Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Local Division Hamburg

UPC_CFI_660/2025
UPC_CFI_1326/2025
Decision of the Court of First Instance of the Unified Patent Court delivered on 04/11/2026

HEADNOTES:

1. The person skilled in the art will take the function of a feature, that is described solely in terms of physical properties, into account when interpreting the claim in order to determine the scope of protection. The scope of protection therefore covers only those embodiments which are capable of performing the function attributed to them by the patent.

2. If a counterclaim for revocation is filed conditionally and the condition is not fulfilled, the parties shall bear their own costs incurred in respect of the counterclaim for revocation, because if the counterclaim is not decided, neither party wins or loses.

KEYWORDS:
Claim construction
Infringement of the patent in suit
Cost allocation in conditional counterclaims for revocation

PARTIES OF THE PROCEEDINGS:

Steros GPA Innovative S.L., represented by the CEO, Pau Sarsanedas Millet, Calle Salvador Alarma, 16, 08035 Barcelona, Spain,

Claimant,

Representatives: all attorneys-at-law of Grünecker PartG mbB admitted in the Federal Republic of Germany and to the UPC, especially Mr. Sebastian Ochs and Mr. Björn-Alexander Bockelmann, Leopoldstrasse 4, 80802 Munich,

European patent attorneys of Grünecker PartG mbB who have the necessary qualifications pursuant to Article 48 (2) of the Agreement on a Unified Patent Court (UPCA), especially Dr. Peter Milteny, Leopoldstrasse 4, 80802 Munich

Electronic address:
Rechtsanwaltspostfach@grunecker.de

versus

OTEC Präzisionsfinish GmbH, represented by the CEOs Helmut Gegenheimer, Soran Jota und Nico Gegenheimer, Heinrich-Hertz-Straße 24, 75334 Straubenhardt-Conweiler, Germany,

Defendant,

Representatives: Attorney-at-law Klaus Haft, Hoyng Rokh Monegier, Steinstraße 20, 40212 Düsseldorf,

European patent attorney and representative of the UPC, Stefan Lenz, Lichti Patentanwälte Partnerschaft mbB, Bergwaldstraße 1, 76227 Karlsruhe, Deutschland

Electronic address:
Klaus.Haft@hoyngrokh.com

PATENT AT ISSUE: **EP 4 249 647**

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT-MATTER OF THE PROCEEDINGS: Infringement – Counterclaim for revocation

PANEL:
Panel of the Local Division in Hamburg

DECIDING JUDGE:

Full Panel

Presiding Judge and JR	Sabine Klepsch
Legally qualified Judge	Dr. Stefan Schilling
Legally qualified Judge	Petri Rinkinen
Technically qualified Judge	Rudi Goedeweeck

ORAL HEARING:

22.09.2026, 10:00

SUMMARY OF FACTS

1 The Claimant asserts claims against the Defendant for infringement of the European Patent EP 4 249 647 B1 with unitary effect (hereinafter: patent-in-suit or patent, Exhibit GRU 2), entitled "Electrolytic Medium and Electropolishing Process using such electrolytic Medium". The application of the patent-in-suit was filed on 30 November 2021. On 26 February 2025, the European Patent Office (EPO) granted the European Patent. The request for unitary effect has been filed on 21 March 2025. On the same day the decision on the request for unitary effect has been made. The Defendant filed an opposition at the EPO on 28 October 2025. On 26 August 2026 the Opposition Division of the EPO issued its preliminary opinion (Exhibit GRU 26).

2 The Claimant is part of the DryLyte-group and alleges to be the exclusive licensee to the patent-in-suit. The patent proprietor Drylyte, S.L., belongs to the same group of companies as the Claimant and is informed about this case.

3 The patent-in-suit protects electrolytic medium and electropolishing processes using such electrolytic media.

4 The patent-in-suit consists of 15 claims. The Claimant has based its present infringement action with regard to a direct infringement on independent product claim 1, especially dependent claims 2 – 6, independent use claim 10 and independent process claim 11, especially dependent claims 13 and 14 and an indirect infringement based on independent process claim 11, especially dependent claims 13 and 14.

