

**Judgment**  
**of the Court of First Instance of the Unified Patent Court delivered on 10**  
**April 2025**  
**concerning EP 3 356 109 B1**

HEADNOTES:

1. Product-by-process claims are characterised by the fact that the technical content of the invention does not generally consist in the process as such, but in the technical properties conferred on the product by the process. The decisive factor is how the person skilled in the art understands the information regarding the manufacturing method and what conclusions they draw from this regarding the nature of the product as claimed.
2. Any financial compensation for the use of the published EP application also falls within the jurisdiction of the Unified Patent Court (Article 32(1)(f) of the UPC Agreement). As such compensation is not regulated in either the EPatVO or the EPGÜ, the Court must, on the basis of Article 24(1)(c) EPGÜ, apply the provision of Article 67 EPC, which grants Member States discretion regarding its implementation. As there is as yet no uniform regulation on the issue of compensation, it is initially for the claimant seeking such compensation to set out the conditions for compensation for each of the Member States in question.

KEYWORDS:

Product-by-process claims; manufacturing process; claims for compensation; limitation period

Claimant:

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PATENT IN DISPUTE:

European Patent No. EP 3 356 109 B1 DECISION-MAKING

BODY/CHAMBER:

Panel of the Düsseldorf Local Chamber

JUDGES:

The decision was delivered with the participation of Presiding Judge Thomas as the reporting judge, legally qualified Judge Dr Thom, legally qualified Judge Brinkman and technically qualified Judge Ashley.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Action for infringement and counterclaim for annulment

ORAL HEARING: 13 February 2025

BRIEF SUMMARY OF THE FACTS:

1. The plaintiffs are bringing proceedings against the defendant for infringement of European Patent EP 3 356 109 B1 (hereinafter: the patent in dispute).
2. The patent in dispute was filed on 25 January 2017 in German, claiming the priority of DE 10 2016 101 274 dated 25 January 2016, by the second claimant and the third counter-defendant. The notice of grant was published on 9 March 2022. The patent in dispute is in force in Germany, France, Ireland, Italy and Slovenia. No opposition was filed with the European Patent Office against the grant of the patent in dispute. The opt-out declared on 15 May 2023 in respect of the patent in dispute was withdrawn on 2 February 2024.
3. On 30 December 2022, the parties, including the third-party counter-defendant, concluded a 'Declaration of Sale and Transfer for the intellectual property rights relating to the German priority application DE 10 2016 101 274 entitled "Frame for a vehicle with at least one structural part made of foam resin and method of manufacture therefor"'. Reference is made to Annex K 1 regarding the content of this agreement.
4. The patent in dispute is entitled 'Frame for a vehicle comprising at least one structural component made of foam resin, and a method of manufacturing the same'. Its claims 1, 3, 4, 7 and 9 read as follows:

Claim 1:

"Frame (11) for a vehicle (10) comprising at least one structural component (15), wherein the structural component (15) is produced as a cast part (52) in a mould (50) and

the mould (50) reproduces the three-dimensional external shape of the structural part (15), wherein the structural part (15) is formed by a self-expanding foam resin (20),

**characterised in**

**that** the structural component (15) is at least partially coated on the outside with a protective layer (19),

whereby the structural parts (15) form a load-bearing part of the frame (11).

Claim 3:

"Frame (11) according to claim 1 or 2,

**characterised in**

**that** at least one insert element (16) is provided in the structural part (15), which is at least partially embedded.”

Claim 4:

“Frame (11) according to claim 3,

**characterised in that,**

**that** the insert element (16) is a reinforcing element (17) and improves the mechanical strength, in particular the tensile and/or compressive strength, of the structural component (15),

wherein the reinforcing element (17) is formed at least from glass fibres, carbon fibres, a reinforcing mat, a sandwich structure, an inner core, a metallic reinforcing element or a combination thereof and/or

**that** the insert element (16) is a connecting element (18), whereby the structural part (15) can be connected to other parts, in particular to the frame (11) of the vehicle (10).”

Claim 7:

“Frame (11) according to one of the preceding claims,

**characterised in**

**that** the foam resin (20) has a density of between 100 and 300 kg/m<sup>3</sup>, preferably between 130 and 200 kg/m<sup>3</sup> and particularly preferably between 140 and 180 kg/m<sup>3</sup>, and/or that the foam resin (20) has a thermal conductivity of between 0.1 and 0.015 W/(m·K), preferably between 0.08 and 0.02 W/(m·K), particularly preferably between 0.05 and 0.021 W/(m·K), and/or

the structural component (15) has a tensile strength of between 15 and 25,000 N/mm, preferably between 30 and 10,000 N/mm, more preferably between 45 and 2,000 N/mm, and between 100 and 1,600 N/mm.”

Claim 9:

“Frame (11) according to any of the preceding claims,

**characterised in that**

**that** a void (11.1) between at least two structural parts (15) can be filled by a filling element (12), wherein, in particular, the filling element (12) is configured as a wall (12.1) and/or roof element (12.2), and wherein, in particular, at least one recess (12.3) for a window or a door may be provided.”

5. Figures 1, 4 and 5, shown below, illustrate preferred embodiments of the invention. Figure 1 is a three-dimensional view of a structural component with suggested insert elements:

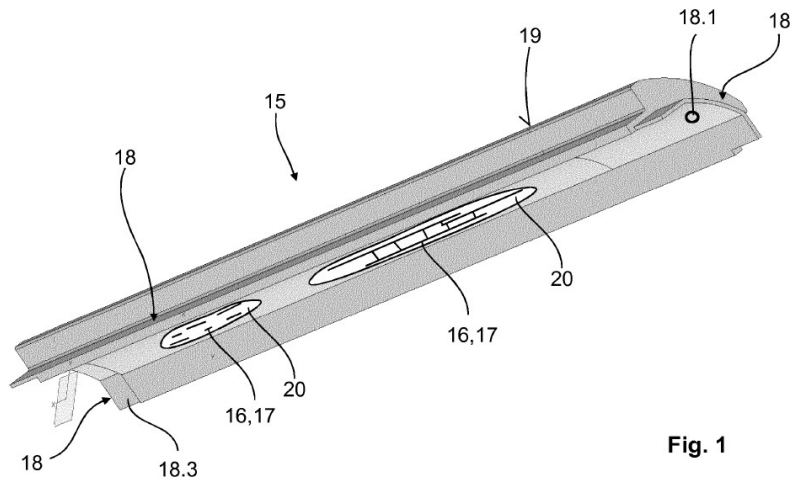


Fig. 1

6. Figure 4 shows a frame for a caravan with the structural parts in a three-dimensional view, wherein the frame in Figure 5 comprises additional infill elements:

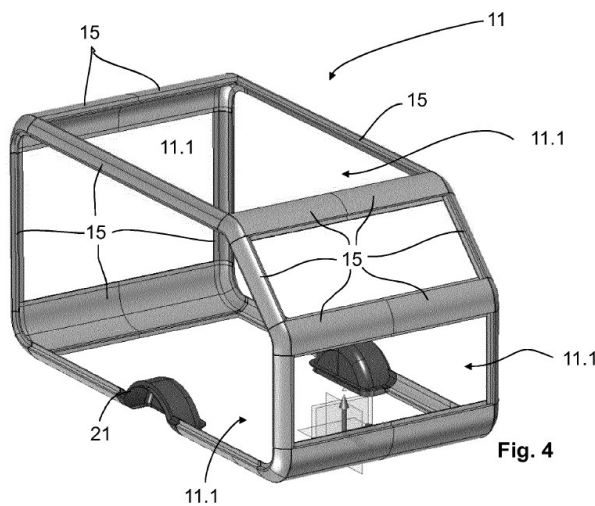


Fig. 4

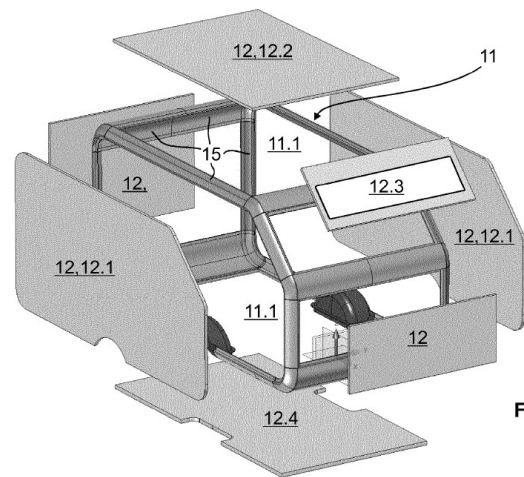


Fig. 5

7. The second claimant is, amongst other things, the owner and managing director of Freitec Kunststoffe GmbH and Freitec Technologies GmbH. In the past, and prior to the filing of the contested patent, he concluded a development agreement with the defendant, together with the third-party counter-defendant (and jointly with their companies), which was also implemented for a certain period of time. This development project concerned the implementation of the invention according to the contested patent for the defendant's caravans and motorhomes, and specifically the development of a lightweight caravan using the 'Frame Concept' for such motorhomes and caravans, as is the subject matter of the contested patent.
8. Together with the third-party counter-defendant, the second claimant built a test model on the basis of the development contract, and the required characteristics were confirmed during testing. The defendant marketed this model under the name 'Travelino' and subsequently commissioned a further design for a caravan, the 'Deseo'. This design was also created by the second claimant and the third counter-defendant, who handed over the production data for this model. The parties did not conclude an agreement granting rights of use. No response was received to enquiries regarding this matter.
9. The defendant subsequently commissioned the second claimant and the third counter-defendant to develop a further design requiring fewer moulds for the individual frame components. This design was also created by the second claimant together with the third counter-defendant, whereby

this concept was also handed over to the defendant. Without any feedback and without an agreement on the granting of rights of use, the defendant launched the 'Azur' model on the market on this basis. Following further contact, the defendant stated that it assumed no patent would be granted. Subsequently, both the second claimant (by agreement) and the third counter-defendant terminated the development agreement by giving notice.

10. The defendant advertises the technology it uses as 'state-of-the-art Fibre FRAME technology'. It uses this technology in both its 'DESEO' caravan and its 'AZUR' caravan (hereinafter: the contested embodiments). In this regard, the defendant's website states, inter alia (see bundle of exhibits K 5):

"Thanks to state-of-the-art fibre frame technology, we've managed to make the DESEO even more flexible and spacious. The variable interior layout and forward-thinking design strike the perfect balance between utility and living space, meaning it can even carry two full-size motorbikes. Once you reach your destination, the DESEO transforms into a fully equipped, comfortable caravan. Pretty handy, isn't it?"

"Progressive design through innovative construction: this is what the future looks like. Our DESEO. A real storage space wonder with nooks and crannies. Even though most of them are actually rounded – and, of course, particularly practical, as they protect all the equipment we've packed into the exterior."

[...]

"The self-supporting fibre frame not only ensures greater flexibility in the layout and interior design, but also supports the progressive design language."

11. Furthermore, the following explanation can be found on the website of the German "Caravaning Institute" (see Annex K 6):

"Fibre Frame is a high-strength fibreglass frame that ensures a rigid, self-supporting structure and also allows for uncompromising ultra-lightweight construction with enhanced crash safety.

The advantages:

- bonded surface elements with a continuous density layer
- enables completely new approaches to layout design and furniture placement in the future (such as variable layouts or freely positionable elements)
- The frame's manufacturing process opens up new possibilities for implementing 'multidimensional' elements in the design process
- Automated production, further processing and finishing of the frame and surface elements on the production line are in preparation and will be integrated as part of the modernisation of the production lines
- In theory, functions (such as cable ducts) can be integrated into the frame as early as the manufacturing stage.
- Increased load-bearing capacities (roof) are possible

12. Finally, a press release from the defendant (Exhibit K 7) states:

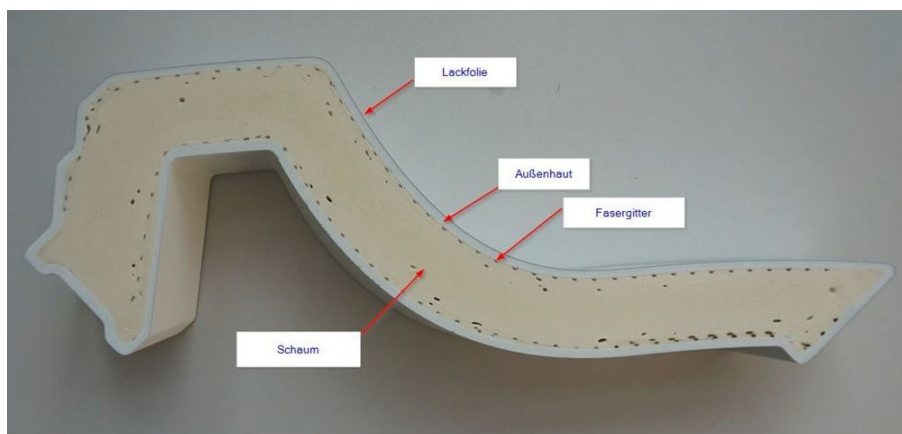
"The pioneering frame technology is based on fibre frame components that are automatically bonded together to form a stable frame, thereby eliminating the need for any screw connections. The self-supporting, high-strength frame ensures optimum stability and durability

and, compared to conventional caravan construction, offers significantly greater flexibility in layout and interior design.”

13. It further follows from this press release that the frame concept described is also used in the contested embodiments.
14. The plaintiffs ordered a structural component from the defendant in the form of an A-pillar for a caravan frame and had it tested by Gesellschaft für Werkstoffprüfung mbH (GWP). Reference is made to Annex K 15 regarding the content of the test report. The structural component examined is shown below:



15. In cross-section, the component comprises the following parts, labelled by the plaintiffs:



16. Shown below is a diagram provided by the defendant regarding the 'Fiber Frame System', from which the structure of the frame, consisting of the various structural components, can be seen:



CLAIMS OF THE PARTIES:

Claims:

17. The plaintiffs finally request that

I. that the defendant be ordered to,

1. to refrain from producing a vehicle frame comprising at least one structural component, wherein the structural component is produced as a cast part in a mould and the mould reproduces the three-dimensional external shape of the structural component, wherein the structural component is formed from a self-expanding foam resin,

within the territory of the Federal Republic of Germany, the French Republic, Italy and Slovenia

manufacturing, placing on the market, offering for sale, using and/or importing, exporting and/or possessing for the aforementioned purposes,

wherein the structural part is at least partially coated on the outside with a protective layer, wherein the existing structural parts form a load-bearing part of the frame;

(Claim 1 of EP 3 356 109)

2. in the event of a breach of the order pursuant to I. 1., to pay the court a penalty payment of up to EUR 250,000 for each instance of breach;
3. to provide the plaintiffs with information regarding the acts of infringement committed since 8 September 2018 in accordance with I. 1., specifying
  - a) the origin and distribution channels of the infringing products;
  - b) the quantities produced, manufactured, delivered, received or ordered, and the prices paid for the infringing products, and
  - c) the identity of all third parties involved in the manufacture or distribution of the infringing products;
4. the products referred to in I. 1., which have been delivered since 9 April 2022, within a period of 30 days following service of the notice within the meaning of Rule 118(8) sentence 1 of the Rules of Procedure and, where applicable, the certified translation, at the defendant's expense
  - a) from the distribution channels, by notifying the third parties from whom the infringing products are to be recalled

that this Court has found that the products infringe European Patent EP 3 356 109, whereby the defendant must give a binding undertaking to the third parties to reimburse the costs incurred, to bear the packaging and transport costs incurred, to reimburse the customs and storage costs associated with the return of the products, and to take the products back

and

b) to remove them definitively from the distribution channels by the defendant, noting that this court has found that the products infringe European Patent EP 3 356 109, to request third parties who are commercial customers, but not end users, with regard to the products referred to in I. 1, to cancel all orders relating to the products referred to in I. 1 and to submit to the court and the plaintiffs, within the specified period of 30 days following service of the notice within the meaning of Rule 118(8) (1) of the Rules of Procedure and, where applicable, the certified translation;

5. to destroy the products referred to in I. 1. which are in the direct and/or indirect possession of and/or owned by the defendant, or to hand them over to a bailiff to be appointed by the plaintiffs for the purpose of destruction at the defendant's expense;

II. to order the defendant to reimburse the plaintiffs for all damage incurred by them as a result of the acts referred to in I. 1. in the period since 9 April 2022 and which will be incurred in the future;

III. to order the defendant to pay the plaintiffs reasonable compensation for the period from 8 September 2018 to 8 April 2022 in respect of the acts referred to in I. 1.;

IV. order the defendant to pay the plaintiffs the sum of EUR 100,000 as provisional damages;

V. order the defendant to bear the costs of the proceedings.

18. With regard to the wording of the 'in particular, if' claims, reference is made to the statement of claim.

19. The defendant requests that

I.1. that the action for infringement be dismissed;

I.2. in the alternative:

- a) order the third-party counter-defendant to transfer his legal position as the current licensor of the rights of use in favour of the defendant under the development agreement in respect of the French, Italian and Slovenian parts of European patent EP 3 356 109 (hereinafter: the patent in dispute) to the first plaintiff;
- b) to dismiss the infringement action.

I.3. further in the alternative:

to stay the proceedings pursuant to Rule 266(5), first sentence, of the Rules of Procedure and to refer the following questions to the Court of Justice of the European Union for a preliminary ruling pursuant to Article 21 of the EPGÜ in conjunction with Article 267 TFEU:

- a) Does the legal order of the European Union require the application and interpretation of the EPC to be in accordance with the principles of the application and interpretation of treaties codified in the 1969 Vienna Convention on the Law of Treaties and recognised under customary international law?
- b) Does it follow from Article 15(d) of the Rome II Regulation that the EPG, which under the EPGÜ has no procedural powers in relation to patent infringements under national law, cannot therefore issue orders for injunctions, remedies, disclosure or the award of damages?
- c) Is Article 11(1) of the Enforcement Directive to be interpreted as meaning that a final order may not be issued if only an imminent infringement is established?
- d) Is Article 11(1) of the Enforcement Directive to be interpreted as meaning that only the continuation of the established act of infringement may be prohibited, e.g. in the case of a finding of infringement by way of offering, the continuation of the offering, whilst acts of infringement that have not been established cannot be prohibited?
- e) Is Article 3(2), first sentence, of Regulation (EU) No 1217/2010 or Article 3(2) and (3) of Regulation (EU) 2023/1066 to be understood as requiring a research and development contract to be interpreted in such a way that, in cases of doubt, it must be assumed that the contract grants the parties unrestricted access to the final results of the joint research and development, including the intellectual property rights arising therefrom and the know-how resulting therefrom?
- f) Does the principle of the free movement of goods under EU law mean that the EPG may not exercise its procedural powers under Articles 56 et seq. EPGÜ against the defendant in an infringement action who can rely on a contractual right of use in respect of the patent in dispute, which was granted to him by the original co-owner of the patent in dispute, who, in breach of contract, failed to transfer his legal status as licensor to the purchaser of the share in

disputed patent, who is now bringing proceedings against the defendant under that patent, in favour of the defendant?

- g) Does the EU law doctrine of *implied* powers require an interpretation of Article 32(1)(a) of the European Patent Convention (EPC) such that a 'counterclaim relating to licences' may also be directed against a person who has not previously been a party to the infringement proceedings (third-party counterclaim)?
- h) Does the case-law of the Court of Justice of the European Union on EU-wide exhaustion apply *mutatis mutandis* to the right of prior use, e.g. pursuant to Section 12 of the German Patent Act (PatG)?
- i) Does EU law, in particular Article 9(3) of the Unitary Patent Regulation, require Article 25(a) of the EPGÜ to be understood as an exhaustive list of the acts of use reserved to the patent proprietor?
- j) Does EU law, in particular Article 9(3)(e) of the Unitary Patent Regulation, require Article 25(a) of the Unitary Patent Act to be interpreted as meaning that advertising does not constitute an act of offering within the meaning of Article 25(a) of the Unitary Patent Act?

