



Mannheim Local Division
UPC_CFI_745/2024

Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 6 June 2025
concerning EP 4 108 413
concerning App_20490/2025
(R. 263 RoP)

CLAIMANT/APPLICANT:

Sunstar Engineering Europe GmbH, Emil-Fischer-Straße 1 - 86641 - Rain am Lech - DE,

represented by: Holger Stratmann

DEFENDANT:

CeraCon GmbH, Talstraße 2 - 97990 - Weikersheim

represented by: Matthias Sonntag

PATENT AT ISSUE:

European patent EP 4 108 413

PANEL/DIVISION:

Panel of the Local Division in Mannheim

DECIDING JUDGES:

This order is issued by the legally qualified judge and judge-rapporteur Böttcher

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement action – R. 263 RoP

BRIEF SUMMARY OF THE FACTS:

Claimant applies for leave to change its claim for damages to the extent that it also includes profits from sales of sealing material and services/maintenance for the allegedly infringing products.

In its statement of claim, Claimant alleges that CeraFLOW machines of Defendant indirectly infringe the patent-in-suit.

The requests in the operative part of the statement of claim read, in part, as follows:

[...]

II.

[...]

2.2 provide counsel for Claimant, within 4 weeks after service of the judgement, with an electronic Excel table, prepared and verified by an independent auditor – or any other professional the Court deems suitable for providing such statement –, about the extent to which the Defendant has supplied consumables, in particular sealing material, in particular the sealing material CeraPUR®, since 26 August 2023 to customers for use in a dispenser characterized under II.1., stating in each case

- (i) the origin and distribution channels of the infringing products, including names and addresses of suppliers and other prior owners as well as of commercial customers and points of sale for which the infringing products were destined;
- (ii) the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the infringing products;

in particular

- the individual deliveries, broken down by delivery quantities, times and prices and the respective product designations as well as the names and addresses of the customers;
- the turnover, the gross margin and the contribution margin generated by the Defendant with the sale of these products;
- the individual offers, broken down by quantities, times and prices and product designations as well as the names and addresses of the commercial offer recipients;
- the advertising carried out, broken down by advertising media, their circulation, distribution period and distribution area, and in the case of Internet advertising, the domain, access figures and placement periods of each campaign;

and

- (iii) the identity of any third person involved in the production or distribution of the

infringing products;

in particular

- the names and addresses of the commercial buyers for which the products were intended,

whereas copies of the relevant documents (namely invoices, alternatively delivery receipts) are to be submitted as proof of the information, whereas confidential details beyond the information identified above may be redacted.

- 2.3 provide counsel for Claimant, within 4 weeks after service of the judgement, with an electronic Excel table, prepared and verified by an independent auditor – or any other professional the Court deems suitable for providing such statement –, about the extent to which the Defendant has concluded service contracts, since 26 August 2023, for equipment of the type described in I.1. with the commercial customers listed in II.2., in particular by providing an organised list of the individual service contracts, copies of all relevant service contracts being provided by the Defendant as evidence, with details requiring confidentiality being redacted;

[...]

IV. Defendant is liable

[...]

2. for all damages resulting from the patent infringement referred to under II.1. that occurred since August 26, 2023.

[...]

In the grounds of its statement of claim, with respect to the request for information on consumables and service contracts, Claimant argues that an infringer has to return any (and all) unfair profits made from the infringement in order not to benefit from the infringement at all. In Claimant's opinion, this includes profits that are causally linked to the patent infringement, i.e. profits that the infringer has made, for example, from additional business generated as a result of the patent infringement. Since a claimant has the possibility to calculate damages on the basis of the infringer's profits, Claimant is of the opinion that, in the case at hand, it is entitled to the information sought about the sales of CeraPUR sealing materials and the service contracts for the allegedly infringing machines, because such business is (potentially) additional business generated as a result of the alleged patent infringement (cf. SoC, paras. 168 et seq.).

