

UPC_CFI_363/2024
DECISION ON THE
MERITS
of the Court of First Instance of the Unified Patent Court, delivered on
01/08/2025

ABSTRACT

1- The scope of protection of the patent claims:

It is irrelevant that the descriptive part retains the method of superimposition; what matters is the scope of protection as defined by the claims, which are expressly limited to the 'edge-to-edge' method. The Court also notes that the addition of the words "placed edge to edge" in claim 1 should have led, at the time of grant of the patent, to the deletion of the "superimposed" method of realisation of the invention mentioned in the description, as this method does not fall within the scope of protection of the patent as finally claimed. (See *Agfa v Gucci*, Hamburg Regional Court, 30 April 2025, UPC_CFI_278/2023, Headnote 3: "*Specifications in the description that are not consistent with the granted claims cannot serve as a basis for a broad interpretation of a claim.*")

2- The admissibility of an allegedly late request:

In this case, the Court considers that the claim for infringement by equivalence, which was made immediately after the statement of defence, is not late (at the stage of the reply), since this claim does not change the nature of the claimant's procedural strategy, which merely adapts it in the light of the arguments put forward in the defence, and the defendant was able to respond to it in its rejoinder. For these reasons, the claim for infringement by equivalence is admissible in this case.

3- Indirect infringement within the JUB (Art. 26 AJUB and Art. 69 EPC and its interpretation protocol):

In light of the case law of the JUB (see *Mannheim UPC LD, 6 June 2025 - 471/2023-Headnote3*; *Brussels UPC LD, 17 January 2025, para. 98 - CFI 376/2023*), this Division considers, on the one hand, that the most harmonised interpretation possible within the JUB should be adopted when ruling on claims of infringement by equivalence and, on the other hand, that, in any event, in view of the different tests applied in the contracting Member States of the AJUB, it is necessary to first answer a question that is the lowest common denominator and constitutes the first criterion for examining equivalence: Do the modified (or substitute) means essentially fulfil the same function to achieve essentially the same effect?

KEYWORDS

Scope of the patent, admissibility, late application, infringement by equivalence, Art. 26 AJUB, Art. 69 EPC and its interpretation protocol.

APPLICANTS

N.J DIFFUSION SARL

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Vincent BLOCH, acting as administrator of N.J. DIFFUSION SARL with a mandate to assist,

Florence DAUDE, acting as legal representative of N.J. DIFFUSION SARL, Represented by **Catherine**

MATEU

DEFENDANT

GISELA MAYER GmbH

Litzelsdorfer Straße 3 87700
- Memmingen – DE

Represented by **Frédéric PORTAL**

PATENT IN DISPUTE

<i>Patent number</i>	<i>Patent</i>
EP2404516	NJ DIFFUSION SARL

COMPOSITION OF THE CHAMBER – CHAMBER SITTING IN PLENARY SESSION

President and Judge-
Rapporteur **Camille Lignières**

Qualified judge
on legal matters **Carine Gillet**

Qualified judge
in legal matters **Stefan Schilling**

LANGUAGE OF THE PROCEEDINGS: French

DECISION

THE PARTIES

1. N.J Diffusion (hereinafter 'NJ'), the applicant in the main proceedings, is a French company specialising in hair replacement, extensions, hairpieces and hair care. This company has a network of reseller partners at national and European level. It is the proprietor of European patent EP 2 404 516 (hereinafter "EP'516").
2. GISELA MAYER (hereinafter "GM"), the defendant in the main proceedings, is a German company specialising in wigs and hairpieces.
3. Both companies are SMEs and are competitors on the European market.

FACTS AND PROCEDURE

4. On 1 July 2024 NJ initiated infringement proceedings against GM for infringement of patent EP'516 before the Paris Local Division of the Unified Patent Court (hereinafter "UPC"). The case is registered under number ACT_39091/2024.
5. No preliminary objections were raised by the defendant, in particular regarding the jurisdiction of the Unified Patent Court and the internal jurisdiction of the Paris Local Division.
6. The defendant contested the alleged infringement but did not file a counterclaim challenging the validity of the patent relied on in support of the main infringement action. A request for a guarantee on the basis of R. 158 RdP made by GM was rejected first by the Judge-Rapporteur and then by the panel in accordance with Rule R. 333 RdP by order of 30 April 2025. Finally, an exchange of additional briefs was authorised by the Reporting Judge, but NJ's last additional brief was partially dismissed at GM's request on the following grounds: "The Judge-Rapporteur orders the exclusion from the proceedings, on the grounds of inadmissibility under Rules 9.2, 12.5 and 36 of the Rules of Procedure, of the following elements in the brief submitted by N J DIFFUSION SARL on 17 February 2025:

All developments except paragraphs 175 to 183, 216 to 231, 336 to 340 and paragraphs paragraphs 342 to 346 of section 7.2.

By judgment of 5 June 2025, the Paris Commercial Court initiated receivership proceedings against NJ. The bodies responsible for the collective proceedings agreed to continue the proceedings and voluntarily intervened in the case. (Certificates dated 13 and 16 June 2025). GM was heard on this intervention at the pre-trial hearing on 17 June 2025 and justified its claim of €50,000 to the judicial administrator representing the creditors (AR dated 16 June 2025). The voluntary intervention of the bodies involved in the proceedings on behalf of the claimant was therefore admitted to the present proceedings.

By procedural order dated 19 June 2025, the request to postpone the oral hearing scheduled for 20 June 2025 was rejected, it was noted that the proceedings on the merits initiated by NJ before this court would continue, and GM's claim for indemnity filed after NJ's receivership was dismissed as inadmissible.

THE PARTIES' CLAIMS

7. In its latest statement (statement in intervention of 12 June 2025), N.J DIFFUSION requests the Court to:

Take note of the receivership of NJ DIFFUSION,

Declare Mr Vincent BLOCH admissible in his voluntary intervention as judicial administrator of NJ DIFFUSION,

Declare Ms Florence DAUDE admissible in her voluntary intervention as legal representative of the creditors of NJ DIFFUSION.

8. This application for intervention is made in support of all the claims brought by NJ DIFFUSION against GISELA MAYER.
9. NJ DIFFUSION, in its statement of claim, requests the Court to take the following measures:

AS A MAIN CLAIM

Declare GISELA MAYER's claims inadmissible and, at the very least, unfounded in their entirety and, consequently, dismiss them.

