Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Local Division Munich

UPC_CFI_628/2024
UPC_CFI_125/2025

Decision on the merits

of the Court of First Instance of the Unified Patent Court
Local Division Munich
issued on 13 January 2026

HEADNOTES:

1. Patent infringement is not excluded by the fact that a device is normally operated in a non-infringing manner and customers therefore do not regularly make use of the patented teaching, as long as the use of the patented teaching remains possible when using the device.

   In the case of a medical device, however, the possibility of an irregular but patent-compliant use can only be considered as patent infringement if such use is in line with professional practice and the recognised rules of medical science.

2. The unconditional transition from a counterclaim to a dependent counterclaim, which is dependent on the occurrence of an intra-procedural condition (i.e. a finding of patent infringement by the Court), means that the counterclaim is limited in accordance with Rule 263.3 of the Rules of Procedure (RoP).

3. If, in accordance with the counterclaimant's request, no decision is made on the Counterclaim, the counterclaimant must bear the costs for the counterclaim.

CLAIMANT AND COUNTERCLAIM-DEFENDANT (HEREAFTER "CLAIMANT")

Emboline, Inc., 2901 Mission Street, Bldg 2, CA 95060, Santa Cruz, USA

represented by: Dr. Thure Schubert, attorney-at-law, Vossius & Brinkhof UPC Litigators

DEFENDANT AND COUNTERCLAIMANT (HEREAFTER "DEFENDANT")

AorticLab srl, Via Ribes, 5, 10010, Colleretto Giacosa TO, Italy

represented by: Sabine Agé, attorney-at-law, HOYNG ROKH MONEGIER

PATENT AT ISSUE

European patent n° EP 2 129 425

LANGUAGE OF THE PROCEEDINGS

English

DECIDING JUDGES

This decision was issued by Panel 1 of the Local Division Munich:

Dr. Matthias Zigann, presiding judge
Petri Rinkinen, legally qualified judge
Dr. Elisabetta Papa, technically qualified judge
Tobias Pichlmaier, legally qualified judge (judge-rapporteur)

ORAL HEARING: 02.12.2025

DECISION: 13.01.2026

Summary of the facts

1. The claimant alleges that the defendant has infringed EP 2 129 425 (hereafter “the patent”). The patent was filed on 29 November 2007 under the title

“EMBOLIC PROTECTION DEVICE”

2. The mention of the grant of the patent was published on 27 December 2023.

3. The Patent is in force in the UPC member states Germany, France and Italy.

4. Claim 1 of the patent reads:

> An embolic protection device, comprising: an approximately cylindrical outer structure (102) made of a filter mesh material; an approximately conical inner structure (104) made of a filter mesh material positioned inside of the cylindrical outer structure (102); wherein on a downstream end (110) of the embolic protection device (100), a wider end of the conical inner structure (104) is joined to the cylindrical outer structure (102); wherein an upstream end (108) of the embolic protection device (100) is open for blood to flow between the conical inner structure (104) and the cylindrical outer structure (102); with a space between the conical inner structure (104) and the cylindrical outer structure (102) defining a collection chamber (103) for captured emboli; wherein the narrow upstream end of the conical inner structure (104) has a catheter port (106) configured for passage of a catheter shaft through the catheter port (106); characterised in that the device further comprises at least one retraction member (116, 120) encircling the circumference of the cylindrical outer structure (102); and a pull loop (122) or other graspable structure (122) near to the downstream end (110), wherein said pull loop (122) or other graspable structure near to the downstream end (110) is connected to the retraction members (116, 120) and is engageable by a hook (154) on the distal end of an elongated member (156) within a retrieval catheter (152).

5. The claimant is the registered proprietor of the patent.

6. The defendant is an Italian based company which manufactures the embolic protection device “FLOWer” (hereafter “attacked embodiment”).

Parties' submissions and requests

7. With its infringement action (UPC_CFI_628/2024), the claimant alleges that the attacked embodiment infringes the patent. The claimant argues that the attacked embodiment shows all features of claim 1 of the patent. In particular it comprises structural features that can function as a graspable structure (pull loop) which are engageable by a hook.

8. The defendant disputes patent infringement. In the opinion of the defendant, the attacked embodiment does not comprise a pull loop or a graspable structure, especially since there is no need for a pull loop or a graspable structure due to the design of the attacked embodiment (permanent connection between the filter section and the inner catheter). In addition, other claim features have not been realized in the attacked embodiment. The defendant also disputes the validity of the patent and has filed a counterclaim (UPC_CFI_125/2025).

Requests regarding the infringement action (UPC_CFI_628/2024)

9. **The claimant requests** the Court

I. to order the defendant in the territories of Germany, France and Italy,

to cease and desist from

making, offering, placing on the market, using or importing or storing for those purposes within the states mentioned in item I. above

embolic protection devices, comprising: an approximately cylindrical outer structure made of a filter mesh material; an approximately conical inner structure made of a filter mesh material positioned inside of the cylindrical outer structure; wherein on a downstream end of the embolic protection device, a wider end of the conical inner structure is joined to the cylindrical outer structure; wherein an upstream end of the embolic protection device is open for blood to flow between the conical inner structure and the cylindrical outer structure; with a space between the conical inner structure and the cylindrical outer structure defining a collection chamber for captured emboli; wherein the narrow upstream end of the

conical inner structure has a catheter port configured for passage of a catheter shaft through the catheter port; characterised in that the device further comprises at least one retraction member encircling the circumference of the cylindrical outer structure; and a pull loop or other graspable structure near to the downstream end, wherein said pull loop or other graspable structure near to the downstream end is connected to the retraction members and is engageable by a hook on the distal end of an elongated member within a retrieval catheter;