II. in the alternative:

- a) to make the enforcement of the decision, in the event of a conviction of the defendant, conditional upon the provision of security or an equivalent guarantee ensuring adequate compensation for any damage caused by the enforcement, should the decision subsequently be amended or set aside (Art. 82(2) EPGÜ and Rule 354(2), first sentence, VerfO);
- b) insofar as the enforcement proceedings are governed by the law of the Contracting States (Article 82(3), first sentence, EPGÜ), to reserve to the defendant the legal remedies and means of averting enforcement to which she is entitled under the relevant national law;

III. to order the plaintiffs to bear the costs of the proceedings.

20. The claimant requests that

- 1. that the counterclaim against the first and second claimants and the third counter-defendant be dismissed;
- 2. to dismiss the application for a reference to the ECJ;
- 3. to reject the application for security for the enforcement of the decision.

Counterclaim for annulment:

21. Finally, the defendant requests that

- I. that European Patent EP 3 356 109 be declared wholly invalid with effect for the Federal Republic of Germany, the French Republic, the Italian Republic and the Republic of Slovenia.
- II. In the alternative:
  - a) in the event of a judgment against the defendant, to make the enforcement of the decision conditional upon the provision of security or an equivalent guarantee ensuring adequate compensation for any damage caused by the enforcement, should the decision subsequently be amended or set aside (Article 82(2) of the EPGÜ and Rule 354(2), first sentence, of the Rules of Procedure);
  - b) insofar as the enforcement proceedings are governed by the law of the Contracting Member States (Article 82(3), first sentence, of the EPGÜ), to reserve to the defendant the remedies and options available to it under the relevant national law to prevent enforcement;
- III. to order the plaintiffs to pay the costs of the proceedings.

22. The plaintiffs request that

1. that the counterclaim for invalidity be dismissed;
2. to order the defendant to bear the costs of the counterclaim for

invalidity. Requests for amendment of the patent:

23. The plaintiffs request

1. the counterclaim for declaration of invalidity be dismissed; in the alternative, the counterclaim for declaration of invalidity be dismissed to the extent of auxiliary claims 1 to 17, the auxiliary claims being submitted in the order 1 to 17;
2. that the defendant be ordered to pay damages to the extent claimed in the statement of claim, but in each case in relation to the maintained version of the claims in accordance with the alternative claim.

24. With regard to the wording of auxiliary claims 1 to 17, reference is made to the bundle of annexes K 22.

25. The defendant has opposed the requests for amendment of the contested patent, as

1. in its view, the proposed amendments are either inadmissible or
2. the patent in dispute cannot be maintained as requested, or
3. that the patent in dispute had not been infringed.

KEY PROCEDURAL STEPS:

26. Insofar as the plaintiffs initially sought orders relating to the territory of the Republic of Ireland in their statement of claim, they withdrew the claim in their reply to the infringement proceedings dated 10 July 2024. The defendant consented to this partial withdrawal of the infringement action in its rejoinder of 10 September 2024 and requested the court to admit it pursuant to Rule 265(1) sentence 2 of the Rules of Procedure, to issue the decisions and orders pursuant to Rule 265(2) of the Rules of Procedure, and, in particular, to make an order for costs against the plaintiffs.
27. With regard to the counterclaim for annulment, the defendant explained in its written submission of 10 February 2025 that its counterclaim for annulment of 23 February 2024 had included a claim concerning the Republic of Ireland in the event that Ireland had become a contracting Member State by the time the Local Chamber had ruled on the counterclaim for annulment. Since this was not the case, it made it clear that, with regard to the counterclaim for annulment, the application set out above, which did not include the Republic of Ireland, was being made. At the hearing, the defendant applied for leave to be granted in the event that the claims now brought were to be accompanied by a partial withdrawal of the counterclaim for annulment. The plaintiffs and the third-party counter-defendant consented to such a partial withdrawal of the counterclaim for annulment at the hearing, subject to the burden of costs.

FACTUAL AND LEGAL ISSUES:

A. Opposition

28. In its opposition filed on 12 March 2024, the defendant challenges the lack of international jurisdiction of the Unified Patent Court in relation to Ireland.
29. Furthermore, the defendant is of the opinion that, having regard to the prohibition of retroactivity under international law as laid down in Article 28 of the Vienna Convention on the Law of Treaties (hereinafter: Vienna Convention on the Law of Treaties, VCLT), the Unified Patent Court lacks jurisdiction for the period prior to the entry into force of the UPC Agreement.

B. Action for infringement

30. In the plaintiffs' view, the structural elements manufactured and distributed by the defendant make use of the technical teaching of the contested patent. They take the view that, in accordance with the invention, the mould reproduces the three-dimensional external shape of the structural element. The structural part must be manufactured in such a way that it is suitable for production in a mould which reproduces the three-dimensional external shape of the structural part. This is the case when manufactured using a foamed two-component polyurethane, as is used in the contested embodiments. This is usually produced in a mould, whereby the mould defines the shape of the structural component to be produced. Furthermore, a two-component polyurethane is also a self-expanding foam resin. Moreover, in the contested embodiments, the structural part is also at least partially coated on the outside with a protective layer, which is referred to as the 'outer skin' in the cross-section shown above. This outer skin also consists of a two-component polyurethane resin, which is not a foam structure but a cast, non-

is constructed from foamed material. Ultimately, the structural component in question forms a load-bearing part of the frame. It is apparent from the defendant's explanations regarding its 'frame technology' (Exhibit K 6) that the structural components at issue here form a frame and are therefore the load-bearing parts of the frame. The defendant describes its frame as a 'self-supporting fibre frame'.

31. The defendant disputes the standing of the first plaintiff to bring proceedings. The first plaintiff bases its alleged co-ownership of the patent in dispute on the agreement submitted as Annex K 1. Even if the Rules of Procedure do not contain any provision for the transfer of the patent in dispute prior to the proceedings, Rule 312(1) of the Rules of Procedure must apply *mutatis mutandis* in this respect. Consequently, the new proprietor of the patent in dispute can, from the outset, only act as a claimant to the extent that the patent and the claims asserted in the proceedings have been transferred to him. The extent to which claims already arising from the infringement of an acquired European patent pass to the assignee is determined, on the basis of the country-of-protection principle, by the national legal systems applicable to the individual national parts of a European patent. However, the agreement submitted as Annex K 1 does not contain any assignment to the first claimant of the third-party counter-defendant's shares in allegedly already existing (*quod non*) claims for information and accounting, damages and compensation arising from the German part of the patent in dispute. The mere mention of 'claims' is not sufficiently specific. Consequently, the shares in claims against third parties arising from the use of the subject-matter of the contested patent have not been transferred to the first claimant under the applicable German law. The first claimant is therefore not entitled under Rule 312(1) of the Rules of Procedure. Furthermore, in their infringement action, the plaintiffs had not argued, even with regard to France, Italy and Slovenia, why the first plaintiff should be able to claim information, damages and compensation for acts of use that occurred prior to the transfer pursuant to Annex K 1 of 30 December 2022, even though it was obliged to do so, *inter alia*, under Rule 13(1)(f) of the Rules of Procedure. In the absence of any contrary submission by the applicants, the presumption under Rule 8(5)(c) of the Rules of Procedure is therefore rebutted.
32. Apart from that, the contested embodiments did not make use of the technical teaching of the contested patent.
33. Insofar as the structural component is to be produced as a casting in a mould in accordance with the invention, a structural component only complies with the teaching of the contested patent if it has actually been produced as a casting in exactly one mould. The contested patent is based on WO 2017/129589 A1. According to claim 1 thereof, the structural part need only be *producible* as a casting in a mould. Since this feature had been objected to on the grounds of lack of clarity in both the international and European phases of the grant procedure, it had been amended to the effect that the structural part was *produced* as a casting in a mould. Such production was therefore essential for the realisation of the claimed technical teaching.
34. Furthermore, during manufacture in a mould, the structural component must also be coated with the protective layer on the outside.
35. Insofar as the structural component according to the invention is to be coated at least partially on the outside with a protective layer, this is to be understood to mean that the protective layer lies at least partially on the outside and is not covered by a further layer. This is intended, on the one hand, to achieve material savings and simplify production

. Secondly, a high-quality and attractive surface is also intended to be provided directly as a visible surface on the vehicle's exterior. Against this background, the protective layer must in any case lie on the exterior in the area which forms the surface as a visible surface on the vehicle's exterior. A structural component whose protective layer is completely covered on the exterior in these areas by a further layer therefore does not fall within the scope of the claim.

36. The method set out in patent claim 1 describes a total of four advantageous properties of the structural component: Firstly, the protective layer has a uniformly controlled thickness. Secondly, protruding spacers are avoided. Thirdly, the protective layer can be designed to be particularly thin, which enables a particularly lightweight component. Finally, fourthly, the foam core and the protective layer are particularly closely bonded to one another.
37. Based on such an understanding of the scope of protection, the contested embodiments fail to implement the technical teaching protected by patent claim 1.
38. In the manufacture of the contested embodiments, not just one but two moulds are used.
39. Furthermore, the application of a protective coating to the side panel does not take place in the same mould in which the side panel itself is produced, but in a second mould. This additional step requires hook-shaped spacers, which remain in the final product. The extra step necessitated by the second mould complicates mass production. Furthermore, partly due to the second mould and the hook-shaped spacers, there can be no question of material-saving production. As the hook-shaped spacers do not disappear but remain visible after the second process step (flooding with a two-component polyurethane resin), it is additionally necessary to apply a coat of paint to the exterior in a third process step.
40. Finally, the structural component in question is not partially covered on the outside with a protective layer. Rather, in the areas that form the surface within the vehicle's field of view, the protective layer is completely covered on the outside by a further coat of paint.
41. Furthermore, the plaintiffs have failed to provide sufficient evidence of acts of use that meets the requirements of the EPGÜ or the Rules of Procedure. Pursuant to Rule 13(1)(i) of the Rules of Procedure, the infringement action must contain one or more instances of alleged or threatened acts of infringement, specifying the date and place of the respective act as well as the designation of the alleged patent claims. For the period prior to 1. June 2023, the plaintiffs must therefore set out specific alleged acts of use in Germany, France, Italy and Slovenia and explain to what extent these alleged acts of use infringe individual patent claims of the respective national parts of the contested patent under the applicable national patent law.
42. The present action for infringement does not meet these requirements. It contains no specific allegations regarding alleged acts of use prior to 1 June 2023 in Germany, France, Italy and Slovenia.

43. The test purchase mentioned in the infringement claim is ruled out as an act of use from the outset, as the delivery intended thereby took place with the plaintiffs' consent.
44. The advertising submitted as Annexes K 5 to K 7 and K 18 does not constitute an offer within the meaning of Article 25(a) of the EPGÜ. Furthermore, Annex K 18 was introduced into the proceedings late, which is why this annex cannot be taken into account from the outset. Common to the concept of an offer in all authentic language versions is that the offer must specify the terms of the transfer sufficiently so that it can be accepted by the offeree with a simple 'yes'. An objective observer would only assume the offeror's intention or willingness to transfer the presented item to the offeree, and thus that an offer within the meaning of Article 25(a) of the EPGÜ exists, if the offer were formulated in such concrete terms that it could be readily accepted by the offeree vis-à-vis the offeror.
45. The plaintiffs have contested this argument. In particular, the defendant expressly pointed out during out-of-court settlement discussions that it had sold just under 600 motorhomes of the 'Deseo' model by the end of 2023. With regard to the 'Azur' model, the defendant stated that it had sold just under 70 units by the end of 2023.

C. Counterclaim and third-party counterclaim relating to a licence

46. The defendant claims a right of use based on a licence which, in its view, should be asserted as a counterclaim in relation to a licence under Article 32(1)(a) of the EPGÜ. In the present case, the Unified Patent Court has temporal jurisdiction over such a claim, as the rights of use asserted here, although originating from the period prior to 1 June 2023, continue to this day.
47. The counterclaim is well-founded, as the defendant can rely on contractual rights of use against the claimant. The defendant is therefore acting with the consent of the claimants within the meaning of Article 25 of the EPGÜ, which is why the rights under the patent in dispute are exhausted under Article 29 of the EPGÜ. Consequently, the claimants are not entitled to a right of prohibition under the patent in dispute.
48. A right of use exists vis-à-vis the second plaintiff arising from a termination agreement. The following agreement exists between the second plaintiff and the defendant with regard to the German patent application DE 10 2016 101 274.2 and the subsequent application WO 2017/129589, from which the patent in dispute also originated:

“Should the patent application referred to in the development agreement (DE 10 2016 101 274.2) or a subsequent application arising from this patent application (e.g. WO 2017/129589), HÄRTWICH undertakes not to assert any rights arising from such a patent or utility model against KTG or any company affiliated with KTG.”
49. HÄRTWICH refers, inter alia, to the second claimant, whilst KTG is the defendant. The second claimant had, by means of the clause set out above, indicated that the defendant was permitted to utilise the teaching of the contested patent.
50. Furthermore, the defendant is entitled to a right of use vis-à-vis both plaintiffs under a development agreement concluded between the third-party counter-defendant, the second plaintiff (and their respective companies) and the defendant, the content of which is referred to in Annex 10. This licence agreement grants comprehensive,

non-remunerated and non-terminable rights of use in respect of the subject-matter of the patent in dispute.

51. The notice of termination given by the plaintiffs in their letter of 16 October 2023 (Exhibit rop 12) is invalid. The termination was effected for good cause pursuant to Section 7(2) of the development agreement. Under this provision, a period for remedy must first have been set in advance and must have proved fruitless. This requirement has not been met in the present case. Furthermore, there is no valid cause justifying extraordinary termination. The alleged use of the disputed patent cited by the plaintiffs is permitted to the defendant under the contract and does not constitute a breach of duty. The plaintiffs have not substantiated an alleged failure to continue the development.
52. The contractual right of use applies to both plaintiffs and, in particular, to the first plaintiff. With regard to the German part of the patent in dispute, succession protection applies following its proportional transfer. In this respect, Section 15(3) of the German Patent Act applies, according to which a transfer of rights or the granting of a licence does not affect licences previously granted to third parties.
53. With regard to the French, Italian and Slovenian parts of the contested patent, the Unified Patent Court lacks procedural jurisdiction in relation to the first claimant following the transfer of her respective share. Even with regard to these national parts, the defendant could oppose the infringement action brought by the first claimant by invoking a right of use to which it is entitled under the development agreement, irrespective of whether the applicable law provides for succession protection. The UPC Agreement does not provide for claims within the meaning of Section 194(1) of the German Civil Code (BGB), but exclusively for procedural powers under Article 56 et seq. of the UPC Agreement, on the basis of which the UPC may impose legal consequences at its discretion. In exercising its procedural powers and in exercising due discretion, the EPG must ensure fairness and equity by taking into account the legitimate interests of the parties and by considering that Section 11(5) of the development agreement obliges the parties to impose their obligations arising from the agreement on their legal successors. This obligation also applies to the third-party counter-defendant. In the present proceedings, the defendant cannot be disadvantaged by the fact that the third-party counter-defendant failed to fulfil this obligation in breach of contract. Rather, the court must, in the exercise of its discretion and its procedural powers, treat the defendant as if the third-party counter-defendant had fulfilled its obligation under Section 11(5) of the development agreement.
54. Furthermore, in exercising its discretion, the Unified Patent Court must respect the primary-law principle of the free movement of goods – which must be given priority under Articles 20 and 24(1)(a) of the EPGÜ – and, in particular, the prohibition on quantitative restrictions on imports and on all measures having equivalent effect between EU Member States (Article 34 TFEU). The effect of exhaustion arising from the grant of a right of use under the development agreement in respect of the patent in dispute cannot be set aside simply because the third-party counter-defendant, in breach of his obligation under Section 11(5) of the development agreement, failed, in the context of the transfer of his share in the patent in dispute, to assign to the claimant his position as licensor of the rights of use under the development agreement in respect of the French, Italian and Slovenian parts of the patent in dispute
  - 1). The Unified Patent Court must also, in relation to the first plaintiff, place the defendant in the same position as if the third-party counter-defendant had fulfilled his obligation under Section 11(5) of the development agreement, in accordance with the primary-law principle of the free movement of goods.

55. The third-party counterclaim is also well founded, as the third-party counter-defendant is obliged, under the development agreement, to transfer his legal status as the current licensor of the rights of use in favour of the defendant under the development agreement in respect of the French, Italian and Slovenian parts of the contested patent to the first defendant. In the alternative, it should be ordered, as a first step, that the third-party counter-defendant transfer his legal status as the current licensor of the rights of use in favour of the defendant under the development agreement in respect of the French, Italian and Slovenian parts of the patent in dispute to the first plaintiff. As a second step, the infringement claim should be dismissed.
56. In the Plaintiff's view, no right of use arises from the settlement agreement referred to by the Defendant (Exhibit K 20). The agreement relates exclusively to the 'Travelino' model. The provision referred to by the Defendant is not to be found in the settlement agreement.
57. Nor can the defendant derive a right of use from the development agreement (Annex rop 10). That agreement merely provides that the defendant may use the model "Travelino". It had been made clear that any other developments would require a separate agreement to grant the right of use. According to the contract, the parties had assumed – and had also expressly stipulated – that the right of use could arise from the licence agreement and would remain in force for the duration of that agreement. The defendant had never approached the plaintiffs with a request to conclude a licence agreement. When the plaintiffs enquired about a licence agreement, the defendant had indicated in discussions that it did not wish to conclude such a licence agreement. It assumed that the patent in dispute would not be granted. Following the development of the 'Travelino' model, there were commissions to develop framework concepts for the 'Deseo' and the 'Azur'. The plaintiffs had also developed the frame construction for these models and presented this development to the defendant. To this end, the plaintiffs had built prototype caravans and presented them to the defendant. The plaintiffs had also presented drawings of all frame components which they had developed for these models. The frame construction for both the 'Deseo' and the 'Azur' was developed independently. It is based neither on the 'Travelino' nor does it correspond to it. Nor was it a joint development.
58. Furthermore, the development contract was also validly terminated. Although the plaintiffs had submitted the framework concepts commissioned by the defendant, including the drawings, they received no response as to whether the defendant intended to implement them, even after repeated enquiries. Nor had the defendant complied with the request to conclude a licence agreement, nor had the defendant informed the plaintiffs that it had in fact commenced production of the 'Azur' and 'Deseo' models. The defendant had not submitted any order enquiries in the six-month period prior to the termination. The termination was therefore justified. Under the terms of the contract, no notice period was required in the event of a six-month absence of adequate order enquiries. Furthermore, the termination was also justified because the defendant had called into question the patentability of the patent in dispute.
59. The third-party counterclaim is subject to a condition and is therefore inadmissible. Nor can the defendant successfully rely on Article 32(1)(a) of the EPGÜ in this regard. That provision concerns a right to use the patent in dispute. The third-party counterclaim, however, is based on the premise that no such right of use exists. This is a standard contractual dispute which must be resolved before the national courts. The Unified Patent Court lacks jurisdiction over disputes concerning licence agreements.

60. Apart from that, the third-party counterclaim is directed at a nullum. The third-party counterclaimant is neither the proprietor of the patent in dispute nor the authorised user. Irrespective of this, the third-party counter-defendant is also under no obligation to grant any rights. The Unified Patent Court already lacks jurisdiction over the defendant's plea of breach of contract.
61. The defendant contested this. In particular, the "settlement agreement" submitted as Annex K 20 is not the termination agreement referred to in the statement of claim. The settlement agreement dates from 2020, whereas the termination agreement was concluded in 2018, as evidenced by the plaintiffs' notices of termination. Whilst the termination agreement was, according to the statement of claim, concluded with the second plaintiff, the settlement agreement submitted as Annex K 20 was concluded only with Freitec Kunststoffe GmbH. Finally, the termination agreement mentioned in the statement of claim relates to the development contract. This is not provided for in the settlement agreement set out in Annex K 20. Instead, Freitec Kunststoffe GmbH merely waives alleged claims against the defendant amounting to EUR 181,392.70 and agrees with the defendant on a settlement amount of EUR 50,000 (Annex K 20, Recital 3).