Declare that, by manufacturing, having manufactured, exporting, importing, holding, storing, placing on the market, offering for sale and selling in France, Belgium, Spain, Italy and Portugal, for use, wigs reproducing the characteristics of European patent No. 2 404 516 B1, and in particular claims 1 to 4 and 7 to 9, the company GISELA MAYER is guilty of acts of literal infringement within the meaning of Article 25 of the Agreement on a Unified Patent Court,

CONSEQUENTLY,

Order GISELA MAYER to pay N.J DIFFUSION the sum of 300,000 euros in provisional damages, IN THE ALTERNATIVE

To rule that, by manufacturing, having manufactured, exporting, importing, holding, storing, placing on the market, offering for sale and selling in France, Belgium, Spain, Italy and Portugal for use as wigs reproducing the characteristics of European patent No. 2 404 516 B1, and in particular claims 1 to 4 and 7 to 9, GISELA MAYER is guilty of acts of infringement by equivalent means within the meaning of Article 69 of the European Patent Convention,

CONSEQUENTLY,

Order GISELA MAYER to pay N.J DIFFUSION the sum of 300,000 euros in provisional damages,

IN ANY EVENT

Order the disclosure of all accounting documents relating to each model of wig reproducing patent EP'516 manufactured, caused to be manufactured, exported, imported, held, stored, placed on the market, offered for sale and sold in France, Belgium, Spain, Italy and Portugal by GISELA MAYER or on its behalf by its suppliers, partners and distributors, as well as the turnover resulting from the sale of these wigs and the margins made in these countries, subject to a penalty of £2,000 per day of delay from the date of notification of the forthcoming decision,

Order the disclosure of information concerning the identity of the manufacturer(s) and supplier(s) of each model of wig reproducing patent EP'516 of which GISELA MAYER is aware.

Prohibit GISELA MAYER from using the process, manufacturing, exporting, importing, possessing, storing, placing on the market, offering for sale and selling in France, Belgium, Spain, Italy and Portugal of wig models reproducing the characteristics of claims 1 to 4 and 7 to 9 of European patent No. 2 404 516 B1, subject to a penalty of €2,000 per day of delay and per infringement found from the date of notification of the decision to be rendered,

Order GISELA MAYER, within 15 days of notification of the decision to be rendered and subject to a penalty of €2,000 per day of delay and per infringement found:

- To recall or have recalled all of the wigs in question in circulation in France, Belgium, Spain, Italy and Portugal, as well as all stocks held by its distributors and partners in those countries,
- To destroy, at its own expense, the wigs thus recalled and those remaining in its possession.

To order GISELA MAYER, within 15 days of notification of the decision to be taken and subject to a penalty of €2,000 per day of delay, to provide proof of the withdrawal and destruction of the wigs in question.

Order the publication of the decision to be made in five French or foreign newspapers or periodicals chosen by N.J DIFFUSION within 15 days of the decision being made, subject to a penalty of €2,000 per day of delay, at the expense of GISELA MAYER.

Order the publication of the operative part of the decision to be rendered in legible characters on the home page of the website www.gisela-mayer.com within 48 hours of the pronouncement of the decision to be rendered, subject to a penalty payment of €15,000 per day of delay, at the expense of GISELA MAYER,

Declare that the Court reserves the right to determine the amount of the penalties thus ordered,

Order GISELA MAYER to pay N.J DIFFUSION the sum of €56,000 in reimbursement of legal costs.

Order GISELA MAYER to pay N.J DIFFUSION the sum of €30,000 as a provision for costs if the decision on costs is the subject of separate proceedings,

Order GISELA MAYER to reimburse N.J DIFFUSION for all legal costs.

10. GM, the defendant in the main proceedings, made the following claims in its latest defence statement dated 18 June 2025 (in response to the voluntary interventions on the side of the claimant):

- I. Declare the infringement action brought by NJ DIFFUSION SARL against GISELA MAYER GmbH on the basis of the claims of European patent EP 2 404 516 B1, in particular claims 1 to 4 and 7 to 9, inadmissible or at least unfounded; dismiss it;
- II. Declare inadmissible, and in any event unfounded, all the arguments, claims, conclusions and requests of N.J DIFFUSION SARL and the voluntary interveners; dismiss them;
- III. Order N.J DIFFUSION SARL and the voluntary interveners, in their respective capacities, to pay all legal costs and other expenses incurred by GISELA MAYER GmbH, and to pay it at least the recoverable costs, which shall not be less than the applicable ceiling;
- IV. Order N.J DIFFUSION SARL and the voluntary interveners, in their respective capacities, to pay GISELA MAYER GmbH a provision on costs of EUR 50,000 (fifty thousand euros).
- V. In the alternative, should the Court find that the claim is not eligible for the preferential treatment provided for in Article L. 622-17 of the French Commercial Code, order that this claim be included in the liabilities of GISELA MAYER GmbH in the amount of €50,000 (fifty thousand euros), subject to further determination.

VI. In the further alternative:

Subordinate the enforcement of any decision or order of the court in favour of the Claimant to the provision by the latter and by the voluntary interveners, in their respective capacities, of a guarantee (by deposit of funds or bank guarantee) in favour of GISELA MAYER GmbH for a total amount of at least three hundred thousand (300,000) EUR, as follows:

- Injunction:
One hundred and eighty thousand (180,000) EUR, or at least 60% of the value of the dispute;
- Damages:
One hundred and twenty thousand (120,000) EUR, or at least 40% of the value of the dispute;
- Court costs, legal fees and other expenses: 110% of
the amount to be paid;

Limit the amount of damages to four thousand five hundred and sixty-three (4,563) euros;

Limit the amount of any penalty payment to one hundred (100) euros per day of delay.

GROUND FOR THE DECISION

On the admissibility of the infringement action brought by NJ

11. Rule 13.1(n) of the JUB Rules of Procedure provides that: "*1. The applicant shall file a statement of claim with the division of its choice [Article 33 of the Agreement], which shall contain:*

(...) n) the reasons why the facts alleged constitute an infringement of the patent claims, including the legal grounds and, where appropriate, an explanation of the proposed interpretation of the claims;"

12. GM argues that NJ's infringement action is inadmissible because it does not meet the conditions set out in Rule 13.1(n) RdP, in that the statement of claim is devoid of any interpretation of the claims and the claimant does not provide any reasoning to justify the infringement (paragraph 12 of the statement of defence).

13. However, in paragraphs 61 and 62 of its statement of claim, the claimant sets out its arguments to support its allegations of infringement, relying on a commentary on close-up photographs of the inside of one of the wigs marketed by GM that are alleged to be infringing. Although brief, this presentation is sufficient for the Court to consider that the reasons why the facts alleged constitute an act of infringement of the patent claims have been set out by the claimant, as required by Rule 13.1(n) of the Rules of Procedure.

14. Furthermore, the Court notes that the explanation of the proposed interpretation of the claims is not required by Rule 13.1(n), but may be provided "where appropriate". In the present case, the applicant considered that the interpretation of the terms of the opposing claims was not

not necessary because it considered that these terms had no particular meaning in the technical field of hairpieces that would differ from their common meaning and that the patent description did not give them any special meaning either (reply brief §98, §120 and 121).

