

# Kluwer Patent Blog

## First ever permanent injunction at the UPC as the Düsseldorf Local Division issues its final decision in Franz Kaldewei v Bette

Eden Winlow (Bristows) · Wednesday, July 3rd, 2024

In a [decision](#) issued today, the Düsseldorf Local Division has ordered the first ever permanent injunction at the UPC following a hearing on 16 May 2024. The injunction covers seven UPC member states: Austria, Belgium, Denmark, France, Italy, Luxemburg and the Netherlands. Notably, Germany was not included in the claim.

The patent in question in this case is Franz Kaldewei's [EP 3375337](#) for a “Bathtub Sanitation Device”, with the UPC having jurisdiction over this classical European Patent during the transitional period.

This was one of the first infringement cases filed when the UPC opened its doors on 1 June 2023. It is impressive that the Court has managed to keep to its goal of issuing a final or “merits” decision within approximately a year of proceedings being issued. In pursuit of that goal in this case, the Court rejected a request by the defendant for a retrospective extension of a deadline to submit documents, citing proper preparation for the oral hearing in its reasoning. The ability to obtain fast relief and a wide-ranging injunction will be attractive to potential claimants but we will have to wait and see if the UPC can maintain this level of efficiency as the caseload continues to build.

In this final decision, the Court found that the patent was invalid in its granted form due to obviousness, but upheld an auxiliary request as valid. It is on the basis of this auxiliary request that the injunction has been ordered. In its reasoning, the Court appears to follow a rather EPO-style approach to validity (discussed in more detail below) and whilst this may be an indication of the direction the UPC will take in assessing validity, only the outcome of any appeals will begin to give true clarity on the correct tests to be applied.

The Court also rejected a prior use defence from Bette, interpreting this provision rather narrowly.

Please note that quotes from this decision are based on an English machine translation of the official German language decision, so their accuracy cannot be guaranteed.

### Validity

On claim construction, the Court appears to adhere to the guidance set out by the UPC Court of

Appeal in *10x Genomics v Nanostring*, which stated “*the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim*”. Here, the Court references the patent description throughout to support their findings on what the notional skilled person would understand the scope of the claims to be.

In relation to novelty, the Court states the following, with reference to a prior decision (CFI\_452/2023) by the same Local Division:

*“A technical teaching is new if it deviates from the prior art in at least one of the known features. Only that which is directly apparent to a person skilled in the relevant technical field from the publication or prior use is anticipated in the prior art. Findings that a person skilled in the art only obtains on the basis of further considerations or by consulting other publications or uses are not prior art.”*

At first glance, this appears similar to the EPO’s clear and unambiguous disclosure requirement. In fact, when applying the above test to the facts, the Court states on a number of occasions that “*the skilled person cannot directly and unambiguously infer...*” (emphasis added).

Regarding inventive step, the Court states the following:

*“Only a person skilled in the art who is inventive is rewarded with a patent, see Art. 56 EPC. This inventive solution begins beyond the area which, based on the state of the art, is defined by what the skilled person with average knowledge, skill and experience can routinely develop and find in the relevant technical field (see Benkard/Söldenwagner, EPC, 4th ed., Art. 56 para. 9). An invention is deemed to exist if it does not result from the usual approach of the person skilled in the art, but requires an additional creative effort on their part”*

In applying this to the claim as granted, the Court found that based on DE 954 (the prior art) “*it is a routine consideration for the person skilled in the art, who has been faced with the task of specifying a sanitary tub device which can be easily formed in different sizes and has good functional properties, to form the profile pieces as well as the tub support from rigid plastic foam*” (emphasis added).

This reasoning appears very akin to the EPO’s problem-and-solution approach, which includes establishing an “objective technical problem” to be solved, and considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person. The Court of Appeal notably steered clear of adopting such a rigid approach in *10x Genomics v Nanostring*.

In contrast to the claim as granted, the auxiliary request was found to be novel and inventive.

### Contributory Infringement

On the issue of contributory infringement, the Court stated that there is a double territorial requirement in that the offer and/or delivery of the essential element must take place in the UPC territory and the invention must also be used in the UPC territory. They acknowledged that it is questionable whether it is sufficient for this that the offering/delivery exists in one of the contracting member states and is intended for direct use of the invention in another, different, member state but found that it was not necessary to decide this question in the present case because

the defendant also fulfilled the objective element of contributory patent infringement according to the narrower view. We will therefore have to wait for further case law to clarify this point.

### Prior Use

The Court rejected a prior use defence raised by Bette. Art. 28 UPCA stipulates:

*“any person, who, if a national patent had been granted in respect of an invention, would have had, in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention”* (emphasis added).

The Court drew attention to the narrow wording emphasised above, and found that the user of the technology according to the invention can only invoke the rights granted to them by the respective national regulations of the respective contracting member states.

In this respect, the existence of a right of prior use must be claimed for *each* of the protected states under their own conditions. In short, there is no ‘European’ or ‘UPC’ right of prior use, and instead this falls to national law. As the Defendant had only submitted information on the ownership of the invention and its utilisation within Germany (which was not included in this claim) the defence failed.

### Conclusion

There is a lot in this decision to be digested but it gives helpful guidance on the tests that are likely to be applied in final decisions at the UPC. An appeal is widely expected so hopefully, the Court of Appeal will clarify this guidance soon too. With several other final decisions due in the coming weeks (including *Dexcomm v Abbott* expected this Friday) this will be a very busy time for European patent litigators keeping up to date with the UPC.

---

*To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).*

## **Kluwer IP Law**

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

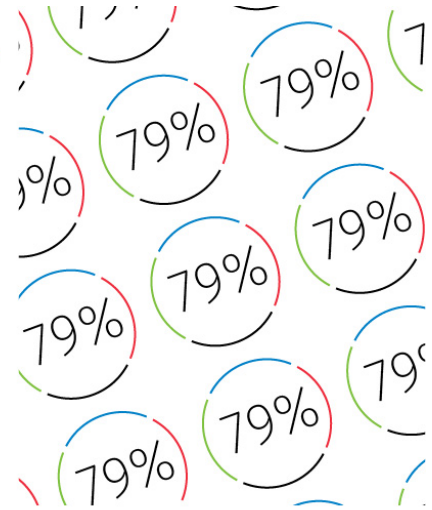
Learn how **Kluwer IP Law** can support you.

---

79% of the lawyers think that the importance of legal technology will increase for next year.

**Drive change with Kluwer IP Law.**

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT  
The Wolters Kluwer Future Ready Lawyer  
Leading change

This entry was posted on Wednesday, July 3rd, 2024 at 3:45 pm and is filed under [\(Indirect\) infringement](#), [Case Law](#), [Infringement](#), [Injunction](#), [Prior use right](#), [Revocation](#), [Unitary Patent](#), [UPC](#). You can follow any responses to this entry through the [Comments \(RSS\) feed](#). You can leave a response, or [trackback](#) from your own site.