Claim 1 reads as follows:

> Electrolytic medium comprising:
> - a set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 micronS/cm, and
> - a non-conductive fluid immiscible in the conductive solution, immiscible being understood as not forming a single phase in any proportion from 0 to 100°C, the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current.
>
> the electrolytic medium being suitable for an electropolishing process comprising the steps of:

a) connecting at least one piece to be polished to a power supply;
b) connecting at least one electrode to the opposite pole of the power supply;
c) contacting the at least one piece to be polished and the solid electrolyte particles of the electrolytic medium with a relative movement between the piece and the particles;
d) applying a potential difference between the piece to be polished and the electrode, which produces a current flow between them through the electrolytic medium.

Claim 10 reads as follows:

Use of the electrolytic medium according to any of claims 1 to 9 in an electropolishing process.

Claim 11 reads as follows:

Electropolishing process characterized by comprising the steps of:
a) connecting at least one piece to be polished to a power supply;
b) connecting at least one electrode to the opposite pole of the power supply;
c) contacting the piece to be polished and the solid electrolyte particles of the electrolytic medium comprising

- A set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 micronS/cm and
- A non-conductive fluid immiscible in the conductive solution, immiscible being understood as not forming a single phase in any proportion from 0 to 100°C, the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current

with a relative movement between the piece and the particles;
d) applying a potential difference between the piece to be polished and the electrode, which produces a current flow between them through the electrolytic medium.

5 The Defendant, a German company, is, as the Claimant, also active in the electro-polishing/electro-finishing market. It sells both, the necessary machines, such as, e.g. the EF-Smart or EF-One and the respective media used for the electro-polishing/electro-finishing as attacked herewith. The Defendant sells an electrolytic medium EF 16-11 and a refill RF 16-0 (following: attacked embodiments). EF 16-11 is an electrolytic medium comprising free electrically conductive solid bodies and a surrounding liquid, the latter being functionally equivalent to the refill liquid RF 16-0. EF 16-11 consists of a first less dense liquid phase and a second denser liquid phase.

6 With its submission of 17 July 2025, the Claimant filed an infringement action directed against the marketing of the Defendant's attacked embodiments. This was preceded by proceedings for the ordering of provisional measures (UPC_CFI_281/2025). The Court granted the application on 16 June 2025 and Claimant enforced the decision on 7 July 2025. The Defendant appealed (UPC_CoA_579/2025) the decision issued by the Local Division and filed an application for suspensive effect (UPC_CoA_581/2025). While the application for suspensive

effect was already rejected (ORD_32771/2025), the Court of Appeal rejected the application for provisional measures with its decision of 7 November 2025 (Exhibit GRU 19).

7 The Claimant analysed the attacked embodiments and submitted the analysis in a video (Exhibit GRU 8) and a summary of the video (Exhibit GRU 9).

8 In addition, and to avoid repetition, reference is made to the parties' submissions and the entire contents of the file.

STATEMENT OF THE FORMS OF ORDER SOUGHT BY THE PARTIES:

Infringement action

9 With its Statement of Claims of 17 July 2025, the Claimant requests:

I. The Defendant is ordered to cease and desist from

1. manufacturing and/or offering, placing on the market, using or importing or possessing

an electrolytic medium, comprising:
- a set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 micronS/cm, and
- a non-conductive fluid immiscible in the conductive solution, immiscible being understood as not forming a single phase in any proportion from 0 to 100°C, the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current;
the electrolytic medium being suitable for an electropolishing process comprising the steps of:
a) connecting at least one piece to be polished to a power supply;
b) connecting at least one electrode to the opposite pole of the power supply;
c) contacting the at least one piece to be polished and the solid electrolyte particles of the electrolytic medium with a relative movement between the piece and the particles;
d) applying a potential difference between the piece to be polished and the electrode, which produces a current flow between them through the electrolytic medium.

in Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania. Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia and Sweden, as well as in the United Kingdom, in Czech Republic, Spain, Switzerland/Liechtenstein,

(direct infringement of claim 1 of EP 4 249 647 B1)

especially if
the particles that retain a conductive solution comprised in the electrolytic medium according to claim 1 have a gel-like structure;