15. Consequently, NJ's action for infringement is admissible.

On the merits of the infringement action

Presentation of the patent in question

16. Patent EP'516 (Exhibit 3 of NJ), owned by NJ, was filed on 7 July 2010 in French and granted on 24 January 2018. It is entitled 'Wig and method of manufacture'.
17. This patent is in force at the time of NJ's infringement claim in the following contracting Member States: Belgium, Spain, France, Italy and Portugal (Exhibit 3 of NJ).
18. EP'516 relates to a wig and also covers the method of manufacturing the same (patent [0001]).
19. With regard to the technical field relating to hairpieces, the descriptive part of the Patent explains that nowadays, the use of wigs has increased considerably due to hair loss affecting all sections of the population and resulting from therapeutic treatments used to combat certain serious diseases (cancer, alopecia, etc.) ([0004] of the Patent).
20. In the prior art, it is known that the cap or internal support of the wig consists, on the one hand, of a tulle or fine mesh fabric intended to cover the frontal, temporal and occipital areas and, on the other hand, of a monofilament intended to cover the vertex area ([0006] and Fig. 1 of the Patent). The Court notes that in the prior art, the connection areas between the cap and the monofilament are connected with a seam forming a fold (tucked in or hemmed) on the reverse side of the edge ([0008] and Fig. 1) and that these connection areas are covered by sewing and gluing flexible non-slip strips [0010].
21. Previous wigs had disadvantages in terms of the monofilament being sewn to the edges of the tulle around the vertex to form a connection area. These connection areas were made up of numerous layers of fabric that overlapped and intertwined, which was uncomfortable for the user (itching, trauma) and made the wig difficult to clean.
 - This is uncomfortable for the user (itching, trauma),
 - and detracts from the aesthetic appearance as they may be visible.
 - In addition, the various connections require long and meticulous work to make the wig, which affects the cost price ([0012] to [0015] of the patent).
22. Patent EP'516 proposes to overcome these difficulties by disclosing a lightweight and comfortable wig, which also improves aesthetics as the connection areas are practically undetectable ([0020] to [0021]).

23. The patent in question comprises nine claims, including independent product claim 1 and dependent claims 2 to 6, as well as independent process claim 7 and dependent claims 8 and 9.
24. Claim 1 in French reads, according to the division of features proposed by the defendant and not contested by the claimant, and which the Court adopts as follows:

"1.1 Wig comprising **an internal support or cap (1)** on which natural or artificial hair is implanted,

1.2 said cap (1) being **made up of at least two pieces of lightweight, fine-mesh fabric (2, 3)**

1.2 shaped to cover the different areas of a user's head,

1.3 at least one of these pieces of fabric being made up of a transparent fabric (3) called "**monofilament**",

1.4 characterised in that the **adjacent edges (4, 5)** of the monofilament piece (3) and the parts (2) of the cap (1) **assembled by means of a thin strip**

1.4a of a flexible and transparent or translucent material (6)

1.4 b covering and overlapping said edges (4, 5) to form a substantially flat joining area (7),

1.5 [characterised] in that the outer surface of the flexible joining strip (6) has an **anti-slip film or coating**, and

1.6 [characterised] in that the adjacent edges (4, 5) of the monofilament piece (3) and the parts (2) of the cap (1) contiguous with said monofilament piece (3) are **placed edge to edge** and

1.6a the flexible and transparent assembly strip **covers and overlaps said edges** (4, 5).

25. Claim 7 in French reads, according to the division of the features proposed by the defendant and not contested by the claimant, and which the Court adopts as follows:

"7.1. Method of manufacturing a wig according to any of claims 1 to 6,

7.2. comprising an internal support or cap (1) made up of at least two pieces of lightweight, fine-mesh fabric (2, 3) shaped to cover the different areas of a user's head, at least one of these pieces of fabric being made of a transparent fabric called monofilament (3), characterised in that the adjacent edges (4, 5) of the piece of monofilament (3) and the parts (2) of the cap (1) adjacent to said piece of monofilament (3) by means of a thin strip (6) of a flexible and transparent or translucent material, the outer surface of which has an anti-slip film or coating

, which is placed over and overlapping the said edges (4, 5) so as to form a substantially flat assembly area (7).

26. According to the applicant, the invention protected by the patent in question overcomes the disadvantages of the prior art relating to discomfort and lack of aesthetic appeal thanks to the configuration of the wig cap, in that the thin, flexible and transparent or translucent strip covers and overlaps the adjacent edges (4 and 5) of the wig pieces, forming a virtually flat assembly area (paragraph 46 of the statement of claim). The applicant adds that the flexible assembly strip (6) intended to come into contact with the skin of the scalp advantageously comprises a non-slip film or coating. (§48 of the application). This operation is described in [0028] of the Patent and illustrated by Figures 4A and 4B:

Fig. 4A

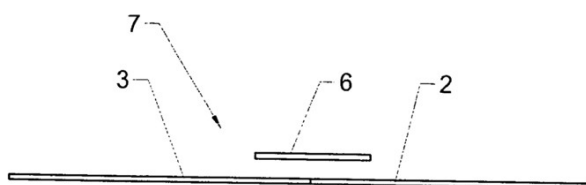
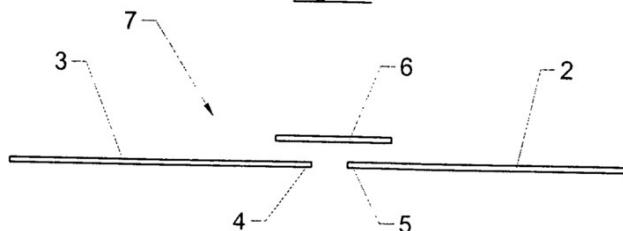


Fig. 4B



Interpretation of the contested terms of the claims

The person skilled in the art

27. The characteristics of the claims must be interpreted in relation to the person skilled in the art. In this case, the Court adopts the definition proposed by GM relating to the person skilled in the art, which is not contested by the applicant and is appropriate to the present case: the specialist in the manufacture of wigs (page 23 of the statement of defence).

Principles of interpretation

28. In accordance with Article 69 of the European Patent Convention (EPC) and the Protocol on its interpretation, this Court adopts the standard of interpretation of patents established by the Court of Appeal of the JUB in two orders (UPC_CoA_335/2023 and UPC_CoA_1/2024).

1) The patent claim is not only the starting point but also the basis for determining the scope of protection of the European patent.

2) The interpretation of a patent claim does not depend solely on the strict and literal meaning of the terms used. On the contrary, the description and drawings must always be used to aid in the interpretation of the patent claim and not only to resolve ambiguities in the patent claim.

3) However, this does not mean that the patent claim serves only as a guideline and that its scope can be extended to what the patent holder had envisaged, taking into account the description and drawings.

4) The patent claim must be interpreted from the perspective of a person skilled in the art.

5) By applying these principles, the aim is to combine adequate protection for the patent holder with sufficient legal certainty for third parties.

