting him from continuing to perform his duties as director of the fourth defendant in such a way that the fourth defendant is able to continue infringing the patent in suit. Such an understanding of the injunction application against the sixth defendant already follows from the fact that the plaintiff made it clear in the statement of claim that the subject matter of the injunction application in the case of the sixth defendant is his activity (or inactivity) as director of the fourth defendant. In doing so, it clearly expressed its request for an injunction for all parties to the proceedings.

- dd. The defendant's application for recognition of the judgment of the Higher Regional Court of Düsseldorf (Ref. I- 2 U 59/23) pursuant to Art. 36(1), (3) of the Brussels I Regulation is to be dismissed with regard to the defendant 6) with regard to the actions of the fourth defendant outside the territory of the Federal Republic of Germany. The effect of the judgment, which is recognisable under Article 36 of the Brussels I Regulation, is limited in geographical scope to the Federal Republic of Germany.

II. Application for an injunction

The injunction sought in claim A.I. is based on Art. 64 EPC, Art. 25 (a), 63 (1) sentence 1 EPCG. No reasons for restricting or refusing an injunction against the defendants are asserted, nor are any otherwise apparent.

In view of the limited liability of defendants 1), 5) and 6) as intermediaries, the judgment must be limited accordingly; as explained (above, sections C.I.2.f.cc., C.I.2.g.cc. and C.I.2.h.cc.) – is implicitly included as a minus in the plaintiff's more comprehensive claim. The action is to be dismissed to the extent of the surplus.

Furthermore, the action is to be dismissed insofar as the liability as an intermediary affects the actions of defendants 2) and 4) in relation to the Federal Republic of Germany

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

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

The claims asserted in claim A.II. can only be asserted against an infringer, not against an intermediary, and are based on Art. 64 EPC, Art. 64(2)(b), (d) and (e) EPC. In this respect, however, there are also no claims against 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 (Article 64(4) EPC). The same applies to destruction.

IV. Application for a declaration of liability for damages

The plaintiff is entitled to damages pursuant to Art. 64 EPC in conjunction with Art. 68 EPC against defendants 2), 3) and 4).

In any case, they have negligently infringed the patent in suit and are therefore liable to pay damages to the plaintiff for the acts committed since 28 December 2016, the date of publication of the grant. This is because those who themselves commit acts of infringement must observe third-party industrial property rights and take reasonable precautions not to infringe them. The defendants 2), 3) and 4) have not presented any relevant arguments in this regard. The reference to the judgment of the Regional Court of Düsseldorf does not exonerate them. On the one hand, the judgment only concerns the German part of the patent in suit and only defendants 2) and 4), and on the other hand, it is generally known that first-instance judgments of a German infringement court are subject to appeal and thus to review and possible reversal. Defendants 2), 3) and 4) could therefore not rely on this alone. Incidentally, the legal force 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 statement of claim.

The other defendants cannot be held liable for damages because, as explained above, intermediaries are not liable for damages.

Since the claimant cannot quantify the claim for damages without the defendant's information through no fault of its own, the claimant has a legitimate interest in having this determined.

V. Request for information

A corresponding claim by the plaintiff against defendants 2), 3) and 4) arises from Art. 67(1) EPGÜ, R. 191 VerfO.

VI. Application for provisional award of damages

According to Rule 119 of the Rules of Procedure, the Court may award provisional damages to the prevailing party, which shall at least cover its anticipated costs for the damages and compensation proceedings.

The applicant estimates the corresponding costs based on an assumed value in dispute of at least EUR 1 million for the proceedings on the amount in dispute in accordance with the court's schedule of fees as follows:

- Court costs EUR 7,000
- costs of legal representation EUR 112,000.

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

VII. Request for publication of the decision

The applicant's right to publication of the court's decision is based on Article 80 of the EPC. When publishing the decision, the applicant must comply with the General Data Protection Regulation.

VIII. Penalty payment

In the event of non-compliance with the orders under claim A., repeated penalty payments may be imposed on the defendants (Article 63(2) EPC, Rule 354.3 RPO). The amounts proposed by the applicant are necessary to ensure compliance with the court orders. They also reflect the economic damage that the claimant could suffer if the defendants fail to comply with the law. The defendants have not contested this.

D.

The decision on costs is based on Art. 69 EPCU, R. 118.5 RPC.

The action is unsuccessful with regard to consequential claims against defendants 1), 5) and 6). The counterclaims for annulment are completely unsuccessful. The Chamber assesses the plaintiff's partial success with the infringement action at 5/6.

E.

Direct enforceability is based on Art. 82 EPC.

A security deposit or bank guarantee was not required.