D. Right of prior use

62. Insofar as the defendant continues to rely on a right of prior use, it takes the view that such a right must be asserted against the infringement claim as an action relating to a right of prior use pursuant to Article 34(1)(g) of the EPGÜ. The Unified Patent Court also has jurisdiction over such an action in terms of time under Article 32(1)(g) of the EPGÜ, since although the prior use right asserted here dates from before 1 June 2023, it continues to this day.
63. On the merits, the defendant is entitled to a right of prior use.
64. The defendant first presented its Eurostar caravan to the public at the Caravan Motor Touristik (CMT) trade fair in January 2013, for which it won the 'Red Dot Award'. During the trade fair in Stuttgart, the defendant's 'Caravans' catalogue was distributed; reference is made to Annex rop 14 regarding its contents. From the same date, the defendant began marketing the 'Grande Puccini' caravan. In this regard, reference is made to the catalogue submitted as Annex rop 15. A technical drawing created on 1 February 2012 by an employee of the defendant and amended on 1 March 2012 depicts a long-fibre injection moulded front section with a window (Exhibit rop 16). The nose section depicted, to which reference is made in Exhibits rop 14 and rop 15, was used from the 2013 model year onwards. With regard to the characteristics of the nose section depicted, the following is stated in Exhibit rop 16:

"LFI moulded part

Outer skin: deep-drawn part made of ABS-PMMA

RAL9023, 3 mm thick, with PE protective film

Back-foamed with a glass fibre-polyurethane mixture,

density 0.5 kg/dm<sup>3</sup>

Surface area of outer skin including window area: 445 dm<sup>2</sup> Total

volume including window area: 88 dm<sup>3</sup>

Deep-drawing, foaming tool and trim based on 3D data”

65. In addition, the defendant refers to German patent application DE 10 2013 008 364 A1 with regard to the characteristics of the bow section.
66. A bar chart submitted as Annex 17 shows the quantities of LFI bow and stern sections, with and without [REDACTED] [REDACTED] [REDACTED] (hereinafter: ‘[REDACTED]’ has supplied to the defendant since 2012: LFI front and rear sections, with and without windows, for the Grande Puccini (W23) caravan, the Eurostar (W03) caravan and the Tabbert Supreme (W29) caravan. The LFI front and rear parts supplied by [REDACTED] to the defendant also included the front part for the Grande Puccini caravan shown in Annex 16 (‘Front panel with window W23-13, item no. R 10132223’). The LFI front sections for the Eurostar caravan (‘Front panel with window “W03-13”, item no. R 10132417) are identical in their characteristics to the LFI front section for the Grande Puccini caravan (item no. 10132223) except for the exterior colour. The same applies to the LFI front sections for the Tabbert Supreme caravan (front panel with window W29-13, item no. 10132293) supplied by [REDACTED] to the defendant.
67. A glass-fibre-reinforced polyurethane foam (LFI) is also used in the contested embodiments. The Eurostar, Tabbert Supreme and Grande Puccini caravans, including LFI front sections as shown in Annex rop 16, had already been sold by the defendant prior to the priority date of the contested patent in, inter alia, Germany and France (see Annexes rop 19-1, rop 19-2 and rop ZA2). The front section shown in Annex rop 16 embodies all the features of patent claims 1, 3, 4, 7 and 9 of the contested patent. The defendant was therefore in possession of the invention on the priority date of the contested patent.
68. The German right of prior use also extends to the other countries at issue here on the basis of the free movement of goods pursuant to Article 28 et seq. TFEU.
69. The claimant disputes the defendant’s arguments regarding prior use on the grounds of lack of knowledge. This applies in particular given that the components shown in Annex 16 embody the features of the contested patent, were used in the caravans listed, and were in fact installed in caravans at the priority date of the contested patent.
70. The component shown in the aforementioned annex appears to be a front or rear section and relates to the outer wall of the caravan. It is not a frame component of the caravan and, in particular, not a structural part of the frame, but rather a filler element, as further described in the specification of the contested patent, and thus a component of the outer skin which has nothing to do with the frame. Nor does it follow from the defendant’s submissions that the component is manufactured in a mould. It can be seen from Annex WK 15 that it is a deep-drawn part. This is produced by deep-drawing the outer contour. In a further step, the interior of the deep-drawn part is filled with a glass fibre-polyurethane mixture. It is therefore not manufactured in a mould. DE '364 cannot be used to establish a right of prior use, as it does not reflect the actual nature of the component. In the

Furthermore, it is clear from the patent specification that this is a component of the outer shell. Moreover, a right of prior use would also be geographically limited.

#### E. Counterclaim for nullity

71. In the defendant's view (the claimant in the counterclaim for revocation), the contested patent should be declared invalid in its entirety, as the ground for invalidity of lack of industrial applicability within the meaning of Article 138(1)(b) of the European Patent Convention (EPC) is present. According to claim 1 of the contested patent, protection is sought for a vehicle frame comprising at least one structural part, whereby the structural parts referred to in the characterising part of this claim are defined as forming a load-bearing part of the frame. In order to determine the scope of protection of the patent claim, it is first essential to define the term 'vehicle frame'. According to Wikipedia, the frame or chassis of a vehicle refers to the load-bearing parts of a vehicle which serve to support the drive, the bodywork or the payload. Accordingly, the frame consists of the load-bearing parts. According to the claim, the existing structural parts are intended to form a 'load-bearing part' of the frame. Consequently, non-load-bearing parts of the frame must also exist. However, it remains entirely unclear what the load-bearing and non-load-bearing parts of the frame are supposed to be.
72. Furthermore, the subject-matter of the contested patent protected by claim 1 is, in each case, based on DE 198 98 026 A1 (Annex WK3), DE 10 2015 111 421 A1 (Annex WK 4), DE 10 2013 006 300 A1 (Annex WK 5), DE 10 2014 204 369 A1 (Annex WK 7), EP 0 670 357 A1 (Annex WK 26), DE 10 2013 008 364 A1 (WK 31), a technical drawing submitted by the plaintiffs on 1 February 2012 (Exhibit WK 15) and a product catalogue from Fendt-Caravan dated August 2014 (Exhibit WK 19) (Article 24(1)(c) of the European Patent Convention in conjunction with Article 138(1)(a), Article 54 EPC).
73. Finally, the defendant alleges a lack of inventive step (Article 24(1)(c) of the German Patent Act (EPGÜ) in conjunction with Article 138(1)(a) and Article 56 of the European Patent Convention (EPÜ)). In this context, the defendant relies on a combination of DE 10 2013 215 933 A1 (Annex WK 6) with common technical knowledge or Annexes WK 3, WK 4 and WK 5, as well as EP 1 484 150 A2 (Annex WK 11), EP 1 212 189 (Annex WK 25) in conjunction with common technical knowledge or Annexes WK 3, WK 4, WK 5, WK 11, and Annex WK 31 in conjunction with Annexes WK 3 to WK 7, WK 15 and WK 26.
74. With regard to the defendant's contention that the sub-claims lack legal validity, reference is made to the arguments put forward in the counterclaim for revocation.
75. The plaintiffs and the third-party counter-defendant defend the contested patent in the form in which it was granted. In the alternative, they assert a total of 17 alternative claims, the wording of which is set out in the bundle of annexes K 22.

#### F. Legal consequences

76. In the defendant's view, the Unified Patent Court has no jurisdiction with regard to acts of use prior to 1 June 2023. Pursuant to Article 56(1) of the UPC Agreement, the powers of the Unified Patent Court are limited to those expressly set out in the UPC Agreement. When exercising the procedural powers under Articles 56 et seq. of the UPC Agreement as *lex fori*, other provisions of the UPC Agreement that are also to be classified as *lex fori*, e.g. Articles 25 et seq. of the UPC, which are also to be classified as *lex fori*, are decisive for the determination of a patent infringement. National

The law should, at most, be applied, for example, in the context of a preliminary question under contract law. Consequently, the Unified Patent Court lacks the procedural powers that would enable it to order legal consequences resulting from a patent infringement under national law. Therefore, with regard to Germany, France, Italy and Slovenia, the Unified Patent Court cannot issue any orders concerning acts of use from the period prior to the entry into force of the UPC Agreement. The lack of procedural powers with regard to patent infringements under national law would, in the present case, additionally mean that the Unified Patent Court already lacks jurisdiction under Article 32(1)(a) of the UPC Agreement. Rather, the national courts would have jurisdiction in this regard.

77. Furthermore, the Unified Patent Court is not competent under Article 32(1)(a) of the UPC to rule on the infringement action in so far as it relates to the period during the opt-out of the contested patent from 15 May 2023 to 2 February 2024.
78. Insofar as the claimant seeks a final injunction under Section 63(1), first sentence, of the German Patent Act (EPGÜ), this would require a finding of patent infringement after 1 June 2023, which is lacking in this case. The claimants have so far failed to set out any specific acts of infringement, either for the period after 1 June 2023 or for the period prior to that date. Acts of use from the period prior to 1 June 2023 could not, moreover, justify a permanent injunction on the grounds of an imminent patent infringement. Apart from that, an injunction could only be sought in respect of those alternative courses of action for which a patent infringement had actually been established.
79. Furthermore, the Unified Patent Court lacks jurisdiction insofar as compensation is sought for acts of use prior to 1 June 2023. Since Article 67 EPC only partially harmonises the right to compensation, the relevant national requirements and legal consequences under national law must in any event also be taken into account. The Unified Patent Court could only award compensation under the relevant national law if the plaintiffs proved that the requirements laid down in the individual EPC contracting states were met. There was a lack of such a submission by the plaintiffs.
80. Furthermore, the defendant raises the defence of limitation. The development agreement between the parties has been in place since 2016. Consequently, the plaintiffs or their legal predecessors have been aware of all the defendant's actions since 8 September 2018, or should reasonably have become aware of them by that date. Consequently, the claims in the infringement action filed on 24 February 2024 in relation to all forms of financial compensation are in any event barred for the period prior to 24 February 2019 pursuant to Article 72 of the EPGÜ. With regard to Germany, pursuant to Article 72 and Article 24(2) and (3) of the EPGÜ, the shorter limitation period of three years applies (Sections 195 and 199 of the BGB).
81. With regard to the sought-after order for the recall, removal from distribution channels and destruction, it should be noted in the present case, in particular, that the defendant and the plaintiffs or their legal predecessors were engaged in a development cooperation and that the present legal dispute ultimately arises from the fact that the plaintiffs rejected an out-of-court settlement offer for an exclusive licence for reasons that are objectively incomprehensible. The present action for infringement constitutes a gross breach of the duties of loyalty arising from the development cooperation

. Furthermore, it should be borne in mind that, had the plaintiffs developed a viable product (which they did not), they intended to supply it to the defendant at an average selling price of EUR 650, whereas the list price of the caravans at issue here is EUR 28,100 or EUR 41,400, and thus many times that amount. The plaintiffs' asking prices for their own product would therefore demonstrate that the subject-matter of the contested patent constitutes only a very minor aspect of a caravan. Consequently, the recall, removal from the distribution channels and destruction of the defendant's caravans would be entirely disproportionate to the infringement alleged by the plaintiffs.

82. With regard to the interim damages also claimed by the plaintiffs, the defendant argues that the out-of-court settlement offer made by the defendant—without any admission of liability—in the form of a one-off payment of EUR 100,000 for an exclusive licence does not constitute a suitable basis for the award of interim damages. Furthermore, the introduction of the settlement offer made by the defendant prior to the proceedings into the court proceedings constitutes a breach of Rule 11(3) of the Rules of Procedure and leads to a prohibition on its use.
83. The plaintiffs have contested this.
84. With regard to the sought injunction, it must be taken into account that the claimant had also presented instances of use after 1 June 2023, which remained undisputed.
85. Insofar as the defendant invokes the limitation period, there is no submission regarding its prerequisites. In the present case, the plaintiffs became aware of the infringing acts when they had a component supplied by the defendant inspected. The reports dating from August 2023 were commissioned in July 2023. The defendant's plea of limitation is therefore incomprehensible. No knowledge of the patent infringement arose from the development cooperation.
86. The plaintiffs dispute the defendant's claimed 'average selling price' of EUR 650, cited by the defendant in connection with the alleged disproportionate nature of the recall, the removal from distribution channels and the destruction, on the grounds of lack of knowledge. In this context, the defendant fails to take into account that the selling price for a single component (right A-pillar) of the frame is EUR 1,187.63. A caravan contains approximately 20 such frame components. It should also be taken into account that the present invention constitutes a fundamental further development, resulting in a caravan having an independent load-bearing structure. In the prior art, by contrast, the strength and structure of the caravan were achieved by the internal fittings.
87. The award of provisional damages in the amount of EUR 100,000 is appropriate, taking into account the acts of infringement already admitted. Insofar as the defendant invokes confidentiality in relation to the out-of-court settlement discussions and a resulting breach of Rule 11.3 of the Rules of Procedure, it did not at any time indicate that the data and information were not to be disclosed to third parties. Above all, the defendant has not disputed that it sold a total of 600 'Deseo' model caravans and 70 'Azur' model caravans (by the end of 2023). That alone justifies the amount of damages claimed.

LEGAL ASSESSMENT:

88. In so far as the action initially also covered the territory of the Republic of Ireland, the partial withdrawal of the claim declared in each instance was to be permitted in accordance with Rule 265(1), second sentence, of the Rules of Procedure, following consultation with the other party in each case. The defendant's submissions in the counterclaim for annulment can be understood to mean that the Republic of Ireland is to be covered by the counterclaim for annulment only if it has become a Contracting Member State at the time of the decision on the counterclaim for annulment. Since this is not the case, the defendant (plaintiff in the counterclaim) does not seek a decision with regard to the Republic of Ireland. It was therefore unnecessary to admit the partial withdrawal of the counterclaim for annulment, which was merely declared by the defendant (plaintiff in the counterclaim) in the alternative.

A. Decision on the objection:

89. The opposition is admissible. In particular, it was filed within one month of service of the statement of claim (Rule 19(1) of the Rules of Procedure).

90. Since the claimants no longer seek a decision in respect of the Republic of Ireland, the question of the international jurisdiction of the Unified Patent Court in respect of the infringement action concerning the Republic of Ireland no longer requires a decision.

91. In all other respects, the opposition is unfounded. The Unified Patent Court has jurisdiction over the action without any time limit pursuant to Article 32(1)(a), Article 2(g) and Article 3(c) of the UPC Agreement.

92. Under Article 32(1)(a) of the EPGÜ, the Unified Patent Court has, inter alia, exclusive jurisdiction over actions relating to actual or threatened infringement of patents; under Article 2(g) of the EPGÜ, this subject-matter jurisdiction also extends to infringement proceedings concerning a European patent which, in accordance with Article 3(c) of the UPC had not yet expired at the time of the UPC's entry into force. The jurisdiction of the Unified Patent Court in substantive matters is therefore, in principle, established in the present case. The plaintiffs are asserting claims based on the (alleged) use of a European patent which had not yet expired on 1 June 2023. The plaintiffs had withdrawn the opt-out they had initially declared in relation to the patent in dispute before the date of filing the action with the Unified Patent Court, which is decisive for the delimitation of jurisdiction between the national courts and the Unified Patent Court; consequently, the present proceedings fall within the jurisdiction of the Unified Patent Court (see: UPC\_CoA\_30/2024, APL\_4000/2024, Order of 16 January 2025, para. 82 – Fives ECL v REEL; UPC\_CFI\_342/2024 (Munich Circuit, Panel 2), Order of 10 February 2025, paras. 32–36 – Phoenix Contact v. Industria Lombarda Materiale Electrico; UPC\_CFI\_15/2023 (Munich Regional Court, Panel 1), decision of 15 November 2024, p. 23 – Edwards Lifesciences v. Meril; UPC\_CFI\_358/2023 (Paris Regional Court), decision of 13 November 2024, para. 210).

93. The jurisdiction of the Unified Patent Court covers the entire period claimed in the action. The dispute is also referred to the Unified Patent Court for a decision in so far as the action asserts claims relating to (alleged) acts of use prior to 1 June 2023 (entry into force of the UPC Agreement) and prior to 2 February 2024 (withdrawal from the opt-out). This does not constitute a breach of Article 28 of the UPC Rules of Procedure. With regard to jurisdiction, there is already no retroactive effect. To avoid repetition, reference is made in this respect to the comments of the Munich Local Chamber in the order of 10 February 2025 (UPC\_CFI\_342/2024, Panel

2, paras. 38–46 – Phoenix Contact v. Industria Lombarda Materiale Elettrico), with which the Chamber concurs.

B. Admissibility of the counterclaim for nullity

94. There are no concerns regarding the admissibility of the counterclaim for nullity.
95. Since the defendant is no longer challenging the Irish part of the patent in dispute in its counterclaim for revocation, the Unified Patent Court has international jurisdiction over the counterclaim for revocation. Pursuant to Article 32(1)(e) of the UPC Agreement, the Unified Patent Court has exclusive jurisdiction over counterclaims for the revocation of (European) patents. As no opt-out (Article 83(3) of the UPC Agreement) from the Court’s exclusive jurisdiction in respect of the patent in dispute is currently in force, the Unified Patent Court – as the common court of the Member States of the UPC Agreement – has international jurisdiction over the present counterclaim pursuant to Article 24(4), 71a(2)(a) 71b(1) of Regulation (EU) No 1215/2012.

C. Standing to sue

96. As proprietors of the patent in dispute, the plaintiffs are entitled to bring proceedings before the Court, Article 47(1) of the EPC.
97. The defendant has rightly not disputed that the patent in dispute was validly assigned by the third-party counter-defendant to the first claimant in respect of the countries of Germany, France, Italy and Slovenia, which are still the subject of the infringement proceedings. Apart from that, the plaintiffs are entered in the register as proprietors of the patent in dispute (see Annex K 3), so that there is a rebuttable presumption in their favour that they are entitled to be entered as proprietors of the patent in dispute (Rule 8.5(a) and (c) of the Rules of Procedure).
98. The defendant’s argument that Rule 312 of the Rules of Procedure should be applied analogously to assignments made prior to the commencement of proceedings lacks both a common interest and an unintended gap in the legislation. If a patent or a patent application is transferred to another party after proceedings have commenced, the question arises as to whether, and if so how, the new proprietor can be involved in the proceedings. On this basis, Rule 312(1) of the Rules of Procedure grants the court the option of authorising the new proprietor to join the proceedings as a party pursuant to Rule 305 of the Rules of Procedure or to take the place of a party, provided that the patent and the claims asserted in the proceedings have been assigned. If, by contrast, the patent or the patent application was already assigned prior to the proceedings, no such authorisation to join is required. In this case, the new proprietor is entitled from the outset to initiate proceedings pursuant to Article 47(1) EPC in conjunction with Rule 8(5)(a) and (c) of the Rules of Procedure.
99. Contrary to the defendant’s view, the declaration of sale and transfer submitted as Annex K 1 also transferred claims for information, damages and compensation arising from the period prior to 30 December 2022 to the first claimant. It states, inter alia:

“This agreement transfers exclusively the share held by Mr Alexander Christ of 50679 Cologne (DE) in the intellectual property portfolio, **together with all rights, obligations and claims, including those arising from past transactions**, to the purchaser, the

company  
Yellow Sphere Innovations GmbH, represented  
by the managing director Mr Guido Endert  
[...]

(Emphasis added)

100. Since all (and thus every) right, obligation and claim is to be expressly assigned, including those arising from past events, there are no concerns regarding the agreement from the perspective of specificity, at least under applicable German law (Section 398 of the German Civil Code (BGB)) (see: Palandt/Grüneberg, 80th ed., Section 398, para. 14 et seq.). Nor, contrary to the defendant's view, is there any reason to assume that the provision in question should be interpreted as covering only claims within the internal relationship between the contracting parties and not against third parties. Based on the wording of the agreement, it is clear that the first claimant is to take the place of the third-party counter-defendant in full with regard to the patent in dispute and the rights and obligations arising therefrom.
101. The declaration of sale and assignment also relates to the set of intellectual property rights defined in the preamble. It therefore also covers the French, Italian and Slovenian parts of the contested patent. There is thus no reason to doubt the standing of the first claimant to bring proceedings in respect of these countries. The defendant has not substantially contested the validity of the assignment under French, Italian and Slovenian law, but has referred solely to the alleged, but in fact non-existent, invalidity of the assignment in Germany.
102. Since the plaintiffs have already sufficiently demonstrated the standing of Plaintiff 1) by reference to the agreement submitted as Annex K 1 to the file, the question raised by the defendant regarding the admissibility of subsequent submissions does not require further discussion at this point.