29. With regard to claim 1, certain terms are disputed between the parties as to the interpretation of the claimed subject matter.

30. The terms "lightweight fabric" and "fine mesh":

31. GM notes that the patent in question does not define these concepts in any way, whereas the cap comprises at least two of these "lightweight" "fine-mesh" fabrics, and that tulle and monofilament are examples of such fabrics. (Paragraph 73 of Gisela Mayer's statement of defence dated 11 October 2024).

32. NJ specifies that, according to the patent, the word "tulle" must be considered equivalent to any lightweight fabric formed by a network of fine, more or less elastic meshes, and that the word "monofilament" or "micro skin" refers to a lightweight, transparent or translucent fabric with very fine meshes, produced by means of a special weaving process (with regard to character 1.a,b,c [0038]), NJ concludes that tulle and monofilament are therefore two types of lightweight fabric with fine meshes. (§116 of the reply brief).

33. The Court notes that the parties do not ultimately disagree on these terms.

34. The terms "fine strip" in claim 1, feature 1.4:

35. NJ argues that this qualifier has no particular meaning in the technical field of hairpieces, which differs from its common meaning, and that the patent description does not give it any special meaning either (reply §98). According to NJ, the feature that the assembly strip is "thin" is understood to mean "very thin" according to the Larousse dictionary.

36. GM argues, on the contrary, that the term "thin" is subjective because its meaning depends on the context of the patent; in this case, the assembly strip must be thin enough to ensure

the function claimed in the patent, namely to form a "substantially flat" assembly area. According to GM, the patent specifies and claims (claim 5) a thickness of 0.05 mm to 0.15 mm [0054], and the defendant asserts that outside this range of values, it is impossible for a person skilled in the art to determine what thickness is sufficiently thin to provide a comfortable feeling to the wearer of the wig. Furthermore, according to GM, the figures in the patent that help to interpret the patent indicate that the thickness of the assembly strip is similar to that of tulle or monofilament fabrics (see Figures 4 A and 4B above, for example), so that the assembly area is virtually flat. (pages 30 and 31 of the reply brief)

37. The Court follows GM's reasoning when it argues that the strip is thin in order to allow the assembly area to be virtually flat, but does not follow it to its conclusion when it deduces that the thickness of this strip must necessarily be between 0.05 mm and 0.15 mm because, as NJ points out in paragraph 120 of its reply, claim 1 does not protect against precise measurements relating to the thickness of the strip, and only dependent claim 5 proposes to fix the thickness in figures by repeating the measurement range as mentioned in the patent description.

38. The terms "edge to edge" (feature 1.6):

39. NJ notes that, while the embodiment in which the pieces of fabric are placed edge to edge "eliminates any excess thickness" ([0051]), the embodiment in which the pieces are superimposed means that the excess thickness "is practically reduced" ([0025] compared to the prior art (§141 to 144 of the reply brief). NJ therefore argues that these are two embodiments that should not be contrasted or distinguished, as they achieve the same end of effectively reducing the disadvantage of excess thickness.

40. GM argues, on the contrary, that feature 1.6 indicating a "edge-to-edge" assembly cannot be equated with a "superimposed" assembly (§103 of the defence brief), pointing out that without this express limitation on the method of implementation of a placement "edge to edge" indicated in claim 1, the patent would not have been granted by the EPO (paragraph 105 of the statement of defence), in view of the exchanges between NJ and the EPO during the grant phase. (see exhibits 5 to 7, and in particular exhibit 6 from GM entitled "BP6-EPO PROCEDURE - AMENDMENT OF CLAIMS")

The Court considers, as GM argues, that the patent indicates in the description two distinct modes of realisation for ensuring the connection between the fabrics, namely "edge to edge" positioning and "superimposed" positioning, but that only one mode of realisation is mentioned in claim 1, with the aim of limiting the scope of the invention.

41. The terms "transparent or translucent" (claim 1, features 1.4 a and 1.6 a):

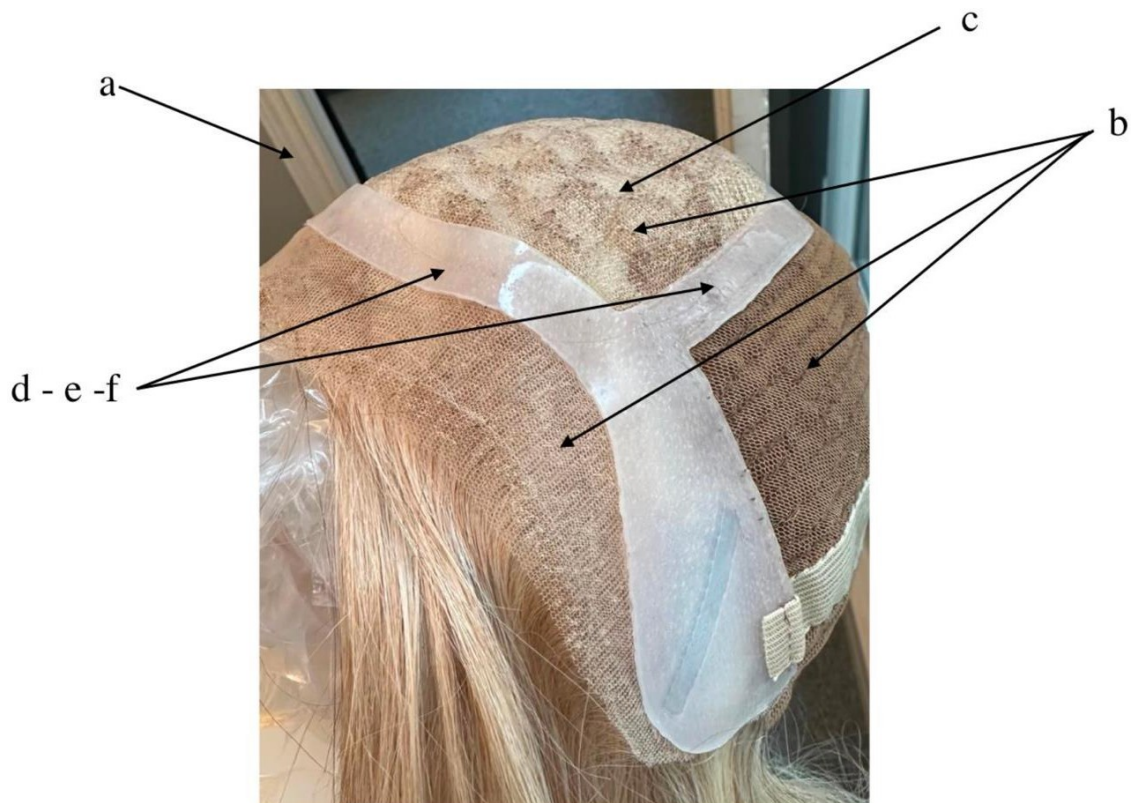
42. NJ explains that the term "translucent" refers to a body "that allows diffuse light to pass through without allowing objects to be distinguished through it" (cnrtl.fr in §121 of the reply brief), whereas "transparent" allows objects to be distinguished through it. NJ adds that the patent protects a material that can be either transparent or translucent in an equivalent manner.