(independent claim 1 of the patent)

in particular,

wherein the filter mesh material of the conical inner structure and the cylindrical outer structure is made of a polymer;

(dependent claim 2 of the patent)

and/or

wherein the catheter port has a resilient seal configured for forming a seal around a catheter shaft placed through the catheter port;

(dependent claim 3 of the patent)

and/or

wherein the embolic protection device has an undeployed retracted condition and a deployed expanded condition; in particular, in combination with a tubular outer delivery sheath to maintain the embolic protection device in the undeployed retracted condition prior to deployment;

(dependent claims 5 and 6 of the patent)

and/or

wherein the filter mesh material of the conical inner structure and the cylindrical outer structure is supported by a framework that includes an upstream hoop, a downstream hoop and at least one longitudinal strut that form the cylindrical outer structure, and at least one angled strut that, together with the downstream hoop, form the conical inner structure; in particular,

wherein the framework is a self-expanding framework made of a resilient metal and/or polymer material or when the framework is made of a shape-memory material;

(dependent claims 7 and 8 of the patent)

and/or

wherein the conical inner structure is shorter than the cylindrical outer structure in a longitudinal direction;

(dependent claim 9 of the patent)

and/or

wherein the embolic protection device is retractable for retrieval from a patient's blood vessel and preferably wherein the embolic protection device is configured to retract an upstream end of the cylindrical outer structure first to assure that any captured emboli do not migrate out of the collection chamber during retraction;

(dependent claim 13 of the patent);

in particular, but not limited to, the "FLOWer Transcatheter Antiembolic Filter" devices

as exemplarily shown below:

II. to order the defendant for each case of violation of the order under item I. to make penalty payments to the Court, which are to be determined by the Court in reasonable proportion to the importance of the order to be enforced, whereby an amount of EUR 10,000.00 for each case of violation is suggested;

III. to declare that Defendant has infringed European Patent No. 2 129 425 in respect to the embolic protection devices as specified in item I.;

IV. to order the defendant, under the forfeiture of a recurring penalty payment of up to EUR 10,000.00 for each day of delay, within a period of 1 month from the date of service of the judgment subject to Rule 118.8 of the Rules of Procedure,

to provide claimant with information in a complete and orderly list in an electronic form that can be analyzed by means of electronic data processing (EDP), broken down by month of a calendar year and by infringing product, as to the extent to which it (the defendant) has committed the acts referred to in item I above since 27 December 2023, specifying

1. the origin and distribution channels of the infringing products;

2. the quantities produced, manufactured, delivered, received and/or ordered, as well as the price obtained for the infringing products; and

3. the identity of any third person involved in the production and/or distribution of the infringing products;

4. the individual offers, broken down by the quantities, dates, prices and type designations as well as the names and addresses of the commercial recipients of the offers;

5. the advertising carried out, broken down by advertising medium, its circulation, distribution period and distribution area, in the case of Internet advertising the domain, the access figures and the placement periods;

6. the actual costs broken down by individual cost factors and the profit made;

whereby as proof of the information provided the corresponding receipts (i.e., invoices, alternatively delivery notes) are to be submitted in copy with the proviso that data to which the information owed does not relate and with regard to which there is a justified interest in confidentiality on the part of the defendant may be covered or blacked out;

V. to order the defendant, under the forfeiture of a recurring penalty payment of up to EUR 10,000.00 EUR for each day of delay, within a period of 1 month from the date of service of the judgment subject to Rule 118.8 of the Rules of Procedure,

1. to recall and permanently remove from the channels of commerce the products as specified in item I. above which have been placed on the market in Germany, France and Italy since 27 December 2023, to notify the third parties from whom the products are to be recalled that this Court has found that the respective product infringes the European patent No. EP 2 129 425, with a binding undertaking by defendant to repay the purchase price already paid, if any, to reimburse the third parties for the costs incurred, to pay the necessary transport, shipping and packaging costs incurred, to reimburse the customs and storage costs associated with the return of the products, and to take back the products;

2. to destroy the products as specified in item I. above and the advertising materials and implements for manufacture which are in defendant's direct or indirect possession and/or ownership in Germany, France and Italy (including any products and advertising materials that come into its direct or indirect possession and/or ownership pursuant to item V.1 or otherwise) and to provide claimant with proof of the destruction, or, at its option, to hand them over to a bailiff to be appointed by claimant for the purpose of destruction;

VI. to declare that defendant is liable to compensate claimant for all damages that incurred (including interest) and will incur due to the acts specified in item I. above and committed since 27 December 2023, as to be specified in separate damage proceedings;

VII. to order defendant to pay interim damages, with the amount the discretion of the Court, whereby at a minimum, claimant's expected costs of the proceedings for the award of damages and compensation must be covered, whereby an amount of at least EUR 100,000 is suggested;

VIII. allow claimant to display the Court's decision and to publish it (including the announcement thereof) in full or in part on its website and in public media, including industry journals of its choice;

IX. to order defendant to pay the reasonable and proportionate legal costs of these proceedings and other expenses in a provisional amount to be specified in the course of these proceedings and to declare that defendant is to pay any further reasonable and proportionate legal costs of these proceedings and other expenses as to be further specified in separate cost proceedings;

X. to declare that the orders according to items I., II., IV., V., VII. to IX. are immediately enforceable not withstanding any appeal,

alternatively,

in the event that a security is ordered, to permit claimant to provide it by bank or savings institution guarantee and determines the amount of the security separately for each claim awarded and for the decision of cost liability,

alternatively,

to permit claimant to avoid enforcement with respect to the costs of the proceedings against provision of security;

XI. [application for a decision by default]

XII. [application with regard to the service of the Statement of Claim]

10. **The defendant requests** the Court to

1. dismiss the action (Rules 23, 24(g) RoP);

