EIP

Ortovox vs Mammut

Local Division Düsseldorf

Order dated 14th January 2025

UPC_CFI_16/2024, ACT_2379/2024, ORD_63035/2024[1]

Infringement Action and Counterclaim for Revocation

Background

There is a **procedural history** to this 1st instance decision on the merits. First, the Local Division Düsseldorf (in the following "LD DUS") granted an **ex parte PI** in favor of patent owner Ortovox Sportartikel GmbH (in the following "Ortovox" or "Claimant") in December 2023 (we reported on this here[2]). This was then **reviewed and confirmed** in April 2024 (we reported on this here[3]). Mammut Sports Group AG and Mammut Sports Group GmbH (in the following "Mammut" or "Defendants") **appealed the PI** decision without success (CoA decision in September 2024, we reported on this here[4]).

Ortovox started proceedings on the merits (infringement action) and Mammut filed a counterclaim for revocation - this report summarizes the main points of the order in this proceeding on the merits.

Ortovox was successful (again).

The patent in suit (EP 3 466 498 B1) protects an "avalanche transceiver". The Claimant's action is directed against the offer and sale of the avalanche transceiver "Barryvox S2". The Defendants are currently offering the "Barryvox S2" with a notice that voice control is not available in Germany and Austria. To activate voice control for the first time, users must use the "Barryvox App" and connect it to the "Barryvox S2." This requires enabling location tracking on the device running the app (e.g. a smartphone). The location tracking

checks if the user is in a country where voice control should not be available (e.g., Germany or Austria). However, if voice control is once activated abroad, it can be used
p2 temporarily in Germany and Austria.

Decision

~~Scope of protection~~

The Defendants argued that the “sound signal” of the patent in suit only communicates “right/wrong” on the semantic level. Other “sound patterns” are not covered by the term “sound signal” of the patent in suit.

Concerning a feature, where a “sound signal is suppressed” during the output of a voice message, it was argued that the sound signal must exist for such “suppression” and that it is not sufficient if the sound signal is not generated in the first place. So, according to the Defendants, the Claimant limited itself to the simultaneous signals (sound and speech signal) and their relative volume or suppression.

For the ~~interpretation~~ of the patent in suit the Court (with reference to Art. 69 EPC) made clear that not only the wording, but also the description and the drawings must always be taken into account. The Court concluded that there is no indication in the patent in suit of the distinction between "sound signals" and "sound patterns" advocated by the Defendants. If they are associated with the search for at least one other avalanche transceiver, "sound patterns" are therefore also "sound signals" within the meaning of the patent in suit.

In relation to the dispute concerning the meaning of “suppression” the Court stated that suppression of the sound signal requires that the sound signal is no longer acoustically perceptible. The technical means used for this purpose are left open in the patent in suit. At no point does it deal with the more detailed technical design of the suppression of the sound signal. The scope of protection therefore covers both designs in which the volume of the sound signal is temporarily set to zero and those in which the signal is temporarily no longer generated.

~~Infringement~~

The Defendants denied the existence of a “sound signal” in the attacked embodiment. There, a special (patented) “sound pattern” is used and these sound patterns have a semantic content that is clearly excessive compared to simple sound signals within the meaning of the patent in suit.

Furthermore, according to the Defendants, in the attacked embodiment, the sound

pattern is completely cancelled while a voice message is being output. This involves switching to a different generator. Therefore, nothing is "suppressed" – the different
p3 signals do not exist simultaneously.

In its decision, the Court found that the Defendants had infringed the patent. The Court held that the sound patterns used in the attacked embodiment are sound signals different from voice messages and thus sound signals within the meaning of the patent in suit.

Further, the Court explained that it is undisputed that the attacked embodiments have two different signal sources, namely one for sound patterns and the other for acoustic speech, whereby during operation in search mode **only one** of the two sources is selected and reproduced via the loudspeaker. If the voice message is output in the attacked embodiment, the sound signal is therefore not output. In other words, its generation is temporarily interrupted and thus suppressed within the meaning of the patent in suit.