In its application pursuant to R. 263 RoP, which was filed on 29 April 2025 together with the reply in the infringement proceedings, Claimant argues that, due to an obvious oversight, in the request regarding damages (request IV.) in the statement of claim, no reference was made to the CeraPUR sealing materials and the service contracts, whereas, from the statements in paras. 165 et seq. of the statement of claim, it was sufficiently clear that Defendant is liable for damages in respect of the sale of CeraPUR and the provision of services under the service contracts. The Claimant is of the opinion that a corresponding clarification of request IV. is admissible from the outset and submits the present application pursuant R. 263 RoP as a precautionary measure and as an auxiliary request regarding request IV. In this regard, Claimant argues that the requirement set out in R. 263 RoP are met. An obvious oversight could not constitute negligence in the meaning of R. 263.2 (a)

RoP, taking into account its rationale to protect the front-loaded procedure. In addition, an obvious error could not hinder Defendant's ability to defend itself within the meaning of R. 263.2 (b) RoP, taking into account that Claimant has set out in its statement of defence all relevant facts and legal arguments.

Defendant opposes the request. In Defendant's opinion, the requirements set out in R. 263 RoP are not met. In particular, an obvious oversight can hardly qualify as not being avoidable when reasonable diligence were applied.

For further details, reference is made to the pleadings of the parties.

Claimant requests,

to grant leave regarding the claim for damages, motion IV., to also refer to profits it made from the sale of the CeraPUR sealing material intended to be used for the CeraFLOW machine and from the performance of services for the CeraFLOW machines, as claimed in motion IV.2. provided in the Reply to the Statement of Defense, which states:

IV. Defendant is liable

- 1. for all damages resulting from the patent infringement referred to under II.1. that occurred since August 26, 2023;*
- 2. for all damages resulting from the sale of the CeraPUR sealing material for use with the CeraFLOW machines and/or the performance of service/maintenance for the CeraFLOW machines since August 26, 2023;*

Upon enquiry by order of 30 April 2025, Claimant confirmed that it seeks damages only in respect of the sealing material and service/maintenance relating to CeraFlow machines which have been put on the market in a patent infringing manner and, therefore, does not consider the sale of sealing materials and service/maintenance as such to be patent infringing. As an auxiliary request, should the court deem such clarification necessary, Claimant relies on request IV. as amended as follows:

IV. Defendant is liable

1. for all damages resulting from the patent infringement referred to under II.1. that occurred since August 26, 2023;
2. for all damages resulting from the sale of the CeraPUR sealing material for use with the CeraFLOW machines and/or the performance of service/maintenance for the CeraFLOW machines which were placed on the market in a patent infringing way according to II.1 since August 26, 2023;

Defendant requests:

the application to be dismissed.

REASONS FOR THE ORDER:

1. Request IV. of the operative part of the statement of claim as originally filed is to be interpreted as seeking the declaration that the general requirements for damages are generally met,

which in particular covers damages arising from sales of CeraPUR sealing materials and from service/maintenance contracts, if and insofar as these are relevant for the assessment of the amount of damages. Request IV. as originally filed is not to be interpreted as already seeking a positive finding that damages arising from sales of CeraPUR sealing materials and from service/maintenance contracts actually exist.

In this respect, the clarifying amendment to the wording of the request IV. is admissible without the need of an application pursuant to R. 263 RoP and permitted if necessary.

a) Claimant's request IV. as originally filed with the statement of claim already has to be interpreted as to encompass all damages arising from the alleged infringing acts.

Claimant's statement of claim contains a request for information regarding CeraPUR sealing materials and service/maintenance contracts. In this context, in its statement of claim, Claimant has elaborated on its (potential) entitlement to damages with regard to profits stemming from sales of CeraPUR sealing materials and from service/maintenance contracts for the allegedly infringing machines.

Against this backdrop, the wording "all damages resulting from the patent infringement" must not be construed narrowly as to cover only direct profits from sales of the allegedly infringing machines. There is no indication that any part of damages to which the Claimant may be entitled and the amount of which is to be determined in the separate proceedings for determining the damages pursuant to R. 125 et seq. RoP should be excluded from the substantive scope of request IV. as originally filed. Therefore, should damages extend to the afore-mentioned profits, a general obligation to pay damages established in accordance to request IV. as filed also forms the base for damages in this respect without detailing which sort of damages actually exist.

The clarification of the mere wording which does not alter the substance of the claim does not constitute a change of claim within the meaning of R. 263 RoP.

b) Should this be viewed differently, leave to change the claim accordingly is granted in this regard.