2. order that the claimant shall bear the costs of the infringement action and counterclaim for revocation (Art. 69(1) UPCA, Rules 118(5), 150(1), 150(2) RoP);

3. order the defendant to pay the claimant the sum of EUR 100,000 as an interim award on costs (Rules 118(5), 150(2) RoP);

4. [counterclaim, see below]

In the alternative, should the Court find patent infringement, to:

5. refrain from issuing a permanent injunction pursuant to the claimant's request I. (Art. 42(2), 63(1) UPCA, Art. 3(2) of the Enforcement Directive);

6. dismiss the claimant's requests IV.1. and IV.3. as unnecessary and IV.2., IV.4. and IV.6. insofar as they relate to prices, offers, names and addresses of the commercial recipients (i.e. clients) and costs structure;

7. dismiss the claimant's requests V. and VIII. as disproportionate (Art. 64(4) UPCA);

8. dismiss the claimant's request VII. for an interim award of damages as unsubstantiated;

9. make the enforcement of the decision dependent on the prior provision of security by the claimant in the amount of at least 15 million EUR within one month, which may be in the form of a bank guarantee from a credit institution authorized to do business in the territory of a Contracting Member State of the UPC (Art. 82(2) UPCA, Rules 118(8), 352(1), 354(1) RoP); In the further alternative:

10. in lieu of permanent injunction, award the claimant reasonable monetary compensation in an amount to be determined by the Court in its sole discretion;

11. if the Court were to grant requests IV.2, IV.4 and IV.6 in full, order that the information relating to prices, names and addresses of the commercial recipients (i.e. clients), and costs structure (Rules 262 and 262A RoP):

    11.1 shall be treated as strictly confidential by anyone who becomes aware of it as a result of their involvement in the present legal dispute (as a party, intervener, lawyer, witness, expert, court employee or in any other way) and shall not be used or disclosed outside the court proceedings;

    11.2 may only be disclosed to a number of persons not greater than necessary and shall include the respective lawyers of the claimant;

11.3 only the above-mentioned employees/representatives of the are permitted to attend the oral hearings at which confidential information claimant may be disclosed and only they may be provided with the recordings and minutes of the aforementioned hearings insofar as information to be classified as confidential is concerned.

Requests regarding the counterclaim for revocation (UPC_CFI_125/2025)

11. **The defendant requests** the Court to

4. revoke European patent EP 2 129 425 B1 in its entirety with effect in all the Contracting Member States of the UPC in which the patent has effect (Art. 65(2) UPCA, Rule 25 RoP).

12. In the oral hearing, defendant made this request on the condition that the patent is found to be infringed.

13. **The claimant requests** the Court

XIII. to dismiss defendant's counterclaim for revocation of EP 2 129 425 in its entirety and to maintain the Patent in suit as granted ("main request");

XIV. in the alternative, should the court not dismiss defendant's counterclaim for revocation of EP 2 129 425 in its entirety (Sec. XIII), to dismiss defendant's counterclaim for revocation of EP 2 129 425 in part and maintain the patent in suit in accordance with the following conditional proposed amendments (proposed amendments underlined):

1. Auxiliary Request 1: Claim 1: addition of the feature that the embolic protection device is "configured to be deployed in a patient's aorta to protect the aortic arch vessels and downstream organs from potential emboli";

2. Auxiliary request 2: Claim 1: addition of the feature that the catheter port is "configured for passage of a catheter shaft of a therapeutic catheter through the catheter port (106)";

3. Auxiliary request 3: Claim 1: addition of the features that the embolic protection device is "configured to be deployed in a patient's aorta to protect the aortic arch vessels and downstream organs from potential emboli" and "wherein the filter mesh material of the approximately cylindrical outer structure (102) and the approximately conical inner structure (104) has a pore size of 1 mm or less"; and

4. Auxiliary request 4: Claim 1: addition of the features of dependent claim 7 ("wherein the filter mesh material of the conical inner structure (104) and the cylindrical outer structure (102) is supported by a framework that includes an upstream hoop (112), a downstream hoop (114) and at least one longitudinal strut (113) that form the cylindrical outer structure (102), and at least one angled strut (107) that, together with the downstream hoop (1 14), form the conical inner structure (104)").

5. that Auxiliary Requests 1 – 4 be dealt with in the order as stated above and in accordance with their numbering.

6. in case the Court maintains the Patent in suit in the form of one of the auxiliary requests, that:

   a. the counterclaim for revocation be dismissed to the extent that the Patent in suit is upheld;

   b. to render judgment against defendants in the infringement action as requested in the Statement of claim, however, modified to align with the claim scope of the respective auxiliary request being upheld

XV. to order defendant to pay the reasonable and proportionate legal costs of the counterclaim for revocation and other expenses in a provisional amount to be specified in the course of these proceedings and to declare that defendant is to bear any further reasonable and proportionate legal costs of the counterclaim for revocation and other expenses as to be further specified in separate cost proceedings.

14. **The defendant requests** the Court to

12. dismiss claimant's requests to amend EP 2 129 425 B1 (Auxiliary Requests 1 to 4);

13. [refund of court fees paid in excess for the counterclaim];

Should the Court find patent infringement, to:

14. declare, based on claimant's admission, that the normal use of the attacked embodiment (as defined in the Statement of Claim) does not implement the claims of EP 2 129 425 B1 as granted or in the form of Auxiliary Requests 1 to 4;

Should the Court order an injunction, to:

15. declare, as an exception to the injunction, that defendant is permitted to continue making, offering, placing on the market, using and importing and storing for these purposes the attacked embodiment in Germany, France and Italy subject to a modification of section 20 of the troubleshooting guide in the Instructions for Use of the attacked embodiment instructing users to not insert a hook into any structure of the attacked embodiment to retrieve it from a patient's body in a bailout scenario.