(direct infringement of claim 2 of EP 4 249 647 B1)

and/or

wherein the particles that retain a conductive solution are of polymeric material, it is formulated with at least one of these monomers: styrene, divinylbenzene and/or includes sulfonic acid functional groups;

(**direct infringement of claim 3 of EP 4 249 647 B1**)

and/or

wherein the conductive solution is an aqueous solution;

(**direct infringement of claim 4 of EP 4 249 647 B1**)

and/or

wherein the conductive solution is an aqueous solution, comprising sulfonic acids;

(**direct infringement of claim 5 of EP 4 249 647 B1**)

and/or

wherein the non-conductive fluid comprises a fluid being hydrocarbons with five to sixteen carbons;

(**direct infringement of claim 6 of EP 4 249 647 B1**)

2. offering for use and/or using the electrolytic medium according to any of claims 1 to 9 in an electropolishing process

in Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania. Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia and Sweden, as well as in the United Kingdom, in Czech Republic, Spain, Switzerland/Liechtenstein;

(direct infringement of claim 10 of EP 4 249 647 B1)

3. offering for use and/or using an electropolishing process characterized by comprising the steps of:
a) connecting at least one piece to be polished to a power supply;
b) connecting at least one electrode to the opposite pole of the power supply;
c) contacting the piece to be polished and the solid electrolyte particles of the electrolytic medium comprising
- a set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 micronS/cm and
- a non-conductive fluid immiscible in the conductive solution, immiscible being understood as not forming a single phase in any proportion from 0 to 100 °C, the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current

with a relative movement between the piece and the particles;
d) applying a potential difference between the piece to be polished and the electrode, which produces a current flow between them through the electrolytic medium,

in Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania. Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia and Sweden, as well as in the United Kingdom, in Czech Republic, Spain, Switzerland/Liechtenstein;

(direct infringement of claim 11 of EP 4 249 647 B1)

especially if

the conductive solution is an aqueous solution comprising sulfonic acids;

(direct infringement of claim 13 of EP 4 249 647 B1)

and/or

wherein the non-conductive fluid comprised in the electropolishing process comprises a fluid with hydrocarbons with five to sixteen carbons;

(direct infringement of claim 14 of EP 4 249 647 B1)

4. supplying or offering to supply an electropolishing process characterized by comprising the steps of:
a) connecting at least one piece to be polished to a power supply;
b) connecting at least one electrode to the opposite pole of the power supply;
c) contacting the piece to be polished and the solid electrolyte particles of the electrolytic medium comprising
- a set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 micronS/cm and
- a non-conductive fluid immiscible in the conductive solution, immiscible being understood as not forming a single phase in any proportion from 0 to 100 °C, the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current

an electrolytic medium, comprising:
- a set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 micronS/cm, and
- a non-conductive fluid immiscible in the conductive solution, immiscible being understood as not forming a single phase in any proportion from 0 to 100°C, the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current;
with a relative movement between the piece and the particles;

d) applying a potential difference between the piece to be polished and the electrode, which produces a current flow between them through the electrolytic medium.

in Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania. Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia and Sweden, as well as in the United Kingdom, in Czech Republic, Spain, Switzerland/Liechtenstein;

(indirect infringement of claim 11 of EP 4 249 647 B1)

especially if

the conductive solution is an aqueous solution comprising sulfonic acids;

(indirect infringement of claim 13 of EP 4 249 647 B1)

and/or

wherein the non-conductive fluid comprised in the electropolishing process comprises a fluid being hydrocarbons with five to sixteen carbons;

(indirect infringement of claim 14 of EP 4 249 647 B1).