If request IV. is not to be interpreted in the aforementioned sense, its wording is at least an obvious oversight. For the reasons outlined above, it is sufficiently clear that Claimant wishes to have the option of calculating damages based on the infringer's profits, including the profits that the Defendant has made with CeraPUR sealing materials and service/maintenance for infringing machines, if attributable to the infringement. Should Claimant decide to demand the Defendant's profits from the infringement as damages, and should these profits include profits from the sales of CeraPUR and/or from services/maintenance, it is also sufficiently clear from the statement of claim that Claimant also wishes to rely on request IV. as a general declaration of liability for damages in this regard, meaning that the general requirements for damages do not need to be re-examined in this event.

In accordance with the purpose of R. 263 RoP to protect the front-loaded proceedings, such obvious oversights cannot automatically be regarded as grounds for exclusion under Rule 263.2 (a) RoP. Otherwise, it would not be possible to correct obvious oversights in the further course of the proceedings once they have been made, even though such corrections may be less serious than other amendments to the claim.

In the case at hand, the amendment will not unreasonably hinder the Defendant in the conduct of its action. In order to defend itself against the request to order the communication of information,

Defendant already had to address the question of whether the infringer's profits may also include profits from ancillary transactions involving sealing materials and/or service/maintenance.

When assessing whether to grant leave for the amendment of the claim, the court has to balance the conflicting interests of the parties concerned, thereby taking all circumstances of the individual case into account (cf. LD Mannheim, order of 14.05.2025, UPC_CFI_132/2024).

Taking all circumstances of the individual case at hand into account, Claimant's interests in the amendment outweigh Defendant's interests. The amendment relates to an obvious oversight. If a potential claim for damages with regard to CeraPUR sealing materials and/or service/maintenance were not be covered by the request as originally filed, a general obligation of Defendant to pay damages established by the court would not be a binding base to rely on for said damages with regard to the fulfilment of the general requirements for damages. Rather, Claimant were to demonstrate and, if necessary, prove again that all general requirements for a claim for damages are given.

2. To the extent that request IV. as amended is to be interpreted as meaning that it should already be bindingly established in the present proceedings that, in the event of infringement, the Defendant is in any case liable for damages from the aforementioned ancillary transactions, in particular irrespective of the outcome of the disclosure of information, the decision on the application for leave to amend the claim is postponed until after the oral hearing and thus transferred to the panel.

When postponing the final decision on an application pursuant to R. 263 RoP, the interests of the parties have to be considered, taking into account all the circumstances of the individual case (cf. LD Mannheim, order of 14.05.2025, UPC_CFI_132/2024).

In connection with the request to order the communication of information, the Defendant in the proceedings at hand must consider in its rejoinder anyway whether the damages may include profits from said alleged ancillary transactions so that an order to provide information in this regard may be justified, enabling Claimant to examine whether profits attributable to the alleged infringement have been made in this regard.

If necessary, the panel will also have to decide whether individual types of damage can already be determined with binding effect in the proceedings of the infringement action when an award of unquantified damages is sought, or whether this must be reserved for the separate proceedings for determining the damages pursuant to R. 125 et seq. RoP.

ORDER:

1. Request IV. of the operative part of the statement of claim as originally filed is to be interpreted as seeking the declaration that the general requirements for damages are generally met, which in particular covers damages arising from sales of CeraPUR sealing materials and from service/maintenance contracts, if and insofar as these are relevant for the assessment of the amount of damages. Request IV. as originally filed is not to be interpreted as already seeking a positive finding that damages arising from sales of CeraPUR sealing materials and from service/maintenance contracts actually exist. In this respect, the clarifying amendment to the wording of the request IV. is admissible without the need of an application pursuant to R. 263 RoP and, if necessary, permitted.

2. In all other respects, the decision on the application for leave to amend the claim is postponed until after the oral hearing and thus transferred to the panel.
3. The Defendant may comment on the substance of request IV. as amended in its forthcoming rejoinder in the infringement proceedings.

ORDER DETAILS

Order no. ORD_20589/2025 in ACTION NUMBER: ACT_63395/2024

UPC number: UPC_CFI_745/2024

Action type: Infringement Action

Related proceeding no. Application No.: 20490/2025

Application Type: Application for leave to change claim or amend case/pleading (RoP263)

Issued in Mannheim on 6 June 2025

NAME AND SIGNATURE

Böttcher

Legally qualified judge