D. Relevant person skilled in the art

103. In the Chamber's view, the relevant person skilled in the art is a graduate in mechanical engineering (FH) with knowledge in the field of vehicle construction, in particular in the manufacture of vehicle structural components from plastic, specifically from foamed polyurethane.

E. Scope of protection of the contested patent

104. The contested patent relates to a frame for a vehicle comprising at least one structural component made of foamed resin, as well as a method of manufacturing the same.
105. As the person skilled in the art will gather from the introductory remarks in the specification of the contested patent, various structural components, in particular for vehicle construction, are known from the prior art. In the motorhome sector in particular, infill elements of a frame structure are used as wall elements. These infill elements are generally of a plate-like construction, meaning that they have more or less two parallel outer surfaces, between which an intermediate layer is arranged (para. [0002]).

106. Such filler elements can be used in conjunction with reinforced sandwich components. For example, the publication DE 10 2013 114 770 A1, which is cited as prior art in the specification of the contested patent, discloses a manufacturing method and a comparable filler element. Such filler elements are compressed within the mould to form a joint. Furthermore, it is known in the automotive sector to manufacture frame parts from metallic extruded profiles and/or extruded profiles made of plastic, thereby forming the load-bearing part of the vehicle. Such extruded profiles are usually produced by extrusion, so that the resulting parts have a more or less linear extension. Moreover, the linear extension of the frame parts also more or less dictates a square basic shape for the vehicle (para. [0003]).
107. Furthermore, DE 10 2013 215 933 A1 discloses a structural component for a vehicle with mechanical reinforcement. These structural components do not have any specific surfaces and are unsuitable for use in visible areas. Furthermore, EP 0 670 257 A1, cited as prior art in the patent specification, discloses a vehicle with prefabricated, inherently rigid body elements, including a foam core. However, these body elements do not form a frame for the vehicle (para. [0004]).
108. On this basis, according to the description of the contested patent, the objective (the technical problem) of the contested patent is to provide a vehicle frame comprising a structural component and a method for manufacturing the structural component, thereby at least partially overcoming the disadvantages of the prior art. In particular, it is an objective of the present invention to obtain a mechanically strong structural component for the frame of a vehicle, as well as the frame itself, which does not require additional thermal insulation. Furthermore, it is desirable that mass production of the structural component as well as of the frame for a vehicle incorporating the structural component be achievable. In doing so, the aim is to achieve material-efficient use, so that little surplus material is wasted during manufacture (para. [0005]).
109. To solve this problem, claim 1 of the contested patent protects a vehicle frame characterised by a combination of the following features:
1. Frame (11) for a vehicle (10) comprising at least one structural component.
  2. The structural component (15) is produced as a cast part (52) in a mould (50).
    - 2.1. The mould (50) reproduces the three-dimensional external shape of the structural component.
  3. The structural component (15) is formed by a self-expanding foam resin (20).
  4. The structural component (15) is at least partially coated on the outside with a protective layer (19).
  5. The structural components (15) form a load-bearing part of the frame (11).
110. Pursuant to Article 69 EPC, read in conjunction with the Protocol on its interpretation, the patent claim is not merely the starting point but the decisive basis for determining the scope of protection of a European patent. The interpretation of a patent claim does not depend solely on its exact wording in the linguistic sense. Rather, the

description and the drawings must always be taken into account as aids to the interpretation of the patent claim, and not merely used 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, following an examination of the description and the drawings, appears to be the patent proprietor's claim for protection (UPC\_CoA\_335/2023, Order of 26 February 2023 in conjunction with Order of 11 March 2024, GRUR-RS 2024, 2829, Headnote 2 and paras. 73–77 – 10x Genomics v. NanoString; UPC\_CFI\_452/2023 (LK Düsseldorf), Order of 9 April 2024, p. 13, GRUR-RS 2024, 7207, para. 49 – Ortovox v. Mammut; see also UPC\_CFI\_7/2024 (Düsseldorf Division), judgment of 3 July 2024 – Franz Kaldewei v. Bette; UPC\_CFI\_239/2024 (The Hague Regional Court), judgment of 22 November 2024 – Plant-e v. Arkyne (Bio)).

111. That being said, certain features require explanation:
112. Patent claim 1 protects a frame for a vehicle and thus a product. The frame is characterised, first of all, by having at least one structural part (feature 1), whereby the structural parts form a load-bearing part of the frame (feature 5).
113. The structural component is characterised in that it is formed from a self-expanding foam resin (feature 3) and is at least partially coated on the outside with a protective layer (feature 4). In addition, the structural component is to be produced as a cast part in a mould (feature 2), wherein the mould reproduces the three-dimensional external shape of the structural component.
114. Insofar as the structural component is to be coated on the outside with a protective layer in accordance with the invention, this is not to be understood, contrary to the defendant's view, as meaning that the protective layer must necessarily be the outermost layer. Nor must the protective layer necessarily be visible from the outside. Rather, the patent specification in question expressly clarifies in paragraph [0014] that the protective layer may be designed to be reworked and, in particular, to be painted. In contrast, the patent in question only refers to external visibility in the context of the discussion of the embodiment shown in Figure 2 (see paragraph [0020]). However, examples of implementation do not generally permit – as is the case here – a restrictive interpretation of the patent claim characterising the invention in general.
115. On this basis, patent claim 1 thus defines the product claimed (a frame comprising a structural component) at least in part by the manufacturing process (manufacturing the structural component as a casting in a mould that reproduces the three-dimensional external shape of the structural component). It is therefore a product-by-process claim. Such claims are characterised by the fact that the technical content of the invention does not generally lie in the process as such, but in the technical features conferred on the product by the process (see also EPO, Examination Guidelines, Part F, Chapter IV, 4. Clarity and Interpretation, point 4.12.; see also UPC\_CoA\_382/2024 (Court of Appeal), Order of 14 February 2025, APL\_39664/2024 – Abbott v. Sibio). The process serves, in principle, solely to define the product. It is not itself the subject of protection and does not limit such protection. The process feature typically serves to further specify the subject matter, which is not yet sufficiently distinctive when described by the other spatial and physical features, in that the process feature included in the claim leads to a specific additional configuration of the subject matter, which distinguishes the subject matter from the prior art and

distinguishes. The decisive factor is therefore how the person skilled in the art understands the information regarding the manufacturing process and what conclusions they draw from this regarding the characteristics of the product as claimed. However, if the manufacturing process results in properties in the product that can only be achieved in this way and whose presence in the finished product can be ascertained, the patent is ultimately limited to products that can be manufactured in this way.

116. In so far as the claimant initially took the view that the structural part need only be designed in such a way that it is suitable for manufacture in a mould which reproduces the three-dimensional external shape of the structural part (see statement of claim, p. 16, c), this does not do justice to the nature of a product-by-process claim as described in detail above. The decisive factor is which specific features of the product are ‘encoded’ by the process steps included in the patent claim. In the present case, it is therefore decisive which physical properties of the structural part the person skilled in the art derives from the description of the contested patent, taking into account that the structural part is to be produced as a casting in a mould which reproduces the three-dimensional external shape of the structural part.
117. Even though claim 1 was amended during the grant proceedings to the effect that the structural component is no longer to be ‘manufacturable as a casting in a mould’, but is now to be ‘manufactured as a casting in a mould’, it cannot be inferred from this alone that protection is limited to a specific manufacturing process, irrespective of the question—which has not yet been conclusively clarified by the Court of Appeal—as to whether and to what extent such developments in the grant proceedings may be taken into account in the context of patent interpretation. What is decisive, rather, is whether the patent specification provides any indications justifying the conclusion that the use of the process described in feature group 2 is, for technical reasons, indispensable in order to achieve certain features of the product. However, as will be set out in detail below, this is not the case.
118. In so far as the defendant has argued that specifying the particular manufacturing method (as a cast part in a mould) defines characteristics of the structural component that can only be produced by that method, namely *to produce* a frame with a stable structural component made of foam resin *with a particularly high-quality surface* (emphasis added), there is no evidence of the latter in the specification of the contested patent. It is true that the contested patent mentions in paragraph [0014] a sophisticated and attractive surface which can also be used directly as a visible surface in the vehicle area. However, these considerations relate to the incorporation of the protective layer of the structural component into the mould. Unlike method claim 10 (step a) therein), patent claim 1 does not address the question of applying the protective layer. As explained, it is rather a product-by-process claim which protects a frame comprising at least one structural part and thus a product. According to the invention, this must be coated with a protective layer – however it is applied (feature 4). This is all the more true given that, according to sub-claim 2, the protective layer is also to be cast with the foam resin.
119. Nothing else follows from the method of manufacturing the structural component described in feature group 2, which involves using a mould that reproduces the three-dimensional external shape of the structural component. Firstly, the mould can still reproduce the *external shape* of the structural component even if a protective layer is only applied after the casting process. What is required is the reproduction of the three-dimensional external shape of the structural part, but not

that the internal dimensions of the mould correspond to the external dimensions of the structural component. Apart from that, a structural component may also be produced in a mould if the protective layer is applied in a further process step. Patent claim 1 does not address the manner in which the protective layer is applied. In particular, unlike method claim 10, it does not require that the mould be at least partially lined with a protective layer before the pourable foam resin is poured into the mould. The manner in which the protective layer is applied is therefore at the discretion of the person skilled in the art, provided that it is present on the final product, the structural part. The protective layer may therefore be applied either during the pouring of the foam resin or in a further mould in a subsequent process step. Similarly, any other method of applying the protective layer is covered by the scope of patent claim 1.

120. The fact that paragraph [0005] of the description of the contested patent mentions the conservation of materials as one of the objectives of the invention does not imply anything to the contrary. The relevant reference relates to the avoidance of waste of superfluous material (see paragraph [0005]), but not to a possible saving of material through the use of as few production resources as possible, and thus in particular moulds. Insofar as paragraph [0012], by contrast, emphasises the reuse of the mould, this must be read in conjunction with the method described in paragraph [0009]. According to this, the contact surfaces between the mould and the foam resin are at least partially lined with a protective layer, with which the structural part is subsequently lined. This (prior) application of the protective layer ensures that the mould can be reused without any problems (paragraph [0012]). Unlike in Patent Claim 10, however, such lining with a protective layer is not mentioned in Patent Claim 1.
121. The fact that the contested patent is (also) intended to enable the mass production of the structural component (para. [0005]) does not necessitate a different assessment. As the skilled person will gather from paragraph [0012], the mould is intended to be reusable by inserting the protective layer, which is why structurally identical structural parts can be manufactured in small and medium-sized series in a simple manner. The above comments on material savings therefore apply here accordingly, to which reference is made to avoid repetition. Apart from that, it has neither been argued nor is it apparent that such series production can be achieved solely by using a (single) mould.
122. There is no indication in the specification of the contested patent that, as argued by the defendant, the contested patent aims to achieve a uniform thickness of the protective layer which can only be realised by the method described in claim 1. The patent in dispute concerns the provision of a mechanically strong structural component for a vehicle frame which does not require additional thermal insulation (see paragraphs [0005] and [0011]). Since the manufacturing process already incorporates a protective layer of the structural component into the mould, the structural components acquire a high-quality and attractive surface that can also be used directly on the vehicle's exterior (para. [0014]). It is not apparent that this requires an exactly uniform thickness of the protective layer.
123. Nor does the skilled person find any indication in the specification of the contested patent that the protective layer should be as thin as possible. It is true that the aim is to provide a vehicle that is very stable overall, yet lightweight (see col. 4, line 58 – col. 5, line 2). However, it cannot be inferred from the specification of the contested patent that this advantage is to be achieved by a particularly thin design of the protective layer. The thickness of the protective layer is not discussed in the contested patent. Rather, the decisive factor is the formation of the load-bearing part of the frame for a

vehicle by structural components formed from a self-expanding foam resin.

124. Insofar as the defendant further argued at the hearing that, when using the method described in claim 1, no spacers are required which would damage the outer protective layer, the person skilled in the art must take into account that, according to the invention, the structural component is to be coated 'at least partially' with a protective layer on the outside (feature 4). An uninterrupted protective layer completely covering the structural part is therefore not a prerequisite for realising the technical teaching claimed.
125. It cannot be inferred from the contested patent specification that the provision of a mechanically strong and at the same time thermally insulated component, as sought by the invention, requires a particularly close bond between the self-expanding foam resin of the core and the protective layer, which can be achieved exclusively by the method described in claim 1.
126. The creation of surfaces requiring no further finishing, which the defendant continues to raise, is addressed by the contested patent solely in connection with the design of the mould incorporating a protective layer and the subsequent bonding of the swelling foam resin to the protective layer (para. [0009]) or with the incorporation of a protective layer of the structural part into the mould (cf. para. [0014]). However, the design of the mould is not mentioned in Patent Claim 1, unlike in Method Claim 10 (step a) therein). As already explained, Patent Claim 1 does not deal with the application of the protective layer. Rather, it is sufficient, but also necessary, that the structural part is at least partially coated with a protective layer – however it is applied.
127. When the skilled person considers the question of which characteristics are associated with the method described in feature group 2 according to the invention, they will instead take into account the prior art described in paragraphs [0002]–[0004]. Accordingly, on the one hand, plate-like infill elements of a frame structure were known which have, to a greater or lesser extent, two parallel outer planes between which an intermediate layer is arranged. Furthermore, it was previously known to manufacture frame parts in the form of extruded profiles which form a load-bearing frame. These extruded profiles, made of metal or plastic and produced by extrusion, have a more or less linear extension, which is why the frame parts formed from them define a more or less square basic shape for a vehicle.
128. The components known in the prior art are therefore characterised by the fact that they are either not structurally rigid (filler elements) and (therefore) do not form a load-bearing part of the vehicle's frame. Or, whilst they do possess the strength required for load-bearing parts of the frame, the use of components manufactured by extrusion limits the design options to a very limited extent (square basic shape of a vehicle).
129. As the skilled person further gathers from paragraph [0005] of the description of the contested patent, the invention is intended to overcome the disadvantages present in the prior art and to provide a mechanically strong and load-bearing structural component for the frame of a vehicle, namely the frame itself.

130. Feature group 2 addresses the limitations of the design language associated with the extrusion process: If the structural component formed from foam resin is to be produced as a cast part in a mould that reproduces the three-dimensional external shape of the structural component (feature group 2), a more flexible design language for the structural component can be achieved; the limitations on the design language existing in the prior art due to the linear extension of the frame parts are eliminated. Unlike in the prior art, the frame is no longer formed from tubular sections. Rather, the structural parts formed from self-expanding foam resin constitute a load-bearing part of the frame (feature 5), whereby the structural parts not only possess the necessary tensile strength but also feature any design language adapted to the specific requirements of the vehicle in question.
131. Since the structural elements are formed from self-expanding foam resin (feature 3), which can both ensure thermal insulation of the vehicle and possess the necessary tensile strength (see para. [0015] and sub-claim 7), this constitutes a mechanically strong and load-bearing structural component for a vehicle frame that does not require additional thermal insulation.

F. Counterclaim for nullity

132. The counterclaim for nullity is unsuccessful on the merits.

I. Inventive step

133. There is no doubt that the invention as disclosed in claim 1 is so clearly and fully disclosed that a person skilled in the art can carry it out, thereby satisfying the requirements of Article 83 EPC.
134. In support of its argument that the claim is, in its view, unenforceable, the defendant states that claim 1 defines a vehicle frame comprising at least one structural component that forms a load-bearing part of the frame. Consequently, non-load-bearing parts of a frame must also exist. It is not clear what the load-bearing parts and the non-load-bearing parts are supposed to be. However, these considerations do not concern enforceability, but at most the clarity of the claim. This, however, is not a ground for invalidity within the meaning of Article 138 EPC. The defendant's arguments in this regard are therefore, from the outset, not capable of seriously calling into question the legal validity of the contested patent.

II. Novelty

135. The prior art cited by the defendant does not anticipate the technical teaching of the contested patent in a manner prejudicial to novelty.

1. Standard of novelty assessment

136. A technical teaching is novel if it differs from the prior art in at least one of its known features. Only that which is immediately apparent to a person skilled in the art from the publication or prior use is considered to be anticipated by the prior art (see UPC\_CoA\_382/2024 (Court of Appeal), Order of 14 February 2025, APL\_39664/2024 – Abbott v. Sibio). Findings which a person skilled in the art only arrives at following further consideration or by consulting additional documents or prior use do not form part of the state of the art (see UPC\_CFI\_16/2024 (Düsseldorf Regional Court), decision of 14 January 2025 – Ortovox v. Mammut;

UPC\_CFI\_7/2024 (Düsseldorf Division), decision of 3 July 2024 – Kaldewei v. Bette;  
UPC\_CFI\_239/2024 (The Hague Division), decision of 22 November 2024 – Plant-e v. Arkyne (Bioo)).

2. Novelty assessment on a case-by-case basis

137. On this basis, the technical teaching protected by patent claim 1 is found to be novel in relation to the prior art cited by the defendant.

a) DE 198 98 026 A1 (Annex WK 3, hereinafter: DE `026)

138. This applies, first of all, with regard to DE `026.

139. The prior art describes a method for manufacturing moulded plastic parts and, in particular, for manufacturing car roofs (see claim 1). In a first production cycle, a foam core consisting of polyurethane foam with reinforcing inserts embedded within it is produced. In a second work cycle, the foam core is provided with a coating by placing the prefabricated foam core into a mould and holding it therein with the side to be coated precisely spaced from the base of the mould. The cavity between the mould base and the foam core is then flooded with liquid polyurethane until it is completely filled.

140. There is no indication in the prior art that the structural component produced in this manner is a component of a vehicle frame, nor is there any indication that the existing structural components form load-bearing parts of the frame. Consequently, regardless of whether the polyurethane is a self-expanding foam resin, there is in any event no disclosure of features 1 and 5.

b) DE 10 2015 111 421 A1 (Annex WK 4, hereinafter: DE `421)

141. Nor is the technical teaching claimed in claim 1 disclosed in DE `421 in a manner that would render it non-novel.

142. The invention protected therein relates to a surface element for a recreational vehicle, in particular caravans, motorhomes, etc. (para. [0001]). The term 'surface element' encompasses the side walls or sections of side walls of camping vehicles. The roof, the floor or sections of the floor, as well as the rear wall or sections of the rear wall, are also included (para. [0002]).

143. As the skilled person will further gather from claim 1 and paragraph [0005] of the citation, the surface element comprises

1. a frame structure (6, 12, 20) formed from a curable material dispensable from a dispensing device,
2. two cover layers (4, 7; 13, 16; 17, 23) connected to the frame structure, between which the frame structure is arranged, and
3. insulating material (1, 15, 21) which at least partially fills the voids (14) of the frame structure and is also arranged between the cover layers.

144. A possible configuration of the surface element is illustrated in Figure 4 of the citation:

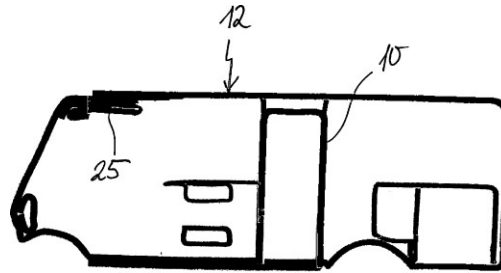


Fig. 4

145. With regard to the material of the frame structure, the skilled person will note from paragraph [0010] of the prior art that it preferably consists of a group comprising (reinforced) plastic or plastic foam reinforced with rice husks. These materials would have particularly favourable physical properties and would be well suited to the manufacture of a frame structure for a surface element according to the invention, e.g. by a casting process.

146. As the skilled person learns from paragraph [0008] of the prior art, the claimed method allows for any geometry of the frame structure.