Grounds for the decision

16. The infringement action is admissible, but unfounded. The counterclaim was not to be decided, as the condition set by the defendant to decide upon the counterclaim did not occur.

Person skilled in the art

17. In order to assess the legal situation in the present case, it is first necessary to determine the person skilled in the relevant art. The person skilled in the art is to be defined as a team comprising an engineer with a solid knowledge of mechanical engineering, materials science and fluid mechanics applying his knowledge to the biomedical field and specifically to that of implantable devices, and a cardiovascular clinician, and particularly an interventional cardiologist. This description of the relevant expertise is not in dispute between the parties.

Subject matter of the patent

18. The patent relates to an embolic protection device that can be deployed in a patient's blood vessel to protect the downstream organs from potential emboli.

19. Embolic protection devices can be used acutely, for example for embolic protection during interventional cardiology procedures, or they can be implanted for chronic embolic protection, for example from cardiogenic emboli or emboli from ruptured or vulnerable aortic plaque. (Par. [0001]).

20. The technical objectives of the patent are explained as providing a device that (par. [0003]):

    (i) can be either used acutely or implanted for chronic embolic protection;

    (ii) does not interfere with transluminal aortic access for performing surgeries and other interventional or diagnostic procedures;

    (iii) can be retrieved and removed from the patient after the necessity for it has passed;

    (iv) can be deployed and retrieved using minimally invasive techniques.

Claim features of the patent

21. In order to achieve this objective, the patent proposes an embolic protection device comprising the following features according to claim 1:

An embolic protection device, comprising:

1. an approximately cylindrical outer structure (102) made of a filter mesh material;
2. an approximately conical inner structure (104) made of a filter mesh material positioned inside of the cylindrical outer structure (102);
3. wherein on a downstream end (110) of the embolic protection device (100), a wider end of the conical inner structure (104) is joined to the cylindrical outer structure (102);
4. wherein an upstream end (108) of the embolic protection device (100) is open for blood to flow between the conical inner structure (104) and the cylindrical outer structure (102);
5. with a space between the conical inner structure (104) and the cylindrical outer structure (102) defining a collection chamber (103) for captured emboli;
6. wherein the narrow upstream end of the conical inner structure (104) has a catheter port (106) configured for passage of a catheter shaft through the catheter port (106);
7. characterised in that the device further comprises at least one retraction member (116, 120) encircling the circumference of the cylindrical outer structure (102);
8. and a pull loop (122) or other graspable structure (122) near to the downstream end (110),
9. wherein said pull loop (122) or other graspable structure near to the downstream end (110) is connected to the retraction members (116, 120)
10. and is engageable by a hook (154) on the distal end of an elongated member (156) within a retrieval catheter (152)

Claim interpretation

22. The principles applicable to claim construction have been set out by the Court of Appeal in its final order in UPC_CoA_335/2023 (Order of 26 February 2024, NanoString v 10x Genomics). The patent claim is not only the starting point but the decisive basis for determining the protective scope of a European patent under Art. 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather 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. The patent claim is to be interpreted from the point of view of a person skilled in the art. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

23. In order to understand the patented device in its entirety, it is helpful to consider first its essential features and their respective functions before examining the details of the device in more detail:

24. The patented device

- is approximately cylindrical in its outer structure and thus corresponds – as shown in Fig. 8 (image detail) – to the inner wall of the blood vessel into which it is inserted,

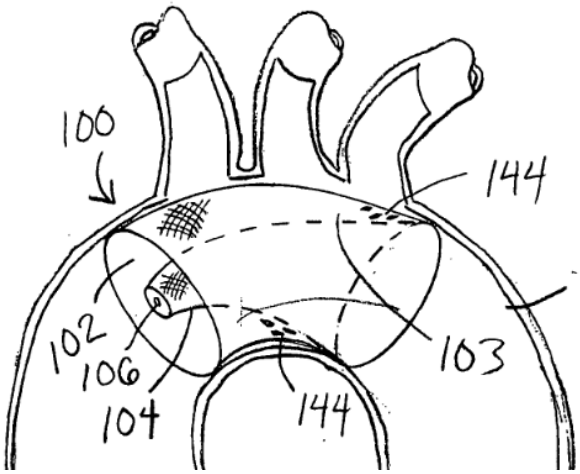


FIG 8

- has two ends, with blood flowing from the upstream end towards the downstream end,

- has a conical inner structure – as shown in Fig. 1 (104) – that is positioned inside the cylindrical outer structure with a narrow upstream end (106) that functions as a catheter port.

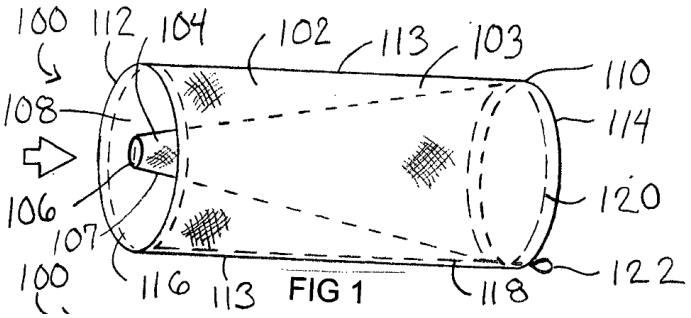
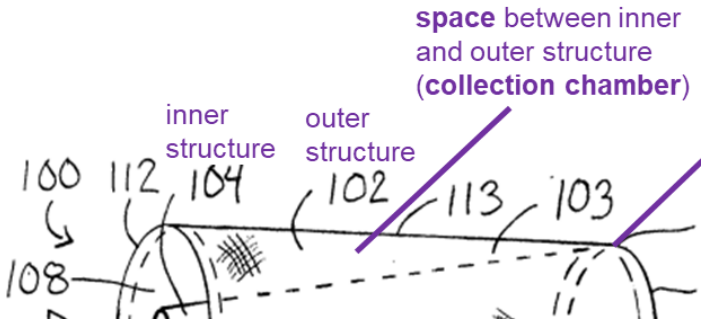


FIG 1

Between the inner structure and the outer structure a space is formed, defining a collection chamber in which captured emboli can be collected.