II. Defendant is ordered for each case of violation of the order according to I., to make a penalty payment to the Court, to be determined by the Court in reasonable proportion to the importance of the order to be enforced, whereby an amount of at least EUR 5.000,00 for each case of non-compliance is suggested;

III. The Court finds that the actions by the Defendant described above under I. infringe the patent EP 4 249 647 B1;

IV. Defendant is ordered, under penalty of a periodic fine of EUR 1,000 for each day of delay, within a period of three weeks from the date of service of the decision,

1. to provide Claimant with information on the extent to which Defendant has committed the acts referred to in Item I. since September 27, 2023, specifying in an orderly electronic form:
   a) the origin and distribution channels of the infringing products,
   b) the quantities produced, manufactured, delivered, received or ordered, as well as the prices obtained for the infringing products, and
   c) the identity of any third person involved in the production or distribution of infringing products;
2. to provide Claimant in order to verify the information provided under IV.1. and to provide information on the profit made with the infringing products with the following documentation in an orderly electronic form:
   a) invoices – or, if these are not available, delivery bills – of the individual deliveries, whereby the respective deliveries must be broken down according to quantities offered, time of the offers, prices of the products offered and type designations as

well as names and addresses of commercial recipients of the sales offers for all products sold or otherwise distributed;

b) evidence of the advertising carried out, including evidence of these advertising activities, whereby the advertising carried out must be broken down by advertising medium, its distribution, distribution period and the distribution area;

c) evidence of the costs, whereby the costs must be broken down according to the individual cost factors, and the profit made;

d) invoices – or, if these are not available, delivery bills – and corresponding accounts of all costs incurred to which Defendant refers when calculating the profits.

V. Defendant is ordered, under penalty of a periodic fine of at least EUR 1,000 for each day of delay, within a period of one week from the date of service of the decision,

1. to recall from the commercial customers the products described above under I. that have been placed on the market since February 26, 2025, with reference to the infringement of the products determined by the Court and with the binding promise to pay any fees and necessary packaging and transport costs, as well as customs and storage costs associated with the return, and to take back the products, whereby the Claimant is to be provided with a sample of the recall letters and a list of the addressees with names and postal addresses or (at the Defendant's option) a copy of all recall letters;
2. to definitively remove from the channels of commerce the products described above under I. that have been placed on the market since February 26, 2025 by exercising retentions of title and/or the termination of long-term obligations and/or exercise of other claims for surrender.

VI. Defendant is ordered, under a penalty of a periodic fine of at least EUR 1.000,00 for each day of delay, within a period of one week from the date of service of the decision, to destroy the products referred to above under I. and/or materials in its direct and/or indirect possession and/or ownership (including any products and/or materials that come into their direct and/or indirect possession and/or ownership pursuant to V. above or otherwise) or, at its option, to hand them over to a bailiff to be appointed or commissioned by Claimant for the purpose of destruction.

VII. Claimant is allowed to publish the Court's decision in whole or in part, including the announcement of the decision, in five public media including industry journals of its choice. In the event that the publication is to be made in its entirety, the decision handed down is to be published in its entirety. In the event of partial publication, the full text of the rubric and the complete operational part of the judgment are to be made available.

VIII. Defendant is obligated

1. to reimburse Claimant for any damages (including interest) incurred by Claimant since February 26, 2025 due to the actions described above under I. as well as those yet to be incurred;
2. to reasonably compensate Claimant and/or depending on the respective national laws of the individual states mentioned under I. pay damages (including interest) to Claimant since September 27, 2023 until February 25, 2025 due to the actions described above under I.

IX. Defendant is ordered to pay preliminary damages of EUR 59.000,00 to Claimant within three weeks from the date of service of the decision.

X. Defendant is ordered to bear the costs of the proceedings, including those relating to the measures ordered above.

XI. The decision is immediately and directly enforceable from the date of service in each of the countries listed under I. without security payment.

10 The Defendant requests:

I. to dismiss the action;

II. order Claimant to pay the costs of the proceedings;

III. to set aside the final order of the Local Division Hamburg of the Unified Patent court dated from 16 June 2025 (ORD_28305/2025, UPC_CFI 281/2025), under the condition that the Court of Appeal of the Unified Patent Court (UPC_CoA_579/2025) upholds the final order ORD_28305/2025.

In the alternative,

IV. to suspend the proceedings of the infringement action in relation to Spain, the Czech Republic, Switzerland/Liechtenstein until the European Patent Office, or a national authority or court of the respective country have made a first-instance decision on the validity of the respective national part of the patent-in-suit.