43. On the contrary, GM argues, with regard to feature 1.6a, that the thin strip can only be "transparent", as opposed to "translucent", arguing that otherwise this feature would add nothing (§112 of the defence brief).
44. The Court agrees with NJ's reasoning that feature 1.6a does not exclude the assembly strip from being translucent as opposed to transparent, since the properties of the assembly strip are explicitly defined by feature 1.4a and 1.6a refers to the assembly strip only to explain the positioning of the edges relative to the other elements of the cap. in relation to the other elements of the cap.

On the materiality of the infringement alleged by NJ

A) Direct infringement (Article 25 AJUB), as the main claim

45. NJ claims that GM wigs in the "ELITE PREMIUM" range infringe its EP'516 patent. To this end, in its statement of claim (§61, page 21), the claimant analyses a photograph of one of GM's wigs (subject of the online purchase report in exhibit NJ No. 8.9) on which, according to the claimant, the reproduction of the distinctive part of claim 1 is visible, namely: the adjacent edges of the pieces of fabric making up the cap are held together (in a contiguous position) by means of a thin strip of flexible, translucent material covered with a non-slip film, said strip covering and overlapping said edges (f):



NJ concludes that the reproduction of the said characterising part is made evident in particular by the use of thin, flexible and translucent strips to connect the pieces of

fabric comprising the cap, which provides a flat connection area with respect to the prior art (paragraph 111 of the statement of claim and paragraph 62 of the statement of reply).

46. GM disputes NJ's allegation, arguing, on the one hand, that the applicant does not rely on any evidence, as a mere reference to a photograph is insufficient to prove infringement, and, on the other hand, that the marketing of the wig from the "ELITE PREMIUM" range does not constitute an infringement of NJ's patent. range.
47. With regard to the lack of evidence, the defendant is correct in pointing out that it is not relevant to compare the allegedly infringing product with NJ's product, but that this comparative analysis must be carried out by comparing the allegedly infringing product with the claims of the opposed patent. This is what the claimant then does in its reply.
48. GM specifically disputes the absence of the following features of claim 1 of patent EP'516, arguing that it is impossible to know from the single photograph produced by NJ whether: (page 41 of the defence statement, §164):
- (i) the adjacent edges of the pieces of fabric making up the cap are held **edge to edge**;
 - (ii) the band is thin;
 - (iii) the strip is made of a flexible and transparent material;
 - (iv) the connection area is flat in relation to the prior art.
49. More specifically, the defendant argues that feature 1.6, which provides that: "*the adjacent edges (4, 5) of the monofilament piece (3) and the parts (2) of the cap (1) adjacent to said monofilament piece (3) are **placed edge to edge***" because it is visually impossible to determine the position of the edges of the monofilament and the adjacent fabric parts (paragraph 191 of the statement of defence).

The challenge to the reproduction of features 1.4, 1.4a, 1.5, 1.6a and 1.6 of claim 1 of NJ's patent by GM's ELITE PREMIUM wigs

50. GM disputes the materiality of the infringement alleged by NJ, arguing that claim 1 is not reproduced in its features 1.4 ("fine"), 1.4a ("flexible") and 1.6a ("transparent") and 1.5 ("film or non-slip coating") by its wigs in the "ELITE PREMIUM" range (and more specifically "ELITE PREMIUM ULTRA LONG", "ELITE PREMIUM LONG", "ELITE PREMIUM MEDIUM LARGE", "ELITE PREMIUM MEDIUM", "ELITE PREMIUM BASIC CAP" and "ELITE PREMIUM SHORT"). (§293 R.36 of NJ + items 7.4, 7.5, 7.6, 7.7, 7.8 and 7.9 of NJ)

Furthermore, GM disputes the reproduction of feature 1.6 of claim 1.

51. On the reproduction of feature 1.4:

Feature 1.4 reads as follows: "*the adjacent edges (4, 5) of the monofilament piece (3) and the parts (2) of the cap (1) contiguous with the monofilament piece (3) are assembled by means of a **thin strip** of flexible and transparent or translucent material (6) covering and overlapping said edges (4, 5) to form a substantially flat assembly area (7).*"

NJ asserts that a strip with a thickness of 1 mm would be "thin" in relation to anti-slip strips for wigs sold on the market (reply brief 120) and that a person skilled in the art would not consider this to be a significant difference.

GM maintains that the ELITE PREMIUM wig has an overlap and covering of the tulle and monofilament edges by the assembly strip, meaning that the surface of the assembly strip is placed above the surface of the fabric edges, that this forms a noticeable protrusion, that this does not correspond to the thin strip within the meaning of the patent, i.e. it must be thin enough to form an almost flat assembly area within the meaning of feature 1.4.

The Court notes that claim 1.4 does not specify the thickness that can be considered thin, but points out that the thinness of the strip must allow for a joining zone to be formed.

"practically flat", as stated in claim 1 of the patent. The Court also notes that, in the description section of the patent, the margin of manoeuvre is limited to between 0.05 and 0.15 mm [0032 and 0054], whereas in the alleged infringing product, the assembly strip is between 1 and 2 mm (see booklet page 18), which is far from the margin proposed in the patent. However, only dependent claim 5 gives precise figures. The Court therefore considers that the scope of claim 1 cannot be limited to this precise thickness margin between 0.05 and 0.15 mm.

In view of the alleged counterfeit wig produced in the file, the Court finds that the strip of 1mm is fairly thin for that the assembly zone appears as "practically flat".

52. Therefore, the reproduction of characteristic 1.4 by the ELITE PREMIUM wig is demonstrated.

53. On the reproduction of characteristic 1.4a:

Feature 1.4a reads as follows: "*made of a flexible, transparent or translucent material*".

According to GM, the assembly strip of the wigs alleged to be counterfeit provides a certain rigidity to the fabric forming the wig so that it supports and predefines the shape of the skull (duplicate statement §146 and 147). GM adds that NJ does not demonstrate that the assembly strip is transparent.

However, GM's arguments are not convincing. First, the Court finds, based on its examination of the ELITE PREMIUM wig submitted for the proceedings, that it is

clearly made of a flexible material in that it can be bent, easily deformed and is flexible. As for the terms "transparent or translucent", as already stated *above* (see § 44), claim 1 considers these two qualifiers to be equivalent: the strip can be either transparent or translucent. And the term "transparent" in line 54 must be interpreted as either one or the other, which is supported by the description in [0047]: "*a flexible material 6 that is transparent or translucent*".