147. However, the citation contains no indication that the existing structural parts form a load-bearing part of the vehicle's frame. Consequently, there is in any event no disclosure of feature 5.

c) DE 10 2013 006 300 A1 (Annex WK 5, hereinafter: DE `300)

148. German Patent No. 300 also discloses a method for manufacturing a structural component. In this process, a lightweight core is positioned within a mould, with the aid of spacer elements, in a pre-assembly position in which the lightweight core is spaced on all sides from the inner wall surfaces of the mould. A liquid, curable foam composition is then introduced into the mould, whereby the foam composition flows around the lightweight core on all sides. Once the foam composition has cured within the closed mould and a shell of the structural component has been formed, the mould is opened and the structural component thus formed is removed (see Patent Claim 1).

149. As the skilled person will gather from paragraph [0061] of the prior art, in a preferred embodiment the structural component is designed as a support element or as a load-bearing component, in particular for a vehicle mirror, a vehicle light, a vehicle number plate or as a handhold for a vehicle (see also paragraph [0124]).

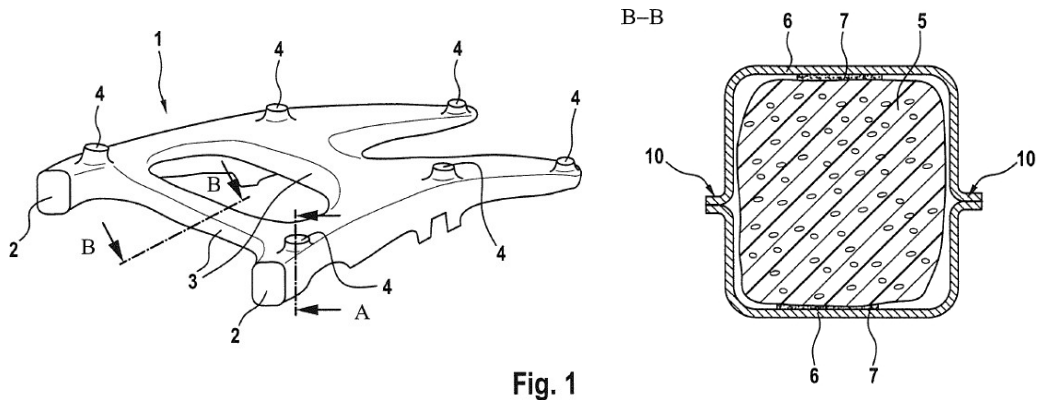
150. It is also not disclosed here that the structural components produced in this way form a load-bearing part of the vehicle's frame (features 1 and 5).

d) DE 10 2014 204 369 A1 (Annex WK 7, hereinafter: `369)

151. The prior art relates to a method for manufacturing a load-bearing vehicle structure, characterised in that a core and at least one shell are formed

and the shell is then placed on the core (see claim 1 and paragraph [0005]).

152. Figure 1 of the prior art, shown below, depicts a load-bearing vehicle structure manufactured according to the method disclosed in the prior art. Figure 3 is a section along line B-B:



153. With regard to the material of the core, the person skilled in the art will gather from paragraph [0008] that it is preferably made of foam, with plastic foam or metal foam being used. The foam is preferably moulded in a mould. This suggests, without this being expressly disclosed in the prior art, that the foam material is self-expanding. The question arises, however, as to whether the general disclosure of a plastic foam also discloses that the structural part is formed by a self-expanding *foam resin* within the meaning of feature 3.

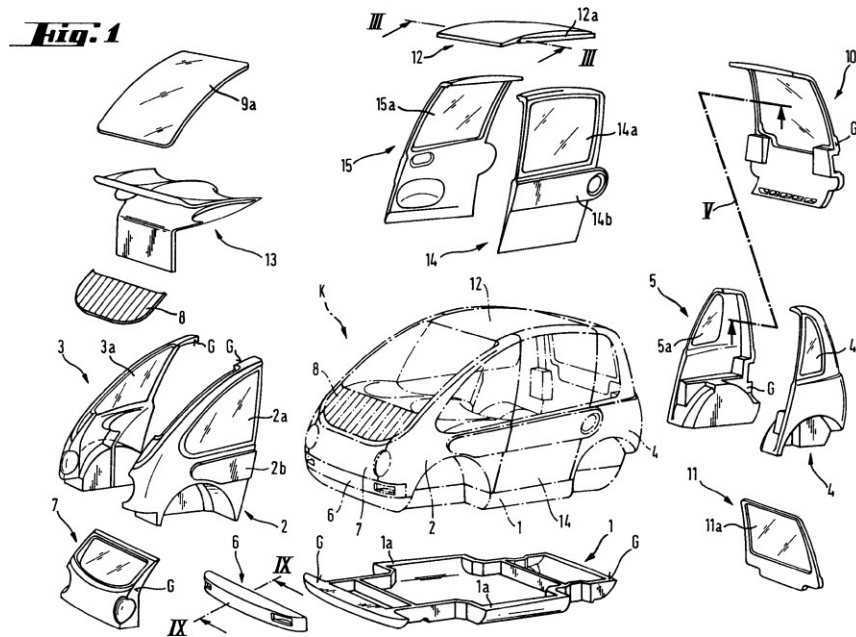
154. Ultimately, this is irrelevant, at least in the context of the novelty examination.

155. Since the solution disclosed in the prior art merely involves two rigid bodies (shells 6) connected to one another, within which a core (5) is located, the *coating* of the structural part with a protective layer required by feature 4 is in any case absent (emphasis added).

156. Furthermore, feature group 2 of the contested patent requires that the structural component be produced in a mould which reproduces the three-dimensional external shape of the structural component. For the product, it follows that the external shape of the core—which is at least partially coated in the final product—corresponds to the external shape of the structural part. However, this is not the case with the solution disclosed in DE '369. As the skilled person will gather from paragraphs [0005] and [0034], the geometry of the core can be designed independently of the shell, so that the core, for example, only contacts the shell in places and cavities remain at other points (see also Figure 3 shown above). However, this is precluded by the requirement contained in feature 2.1, according to which the mould defines the three-dimensional outer shape of the structural part.

e) EP 0 670 257 A1 (Annex WK 26, hereinafter: DE `257)

157. The subject-matter of DE `257, referred to in paragraph [0004] of the description of the contested patent, is a lightweight vehicle with a self-supporting body made of fibre-reinforced plastic, as well as a corresponding body, as exemplified in Figure 1 of the prior art shown below:



158. The essence of the disclosed invention is explained on p. 3, lines 12–26 of the citation as follows:

“The present invention is intended to provide a completely new design principle for a lightweight vehicle with a **self-supporting plastic body**, which is better suited to fibre-reinforced plastic, makes better use of its specific potential, and enables efficient mass production of the body and, consequently, of the entire lightweight vehicle.”

The lightweight vehicle designed to meet this requirement **has a self-supporting body made of fibre-reinforced plastic**, which is **assembled from prefabricated body panels joined together along their joint lines by a curing synthetic resin**, and is characterised by the fact that the prefabricated body elements are inherently rigid (dimensionally stable) and have large-area interfaces with the respective adjacent body elements, and that the body elements are connected over a large area at the joints, without lamination, solely in the region of their interfaces with one another. In this context, the individual body elements are preferably designed as a whole, or at least in the vicinity of their joint or interface surfaces—which are bonded to the adjacent body elements and, where applicable, partially connected by positive locking—as a box-like structure comprising a foam core and a preferably fibre-reinforced plastic shell. The self-supporting body of the invention is designed accordingly.”

(Emphasis added)

159. What is disclosed, therefore, is a self-supporting body, but not a frame for a vehicle in which the structural elements form a load-bearing part of the frame (features 1 and 5 of claim 1).

f) DE 10 2013 008 364 A1 (WK 31, hereinafter: DE `364)

160. The prior art relates to a method for manufacturing a structural component for exterior applications with a high-quality surface and a structural component. Such structural components include, for example, body parts or other vehicle parts, such as bonnets for tractors or elements thereof, radiator cowls, front panels,

skirts, covers or other structural components which *are used in the exterior of a vehicle* and which accordingly have a high-quality surface (paras. [0002] et seq. and [0011], emphasis added).

161. What is not disclosed, therefore, is a frame for a vehicle comprising at least one structural component, wherein the structural components form a load-bearing part of the frame (features 1.

g) technical drawing dated 1 February 2012 (Annex WK 15)

162. Insofar as the defendant attempts to substantiate what it considers to be a lack of novelty by referring to the technical drawing submitted as Annex WK 15, it has neither been sufficiently argued nor is it apparent that this constitutes a structural component of a frame within the meaning of features 1 and 5 of patent claim 1.

163. Furthermore, with regard to the objection of prior use, the comments on the right of prior use apply accordingly.

h) Product catalogue of Fendt-Caravan dated August 2014 (Annex WK 19)

164. Finally, the same applies with regard to the product catalogue of Fendt-Caravan from 2024, submitted as Annex WK 19.

165. It is not apparent that the front modules for caravans described therein and manufactured using the LFI process are structural parts of a vehicle frame that form a load-bearing part of the frame. The fact that these inserts can accommodate items such as windows is not sufficient for this.

III. Inventive step

1. Standard of examination

166. Under Article 56 EPC, an invention is deemed to involve an inventive step if it does not follow in an obvious manner from the prior art for a person skilled in the art.

167. In the view of the Munich Central Chamber (UPC\_CFI\_1/2023 (CD Munich), decision of 16 July 2024 – Sanofi v. Amgen), a view previously endorsed by the Düsseldorf Local Chamber (UPC\_CFI\_363/2023, decision of 10 October 2024, – Seoul Viosys v. expert; UPC\_CFI\_16/2024, decision of 14 January 2025 – Ortovox v. Mammut), the assessment of inventive step always requires a case-by-case evaluation taking into account all relevant facts and circumstances. An objective approach must be adopted. The subjective views of the applicant or inventor are irrelevant. What is relevant is solely what the claimed invention actually contributes to the state of the art.

168. Inventive step must be assessed from the perspective of a person skilled in the art, based on the entire state of the art, including general technical knowledge. It must be assumed that, at the relevant time, the person skilled in the art had access to the entire state of the art that was generally available. The decisive factor is whether the claimed subject-matter is so apparent from the state of the art that the person skilled in the art would have arrived at it on the basis of their knowledge and skills, e.g. through obvious modifications of what is already known.

169. In order to assess whether a claimed invention was obvious to a person skilled in the art or not, it is first necessary to identify a starting point within the prior art. It must be demonstrated why a person skilled in the art would regard a particular part of the prior art as a realistic starting point. A starting point is realistic if its teaching would have been of interest to a person skilled in the art who, at the priority date of the contested patent, was seeking to develop a product or process similar to that disclosed in the prior art, i.e. one having a similar fundamental problem to the claimed invention (see UPC\_CoA\_335/2024, Order of 26 February 2024, p. 34 – NanoString v. 10x Genomics, under ‘cc’ in the original German version, ‘For a person skilled in the art who, at the priority date of the patent in question, was faced with the task of [...] D 6 was of interest’). There may be several realistic starting points, although it is not necessary to determine the ‘most promising’ starting point.
170. If one compares the claimed subject-matter as interpreted with the prior art, the question arises as to whether it would have been obvious to a person skilled in the art to arrive at the claimed solution, starting from a realistic disclosure of the prior art and in view of the underlying problem. If it was not obvious to arrive at this solution, the claimed subject-matter satisfies the requirements of Article 56 EPC.
171. Generally speaking, a claimed solution is obvious if, starting from the prior art, the person skilled in the art would be motivated (i.e. would have an incentive; see the CoA in NanoString v. 10x Genomics, p. 34), to consider the claimed solution and to implement it as the next step (‘next step’, cf. UPC\_CoA\_335/2024, Order of 26 February 2024, p. 35, second paragraph – NanoString v. 10x Genomics) in the development of the state of the art. On the other hand, it may be relevant whether the person skilled in the art would have anticipated particular difficulties in carrying out the next step or steps. Depending on the facts and circumstances of the case, it may be permissible to combine disclosures from the prior art.
172. A technical effect or advantage achieved by the claimed subject-matter compared with the prior art may be an indication of inventive step. A feature selected arbitrarily from a number of possibilities generally cannot contribute to inventive step.
173. A retrospective approach must be avoided. The question of inventive step should not be answered by searching, with hindsight and in the light of the patented subject-matter or solution, for (combined) disclosures in the prior art from which that solution could be derived.

## 2. Assessment of inventive step in the present case

174. Measured against this, the defendant’s (counterclaimant’s) submissions are not sufficient to call the inventive step into serious question.
- a) Based on DE 10 2013 215 933 A1 (Annex WK 6, hereinafter: DE `933) in conjunction with general technical knowledge or Annex WK 3, Annex WK 4, Annex WK 5 and EP 1 484 150 A2 (WK 11)
175. In so far as the defendant (plaintiff in the counterclaim for nullity) argues that there is a lack of inventive step

Although she questions the validity of the patent on the basis of DE '933, her arguments in this regard are based on the premise that the citation discloses all the features of patent claim 1, with the exception of feature 4 of the feature breakdown shown above (protective layer), are disclosed in the citation.

176. However, there is also a lack of disclosure of a vehicle frame comprising at least one structural member, wherein the existing structural members form a load-bearing part of the frame (features 1 and 5).
177. The citation describes a structural component of a vehicle which comprises a foam body having a three-dimensional extent. An example of such a structural component is shown in Figure 1 of the citation, displayed below.

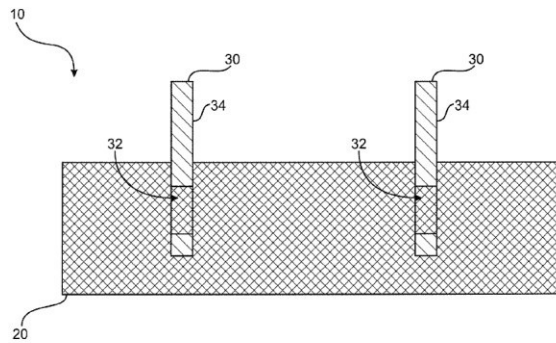


Fig. 1

178. Within the foam body (20) of the structural component (10), at least one reinforcing element (30) for the mechanical reinforcement of the foam body (20) is arranged at least in sections within the foam body. The reinforcing element (30) comprises at least one form-fitting section (32) via which it is connected to the foam body (20) by a form-fit (Claim 1).
179. As the skilled person further derives from Patent Claim 3 of DE '933, the structural component is preferably designed as a body component of the vehicle.
180. The fact that the disclosed structural component may also form part of the vehicle frame is, in any event, not expressly disclosed in the prior art. The defendant therefore refers solely to paragraph [0003], which states:

“A drawback of conventional structural components incorporating foam bodies is that their mechanical load-bearing capacity is limited. In particular, high mechanical loads, such as those that can occur within a vehicle body, are very difficult or impossible to transmit through such foam bodies. Crash situations, in particular, are a limiting factor for the use of foam bodies. Consequently, structural components containing such foam bodies **cannot currently** be used **for the vehicle’s essential load-bearing structures.**”

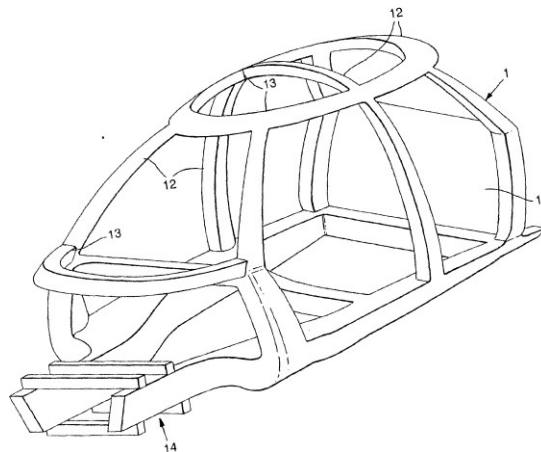
(Emphasis added)

181. From this, the skilled person is likely to conclude that the disclosed structural component can now also be used for load-bearing structural elements due to the reinforcement elements employed. Whether, however, this simultaneously discloses the possibility of use as a load-bearing component in the vehicle frame appears questionable, if only because the contrary—

In the context of load-bearing capacity, the description refers only to body components or outer skin components of the vehicle (see paragraphs [0010], [0012]), but specifically does not mention the frame. The mention in paragraph [0012] of *areas* of an A-, B- and C-pillar (emphasis added) does not suggest otherwise. It is unclear which areas are intended to be affected. It cannot be inferred from the prior art that the entire A-, B- or C-pillar is or can be formed from foam. Furthermore, the prior art is more concerned with attaching the foam component to existing elements. Since the foam body is therefore merely an addition attached to the inside of bodywork parts, there is no reason for the person skilled in the art to provide an additional coating, such as paintwork, particularly given that the prior art also does not indicate that the component is located within the field of view. The conditions for a lack of inventive step are therefore not met. Nor is it otherwise apparent how the average person skilled in the art would arrive at the missing features without inventive thought.

b) WK 25 (hereinafter: EP '189) in conjunction with the technical knowledge and Annexes WK 3, WK 4, WK 5 and WK 11

182. EP `189 discloses a frame structure for a motor vehicle made of plastic, as described in paragraphs [0021] et seq. of the citation and shown in Figure 1 of the citation, which is reproduced below:



183. Contrary to the defendant's view, the disclosed solution does not differ from the solution protected by the contested patent solely in that the solution according to EP `189 lacks a protective layer within the meaning of the contested patent. Rather, feature group 2 and feature 3 are also not disclosed.

184. It is true that the shell described in the prior art, preferably made of carbon fibres, may be filled with a self-expanding foam (see paragraphs [0023] – [0026]). However, the solution claimed by the contested patent is characterised by the fact that the structural component is formed by a self-expanding foam resin, which may, if necessary, be provided with reinforcing elements (see feature 3 of claim 1 and claim 4 of the contested patent). Even if the casting process itself is not part of the claim, the at least one structural component of the frame therefore necessarily consists of a self-expanding foam resin provided with a protective layer.

185. This is not the case with the solution disclosed in the prior art. The reinforcement components described therein are characterised in that they comprise a cored-out and

and thus comprise hollow bodies made of fibres. Insofar as the hollow body produced in this way is filled with a self-expanding foam material (see para. [0014]), this foam material may be completely or partially destroyed during the subsequent course of the process.

186. The skilled person can infer this from the end of paragraph [0015] of EP '189, which states, inter alia:

“The curing, which will take place at elevated temperature, may have the effect of destroying or partially destroying the foam core.”

187. A similar statement is found in paragraph [0023], where, in connection with the explanation of Figure 23, it is stated:

“In the process of curing, which takes place at an elevated temperature, **the foam core of the reinforcement may be partially or even completely destroyed or melted, but this is of no importance.** What remains, as seen in Figure 23, is a honeycomb rigid-walled complete beam structure 108 with a very satisfactory strength-to-weight ratio. Voids where the foam has been destroyed are visible in the darkened areas such as 109.”

(Emphasis added)

188. Unlike the technical teaching protected by the contested patent, the presence of a core made of a self-expanding foam material is therefore possible but not mandatory. The decisive component of the disclosed structural element is the (carbon) fibre sheath. Consequently, there is no disclosure of feature group 2 or of feature 3.

189. Furthermore, the defendant (plaintiff in the counterclaim) has failed to provide a sufficient explanation as to what reason the person skilled in the art would have for providing a protective layer to a protective element as disclosed in EP '189. The mere general reference to the fact that it is already within the scope of the skilled person's expertise and is nothing more than a routine task of a technical nature, which presents itself to the skilled person, to provide the structural parts in question with a protective layer, such as a coat of paint, in order to protect them from external influences, is not sufficient for this purpose. This is all the more true given that the plaintiffs have undisputedly argued that the bodywork is attached to the frame shown in Figure 1, and that the bodywork itself is painted, but not the frame.