As shown in Fig. 11, the device also has at least one retraction member and a pull loop (or other graspable structure) to enable the device to be removed from the blood vessel.

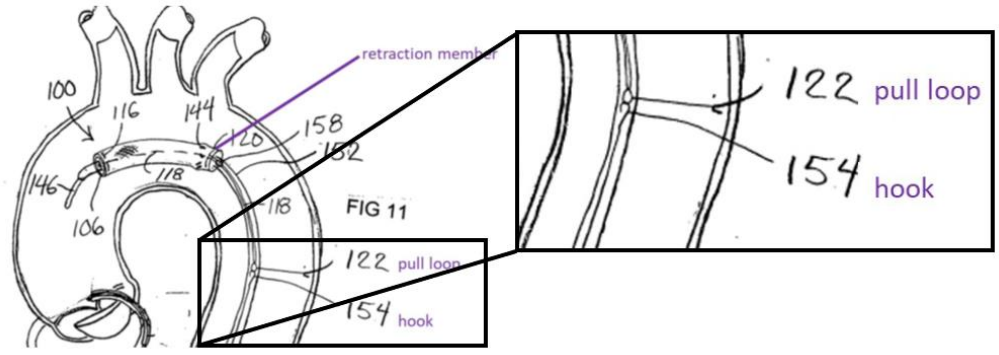


FIG 11

25. The parties debated about the interpretation of some of these features, which therefore require closer examination:

approximately cylindrical outer structure

26. According to the claimant, the “approximately cylindrical shape” of feature 1. is to be understood “more in a functional manner than in a purely geometrical one”. Such definition simply entails the need for the device to fit into the aorta, which is bent and tapered, particularly at the aortic arch, with considerable variations also from patient to patient. The claimant asserts that “[…] the skilled person understands that an approximately cylindrical outer structure may have a conical shape with a larger diameter at the upstream end and a smaller diameter at the downstream end, as this shape allows the device to fulfil its function, i.e. to preferably make a seal with the vessel wall at the upstream end so that blood flows into the device and emboli can be captured in the collection chamber and prevented from entering the side arteries.

27. Also from the view of the Court, the “cylindrical shape” of the outer structure is not to be understood as a precise geometrical cylinder. It is obvious that the external shape of the device (outer structure) corresponds to the shape of the respective blood vessel, which can essentially be described as tubular (cylindrical). However, also a blood vessel, for example the aortic arch, does not have a geometrically exact cylindrical shape. This is why the patent uses the term “approximately” in this context.

28. The patent also mentions a conical shape with regard to the outer structure. In par. [0013] for an alternate construction of such a device it is stated that

> “…the cylindrical outer structure 102 can be made slightly conical with the larger end of the cone on the upstream side.”

Moreover, par. [0030] cites

> “…a cylindrical or conical outer structure 102.”

29. According to the patent disclosure this feature in functional terms is aimed at allowing sealing engagement with the blood vessel at the upstream end (see, e.g., par. [0030]). This explains the approximately cylindrical shape. Furthermore, in the patent a conical structure is identified as an *aliud* to a cylindrical structure. This also follows from

feature 2 of claim 1 (“conical inner structure”). However, patent claim 1 specifies the outer structure to be approximately cylindrical. This means that the outer structure – at least in comparison with the inner structure – has to be described as rather cylindrical than conical.

approximately conical inner structure positioned inside of the cylindrical outer structure

30. The claimant considers that the “approximately conical shape” of the inner structure is to be read in functional terms as relating to the debris-collection function within the space defined between the conical and the cylindrical structure. The claimant asserts that “conical” means “with a shape similar to a cone”.

31. The defendant considers that the “conical shape” must be construed as a shape clearly recognizable as a cone, therefore also with a circular or oval cross section. Moreover, the defendant asserts that the inner and the outer structure are claimed as physically distinct one from the other, with no structural element or component in common.

32. In the Court’s view, the “approximately conical” structure is not to be understood as a precise geometrical cone. However, a conical structure within the patent claim is identified as an *aliud* to a cylindrical structure. In the case of feature 2 both terms are even used in conjunction with each other and can therefore only be understood as expressing a difference in the design of the respective shape. This design is also technically and functionally conditioned, as the cylindrical outer shape relates to the shape of the blood vessel, while the conical inner structure serves the purpose of creating a collection chamber and forming a catheter port with a narrow end typical of the conical shape. This means that the inner structure – at least in comparison with the outer structure – has to be described as rather conical than cylindrical.

narrow upstream end of the conical inner structure has a catheter port configured for passage of a catheter shaft

33. The claimant asserts that – absent a specific definition in the patent – the skilled person would understand “catheter port” as a structural element which forms an opening through which a catheter can be advanced. According to the claimant, the

expression “passage […] through” requires that the catheter port is configured to enable a movement of a catheter shaft through the catheter port.

34. The defendant asserts that feature 6. requires a catheter port arranged at the narrow upstream end of the conical inner structure, which allows for a catheter shaft to be inserted through the embolic protection device to access the surgical site (para. [0021]).