In the further alternative,

V. to suspend the permanent injunction for a reasonable period of time, at least until March 2027 subject to the provision of a security by Defendant of not more than EUR 500,000 by Defendant within one month, whereby the security can be provided in the form of a bank guarantee;

In the further alternative,

VI. to make the enforcement of the decision dependent on the provision of security, which may also be in the form of a bank guarantee (Art. 82 (2) UPCA, R. 352.1, 354.1 RoP).

Counterclaim for revocation

With its Counterclaim (28 October 2025) the Defendant requests:

A. Under the condition that the Local Division Hamburg of the Unified Patent Court finds that the EP 4 249 647 B1 is infringed by the accused embodiments, the Local Division Hamburg of the Unified Patent Court to hear and decide upon the following requests:

I. The European patent EP 4 249 647 B1 is revoked entirely with effect to the territory of Germany, Italy, the Netherlands, and in all other contracting states in which the patent-in-suit is effective and the UPC agreement was ratified at the date of the publication of the grant the patent-in-suit.

II. order Claimant to pay the costs of the proceedings;

In the alternative:

B. The Local Division Hamburg of the Unified Patent Court is requested, having regard to Article 33 of the Unified Patent Court Agreement, to rule:

I. The European patent EP 4 249 647 B1 is revoked entirely with effect to the territory of Germany, Italy, the Netherlands, and in all other contracting states in which the patent-in-suit is effective and the UPC agreement was ratified at the date of the publication of the grant the patent-in-suit.

II. order Claimant to pay the costs of the proceedings.

With its submission of 5 January 2026, the Claimant requests:

1. The Counterclaim for Revocation is dismissed;

2. As an auxiliary measure, the patent-in-suit is amended and maintained on the basis of the amended claims and amended description pages filed herewith as Auxiliary Requests 1 to 9 in this numerical order (Rule 30 RoP).

3. The Counterclaim for Revocation Claimant bears the legal costs.

11 With Reply to the Defence to the Counterclaim of Revocation dated 4 March 2026, the Defendant requests:

The application to amend the patent-in-suit is dismissed.

POINTS AT ISSUE

12 The Claimant asserts that it is entitled to enforce the claims at issue. It is the exclusive licensee of the patent-in-suit. The license agreement dated 10 January 2017, has been translated in the language of the proceedings (Exhibit GRU 1 and GRU1_EN) and has been entered into under Spanish Law. Even though the license agreement may have been signed by the same person on both sides and before the patent-in-suit was granted, this does not prevent the contract from being valid. The license agreement covers the patent-in-suit. The agreement includes any future patents in the field of electropolishing of metals.

13 It is the opinion of the Claimant that the Defendant's attacked embodiment infringes the patent-in-suit.

14 The Claimant is arguing that the term "non-conductive fluid" in claim 1 of the patent-in-suit means that such fluid can itself be conductive but shall not have a conductivity equal or higher than the conductivity of the "set of solid electrolyte particles, comprising solid particles that retain a conductive solution", since those particles are the ones to actually perform the electropolishing by coming into contact with the object to be treated. The patent-in-suit does not consider 10 micronS/cm as an absolute value of what is conductive and what is not. "Non-conductive" does not mean that the "non-conductive" fluid shall not have conductivity at all, since otherwise the requirement of "not significantly conducting electrical current" would not make any sense, but rather allows for the "non-conductive" fluid to actually be conductive. Consequently, the patent appreciates that the requirement that the set of solid electrolyte particles shall present an electrical conductivity greater than 10 micronS/cm, does not automatically pose a threshold for the conductivity of the "non-conductive" fluid. For the functioning of the electropolishing the relative relation of conductivities is relevant, but no absolute value has been used for the conductivity of the non-conductive fluid as this would not properly reflect the invention. The patent-in-suit clearly shows that it is about the relative values of conductivity between the set of solid particles and the non-conductive fluid.