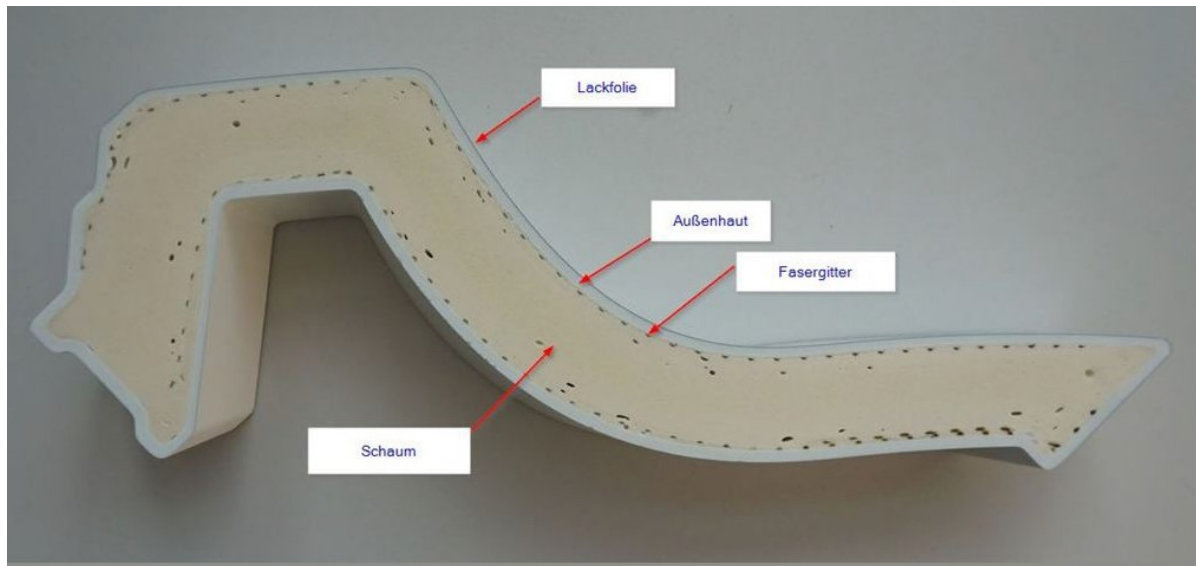
c) WK 31 in conjunction with Annexes WK 3 to WK 7, WK 15 and WK 26

190. Insofar as the defendant (plaintiff in the counterclaim) ultimately attempts to justify the lack of inventive step on the basis of DE '364 (Annex WK 31), that document, as already explained in the context of the novelty examination, fails to disclose the structural component as a load-bearing part of a vehicle frame (features 1 and 5). The defendant (plaintiff in the counterclaim) has not explained why the person skilled in the art would have reason to combine the solution disclosed therein with the solutions disclosed in the documents submitted as Annexes WK 3 to WK 7, WK 15 and WK 26. A mere general reference to the fact that the aforementioned documents disclose that the structural parts described therein may also form a load-bearing part of a vehicle frame is not sufficient for this purpose.

G. Infringement of the patent in dispute:

I. Implementation of the features:

191. The parties rightly do not dispute the fulfilment of features 1, 3 and 6, so that no further comments are required in this respect.
192. Based on the understanding set out in detail above, feature group 2 is also realised in the contested embodiments.
193. The implementation of the method described therein is not a prerequisite for this. Consequently, neither does the fact that the defendant uses more than one mould in the manufacture of the contested embodiments take the invention out of the scope of the contested patent, nor does the fact that, in the contested embodiments, the protective layer is not applied in the mould used to manufacture the foam core preclude the realisation of the technical teaching claimed. Finally, the defendant cannot successfully argue that the mould used to manufacture the foam core does not reproduce the external shape of the structure.
194. What is decisive, rather, is whether the characteristics of the product encoded by the method set out in claim 1 are present in the contested embodiments. This is the case.
195. The defendant itself promotes the Fibre Frame technology it uses by stating that it enables a progressive design language through an innovative construction method and ensures greater flexibility in the floor plan and interior design (see Annex K 5). Furthermore, the defendant has not contested the explanation from the 'Caravan Institute' submitted by the claimant as Annex K 6, according to which Fibre Frame is a high-strength glass-fibre frame that ensures a structurally rigid, self-supporting structure. According to this, the manufacturing process for the frames opens up new possibilities for the implementation of 'multidimensional' elements in the design process. Finally, in the press release submitted as Annex K 7, the defendant also highlights the greater flexibility in floor plan layout and interior design afforded by the Fibre Frame components.
196. The parts manufactured using Fibre Frame technology are therefore not limited to a linear shape, but can be designed in any form to meet the specific requirements for the shape of the frame and, ultimately, of the caravan.
197. The fact that the structural component is also coated on the outside with a protective layer, as described in feature 4, is illustrated by the figure below, taken from the statement of claim:



198. In the contested embodiments, the foam is covered by an outer skin made of a two-component polyurethane resin, thereby forming a protective layer within the meaning of the contested patent. The lacquer film arranged over it does not extend beyond the scope of protection. On the one hand, the contested patent does not preclude the coating of the protective layer, but rather regards this as a means of imparting an aesthetically pleasing appearance to the surface. On the other hand, patent claim 1 contains no specifications regarding the detailed technical configuration of the protective layer. This may therefore be designed as a single-piece or multi-piece structure. If one were to interpret – as is not the case – claim 1 in the same way as the defendant, namely that the protective layer must necessarily be arranged on the very outer surface and must therefore not be covered by further layers, there is no apparent reason not to regard the outer skin and the lacquer film together as a (two-part) protective layer.

## II. Infringement

199. By offering and distributing the contested embodiments (even after the entry into force of the Agreement on a Unified Patent Court (UPCA)), the defendant has committed acts of infringement within the meaning of Article 25(a) of the UPCA. In this context, the offering and placing on the market simultaneously give rise to a rebuttable presumption that the defendant also uses the contested embodiment or imports or possesses it for the purposes of offering, placing on the market or using it (UPC\_CFI\_7/2024 (Düsseldorf Division), decision of 3 July 2024 – Kaldewei v. Bette; UPC\_CFI\_363/2023 (Düsseldorf Regional Court, decision of 10 October 2024 – Seoul Viosys v. expert e-Commerce).

### 1. Applicable law

200. In accordance with the principles developed by the Mannheim Local Chamber, the UPC also applies to acts of infringement committed after the entry into force of the UPC, even in the case of European patents (UPC\_CFI\_162/2024, decision of 11 March 2025, headnote 3(a) and paras. 95–98 – Hurom v. Nuc; see also Tilmann, GRUR-Patent 2025, 51).

201. Even if one were to take a different view and require the application of national patent law to European patents, even where the acts of infringement were committed only after the entry into force of the EPC (see McGuire, GRUR-Patent 2024, 466, in particular para. 33 et seq.), such an interpretation would not lead to a different outcome in the present case. Even then, in order to avoid difficulties arising from the application of diverse

national patent laws, to apply the EPC as harmonised law, unless express reference is made to deviating national provisions (see McGuire, GRUR-Patent 2024, 466, paras. 48–51). Since no such reference exists in the present case, such an interpretation also leads to the application of the EPC in the present case.

202. The fact that the contested embodiments were offered and marketed not only after, but also before the entry into force of the UPC, does not justify a different assessment.
203. In accordance with the principles established by the Mannheim Local Chamber (UPC\_CFI\_162/2024, decision of 11 March 2025, headnote 4(c) and para. 105 et seq. – *Hurom v. NUC*), even taking into account the prohibition on retroactive effect enshrined in Article 28 of the Vienna Convention on the Law of Treaties, the substantive law as laid down in the EPGÜ applies to acts which commenced prior to the entry into force of the EPGÜ and which continued after 1 June 2023.
204. When determining whether infringing acts are ‘ongoing’ in this sense, one must not adopt an overly formalistic approach that would run counter to the objectives of the Agreement. A normative – and thus evaluative – assessment is required. A continuing act is therefore to be assumed if the infringer – as in this case – continues their infringing conduct, even though they could have ceased it in view of the entry into force of the EPGÜ on 1 June 2023. In this case, however, each party retains the right to rely on provisions of national law relating to acts prior to 1 June 2023 which are more favourable to their position than the provisions of the EPGÜ and the Rules of Procedure (UPC\_CFI\_162/2024, decision of 11 March 2025, Headnote 5 and para. 105 et seq. – *Hurom v. NUC*).
205. The Chamber shares the view of the Mannheim Local Chamber that, with regard to the application of national law, it is primarily for the party to put forward its legal arguments relating to national law. In this context, a party may consider either presenting arguments regarding national law through its representatives and/or substantiating these arguments with an expert opinion from a private expert, or proposing to the court that such a private expert opinion be submitted, should the court deem this appropriate and necessary. Only if the legal opinions on national law submitted by the parties do not agree and the court itself is unable to adequately answer the question of national law must the court consider whether an expert appointed by the court, proposed by the party concerned, should be appointed (Mannheim Local Chamber, UPC\_CFI\_162/2024, decision of 11 March 2025, headnote 5 and para. 105 et seq. – *Hurom v. NUC*; Bopp/Kircher/Böttcher, *Handbook of European Patent Litigation*, 3rd ed., § 23 para. 175 et seq.; Ahrens GRUR 2017, 323, 325, Haft/Lohr, GRUR Patent 2023, 69, 71). It would therefore have been for the parties, and in the present case in particular for the defendant, to refer to divergent provisions of national law. However, nothing to that effect can be inferred from the defendant’s submissions, so that the EPC remains the applicable harmonising law.
206. The opt-out declared in relation to the contested patent, but subsequently withdrawn, does nothing to alter this. This concerns the jurisdiction of the Unified Patent Court, but not substantive law (Tilman/Plassmann/W. Tilman, *Unified Patent, Unified Patent Court*, Art. 89 UPC Agreement, para. 29 with reference to Art. 83, paras. 15–19).

## 2. Infringement by the defendant

### a) Test purchase

207. It is undisputed that on 26 June 2024, the first claimant purchased an A-pillar of one of the contested embodiments as part of a test purchase (see Annex K 17).
208. Irrespective of when this structural component was manufactured, the defendant has not substantially contested the plaintiffs' related submission that the defendant offered and distributed the contested embodiments after the EPGÜ came into force. Such distribution is therefore undisputed (Rule 171(2) of the Rules of Procedure), which is why the question raised by the defendant regarding the necessity of specifying concrete acts of infringement after the EPGÜ came into force is irrelevant. The Court does not share the defendant's view that the delivery in the context of the test purchase took place with the plaintiffs' consent and therefore cannot constitute an act of infringement. The very purpose of a test purchase is to clarify possible acts of infringement and to gather evidence for infringement proceedings that may be necessary in the future. This does not imply consent to the distribution of the contested embodiments.
209. Nor can the defendant rely in this context on the fact that the claimant initially failed to specify the place and time of the infringing act, contrary to Rule 13(1)(l)(i) of the Rules of Procedure. The requirements for the statement of claim set out in Rule 13(1)(a) to (i) of the Rules of Procedure are of a formal nature. They must be examined by the Registry as soon as possible after the claim is filed, Rule 16(2) of the Rules of Procedure. If the examination reveals that the requirements have not been met, the Registry shall give the claimant the opportunity to remedy the deficiencies within 14 days, Rule 16(3)(a) of the Rules of Procedure. If the deficiencies are not remedied within this period, a default judgment may be issued pursuant to Rule 16(5) of the Rules of Procedure in conjunction with Rule 355(1)(a) of the Rules of Procedure. By contrast, the requirements set out in Rule 13(1)(j) to (q) of the Rules of Procedure relate to the content of the statement of claim. Accordingly, compliance with these requirements is not checked by the registry, nor is a deadline set in the event of non-compliance, which could lead to a default judgment pursuant to Rule 355(1)(a) of the Rules of Procedure. Rather, compliance with the requirements set out therein concerns the merits of the claim, the examination of which is the responsibility of the judge and must be taken into account by the judge in his decision. In that context, failure to comply with the requirements set out in Rule 13(1)(j) to (q) of the Rules of Procedure may have adverse consequences for the claimant (on a comparable issue in summary proceedings: CoA\_335/2023, App\_576355/2023, Order 26 February 2024, NanoString v 10x Genomics, p. 23 et seq.).
210. The purpose of the requirement under Rule 13(1)(l) of the Rules of Procedure to specify the place and date of the infringing act is to compel the claimant to set out the facts in sufficient detail to allow its grounds and legal arguments to be subsumed thereunder (see in this regard: Tilmann/Plassmann/Steininger, Unitary Patent/Unitary Patent Court, Rule 13, para. 20). At the same time, the defendant is to be enabled to understand the allegation of infringement brought against them and to be able to respond to it specifically.
211. On the basis of these principles, the plaintiffs in the present case initially referred in their statement of claim only in general terms to the test purchase they had carried out (see statement of claim, p. 12, para. 12), without specifying the time and place. However, following a corresponding objection, they clarified their submission in their reply and submitted an invoice as Annex K 17. The test purchase in question has since remained undisputed. Neither were the proceedings delayed by the initially missing details, nor did

any disadvantage for the defendant or the court in the conduct of the proceedings or the preparation of hearings. There is therefore no reason to reject the relevant submission pursuant to Rule 9(2) of the Rules of Procedure.

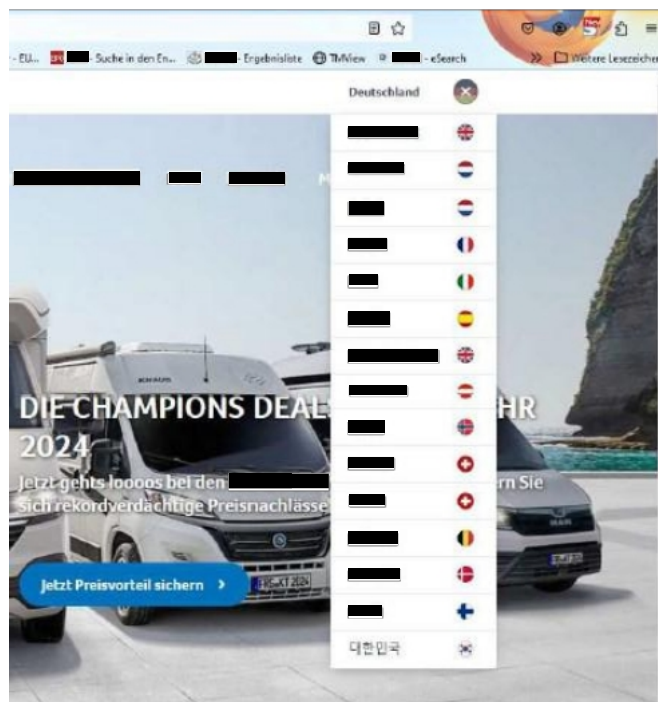
212. Apart from that, the defendant has not addressed the plaintiff's further arguments (see Statement of Claim, p. 23, para. 56; reply, p. 13, para. 40) that, by the end of 2023, just under 600 caravans of the 'Deseo' model and 70 caravans of the 'Azur' model had been sold, has not been disputed on the merits. This statement of facts is therefore also undisputed and must form the basis of the decision (Rule 171(2) of the Rules of Procedure).
213. In so far as the defendant instead objects that the plaintiffs obtained their knowledge from out-of-court settlement discussions, and that the relevant information therefore constitutes a breach of Rule 11(3) of the Rules of Procedure in the present proceedings, the court cannot agree with this. The provision is intended to protect the confidentiality of an agreement reached in proceedings conducted under the auspices of the Mediation and Arbitration Centre. It is intended to ensure that no statements, proposals, offers or concessions, nor any documents drawn up in the course of the session, are used in subsequent court proceedings (see Tilmann/Plassmann/Tochtermann, Unitary Patent, Unified Patent Court, Rule 11 EPGVerfO, para. 18 et seq.). The provision does not apply from the outset to pre-trial discussions between the parties.

b) The defendant's website

214. Furthermore, the defendant's website fulfils the requirements of an offer within the meaning of Article 25(a) of the EPGÜ.
215. The concept of 'offering' within the meaning of Article 25(a) of the European Patent Convention (EPC) is to be understood in patent law in a purely economic sense. Offering is not merely a preparatory act preceding manufacture, placing on the market, importation or possession, but a distinct form of use alongside these acts, which must be assessed independently. In accordance with Article 25(a) of the EPGÜ, the concept of 'offering' – in the case of a product – encompasses any act committed within the scope of the European patent in question which, according to its objective meaning, makes the subject matter of the offer available for acquisition of the right of disposal in a manner perceptible to the outside world. It is not necessary for the offer to fulfil the requirements of a specific, legally effective and binding contractual offer. Nor is it relevant whether the offeror intends to conclude a transaction on their own behalf or on behalf of a third party, or whether, in the case of an offer made on behalf of a third party, they have actually been commissioned or authorised by that third party. What is decisive, rather, is solely whether the act in question actually generates a demand for an object infringing a property right, which the offer holds out the prospect of satisfying. The term 'offering' within the meaning of Article 25 of the EPGÜ specifically also encompasses preparatory acts intended to enable or promote the conclusion of a subsequent transaction concerning an object protected by the patent, which includes the use of the object. This may take the form of allowing interested parties to submit bids for the transfer of the object.
216. For an offer to be made, it is not necessary for all the features of the patent claim to be shown in the advertisement if, upon objective consideration of the actual circumstances of the case, it must be assumed that the technical design of the product depicted corresponds to the subject-matter of the patent. The decisive factor is whether the design in accordance with the patent can be reliably inferred from the existence of other objective circumstances

. A key consideration here is the view of the relevant public regarding the objective explanatory value of the advertisement, to be determined by taking into account all the factual circumstances of the individual case (see, inter alia: UPC\_CFI\_177/2023 (Düsseldorf Regional Court), Order of 18 October 2023 – myStromer v Revolt; Luginbühl/Hüttermann/Küppers/Rbusch, Unified Patent System, Art. 25 para. 44; Tilmann/Plassmann/Busche, Unified Patent, Unified Patent Court, Art. 25 UPC Act para. 24).

217. On the basis of these principles, the extract from the defendant’s website submitted by the claimant as Exhibit K 5 constitutes an offer within the meaning of Article 25(a) of the EPGÜ. For instance, the ‘Deseo’ caravan and the ‘Azur’ model are not merely advertised there at a price of ‘from EUR 30,990’ and ‘from EUR 42,290’ respectively. Rather, in addition to a configurator, there is also a dealer locator via which contact can be made with a dealer at a desired location. It is therefore an offer within the meaning of Article 25(a) of the EPGÜ. The fact that this offer is directed not only at customers in Germany but also in Europe can be seen from the further extract from the defendant’s website submitted as Annex K 18 and the option to select a country available there:



218. There is no reason to reject this Annex, submitted with the reply, as out of time (Rule 9(2) of the Rules of Procedure) simply because, by submitting this further screenshot of the defendant’s website, the plaintiffs are elaborating on their arguments from the statement of claim in response to the arguments in the statement of defence. Furthermore, the relevant submission was not disputed by the defendant on the merits.

219. Contrary to the defendant’s view, the demonstration of an act of infringement for each of the countries at issue is, in any event, unnecessary for the period from the entry into force of the EPGÜ on 1 June 2023, due to the global effect under Article 34 EPGÜ. For the purposes of the global effect, it is irrelevant in which Contracting Member State the infringement of the patent in dispute has taken place or is likely to take place (Tilmann/Plassmann/v. Falck/Dorn, Unitary Patent, Unified Patent Court, Art. 34 para. 37).

220. That aside, the claimant's submission is in any event to be understood as meaning that the defendant offers and distributes the contested embodiments both before and after the EPGÜ came into force in Germany, France, Italy and Slovenia. Even the defendant does not allege any differences between these countries, such as the fact that the contested embodiments are not offered or distributed in certain countries, or are offered or distributed only in a different form.

III. No right of prior use

221. In any event, the defendant cannot successfully invoke a right of prior use in relation to the Member States covered by the agreement at issue.

1. Standard of assessment

222. Article 28 of the EPGÜ stipulates that anyone who has acquired a right of prior use in respect of an invention in a Contracting Member State, had a national patent been granted for that invention, shall have the same rights in that Contracting Member State in respect of a patent covering that invention.