The application for security requires a substantiated presentation of facts about the financial situation of the counterparty, which justify the legitimate concern of a risk of insolvency or indications of insolvency (see inter alia LK Munich, 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, foreseeable difficulties in enforcement may also justify the ordering of security.

Neither of these circumstances has been argued or is otherwise apparent in the present case. The plaintiff, which is based in the Contracting State of the Netherlands, appears to be sufficiently wealthy.

For the above reasons, the presiding judge Dr Zigann, the legally qualified judge Brinkman, the technically qualified judge Dr Hansson and the rapporteur Pichlmaier issue the following

decision

A. The defendants' motions for suspension are dismissed.

B. Defendants 2), 3) and 4) are ordered

I. to refrain from

offering or placing on the market

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

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

wherein the power transmitter comprises:

means for generating the power signal;

means for receiving a signal strength packet from the power receiver to initiate a forced configuration phase;

means for performing the forced configuration phase, wherein a first set of power transfer 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 power receiver;

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 acceptance or rejection of the request to enter the requested negotiation phase;

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

means for performing the requested negotiation phase, wherein a second set of power transmission 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 a message from the power receiver specifying at least one of the power transfer operating parameters, and the power transmitter responds with a message in which the at least one power transmission operating parameter is accepted or rejected,

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

insofar as the power transmitter for inductive power transmission uses chips other than those manufactured and/or sold by Renesas Electronics Corporation or its affiliated companies.

- II. to provide the claimant with information on the extent to which it has committed the acts referred to in B.I. since 28 December 2016, specifying
 1. the origin and distribution channels of the products referred to in section B.I., stating
 - a. the names and addresses of the suppliers and other previous owners, and

- b. the names and addresses of the commercial customers and the points of sale for which the products were intended;
2. the quantity of products delivered, received or ordered, as well as the prices paid for the products in question; and
3. the identity of all third parties involved in the distribution of the products referred to in Section B.I.,

whereby copies of the relevant purchase documents (namely invoices or, alternatively, delivery notes) must be submitted as evidence of the information provided, whereby confidential details may be redacted from the data subject to disclosure;

- III. to pay the claimant an amount of EUR 119,000 as provisional damages.
- C. Defendants 2), 3) and 4) are obliged to compensate the plaintiff for all damages incurred and to be incurred as a result of the actions listed in section B.I. committed since 28 December 2016.
- D. Defendants 1), 5) and 6) are ordered to refrain from performing their duties 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. The decision pursuant to sections B. I., II. and III. as well as sections C. and D. does not apply to any actions of the second and fourth defendants or the legal consequences of such actions within the territory of the Federal Republic of Germany, nor to any liability as an intermediary in relation to such actions.
- F. The plaintiff is permitted to publicise 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. In all other respects, the action for infringement of the patent in suit is dismissed.
- H. In the event of any infringement of the orders under sections B.I and D, the respective defendants shall pay a penalty of up to EUR 100,000 to the court for each day of infringement; in the event of infringements of the orders under section B.II, the penalty shall be up to EUR 50,000 for each day of infringement.
- I. The counterclaims for annulment of the patent in suit are dismissed.

The admission of citation D7 submitted by the defendants in their written statement of 15 March 2024 and the defendants' related submission are rejected.

- J. The costs of the legal dispute are apportioned 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 judgment is provisionally enforceable for the plaintiff without the provision of security.

INFORMATION ON APPEAL

Any party whose claims have been wholly or partially unsuccessful may lodge an appeal against this decision with the Court of Appeal within two months of service of the decision (Art. 73 (1) EPGÜ, R. 220.1 (a), 224.1 (a) VerFO).

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

A certified copy of the enforceable decision shall be issued by the Registrar at the request of the enforcing party, R. 69 RegR.

DETAILS OF THE DECISION

UPC number: UPC_CFI_390/2023






Infringement action: ACT_583273/2023

Counterclaims for annulment: CC_584891/2023

Applications for amendment of the patent:

App_13896/2024

Munich, 13 September 2024

Dr Zigann Presiding Judge	Matthias ZIGANN  Digitally signed by Matthias ZIGANN Date: 11 September 2024, 15:19:10 +02'00'
Brinkman Legally qualified judge	EdgerFrank BRINKMAN  Digitally signed by Edger Frank BRINKMAN Date: 11 September 2024 15:19:42 +02'00'
Pichlmaier Rapporteur	TobiasGünther Pichlmaier  Digitally signed by Tobias Günther Pichlmaier Date: 11 September 2024 14:50:24 +02'00'
Dr Hansson Technically qualified judge	AndersMax Hansson  Digitally signed by Anders Max Hansson Date: 11 September 2024, 15:18:28 +02'00'
For the Deputy Chancellor	CatrinMeyer  Digitally signed by Catrin Meyer Date: 12 September 2024, 11:02:31 +02'00'