However, the Court can see from the products submitted for consideration that the band of the ELITE wig is flexible and translucent. The characteristic "flexible and translucent" of claim 1.4a is therefore well reproduced by the band of the ELITE wig.

54. ***On the reproduction of feature 1.5***

Feature 1.5 reads as follows: "*the outer surface of the flexible assembly strip (6) has a non-slip film or coating*".

GM argues that the fact that the tape feels non-slip to the touch does not prove that it has a coating or film. (§149, rejoinder). However, the Court finds that touching the band of the wig alleged to be counterfeit demonstrates precisely the presence of such a film or coating, the function of which is to act as a grip between the skull and the wig and is therefore non-slip.

55. ***On the reproduction of feature 1.6a***

Feature 1.6a reads as follows: "*the flexible (6) and transparent assembly strip covers and overlaps the said edgings (4, 5)*".

It is sufficient that this strip is not rigid and can easily be shaped to fit the shape of the skull, which is the case with the strip on the ELITE wigs submitted for examination.

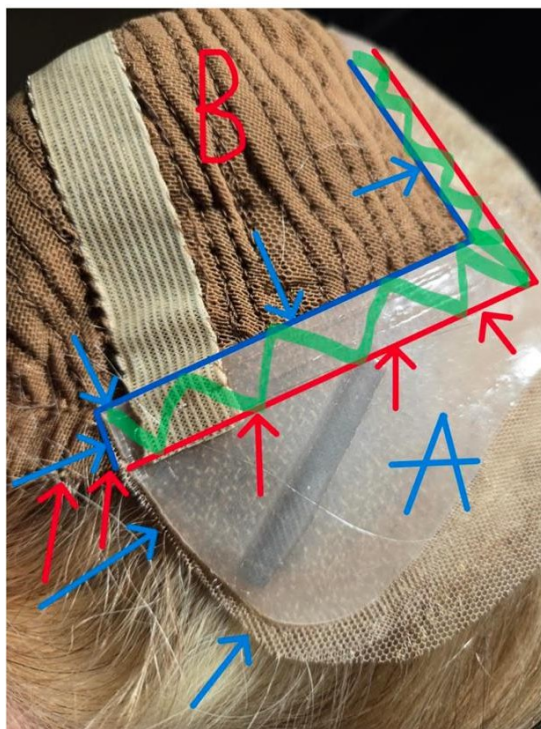
This characteristic is therefore reproduced.

56. ***On the reproduction of feature 1.6***

Feature 1.6 reads as follows: "*the adjacent edges (4, 5) of the monofilament piece (3) and of the parts (2) of the cap (1) contiguous with said monofilament piece (3) are **placed edge to edge***".

According to the defendant, this feature is not reproduced by the wig. GM therefore claims that, based on the photograph presented by NJ as the sole basis for the statement of claim, it is visually impossible to determine the position of the monofilament edges and the adjacent fabric sections, whereas feature 1.6 requires that these edges be placed edge to edge. GM points out that this feature is essential in the patent in question. (Defence brief, page 47). In addition, GM submits for the record an enlargement of the photographs of the wig alleged to be infringing by NJ (exhibits BP 8) showing that the monofilament and tulle fabrics are superimposed (page 55

of the statement of defence). This overlapping area is hatched by the defendant (photograph 8.6 of GM on page 56 of the statement of defence) as follows:



57. GM concludes that for ELITE PREMIUM wigs, the edges of the monofilament and tulle fabrics are not placed edge to edge.
58. In its reply, NJ states that even though GM indicates that it implements the "superimposed" embodiment, it is stated in the description [0025] of the patent that it is intended in this embodiment that the excess thickness is practically reduced compared to the "superimposed" method, the description [0025] of the patent states that this method provides for the excess thickness to be substantially reduced compared to the prior art, whereas the handling of ELITE PREMIUM wigs leads to the conclusion that no excess thickness is tangible at the connection points. NJ concludes that feature 1.6, which provides for the edge-to-edge placement of fabric pieces, must necessarily be reproduced literally. (reply brief, pages 45 to 47)
59. However, as GM rightly points out (page 25 of the rejoinder), it is not disputed that the overlapping edges are not claimed and are therefore excluded from the scope of the patent in question, which relates solely to wigs with adjacent edges that are edge to edge. Even if the patent description mentions a superimposed design, this design is not included in the claims, which define the scope of protection that the patent holder can enforce against competitors.
60. NJ disputes the fact that the ELITE PREMIUM wig uses superimposition. However, the Court notes that it is clear from the enlarged photographs produced by GM (GM booklet No. 13A, No. 13B, 13C) and from the findings made at the hearing following the handling of the ELITE wigs produced that the two types of fabric are superimposed under the assembly strip. However, this method of operation is not covered by claims 1 and 7 (which is constructed as a mirror image of 1). Yet this "edge-to-edge" feature is essential. Indeed, this feature of the invention makes it possible to achieve the objectives pursued by the patent in question and to overcome the disadvantages of the prior art wigs in terms of aesthetics and

comfort plan. Moreover, this reference to "side by side" was suggested during the granting procedure before the EPO and enabled the patent to be granted in this version by limiting its scope (see EPO exchanges in documents 5 and 6 of GM). The patent itself describes two distinct modes of implementation (0024 and 0028), and a person skilled in the art will understand in the context of the patent that "edge to edge" is distinct from "superimposition". It is irrelevant that the superimposed embodiment remains in the descriptive part; what matters is the scope of protection as defined by the claims, which are expressly limited to 'edge to edge'. The Court also notes that the addition of the words 'placed edge to edge' in claim 1 should have led, during the grant phase of the patent, to the deletion of the "superimposed" method of realising the invention mentioned in the description, as this method does not fall within the scope of protection of the patent as finally claimed. (See *Agfa v Gucci*, Hamburg Regional Court, 30 April 2025, UPC_CFI_278/2023, Headnote 3: "*Specifications in the description that are not consistent with the granted claims cannot serve as a basis for a broad interpretation of a claim.*")

61. In the present case, the fact that the edges in the ELITE wigs are superimposed rather than "placed edge to edge" demonstrates that feature 1.6 has not been reproduced. NJ therefore fails to prove the materiality of the alleged infringement.
62. In conclusion, the Court rejects all of NJ's claims regarding direct infringement of claim 1 by the ELITE PREMIUM wigs.

On the dependent claims (Nos. 2 to 4) asserted by NJ

63. Claims 2 to 4 are dependent claims on claim 1 and therefore include the same limitations in that they require, in particular, that the edges of the monofilament (3, red) and the adjacent parts of the cap (2, blue) be placed edge to edge. It follows that, for the same reasons as those set out to demonstrate that claim 1 is not reproduced, there is no infringement of dependent claims 2 to 4.