223. The strict wording of the provision is unambiguous in this respect. The user of the technology covered by the invention may only rely on the rights granted to them by the respective national regulations of the relevant contracting member states. In this respect, the existence of a prior user's right must be demonstrated for each of the protected states under its own conditions. The provision does not provide for a European right of prior use, but rather constitutes a dynamic reference to the respective national law (see Tillmann/Plassmann/Busche, Unitary Patent, Unified Patent Court, Art. 28 UPC Agreement, para. 6). An argument in favour of this legal structure is that an EU-wide prior use right could unduly restrict effective European patent protection. And even if some legal scholars criticise the provision as being contrary to the system (see Smeets, GRUR Patent 2024, 18, 23 para. 25 with further references), its unambiguous wording must be observed and accepted by the court (UPC\_CFI\_7/2023 (Düsseldorf Regional Court), decision of 3 July 2024, p. 26 – Kaldewei v. Bette).

224. Whether a right of prior use, as argued by the defendant, must always be asserted by way of a (counter)claim or may also be raised merely by way of a defence against the allegation of infringement does not require further examination in the present case. On the one hand, the defendant has raised the defence by way of a counterclaim. Secondly, in doing so, it has simultaneously indicated that it intends to defend itself against the allegation of infringement by invoking a right of prior use. The question raised by the defendant is therefore not relevant to the decision.

2. No right of prior use in the present case

225. The defendant primarily asserts a right of prior use under Section 12 of the German Patent Act (PatG). A right of prior use on the part of the defendant on this basis cannot be established.

226. According to the established case law of the Federal Court of Justice (BGH), the act of use or organisation required for the acquisition of a prior user's right under Section 12 PatG presupposes that the person carrying out the act has acquired independent ownership of the invention. Such ownership is deemed to exist if the technical teaching resulting from the problem and its solution is objectively complete and subjectively recognised to such an extent that the invention can actually be carried out (BGH, GRUR 2012, 895, 896 – Desmopressin; GRUR 2010, 47,

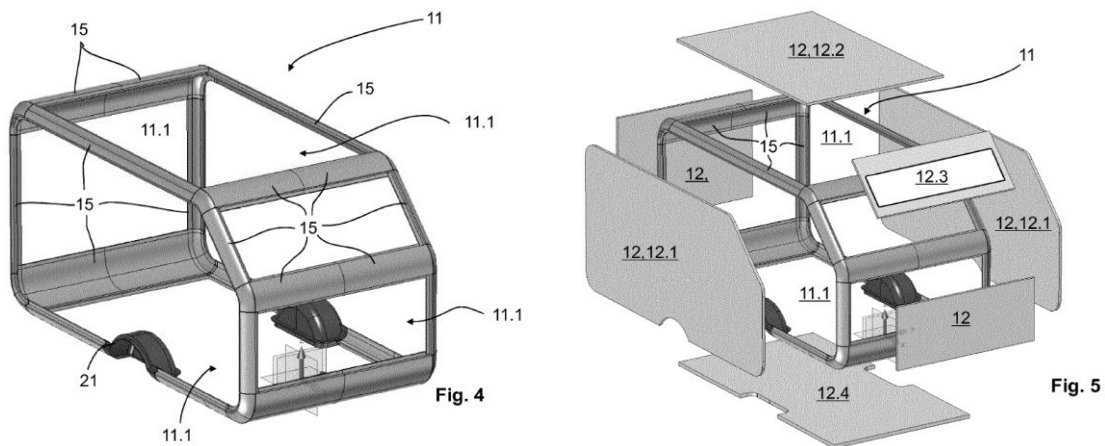
48 – filler). Such knowledge is lacking if the technical measure has not yet progressed beyond the experimental stage, or if an object has been used which exhibits the characteristics of the invention only ‘by chance’ in isolated cases. In both cases, the claim is not based on knowledge that makes it possible to reproduce the technical teaching at any time, so that it is not justified to attribute to it a legal status conferring property rights. Such cases of unconscious or at least insufficiently substantiated use of the technical teaching must be distinguished from claims that are systematically directed towards the realisation of the same. The latter are to be regarded as giving rise to ownership, as they are based on a certain knowledge of the relationship between cause and effect. By contrast, it is not necessary for the person acting to have knowledge of the certain feasibility of the invention. For ownership of the invention cannot be made dependent on conditions which have not become part of the technical teaching within the meaning of the patent claim. Knowledge of effects which, according to the information in the description, are to be associated with the use of the subject-matter of the invention but have not been included in the patent claim cannot therefore be decisive for the question of whether ownership of the invention has been established (BGH, GRUR 2012, 895, 896 – Desmopressin; Benkard/Scharen, Patent Law, 12th ed., § 12 PatG para. 5).

227. Merely owning an invention is not sufficient to establish a right of prior use. Rather, the invention must also be exploited. In any event, steps must have been taken to this end.
228. For the latter, it is necessary that the person invoking Section 12 PatG has made a firm and final decision to exploit the invention commercially. Furthermore, they must have taken steps to prepare for the rapid implementation of the decision and have the intention to exploit the invention. To meet the requirements, two conditions must therefore be fulfilled: firstly, there must be actions aimed at a substantial implementation of the invention. Secondly, these actions must demonstrate a serious intention to exploit the invention in Germany in the near future (BGHZ 39, 389, 398 = GRUR 1964, 20 – Taxilan). Mere preparatory acts for the purpose of exploring the possibility and feasibility of commercial exploitation are not sufficient, nor are preparatory acts for a later planned implementation (Benkard/Scharen, Patent Law, 12th edition, Section 12 PatG, para. 13; BeckOK PatR/Ensthaler, PatG Section 12, para. 7).
229. If the defendant invokes a private right of prior use in a legal dispute, it must be borne in mind that the relevant events typically occur on the defendant’s side. The patent proprietor therefore has no knowledge of the relevant events. It is therefore not sufficient for the defendant to invoke a right of prior use in general and across the board. If the defendant wishes to assert such a right, they must instead specify exactly who, on what occasion, and on the basis of what technical considerations is said to have arrived at the invention. The same applies to accompanying or subsequent acts of use or events for the purpose of imminent use (with reference to German practice: Kühnen, Handbook of Patent Infringement,<sup>16th</sup> edition, Section E, para. 666).
230. Based on these principles, the defendant’s arguments are insufficient to conclusively demonstrate that the conditions for a prior use right of the defendant in the Federal Republic of Germany are met. There is already a lack of ownership of the invention.

231. In this context, it should be borne in mind that patent claim 1 does not protect a single structural component, but rather a vehicle frame comprising a structural component (feature 1), whereby the existing structural components form a load-bearing part of the vehicle frame (feature 6). In addition to the frame covered by the patent, the contested patent also provides for additional filling elements. Paragraph [0016] of the contested patent specification states:

‘[...] The free spaces present within the vehicle frame can be filled by additional infill elements, which may be designed as wall elements or roof elements. Recesses for doors, windows, ventilation slots and the like can then be arranged in these infill elements. The infill elements themselves may be designed as foam resin plastic parts, which are generally provided in the form of panels.’

232. The infill elements thus fill the open spaces formed by the frame, but do not themselves form part of the frame (see also paras. [0002] et seq., [0004], [0007] ‘Vehicle frame structure part’, [0011]). This is illustrated, for example, by Figures 4 and 5, which are shown again below and which explain the invention by means of a preferred embodiment:



233. Whilst only the frame is visible in Figure 4, in Figure 5 it is fitted with additional infill elements (12, 12.1, 12.2, 12.3 and 12.4).

234. Insofar as the defendant attempts to derive a right of prior use by referring to the front and rear sections of the Cara-vans ‘Eurostar’, ‘Grande Puccini’ and ‘Tabbert Supreme’, it fails to succeed in this regard simply because these parts are not components of the vehicle frame, but rather infill elements in the aforementioned sense.

235. This is illustrated by the drawing submitted by the defendant itself as Annex WK 40 to the file:

#### Nachweis Fahrzeugrahmen

In den Seitenwänden sind umlaufend Polyurethan (PU) Leisten als Rahmen eingebaut. Diese dienen als Verbindung der Seitenteile mit dem Boden und dem Dach (Kombination aus Kleben, Schrauben und Dichten).



Darstellung Strukturbeuteil Bug und Heck aus LFI

236. As can be seen from the drawing shown above, the aforementioned models make use of PU strips in which aluminium sheets form the outer surface of the side walls and are mounted onto the PU strips. These PU strips thus form the frame onto which the bow and stern sections in question are mounted. The latter are therefore filling elements in the aforementioned sense, but not (load-bearing) components of the frame. They cannot therefore be used to establish prior use of the invention protected by the contested patent.

237. Since the defendant has already failed to establish prior use in Germany, the question raised by the defendant regarding an extension of the German prior use right on the basis of the free movement of goods pursuant to Article 28 et seq. TFEU does not require discussion.

### 3. Licence defence

238. The defendant cannot successfully rely on a licence in relation to the contested embodiments.

239. Insofar as the defendant has raised a 'counterclaim' or a 'third-party counterclaim' in relation to a licence, it is thereby ultimately contesting, at least in its principal claim, the allegation of infringement made against it on the grounds that the contested patent is licensed in respect of the challenged embodiments. It has not, however, made any claims of its own in this regard in the main claim. On this basis, the defendant has ultimately raised a licence defence, for which the jurisdiction of the Unified Patent Court already arises from Article 32(1)(a) of the UPC Agreement (Luginbühl/Hüttermann/Boos, Unified Patent System, Article 24, para. 50). It can therefore be left open whether such a defence, as argued by the defendant, can only be asserted by way of legal action. The Unified Patent Court would also have jurisdiction over such an action under Article 32(1)(a) of the EPGÜ.

240. On the merits, the defendant is not entitled to such a licence. In particular, the defendant cannot derive such a licence from the development agreement submitted as Annex rop 10. In so far as the defendant additionally relies on a further agreement, it has neither submitted the relevant agreement nor sufficiently substantiated its claims in this regard.

241. The development agreement submitted as Annex rop 10 to the file grants the defendant rights solely in respect of the 'Travelino' caravan, but not in respect of the caravans at issue "Deseo" and "Azur" a licence to use the patent in dispute.

242. This is evident from Section 1(6) of the development agreement, which states, inter alia:

“KTG and the Developer agree **that KTG is always entitled, for the ‘Travelino’ caravan in its current form and design (Annex 2), to use the frame concept, the subject matter of the patent application filed by the joint applicants (Annex 1),** as well as the development(s) made in the field of or in connection with the ‘Travelino’ caravan, in particular the new foam resin composite specially developed by FTC, ~~free of licence,~~ **exclusively and without restriction as to time, place or content, and free of charge,** in particular to exploit them. In this respect, the parties assume that the Travelino caravan is not, and will not become, a mass-market product. This right is not transferable to third parties.

Should KTG subsequently choose a **name other** than “Travelino” for the caravan, this **shall not affect the aforementioned right of use, which is free of charge and otherwise unrestricted.**

Furthermore, KTG and the developer agree that KTG is **entitled, in return for a licence fee to be agreed,** to use **the frame concept, the subject matter of the joint patent application (Annex 1),** as well as the development(s) made in this field/context, in particular the new foam resin composite specially developed by FTC, **for the recreational vehicle sector for the duration of the licence agreement.”**

(Bold type added by the court)

243. The development agreement therefore distinguishes between the “Travelino” model, which is not at issue here, and other models yet to be developed. Whilst the defendant is entitled to a permanent, royalty-free right of use in respect of the “Travelino” model, irrespective of its designation but only in “its current form and design”, it is entitled to such a right in respect of further models only in return for a licence fee to be agreed and only for the duration of the licence agreement. In other words, a licence agreement must first be concluded for these further models. Only then is the defendant entitled to a corresponding right of use.

244. Correspondingly, Section 5 of the licence agreement states, with regard to remuneration, inter alia (emphasis added):

‘(1) Remuneration for the comprehensive rights of use for the frame concept in the form of the patent application filed by the joint applicants “Structural component for a vehicle frame made of foam resin and manufacturing method” (German Patent and Trade Mark Office file number: 10 2016 101 274.2, Annex 1) shall be **regulated within the framework of a licence agreement yet to be negotiated.**

[...]

(2) **With regard to the “Travelino” caravan, KTG is irrevocably entitled to use the development(s), in particular the developed frame/the developed frame concept, based on the patent application (Annex 1),** made from the special foam resin composite in the leisure vehicle sector, **exclusively and without restriction in terms of time, location or content, and in particular free of charge,** and in particular to exploit it. This use and exploitation for the ‘Travelino’ caravan has already been remunerated by KTG’s services within the framework of the Travelino project.”

245. The defendant is therefore granted a right of use free of charge solely for the 'Travelino' caravan. Furthermore, a licence agreement still needs to be concluded, as is ultimately also apparent from Section 6(1) of the development agreement (emphasis added):

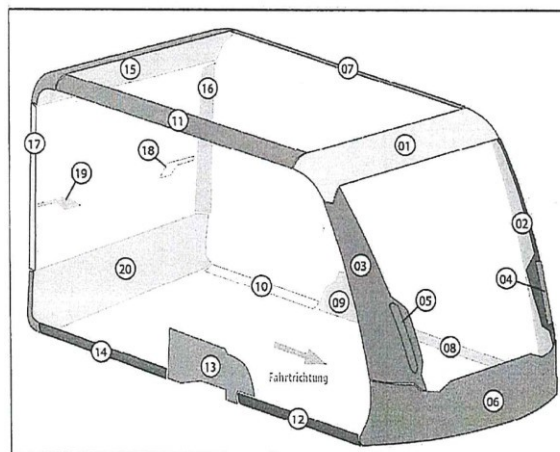
**"All parties already agree today that KTG's exclusive and unrestricted right to use all developments, inventions, work results, industrial property rights and any know-how in connection with the development of the novel frame concept based on the patent application of the joint applicants (Annex 1) in the field of recreational vehicles (motorhomes, caravans, mobile homes) will be regulated in a separate licence agreement in return for appropriate remuneration.**

KTG is entitled to use the frame concept based on the joint patent application for the Travelino project upon conclusion of this contract."

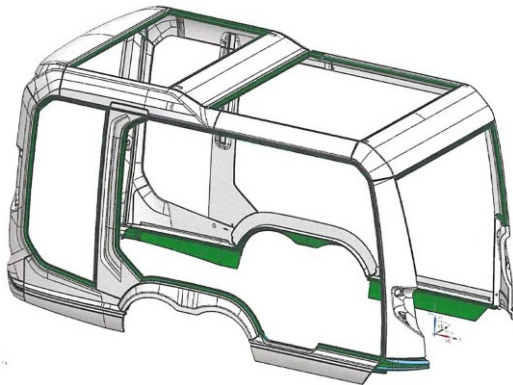
246. The defendant's view that, with regard to further models, the determination of the fee is to be left to a licence agreement to be concluded at a later date cannot therefore be reconciled with the overall terms of the development agreement.

247. On this basis, the models at issue, 'Deseo' and 'Azur', are not already licensed under the development agreement. That these are not merely the 'Travel-ino' model with a different name is already apparent from the affidavit submitted by the defendant itself as Annex rop ZA 1, which identifies the models

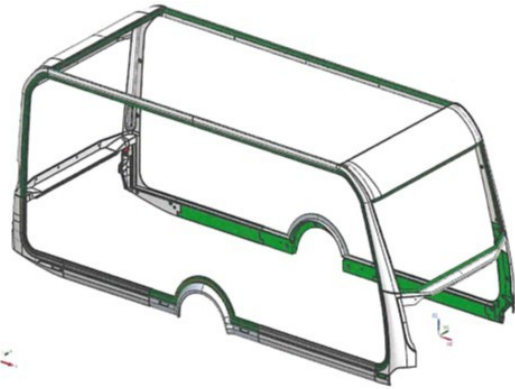
'Travelino', 'Deseo' and 'Azur': Travelino:



Deseo:



Azur:



248. Pursuant to Section 1(6) of the development agreement, the licence granted extends exclusively to the 'Travelino' caravan in its current form and design. Changes are therefore only permissible if they constitute a mere change of name. Any structural modification, such as those evident from the illustrations submitted by the defendant herself, thereon, falls outside the scope of the licence; the conclusion of a licence agreement is required. Whether these modifications are decisive from the perspective of the teaching of the contested patent is, however, irrelevant.
249. In so far as the defendant (plaintiff in the counterclaim) relies on Article 3(2) of Regulation (EU) No 1217/2010 on the application of Article 101(3) of the Treaty on the Functioning of the European Union to certain categories of research and development agreements, this provision relates exclusively to research results arising from joint development. However, it is undisputed that the patent in dispute is not based on joint development. It therefore falls outside the scope of this provision from the outset. The same applies with regard to Article 3(2) and (3) of the Commission Regulation (EU) on the application of Article 101(3) of the Treaty on the Functioning of the European Union to certain categories of research and development agreements. These provisions, too, cover only the intellectual property rights arising from joint research and development, but not the patent in dispute, which is based solely on the plaintiffs' own development.
250. It cannot be established that, as the defendant claims, there is an agreement between the second claimant and the defendant under which the second claimant undertakes not to assert any rights under the patent in dispute against the defendant (see: Statement of Defence, p. 35). The plaintiffs have contested this submission and, for their part, have submitted as Annex K 20 a settlement agreement from 2020, under which the defendant is obliged to use the technical teaching claimed by the patent in dispute for the 'Travelino' model. The provision asserted by the defendant is not contained therein (see Rejoinder, para. 53 et seq.). It would therefore have been incumbent upon the defendant to submit the relevant agreement on which it relied to substantiate its objection that it was entitled to use the patent in dispute. It failed to do so despite a corresponding request by the court.

## H. Legal consequences

### I. Injunction

251. Taking into account the circumstances of the case, the plaintiffs are entitled to an injunction against the continuation of the infringement pursuant to Article 25(a) of the EPGÜ in conjunction with Article 63(1) of the EPGÜ.
252. As already set out in detail, the plaintiffs have demonstrated acts of use, in the form of the offering and distribution of the contested embodiments, at least for the period following the entry into force of the EPGÜ. The question raised by the defendant regarding the possibility of linking the infringement to acts committed prior to the entry into force of the EPGÜ therefore does not arise in the present case with regard to the prospective injunction.

### II. Provision of information

253. The plaintiffs are also entitled to information pursuant to Article 25(a) of the EPGÜ in conjunction with Article 67 of the EPGÜ. There are no objections regarding the manner in which the information is sought.
254. The fact that the information rights provided for in the EPGÜ, as set out in particular in Article 67 EPGÜ and Article 68(3)(a) and (b) EPGÜ in conjunction with Rule 191(1), second alternative, of the Rules of Procedure, also cover periods prior to the entry into force of the EPGÜ has already been set out in detail by the Mannheim Local Chamber (UPC\_CFI\_162/2024, decision of 11 March 2025, Headnotes 6 and 107 – Hurom v. NUC). To avoid repetition, reference is made to the relevant remarks of the Mannheim Local Chamber, with which this Chamber concurs.

### III. Recall

255. The decision regarding the recall from the distribution channels in respect of the products directly infringing the patent is justified under Article 64(2)(b) and (4) of the EPGÜ.
256. In so far as the defendant refers, inter alia, to the duties of loyalty arising from the development cooperation in relation to the recall, it has no right to use the patent in dispute in respect of the contested embodiments arising from this development agreement without a previously concluded licence agreement. Accordingly, the defendant cannot successfully rely on this agreement in relation to the order for recall either.
257. Nor can the defendant successfully argue that the plaintiffs rejected “the very generous settlement offer of a one-off payment of EUR 100,000 for an exclusive licence” (Exhibit K 12) – which was made without any admission of legal liability – for reasons that are objectively incomprehensible. Article 25 of the EPGÜ grants the patent holder, and thus the plaintiffs, the exclusive right to use the patent in dispute. As long as the plaintiffs have not licensed the patent in dispute to the defendant and thereby granted it a corresponding right of use, the defendant is not entitled to such a right of use. Should the defendant nevertheless use the patent in dispute, the plaintiffs have the option of bringing patent infringement proceedings, in which the court may also order the recall of the contested embodiments. There is no apparent obligation on the part of the plaintiffs to accept the defendant’s offer to grant an exclusive licence in return for a one-off payment of EUR 100,000 (see Annex K 12). In particular, no such obligation can be inferred from the development agreement (Annex

rop 10). It is true that, according to this, the parties to the contract agree that the defendant is entitled, in return for a licence fee yet to be agreed, to use the patent in dispute in the field of recreational vehicles *for the duration of the licence agreement* (Annex rop 10, p. 5 at the top and p. 10 at the top, emphasis added). However, this does not mean that the plaintiffs would have been obliged to accept every offer to conclude a corresponding licence agreement. The defendant itself submits that the relevant settlement offer was made without any acknowledgement of a legal obligation. Consequently, no such agreement was subsequently concluded (see Annex K 14).