Also, the Court made clear that the fact that voice control is initially deactivated in the version of the "Barryvox S2" that is now commercially available and must be activated using the "Barryvox App" does not exclude it from the scope of protection of the patent in suit. In addition, if an activation abroad (meaning other countries than Germany and Austria) has taken place, the voice control is also available at least temporarily after returning to Germany or Austria. The Defendants have not taken effective measures to prevent this. They must therefore be held responsible for such activation of the attacked embodiment. The Court phrased a respective guiding principle as follows:

"If a device in its offered or marketed state is not yet capable of making use of all the features of the patent claim because it still requires the activation of certain functions by the customer, the alleged infringer must accept responsibility for the behaviour of his customers if he induces them to such an activation or if he deliberately exploits such an activation by the customer in the knowledge that such an activation will take place."

~~Objection of earlier right~~

In addition, the Defendants argued that if the term "sound signal" is interpreted broadly in the interpretation of the patent in suit in the sense that sound patterns are also covered, then a corresponding interpretation must also be applied to EP 2 527 011 A1 (EP 011; patent owned by Defendants company group). The Defendants referred to German national case law in which the proprietor of a later patent can not prohibit the proprietor of an earlier patent from using his property right if both patents were identical in terms of their features.

p4 The Court held that it does not need to be decided whether the ~~objection of earlier right~~ raised by the Defendants can be raised before the UPC. The Court explained that according to the principles developed by the German Federal Court of Justice, the earlier right can only be invoked by the person who exclusively uses its teaching and does not make use of additional features that are only taught by the later property right (UPC_CoA_182/2024, order of 25 September 2024, para. 217 - Mammut v. Ortovox with reference to BGH, GRUR 2009, 655, para. 27 - Trägerplatte). In the present case not all features of the claims of the patent in suit are anticipated in EP 011.

In relation to EP 011, the Court also left it open whether the Defendants can defend themselves before the UPC against the allegation of direct patent infringement by arguing that the attacked embodiment is already disclosed in the prior art based on a certain interpretation (so-called "Gilette Defence" cf: UPC_CFI_373/2023 (LK Düsseldorf), decision dated 31 October 2024, p. 23 - SodaStream v. Aarke). The mere use of sound signals or sound patterns known from the prior art is not in any case sufficient – EP 011 does not disclose the creating of voice messages as used in the attacked embodiment. The attacked embodiment is therefore not anticipated with all its features in the prior art.

~~Counterclaim for revocation~~

The Defendants raised multiple novelty attacks in their counterclaim for revocation as well as attacks concerning inventive step. According to the Defendants the solutions stated in the patent in suit had been known to the skilled person for a long time. The Defendants also argued that there was a lack of sufficient disclosure pursuant to Art. 138(1)(b) EPC, which was dismissed by the Court. In its decision, the Court dealt with the prior art documents and came to the conclusion that they are not novelty-destroying. The Court also held that the Defendants' submission is not suitable for calling the inventive step into question.

~~Order~~

The Defendants were ordered to cease and desist, destroy, recall and remove the infringing goods in Germany and Austria. Furthermore, the Defendants were ordered to provide information and render accounts and to pay damages. The counterclaim for revocation was dismissed.

In relation to the ordered destruction, the Court pointed out (second guiding principle) that "destruction is intended to reliably prevent the products from entering or re-entering the market. The possibility of a software-based deactivation of a certain function necessary for the realisation of the claimed technical teaching can only speak against destruction if it is ensured that the attacked embodiment cannot be put into a patent-infringing state again when such a solution is used".

An appeal can be filed (within 2 months) – it remains to be seen whether the decision will be appealed.

[1] https://www.unified-patent-court.org/en/node/49400

[2] EX PARTE PI GRANTED

[3] REVIEW of EX PARTE PI

[4] UPC Court of Appeal Confirms Provisional Injunction for Ortovox