15 According to the Claimant, the analysis of the attacked embodiment shows that the attacked embodiment infringes the patent-in-suit. The fact that the fluid surrounding the electrolyte particles of the EF 16-11 is (1) non-conductive and (2) immiscible with the conductive solution in the electrolyte particles has been demonstrated in Exhibit GRU 5. The Defendant's argument that the attacked embodiment contains only one fluid, an oil-in-water-emulsion, does not prevent an infringement.

16 The Defendant argues that the Claimant's requests must be rejected. The Claimant is not entitled to sue. It did not prove that the license agreement is valid. The license agreement is

signed on behalf of both parties by Mr. Pau Sarsanedas Millet and the agreement was signed on 10 January 2017 and thus predates the priority date of the patent-in-suit, without any explanation why and on what basis such advance disposal should be possible.

17 The Defendant disagrees with the Claimant on the construction of the claim. It is of the opinion that the patent-in-suit is not infringed, as the attacked embodiments does not contain a conductive solution and a non-conductive fluid in the meaning of the patent. The attacked embodiment contains an oil-in-water-emulsion with a higher conductivity. The term "non-conductive" is in contrast to the term "conductive" and the "non-conductivity" needs to be below 10 micronS/cm. This follows from the prosecution history of the patent and also preferred examples of the patent.

18 Further, the validity of the patent is in question. Prior use by the Defendant, as shown in Exhibit D1 and D2, destroys the novelty of the patent-in-suit. In addition, the invention of claim 1 is not novel based on Exhibits D3 and D4 and not inventive.

19 In addition, and to avoid repetition, reference is made to the parties' submissions and the entire contents of the file.

GROUNDS FOR THE DECISION

20 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.

INTERNATIONAL JURISDICTION

21 The UPC's international jurisdiction and the LD Hamburg's competence is not disputed. According to R. 19.7 RoP this shall be treated as a submission to the jurisdiction of the Court and the competence of the division chosen by the Claimant.

ADMISSIBILITY

22 The Infringement action and the Counterclaim for revocation are admissible.

A. Infringement action

23 The Claimant is entitled to bring the infringement action before the Unified Patent Court pursuant Art. 47 (2) UPCA, because the Claimant is deemed to be the exclusive licensee of the patent-in-suit.

24 The Claimant has demonstrated that it is the exclusive licensee of the patent-in-suit. It submitted the license agreement dated 10 January 2017 translated in the language of the proceedings (Exhibit GRU 1 and GRU 1_EN). The license agreement has been entered into under Spanish Law.

25 Although the license agreement has been signed by the same person on both sides, this does not prevent this agreement from being a valid contract. Based on the expert opinion provided by the Claimant, multiple representation generally is admissible under Spanish law unless there is a clear conflict of interest between the contracting parties. In the case at hand, licensor (patent holder) and licensee (Claimant) belong to the same group of companies. Whereas licensor's main business field is Research and Development, licensee's (i.e. Claimant's) main business field is manufacture and sales. The license granted results from the corporate structure and ensures comprehensive exploitation of licensor's patents, including the patent-in-suit. Therefore, Mr. Sarsanedas effectively concluded the license agreement on behalf of both contracting parties. A clear conflict of interest cannot be found.

26 The license agreement covers the patent-in-suit. The agreement includes any future patents in the field of electropolishing of metals (Exhibit GRU-1en):

> "Both parties have agreed that the use of the patents of DRYLYTE, S.L. in the field of electropolishing, both those already existing and those that may be added in the future, shall be transferred to STEROS GPA INNOVATIVE, S.L. as an exclusive right. […]
>
> By virtue of this agreement, DRYLYTE, S.L. assigns the use of its patents in the field of electropolishing of metals exclusively to STEROS GPA INNOVATIVE, S.L. The transfer includes both the currently registered patents and all other patents that should be registered during the term of the agreement and its possible extensions."

27 The fact that the priority date of the patent-in-suit is after the Effective Date of the agreement is, therefore, irrelevant. Therefore, the Claimant is entitled to sue.