258. Nor should a recall order be ruled out on grounds of proportionality. Irrespective of the price of individual components, the contested patent does not protect individual components of minor importance, but rather a vehicle frame and thus, ultimately, the basic structure of the caravan, meaning that the caravan cannot otherwise be rendered non-infringing. Against this background, the order to recall is justified even when taking into account the principle of proportionality.

#### IV. Permanent removal from the distribution channels

259. The same applies with regard to the sought-after permanent removal from the distribution channels. In this respect, the sought-after order is based on Article 64(2)(d) and Article 64(4) of the European Patent Convention (EPC).

260. According to the wording of the EPGÜ, the permanent removal of goods from the distribution channels is a separate measure that must be distinguished from the recall. It accompanies the recall, although removal is only an option if the infringer has the practical and legal means to do so. The formulation of specific and sufficiently defined measures must be based on this. The plaintiffs have complied with this following a corresponding court instruction.

261. With regard to the defendant's objection concerning development cooperation, the rejection of the defendant's settlement offer, and the objection of disproportion, reference is made to the comments on the recall to avoid repetition. The defendant raised this objection across the board in relation to the recall, removal from distribution channels and destruction (see Statement of Defence, p. 33).

#### V. Destruction

262. The order for destruction is based on Article 64(2)(e) and Article 64(4) of the EPGÜ.

263. Since the defendant has raised the objection regarding the development cooperation, the non-acceptance of the defendant's settlement offer, and the objection of disproportion here as well, the relevant comments on the recall apply here accordingly.

264. The destruction is intended to reliably prevent the products from entering or re-entering the market (UPC\_CFI\_16/2024 (Düsseldorf Regional Court), judgment of 14 January 2025, p. 31 – Ortovox v. Mammut; UPC\_CFI\_33/2024 (Vienna Regional Court), decision of 15 January 2025, p. 21, para. 4.4. – SWARCO v. STRABAG; Tilmann/von Falck/Tilmann, Unitary Patent, Unified Patent Court, Art. 64 UPC, para. 33). In any event, the relevant claim seeks only the destruction of the infringing items directly or indirectly in the defendant's possession or ownership, meaning that the measure is not disproportionate

## VI. Determination of liability for damages on the merits

265. A finding that the claim for damages is well-founded is possible on the basis of Section 68(1) of the German Patent Act (EPGÜ). The defendant should, in any event, have realised – given the development agreement concluded with the first claimant and the third-party counter-defendant and the intention to patent expressed therein (see Annex rop 10, p. 2) – that, had it exercised due care, its actions infringed the disputed patent, which had since been granted. With regard to the applicable law, the comments on the right to information apply *mutatis mutandis* (see also UPC\_CFI\_162/2024 (Mannheim Regional Court), decision of 11 March 2025, para. 108 – *Hurom v. Nuc*).
266. Insofar as the defendant invokes the limitation period under Article 72 of the EPGÜ, claims relating to all forms of financial compensation must, without prejudice to Article 24(2) and (3) of the EPGÜ, be brought no later than five years after the claimant became aware, or ought to have become aware, of the *last event* giving rise to the claim (emphasis added). In contrast, the English wording refers to the ‘*last fact* justifying the action’. The French version similarly refers to the ‘*dernier fait* justifiant l’action’. This makes it clear that what ultimately matters is the fact or circumstance that gave rise to the cause of action (see also Tilmann/Plassmann/Gundt/W. Tilmann, Unitary Patent, Unified Patent Court, Art. 72 UPC, para. 69; see also Luginbühl/Hüttermann/Hoppe, Art. 72 UPC, para. 54).
267. Since the plaintiffs rely primarily on the test purchase of 20 June 2023 (Exhibit K 17), an earlier starting point for the limitation period could only be considered if the defendant had succeeded in demonstrating that the plaintiffs already had, or should have had, knowledge of all the facts necessary for the examination and demonstration of an infringement of the patent in dispute by the contested embodiments prior to that date. This has not been the case to date. The merely general reference to the development cooperation between the parties since 2016 is no more sufficient for this purpose than the blanket assertion that the plaintiffs or their legal predecessors were aware of, or should have been aware of, all of the defendant’s actions since 8 September 2018.
268. The extent to which, in addition to Article 72 of the European Patent Convention (EPC), recourse may be had to the shorter German three-year limitation period (Sections 195, 199 of the German Civil Code (BGB)) does not require further discussion in the present case. Even if this were the case, assuming in favour of the defendant, this limitation period is also linked to knowledge or the obligation to have knowledge of the facts constituting the infringement. On this basis, the above considerations apply *mutatis mutandis*.

## VII. Provisional damages

269. Pursuant to Section 68 of the German Patent Act (EPGÜ) in conjunction with Rule 119 of the German Patent Court Rules of Procedure (VerfO), the court may award provisional damages to the successful party, subject to conditions determined by the court, which are intended to cover at least the provisional costs of the damages and compensation proceedings incurred by the successful party.
270. On this basis, the provisional damages of EUR 100,000 claimed by the plaintiffs appear reasonable.
271. Apart from the fact that the defendant has already offered the same amount out of court as part of a settlement offer for an exclusive licence to the patent in dispute,

the defendant has also undisputedly admitted out of court that, by the end of 2023, it had sold just under 600 caravans of the 'DESEO' model at a list price of EUR 28,100 and 70 caravans of the 'AZUR' model at a price of EUR 41,400.

272. The defendant does not, in fact, claim that these sales figures are inaccurate. Instead, it merely invokes the need for confidentiality surrounding the out-of-court settlement discussions and a resulting prohibition on disclosure, as the defendant sees it. The court has already set out in detail, in the context of its discussion of the acts of use, why this objection is unsuccessful. Reference may be made to the statements made there to avoid repetition.

#### VIII. Compensation

273. The fact that any financial compensation for the use of the published EP application also falls within the jurisdiction of the Unified Patent Court follows from Article 32(1)(f) of the UPC Agreement ("actions relating to the use of an invention prior to the grant of a patent").
274. Since such compensation is not provided for in either the EPatVO or the EPGÜ, the court must, on the basis of Article 24(1)(c) EPGÜ, the court must apply the provision of Article 67 EPC, which grants Member States discretion as to the form such compensation takes (see also the table in Tilmann/Plassmann/Grabinski/W. Tilmann, Article 32 EPGÜ, para. 103).
275. As with the right of prior use, there is as yet no uniform regulation on this matter. It is therefore initially for the claimant seeking such compensation to set out the conditions for such compensation in each of the Member States in question. The claimants complied with this requirement at the hearing only in relation to the Federal Republic of Germany. There, pursuant to Article II(1)(1) of the IntPatÜG, the applicant for a published European patent application may claim reasonable compensation from any person who has used the subject-matter of the application, even though that person knew or ought to have known that the invention used by them was the subject-matter of the European patent application. As regards the other Member States at issue, there is a lack of submissions, so that the plaintiffs were to be awarded appropriate compensation on the merits solely in respect of the Federal Republic of Germany, and the action was to be dismissed in all other respects.

#### IX. Threat of a penalty payment

276. The requested imposition of a penalty payment for non-infringement ("up to EUR 250,000", Art. 63(2) EPGÜ) is not objectionable.
277. The general threat of coercive measures included in the decision gives the Chamber the necessary flexibility to respond to any breaches of this order, taking into account the interests of both parties and the seriousness of the breach (UPC\_CFI\_16/2024 (Düsseldorf Regional Court), decision of 14 January 2025, p. 39 – Ortovox v Mammut).

X. Decision on costs

278. Pursuant to Article 69(2) EPGÜ in conjunction with Rule 118(5) VerfO and Rule 265(2)(c) VerfO, a decision on costs was to be made.
279. Since the plaintiffs initially extended their infringement claim to the Republic of Ireland but subsequently withdrew that claim as the proceedings progressed, it is justified to order them to bear part of the costs of the infringement claim and, for the remainder, to order the defendant to pay the costs.
280. The counterclaim for annulment and the third-party counterclaim have been unsuccessful. The defendant must therefore bear the costs thereof.

XI. Reimbursement ceiling

281. The setting of the ceilings for reimbursable legal representation costs is based on the decision of the Administrative Committee on the ceilings for reimbursable costs of 24 April 2023 (D - AC/10/24042023\_D).

XII. No security

282. Pursuant to Art. 82(2) EPGÜ, R. 118(8) sentence 2 VerfO, the court may make any order or measure it is to determine subject to the provision of security.
283. As the wording of the aforementioned provision makes clear, the Chamber has discretion when ordering security, whereby the claimant's interest in the effective enforcement of its intellectual property right must be weighed against the interest in the effective enforcement of potential claims for damages in the event of a subsequent setting aside of the judgment.
284. Each case must therefore be assessed on its own merits. The factors to be taken into account when considering whether to order the provision of security include the claimant's financial situation, which may give rise to a legitimate and genuine concern that, in the event of the first-instance decision being set aside or amended, a potential claim for damages cannot be enforced and/or executed, or can only be done so at disproportionate expense. Whether and to what extent such factors exist must be determined, just as in an application for security under Rule 158 of the Rules of Procedure, on the basis of the facts and arguments put forward by the parties. If the Chamber makes an order or measure conditional upon the provision of security, this serves to protect the defendant's position and potential rights. This protection must be weighed against the burden placed on the claimant by the order to provide security. Against this background, it is incumbent upon the defendant to put forward facts and arguments as to why, in the specific case, it appears appropriate to make the order or measure, pursuant to Rule 118(8) of the Constitutional Court Rules of Procedure, conditional upon the provision of security to be determined by the court. If the defendant has complied with this, it is incumbent upon the claimant to contest these facts and grounds in a substantiated manner, particularly as the claimant generally has knowledge of and evidence regarding their financial situation. Likewise, it is the claimant's responsibility, where appropriate, to explain why, despite the reasons put forward by the defendant, his interest in enforcing his intellectual property right outweighs the requirement for a security deposit (see UPC\_CFI\_16/2024 (Düsseldorf Regional Court), judgment of 14 January 2025 – Ortovox v Mammut; UPC\_CFI\_363/2024 (Düsseldorf Regional Court), Dec-

Decision of 10 October 2024, ORD\_598458/2023 – Seoul Viosys v. expert), regarding the application for security pursuant to Rule 158 of the Rules of Procedure: UPC\_COA\_328/2024, Order of 26 August 2024 – Ballinno v. Kinexon Sports; UPC\_CFI\_373/2024 (Düsseldorf Regional Court), order of 5 August 2024 – SodaStream v. Aarke; UPC\_CFI\_514/2023 (Munich Regional Court, Panel 1), order of 23 April 2024 – Volkswagen v. NST, with further references).

285. On the basis of these principles, the defendant has not put forward any grounds that would give rise to making enforcement in the present case subject to the provision of security. The Chamber has therefore refrained from ordering such enforcement security.

I. No referral to the Court of Justice of the European Union (CJEU)

286. There is no reason to stay the proceedings pursuant to Rule 266(5), first sentence, of the Rules of Procedure and to refer the question formulated by the defendants to the ECJ for a preliminary ruling pursuant to Article 21 of the European Patent Convention in conjunction with Article 267 of the TFEU.

287. In the Chamber's view, there is no reasonable doubt that, as an international treaty, the EPGÜ must be assessed in accordance with the principles of the Vienna Convention on the Law of Treaties. The question of ordering final injunctions where only a threatened infringement has been established is not relevant to the decision in the present case, since the Board has found that the patent in dispute has been infringed. The same applies to the question of procedural powers in relation to patent infringements under national law. Since the patent in dispute is undisputedly not based on joint development, it does not fall within the scope of Regulation (EU) No 1217/2010 on the application of Article 101(3) of the Treaty on the Functioning of the European Union to certain categories of research and development agreements. Consequently, the question concerning the interpretation of that Regulation is also irrelevant to the decision in the present case. The question seeking to clarify the scope of the powers under Article 56 et seq. of the EPGÜ, taking into account the free movement of goods, and linked to the (alleged) failure to transfer the legal status as licensor upon the assignment of the patent in dispute, is irrelevant to the decision simply because the defendant was not granted a licence to the patent in dispute. For this reason, the further question raised as to whether the EU law doctrine of 'implied powers' requires an interpretation of Article 32(1)(a) of the EPCU under which a counterclaim relating to licences may also be directed against a person not involved in the infringement proceedings is also irrelevant to the decision. As explained, the defendant cannot rely on a right of prior use in Germany, so that the scope of the ECJ's case-law on EU-wide exhaustion is also irrelevant in the present case.

288. In so far as the defendant wishes the Court of Justice to clarify whether Article 11(1) of the Enforcement Directive (Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights) is to be interpreted that only the continuation of the established act of infringement may be prohibited, whilst acts of infringement that have not been established cannot be prohibited, the Chamber sees no grounds for a reference to the ECJ in this regard either. Firstly, Article 11(1) of the Enforcement Directive merely sets a minimum standard: Member States are to ensure that the competent courts may issue an order against the infringer upon finding an infringement of an intellectual property right. This precludes the conferral of further powers, for example in the case

an imminent infringement. Secondly, as explained, the act of offering and placing on the market simultaneously gives rise to a rebuttable presumption that the defendant also uses the contested embodiment or imports or possesses it for the purposes of offering, placing on the market or using it. If, as in this case, this presumption is not rebutted, the basis for the orders issued is, in this respect too, the finding of a patent infringement. The question raised by the defendant as to whether Article 63(1) of the EPGÜ also opens up the possibility of a definitive injunction in the case of a mere threat of patent infringement is therefore irrelevant in the present case.

289. Why, in determining the scope of the term 'offer' in Article 25(a) of the EPGÜ, reference should be made to the EU Trade Mark Regulation (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the EU trade mark, hereinafter: UMV) and the existing commentary literature on it is not clear. Article 9(3) governs the powers of prohibition arising from a Union trade mark, whereas Article 25 EPGÜ confers certain exclusive rights on the patent proprietor. These are therefore, in each case, fundamentally independent provisions covering different areas of industrial property rights and distinct regulatory fields, each of which must, in principle, be interpreted on its own terms.

J. No order regarding the reservation of national legal remedies to avert enforcement

290. The defendant's further request that the remedies and options available to the defendant under the relevant national law to prevent enforcement be reserved, in so far as the enforcement proceedings are governed by the law of the Contracting Member States, does not give rise to any order. Whether the defendant has access to the relevant national remedies and options is to be determined, where necessary, by the competent national court or enforcement authority on the basis of the relevant provisions.

DECISION:

- A. In so far as the action initially also covered the territory of the Republic of Ireland, the partial withdrawal of the action is permitted.
- B. The defendant's objection is dismissed, in so far as a decision on it was still pending.
- C. The defendant is ordered
- I. refrain from manufacturing a vehicle frame comprising at least one structural component, wherein the structural component is produced as a cast part in a mould and the mould reproduces the three-dimensional external shape of the structural component, wherein the structural component is formed from a self-expanding foam resin,
- in the territory of the Federal Republic of Germany, the French Republic, the Italian Republic and the Republic of Slovenia
- manufacturing, placing on the market, offering for sale, using and/or importing, exporting and/or possessing for the aforementioned purposes,
- wherein the structural component is at least partially coated on the outside with a protective layer, the structural components forming a load-bearing part of the frame;
- (Claim 1 of EP 3 356 109)
- II. in the event of a breach of the order pursuant to C. I., to pay the court a penalty of up to EUR 250,000 for each instance of breach;
- III. to provide the plaintiffs with information regarding the acts of infringement committed since 8 September 2018 in accordance with C. I., specifying
1. the origin and distribution channels of the infringing products;
2. the quantities produced, manufactured, delivered, received or ordered, and the prices paid for the infringing products
- and
3. the identity of all third parties involved in the manufacture or distribution of the infringing products;
- IV. the products referred to in C. I., which have been delivered since 9 April 2022, within a period of 30 days following service of the notice within the meaning of Rule 118(8), first sentence, of the Rules of Procedure and, where applicable, the certified translation, at the defendant's expense

1. to recall the products from the distribution channels by notifying the third parties from whom the infringing products are to be recalled that this Court has found that the products infringe European Patent EP 3 356 109, whereby the defendant must give a binding undertaking to the third parties to reimburse the costs incurred, to bear the transport costs, to reimburse the customs and storage costs associated with the return of the products, and to take the products back,
 

and
  2. to remove them definitively from the distribution channels, by the defendant, noting that this Court has found that the products infringe European Patent EP 3 356 109, instructing third parties who are commercial purchasers but not end users, with regard to the products referred to in C. I. to cancel all orders relating to the products referred to in C. I. and to submit to the court and the plaintiffs, within the aforementioned period of 30 days following service of the notice within the meaning of Rule 118. (8) sentence 1 of the Rules of Procedure and, where applicable, the certified translation;
- V. to destroy the products referred to in C. I. which are in the direct and/or indirect possession of and/or owned by the defendant, or to hand them over to a bailiff to be appointed by the plaintiffs for the purpose of destruction at the defendant's expense;
  - VI. to pay the plaintiffs a sum of EUR 100,000 as provisional damages;
  - VII. to reimburse the plaintiffs for all losses incurred by them as a result of the actions referred to in C. I. in the period since 9 April 2022;
  - VIII. to pay the plaintiffs reasonable compensation for the period from 8 September 2018 to 8 April 2022 for acts as set out in C. I. concerning the Federal Republic of Germany.
- D. In all other respects, the claim is dismissed.
  - E. The third-party counterclaim is dismissed.
  - F. The counterclaim for annulment is dismissed.
  - G. The costs of the action shall be borne by the plaintiffs in the proportion of 12.5% each and by the defendant in the proportion of 75%.
 

The costs of the third-party counterclaim and the counterclaim for annulment shall be borne by the defendant.
  - H. The value in dispute for the claim and the counterclaim for annulment is set at EUR 500,000 in each case.

- I. The upper limit of the recoverable legal representation costs is set at EUR 112,000 for both the claim and the counterclaim for annulment.
- J. The orders under points C. I. to C. VI. shall only be enforceable once the claimants have notified the court of which part of the orders they intend to enforce and have submitted a certified translation of the orders into the official language of the Member State in which enforcement is to take place, and once the defendant has been served with the notification and the (relevant) certified translation.

Düsseldorf, 10 April 2025 NAMES AND SIGNATURES

|   |  |
|---|--|
| <p>Presiding Judge Thomas</p>                   | <p><b>Ronny Thomas</b> Digital signed by Ronny Thomas<br/>Date: 4 April 2025 15:34:13 +02:00</p>                       |
| <p>Legally qualified judge Dr Thom</p>          | <p><b>Anna Bérénice Dr.THOM</b> Digitally signed by Anna Bérénice Dr THOM<br/>Date: 04/04/2025 15:48:15 +02:00</p>     |
| <p>Legally qualified judge Brinkman</p>         | <p><b>Edger Frank BRINKMAN</b> Digitally signed by Edger Frank BRINKMAN<br/>Date: 4 April 2025 17:03:59 +02:00</p>     |
| <p>Technically qualified judge Ashley</p>       | <p><b>Graham William Ashley</b> Digitally signed by Graham William Ashley<br/>Date: 7 April 2025 09:37:03 +02:00</p>   |
| <p>For the Deputy Chancellor Boudra-Seddiki</p> | <p><b>Rachida Boudra-Seddiki</b> Digitally signed by Rachida Boudra-Seddiki<br/>Date: 7 April 2025 09:58:57 +02:00</p> |

INFORMATION ON APPEALS:

Any party whose claims have been rejected in whole or in part may lodge an appeal against this decision with the Court of Appeal within two months of the decision being served (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 Assistant Registrar at the request of the enforcing party, Rule 69 of the Rules of Procedure.

This decision was pronounced in open court on 10 April 2025. Presiding Judge Thomas