35. The disclosure of the patent, particularly Fig. 3 – 6, explains the catheter port as allowing access and movement of the catheter through it. Consistently with the patent disclosure as well as with the general understanding of the relevant feature, a “catheter port” is a structure specifically configured for allowing catheter access through it. It should not be overlooked that the *narrow upstream end of the conical inner structure* is mentioned in this context.

retraction member

36. The claimant notes that the complex of the features defining the retraction components is not limited to a specific retraction mechanism, e.g. a tightening of the retraction member. Moreover, according to the claimant, the “connection” of feature 9 may also be an indirect one.

37. The defendant notes an inconsistency between the wording of feature 7 – which refers to “at least one retraction member” and that of feature 9 – which mentions “retraction members”. In any case, they concede that it is a “mere clerical error”. Furthermore, according to the defendant, the claimed arrangement of the graspable structure and the retraction member refers to embodiments wherein the device can be implanted for chronic embolic protection. As a further confirmation for this construction, the defendant refers to the examination procedure of the Patent (application) and in particular to the discussion concerning the difference with prior art document D5 (EP1179321A2, ‘Green’).

38. Both the wording of the claim and the patent disclosure support a broad construction of feature 7 – 9 as not limited to any specific retraction mechanism. In addition, claiming the retraction member and the pull loop does not appear to necessarily limit the claim to applications for *chronic* embolic protection.

pull loop (or other graspable structure) engageable by a hook

39. According to the claimant, feature 10 just requires that there is the possibility for a hook to engage a graspable structure, while neither the catheter nor the hook are features of claim 1. According to the claimant, any structure that is engageable by a hook, located at the downstream end and connected to a retraction member can be a pull loop /graspable structure. The claimant emphasises that it is a well-established principle of claim construction that only the *objective capability* that the features of a patent claim are realized is decisive, not the intended purpose of the product in question.

40. The defendant asserts that the graspable structure has to be able to be engaged by a hook, but acknowledges that the claim does not require that a hook actually engages the graspable structure. However, in view of the defendant the claim wording entails that there must be “a certain degree of intention and suitability” of the component to function as a graspable structure for retrieval purposes.

41. In the Courts view, the term “engageable” in feature 10 means that a graspable structure – and the overall claimed device – is specifically configured and designed for being engaged by a hook arranged at the distal end of an elongated member within a retrieval catheter. As the feature must be read in the framework of the claim and disclosure as a whole, the “graspability” must apply without any need for modifying the graspable structure itself or other claimed components.

42. In view of the fact that the patented device is intended for use in a blood vessel, the feature can only be understood to mean that a purposeful and targeted return is provided for. Therefore, it is not sufficient that the device has a structure into which a hook can *somehow and somewhere*, even in an unforeseen manner, be inserted in order to remove the device from the blood vessel. In view of the safety and quality standards required for such a medical device, but also with regard to legal certainty for third parties (Protocol Art. 69 EPC), a broad interpretation (somehow engageable by a hook) to this effect is not acceptable.

Infringement of the patent

43. The attacked embodiments do not infringe the patent.

Realization of claim 1 of the patent

Claim features 1 and 2

44. Based on the interpretation of the patent, the use of the terms conical and cylindrical in the patent claim means that the outer structure must be considered to be rather (approximately) cylindrical, while the inner structure must be considered to be rather (approximately) conical. This is shown in an exemplary manner in Fig. 1 of the patent:

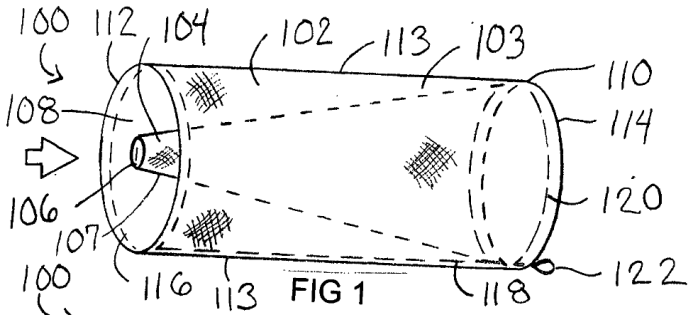
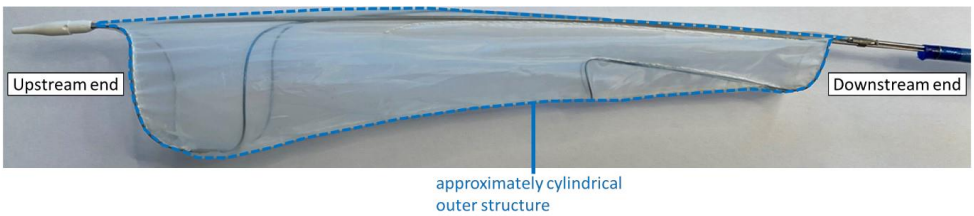
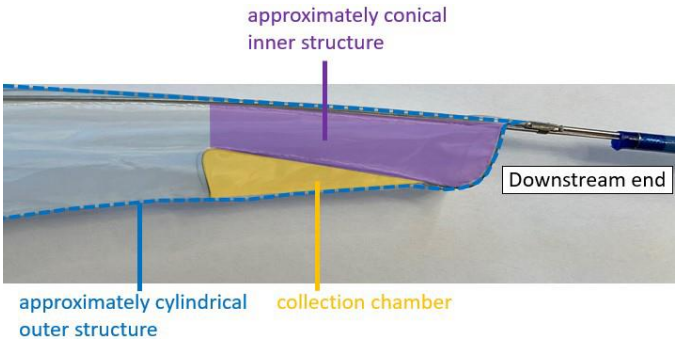