Regarding process claim No. 7 and dependent claims (8 and 9)

64. The main process claim No. 7 is constructed as a mirror image of product claim No. 1. Therefore, the arguments developed in relation to feature 1.6 are also relevant to the process claim in that it has not been demonstrated that ELITE PREMIUM wigs reproduce the process whereby the edges are placed edge to edge, given that they overlap, in view of the infringing product in the file.
65. For the same reasons, there is no infringement of the two dependent claims 8 and 9 of the patent in question.
66. Consequently, NJ fails to demonstrate infringement on the basis of Article 25 AJUB of GM's ELITE PREMIUM wigs and will be dismissed from all its subsequent claims.

B) Infringement by equivalence (Art. 26 UPCA), in the alternative

On the admissibility of the claim

67. GM raises the inadmissibility of the claim for infringement by equivalence on the grounds that it is time-barred.
68. In its statement of claim, NJ made claims based solely on Art. 25 AJUB, i.e. on direct infringement. The claim based on Art. 26 AJUB was only made as an alternative claim in the reply statement, after GM's statement of defence.
69. NJ disputes the late submission on the basis of point 7 of the Preamble to the Rules of Procedure (§161 Reply), which allows for the evolving nature of the proceedings to be taken into account and refers to an order issued by the JUB Local Division of Brussels (8 July 2024, DL of Brussels, 8 July 2024, ORD_37783/2024), which stated: "*the rights of defence therefore allow a party to adapt or supplement its arguments (whether or not supported by new evidence) and its claim as it deems necessary*" (free translation from English). The Court notes that the case law of the Court of First Instance of the JUB cited is relevant since the Local Division of Brussels ruled in this way in the context of an application to declare inadmissible a new argument of infringement based on equivalence, the-rapporteur having rejected that application on the ground that the procedure was evolving, that if the other party had the opportunity to respond (compliance with the adversarial principle and the rights of defence are respected) to that new request, the other party was entitled to change its procedural strategy if that did not alter its nature but was merely an amendment. This order was appealed to the Court of Appeal of the JUB, which rejected the appellant's arguments on the following grounds: "*the CFI has a certain discretion*" (21 November 2024, UPC_CoA_456/2024, APL_44633/2024).
70. In this case, the Court considers that the claim for infringement by equivalence, which was made immediately after the statement of defence, is not late (at the stage of the reply), since this claim does not change the nature of the claimant's procedural strategy, which merely adapts it in light of the arguments put forward by GM in its defence, and the defendant was able to respond to it in its rejoinder. For these reasons, the claim for infringement by equivalence is admissible in this case.

On the merits

71. NJ argues that GM would have achieved the same result without the extra thickness in the connection areas while modifying the layout of the adjacent edges of the fabric pieces sufficiently to avoid literal reproduction. (§164 Reply)
72. To support the existence of infringement by equivalence by the ELITE PREMIUM wig, on which the adjacent edges are superimposed and not placed edge to edge, NJ invokes Article 69(1) of the EPC, arguing that the description

and drawings of the patent must be taken into account when interpreting the claims and points out that the method of superimposition is mentioned therein.

Legal framework:

73. According to Article 24 AJUB, the sources of substantive law for settling disputes before the JUB include, in particular, the EPC.

74. Article 2 of the Interpretative Protocol on Article 69 EPC – which supplements the first article of the Protocol – states:

"In determining the scope of protection, due account shall be taken of any element equivalent to an element specified in the claims."

75. However, this does not mean that the description and drawings can be used to extend the scope of patent protection.

76. In support of its claim, NJ cites the French law applicable to infringement by equivalent. However, in the absence of an agreement between the parties to apply a particular national law on this point, the case law on equivalence as developed within the JUB should be applied here. To date, a decision on the equivalence test has been handed down by the Local Division in The Hague (22 November 2024, UPC_CFI_239/2023), to the effect that:

"The test applied to the assessment of infringement by equivalence is based on the case law in various national jurisdictions, as proposed by both parties in this case. This entails that a variation is equivalent to an element specified in the claim if the following four questions are answered in the affirmative.

- 1) *Technical equivalence: does the variation solve (essentially) the same problem that the patented invention solves and perform (essentially) the same function in this context?*
- 2) *Fair protection for the patentee: Is extending the protection of the claim to the equivalent proportionate to fair protection for the patentee?*
- 3) *Reasonable legal certainty for third parties: does the skilled person understand from the patent that the scope of the invention is broader than what is claimed literally?*
- 4) *Is the allegedly infringing product novel and inventive over the prior art?*

77. The Court notes that this equivalence test, which is an application of the case law developed by the Dutch national courts, was adopted by the Local Division in The Hague following an agreement between the parties on this type of test, which is not the case in the present dispute. (Paragraph 88 of the decision of the Local Division in The Hague)

78. On the other hand, the decision of the Local Division of Mannheim of 6 June 2025 (CFI 471/2023) refers to a harmonised approach within the JUB and proposes criteria based on a compromise between the different doctrines within the Member States, which the Local Division in Paris adopts because this proposal is in line with the spirit of the JUB Agreement, which aims to reduce, as stated in recital 2, *'the fragmentation of the market*

and significant variations between national legal systems", which "are detrimental to innovation, in particular for small and medium-sized enterprises, which have difficulties in enforcing their patents and defending themselves against unfounded actions and actions relating to patents that should be revoked".

79. This decision by the Mannheim Local Division states in its "Headnotes" (free translation into English from the original German version): - *"According to all doctrines of equivalence or equivalence tests of the UPC contracting member states, equivalent patent infringement is ruled out if there is no technical-functional equivalence of the substitute means in the sense that the modified means do not fulfil essentially the same function in order to achieve essentially the same effect. If the same function is not taken as a basis, at least essentially the same effect is taken as a basis (following the Brussels UPC LD, 17 January 2025, para. 98 CFI 376/2023)."*
80. The Brussels Local Division, in its decision of 17 January 2025 (CFI 376/2023) did not rule on the equivalence test to be applied, but indicated that in the context of the two tests proposed by the applicant, it was necessary that at least the function be reproduced and that, in the absence of such reproduction, there would in any event be no reproduction by equivalence. Thus, in Headnotes 3 and paragraph 98 of the decision, it is noted: *"In the absence of functional equivalence, there can be no infringement in equivalence (whatever equivalence test is applied)."*

In the present case:

81. In light of these JUB rulings, this Division considers, on the one hand, that the most harmonised interpretation possible within the JUB should be adopted when ruling on claims of infringement by equivalence and, on the other hand, that, in all cases, in view of the different tests carried out within the contracting Member States of the AJUB, it is necessary to first answer a question that is the lowest common denominator and constitutes the first criterion for examining equivalence: Do the modified (or substitute) means essentially fulfil the same function to achieve essentially the same effect?
82. In the present case, in view of the alleged counterfeit wigs produced and the explanations given by the parties at the oral hearing during the handling of the said products, the Court finds that the essential function of the translucent strip on the ELITE product is not to assemble the two fabrics (the function taught in the patent in question) since the two fabrics are assembled by the two seams positioned on the non-slip strip, but rather, in reality, to cover the seams for greater user comfort.
83. In the absence of the same function as that taught in the patent, the existence of infringement by equivalence cannot be upheld.
84. Consequently, infringement by equivalence is not established, as NJ has failed to prove it.