FIG 1

45. In contrast, it is doubtful whether the use of the terms *approximately conical* and *approximately cylindrical* within the meaning of the patent can be applied to describe the design of the outer and inner structure of the attacked embodiment. According to the illustrations submitted by the claimant (see below), the outer structure of the attacked embodiment cannot be easily assessed as being *rather cylindrical*, particularly in relation to its inner structure. In contrast to the explanations provided by the claimant, it is reasonable to regard the outer structure as *rather conical* and the inner structure as *rather cylindrical* in this respect:



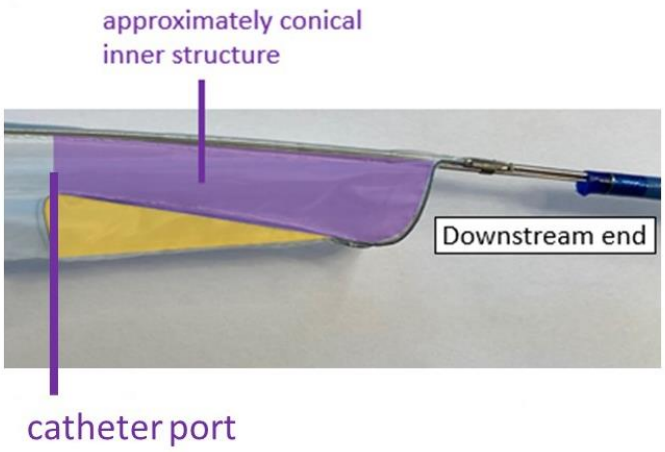


46. However, in consideration of the conclusions reached with regard to feature 10 (see below), the Court may ultimately leave the final assessment of feature 1 open. The same applies to feature 2.

Claim feature 6

47. Based on the interpretation of the patent, with regard to the attacked embodiment the question arises as to whether there is a structure specifically configured for allowing catheter access through it and whether a narrow upstream end can be seen.

48. The claimant has submitted the following illustration as evidence of the realisation of this feature:

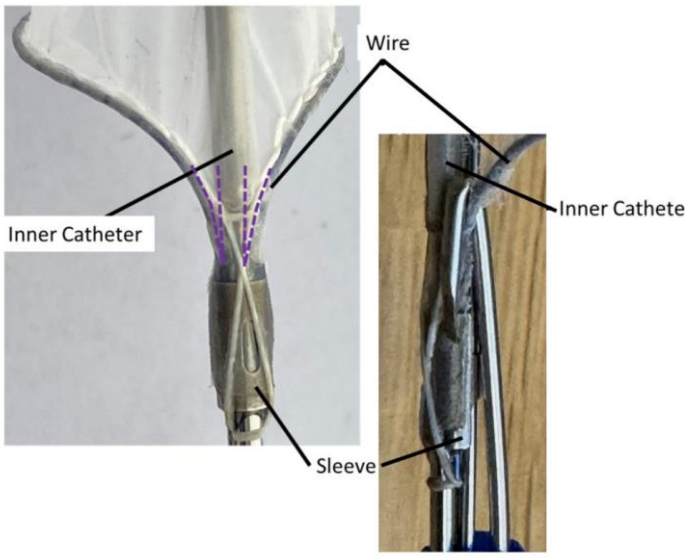


49. It seems at least doubtful whether the generic opening which can be seen in this illustration (in the illustration marked as “catheter port”) can be assessed as a *narrow* upstream end within the meaning of the patent claim.

50. However, with regard to feature 10 (see below), the Court may ultimately leave the final assessment of this feature open.

Claim feature 10

51. The claimant asserts that the attacked embodiment features graspable structures into which a hook can engage as specified in the patent claim. The claimant has submitted the following illustration, which is intended to show a 'V-shaped' graspable structure:



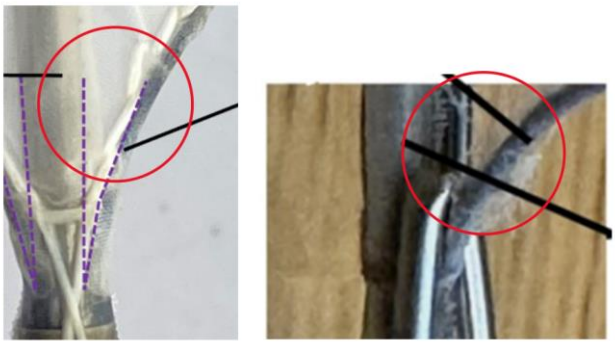
52. The attacked embodiment is objectively neither intended nor suitable for removal from the blood vessel by means of a hook using the section referred to by the claimant as "V-shaped":

53. The attacked embodiment is normally removed from the blood vessel by pulling it out using the rod to which it is firmly attached. The claimant does not argue that the defendant intends to use a different method of removal; it merely considers the use of a hook to be an alternative option.

54. The claimant admitted that if a hook is inserted to the V-shape section, the mesh must be pierced and hence be damaged (Exhibit VB 27, third written witness statement by [redacted]

> "…filter material was pierced. This is why due to the piercing, in some of the pictures of the briefs, no filter material is visible on the enlarged section of the photograph of the bottom part of the "V-shaped graspable structures."

This can also be seen in the illustrations provided:



55. It must be conceded to the claimant that a patent infringement is not excluded by the fact that a device is normally operated differently and that customers therefore do not regularly make use of the patent-infringing teaching. It is also true that patent infringement can be affirmed in such a case even if the manufacturer expressly specifies a different use for its device, as long as the use of the patented teaching remains possible. However, at least in the case of a medical device, the possibility of use in accordance with the patented teaching can only be assumed if such use is in line with professional practice and with the recognised rules of medical science.

56. In order to minimise risks and ensure the best possible quality, the use of such device *lege artis* means that the procedure is performed in accordance with the recognised rules of medical practice, i.e. professionally, carefully and in accordance with current medical standards. This includes correctly applying the device, particularly inserting and removing it correctly, to avoid complications such as bleeding or vascular injuries.

57. Using the attacked embodiment in connection with a hook to retrieve the device from the blood vessel does not constitute proper, professional and intended use of the attacked embodiment. The very fact that a part of the device, namely the mesh, is damaged in this process shows that this is not a procedure that uses the features of the attacked embodiment intended for this purpose. Such a procedure can at best be described as the use of unconventional methods in an emergency. However, the use of a hook in very exceptional and unforeseen circumstances cannot play a role in the assessment of patent infringement. In view of the standards applicable to medical devices, the use to be assessed here is not comparable with the action of a plumber who retrieves an object lost in a drainpipe, whereby any damage to the object or the

drainpipe may be accepted in order to clear the drainpipe. Using the attacked embodiment in combination with a hook is therefore irrelevant in this context.

58. The court does not see any reason to assume that the use of a hook as described by the claimant is a method *lege artis* for retrieving the attacked embodiment.

Realization of dependent patent claims

59. Since all other patent claims asserted as infringed are dependent on claim 1, these are also not infringed.

Counterclaim

60. No decision had to be made upon the counterclaim.

61. During the oral hearing, the defendant declared that it would not pursue its counterclaim as originally filed and instead filed the counterclaim dependent on the occurrence of an intra-procedural condition (i.e. finding of patent infringement by the Court).

62. This means a limitation of the counterclaim in accordance with Rule 263.3 RoP, as the defendant did not make the limitation itself subject to a condition (e.g. the admissibility of such a limitation). The defendant has limited its counterclaim without restriction.

Admissibility of an intra-procedural condition

63. Requesting to decide upon the counterclaim only if the patent is found infringed, the defendant made the counterclaim subject to an intra-procedural condition.

64. Neither the UPCA nor the Rules of Procedure expressly or by way of interpretation indicate that an intra-procedural condition is not admissible. In principle, the Rules of Procedure are familiar with applications made subject to an intra-procedural condition and allow them, as for example Rule 30 RoP shows.

65. Intra-procedural conditions relating to the Court's assessment of a *different matter* (in the present case: finding of patent infringement by the Court) do not disadvantage the other party. Also in accordance with the principle of fairness, it is not apparent what disadvantage it could entail for the claimant if no decision is made on the counterclaim

in the event that the patent is not found infringed. Therefore, the claimant has no legitimate interest to object to the intra-procedural condition.

66. Therefore, applications to the Court to obtain a ruling can generally be linked to the condition that the Court should only rule if a certain intra-procedural event occurs (for the admissibility of such an intra-procedural condition, see also LD Mannheim, decision of 5 December 2025, UPC_CFI_414/2024).

Non-occurrence of the condition

67. Since the Court did not find the patent infringed, the condition on which the counterclaim is to be decided has not been met.

68. According to Art. 76 (1) UPCA, the Court shall decide in accordance with the requests submitted by the parties and shall not award more than is requested. For the present case, this means that a decision on the counterclaim can only be made if the patent is found infringed. A decision on the counterclaim, even though the court does not consider the patent to be infringed, would go beyond the counterclaim and award more than is requested.

Costs

69. As the claimant has incurred costs as a result of the counterclaim and has not agreed to cover them, a decision on this matter must be made, even if no decision is made on the counterclaim itself. Although it must be taken into account that a defendant is forced to file a counterclaim in order to defend itself by raising invalidity arguments (UPC_CoA_393/2025, decision of 20 June 2025), it was its decision to limit the counterclaim.

70. It therefore remains open how the counterclaim would have been decided. As the defendant is responsible that no decision is to be made on the counterclaim, the defendant is also responsible that no decision *in favor of the claimant* can be made in this regard. If the counterclaim had been rejected, the defendant would have had to reimburse the claimant for the corresponding costs. Nothing else applies if, in accordance with the defendant's request, no decision is made on the counterclaim.

71. As the condition has not occurred and thus no decision on the counterclaim is to be made, the costs incurred in so far are to be considered unnecessary. According to Article 69 (3) UPCA, the party that caused unnecessary costs must bear them. The defendant is responsible for the costs incurred by the counterclaim.

72. The defendant therefore must bear the costs for the counterclaim.

Overall costs

73. Since the claimant, as the unsuccessful party, must bear the costs of the infringement action and the defendant – for the same value of the proceedings – bears the costs of the counterclaim, Article 69 (2) UPCA applies: Both parties bear their own costs.

Decision

I. The infringement action is dismissed.

II. Both parties bear their own costs.

Read in open court in Munich on 13 January 2026

Dr. Matthias Zigann Presiding Judge	Matthias ZIGANN Digital unterschrieben von Matthias ZIGANN Datum: 2026.01.12 15:33:30 +01'00'
Petri Rinkinen Legally Qualified Judge	Petri Rinkinen Allekirjoittaja Petri Olavi Rinkinen Päivämäärä: 1/12/26 4:20:44 PM
Dr. Elisabetta Papa Technically Qualified Judge	Elisabetta Papa Firmato digitalmente da Elisabetta Papa Data: 2026.01.12 15:40:30 +01'00'
Tobias Pichlmaier Legally Qualified Judge and Judge-rapporteur	Tobias Günther Pichlmaier Digital unterschrieben von Tobias Günther Pichlmaier Datum: 2026.01.12 14:53:12 +01'00'
For the Deputy-Registrar	Anja Mittermeier Digital unterschrieben von Anja Mittermeier Datum: 2026.01.12 16:37:25 +01'00'

INFORMATION ABOUT APPEAL

An appeal against the present Decision may be lodged at the Court of Appeal, by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of its notification (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

INFORMATION ABOUT ENFORCEMENT

Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP. An authentic copy of the enforceable decision will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.