On legal costs (section 69 AJUB):

As a main argument,

85. GM is seeking a *joint and several* order against NJ and the voluntary interveners, in their respective capacities, to pay a provision on costs in the amount of €50,000. GM is seeking an order for payment against NJ, a debtor in receivership, arguing that this claim would benefit from the preferential treatment provided for in Article L. 622-17 of the French Commercial Code. NJ is contesting this claim for payment.
86. The applicable law is the law of the Member State in which the insolvency proceedings were opened (Article 7 of EU Regulation No. 2015/848 of 5 June 2015, known as the "Insolvency Regulation"), i.e. French law in this case.
- With regard to NJ's situation, Article L.622-7 of the French Commercial Code, applicable by reference in Article L. 631-14 to the receivership proceedings provided for in the same code, establishes the principle of prohibition of payments to creditors prior and subsequent to the insolvency, with the exception of claims covered by Article L. 622-17 of the same code.
87. In order to determine the fate of the claim, it must be established whether the claim arose after the proceedings were initiated and whether it is relevant to those proceedings. According to the settled case law of the French Court of Cassation, claims for costs are based on the non-contractual liability of the parties to the proceedings. They arise from the decision that determines their existence and amount and orders payment (Cass. 3rd civ., 7 Oct. 2009, no. 08-12.920; Cass. com., 21 Jan. 2003, no. 99-21.560; Cass. soc., 12 Feb. 2003, no. 99-42.985). The claim for which GM is seeking payment is therefore a claim that arose after the date on which the collective proceedings were opened.
88. However, it must be determined whether the subsequent claim for which GM is seeking payment falls within the scope of Article L. 622-17 of the French Commercial Code, i.e. whether it constitutes a subsequent, valid and useful claim. In this case, the parties do not dispute the validity of the claim in view of the intervention of the insolvency administrator in the proceedings.
89. It remains for the Court to determine whether the subsequent and regular claim is useful, in other words, whether it arose "for the purposes of the [insolvency] proceedings or the provisional continuation of the authorised activity pursuant to Article L. 641-10 or in consideration for a service provided to the debtor during that continuation of the activity". According to established case law of the Court of Cassation, claims for costs do not constitute a claim that is useful to the insolvency proceedings, given that these claims have only an accidental temporal link with the collective proceedings (Cass. 3^(e)civ., 8 July 2021, no. 19-18.437; Cass. com., 9 Dec. 2020, no. 19-17.579). In this case, the Court notes that these are not expenses useful for improving the economic activity of the debtor in receivership.
90. Consequently, the subsequent claim not covered by the privilege under Article L. 622-17 of the French Commercial Code remains subject to the rules of collective proceedings. The debtor

be ordered to pay a debt (Cass. com., 11 May 1993, no. 91-11.951).

- With regard to the situation of voluntary interveners, they are requested to be ordered to pay *jointly and severally*. The latter, as judicial administrators and judicial representatives in collective proceedings, i.e. "insolvency practitioners" within the meaning of EU Regulation No. 848/2015, are subject to the *lex concursus* in accordance with Article 7(c) of that Regulation. However, the French Court of Cassation has repeatedly held that the liability of the bodies involved in collective proceedings is a special liability regime requiring proof of gross and independent fault. Such fault is characterised, for example, if the insolvency practitioner decides to continue the proceedings when the company's situation is irretrievably compromised and does not seek the cessation of the company's activities or its liquidation (Cass. com., 18 Jan. 2000, No. 98-19.692; Cass. com., 26 Nov. 2002, no. 01-11.437).

91. In the present case, the Court notes that GM, which merely points out that the insolvency proceedings authorities chose to continue the proceedings (paragraph 18 of GM's latest statement of defence), does not demonstrate the existence of any fault, even though they have that power under Article L.622-22 of the French Commercial Code.

92. Consequently, the Court declares GM's main claim for payment of provisional costs against NJ inadmissible and unfounded with regard to the voluntary interveners.

-In the alternative,

93. GM requests the Court to order that this same claim be included in NJ's liabilities for the same amount.

94. In accordance with applicable national law, the Court must determine the amount of the claim so that it can be included in the liabilities of the debtor subject to collective proceedings (Cass. com., 24 Apr. 2007, no. 05-17.452). Therefore, the Court declares GM's request to determine the compensation claim as a provision for its representation costs in accordance with Article 69 AJUB so that this claim may be included in NJ's liabilities to be well founded, and sets it at EUR 50,000, which appears reasonable and proportionate in view of the circumstances of the case and justified by the certificate produced by GM in exhibit 26.

95. The Court adds that it is not necessary to rule on GM's claim for indemnity made in the alternative, since all of NJ's claims have been dismissed.

FOR THESE REASONS,

The Court of First Instance of the JUB:

- 1- Notes the voluntary interventions of the bodies involved in the collective proceedings and the resumption of the proceedings after the filing of claims by GISELA MAYER, in the hands of the creditors' representative,
- 2- Declares that the action for infringement brought by NJ DIFFUSION, assisted by its insolvency administrator, against GISELA MAYER is admissible,
- 3- Rejects all claims by NJ DIFFUSION, assisted by its insolvency administrator, against GISELA MAYER for infringement, direct or by equivalence, based on European patent EP 2 404 516, as well as all subsequent claims,
- 4- Declares that NJ DIFFUSION, assisted by its insolvency administrator, shall bear all costs of the present proceedings, dismisses the claim for payment in this respect and sets the claim in the liabilities of the collective proceedings opened against NJ DIFFUSION at the amount of 50,000 euros as the provision due for GISELA MAYER's legal representation costs,
- 5- States that this decision is subject to appeal in accordance with Rule 220.1 (a) RdP.

Rendered in Paris on 1 August 2025.

C. LIGNIERES, Presiding Judge and Reporting Judge,

Camille Lignières Date:
2025.08.01
10:59:38 +02'00'

C. GILLET, legally qualified judge,

Carine Gillet 31 July 2025
14:47
+02

S. SCHILLING, legally qualified judge,

**Stefan
Schilling** Digitally signed by
Stefan Schilling Date:
31 July 2025
12:36:48

**C. FERHAT, court
clerk,**

Digital signature of
CHARLOTTE CAMILLE
CLAIRE FERHAT

**CHARLOTTE
CAMILLE**

CLAIRE FERHAT Date: 2025.07.31
15:00:04

DETAILS OF THE ORDER

Order No. ORD_69410/2024 in ACTION No.: ACT_39091/2024 UPC No.:
UPC_CFI_363/2024

Type of action: Action for infringement