28 Admissibility of the infringement action is clear and undisputed.

B. Counterclaim for revocation

29 The admissibility of the counterclaim for revocation is clear and undisputed and set under the condition by the Defendant to decide upon the counterclaim only if an infringement was to be found. Such a conditional counterclaim for revocation is permissible (see CoA, UPC_CoA_40/2026, Order of 17 August 2026 – Aortic v Emboline). Thus, the panel has only to examine the counterclaim for revocation in case infringement is found (request A.). As a consequence, the alternative request B. – unconditional counterclaim – is not to be examined.

THE PATENT

A. Subject matter of the patent-in-suit

30 The patent-in-suit generally relates to electropolishing, in particular an electrolytic medium and an electropolishing process using such electrolytic medium.

31 The patent-in-suit discloses that in 2016 a new technology for polishing metal surfaces based on an electrochemical process using a solid electrolyte described in the patent document under publication number ES 2 604 830 was released (see para. [0002]). By using a novel solid

electrolyte, this process substantially improved the conventional liquid electropolishing process. From a practical point of view, the use of corrosive concentrated acid solutions is avoided and no liquid waste is generated. On the other hand, the results obtained surpass those expected from a conventional electropolishing process, since solid bodies free of solid electrolyte increase selectivity by concentrating the electrochemical effect on the roughness peaks (see para. [0002]). Several documents, mentioned in the patent-in-suit (see para. [0003] to [0008]), describe different compositions of the solid electrolyte to carry out the process.

32 The patent-in-suit mentions a number of limitations of the compositions. When the lowest levels of roughness that the system reaches are reached, a characteristic ripple is generated, commonly called ”orange peel”. The particles generate acid exudates on the metal surface that often cause pitting. The acid exudates, together with atmospheric oxygen, oxidize the surface in an uncontrolled way. The final roughness cannot be reduced beyond a limit, which depends on the piece (initial roughness, metal, shape, etc.) and the solid electrolyte (size, composition, concentration, etc.) The evaporation of the contained electrolyte liquid generates a drift of results in the process. The high mechanical resistance of the medium prevents delicate pieces from being polished.

33 The patent-in-suit further refers to patent ES 2 756 948A1, that discloses a solid electrolyte for dry electropolishing of metals comprising: at least one type of active ion exchange resin particles charged with an acidic solution that generate chemical activity and electrical activity, at least one type of particles that moderate the chemical action and/or particles that moderate the electrical conductivity of the particles active, in such a way that the moderating particles reduce the localized attacks to the surface of the polished piece caused by the exudates of the active particles by means of electrically active solid particles (9), comprising an electrical source (2) with an electrode (3) that transmits electric charge to the electrically active solid particles (9) and means for projecting electrically active solid particles onto the surface to be treated (1).

34 Based on the foregoing, the patent-in-suit defines its object to provide a new electrolytic medium and an electropolishing process that uses it. Claim 1 has the following features:

[1] Electrolytic medium comprising:
[1.1] a set of electrolyte particles, comprising
[1.1.1] solid particles that retain a conductive solution,
[1.1.2] the set presenting an electrical conductivity greater than 10 micronS/cm, and
[1.2] a non-conductive fluid immiscible in the conductive solution,
[1.2.1] immiscible being understood as not forming a single phase in any proportion from 0 to 100°C,
[1.2.2] the non-conductive fluid when being at rest at room temperature not significantly conducting electric current.
[2] The electrolytic medium being suitable for an electropolishing process comprising the steps of:
[2.1] a) connecting at least one piece to be polished to a power supply;

[2.2] b) connecting at least one electrode to the opposite pole of the power supply;

[2.3] c) contacting the at least one piece to be polished and the solid electrolyte particles of the electrolytic medium with a relative movement between the piece and the particles;

[2.4] d) applying a potential difference between the piece to be polished and the electrode, which produces a current flow between them through the electrolytic medium.

B. Claim construction

1) Person skilled in the art

35 The technical field in question is the field of surface treatment processes that can be differentiated – among others – by mechanical, chemical and electrochemical processes. The patent-in-suit focuses on certain technical aspects of surface treatment by electropolishing. Thus, the skilled person of the technical field in question would be a mechanical engineer, who is experienced in the field of surface treatment, especially in the field of electropolishing.

2) Interpretation of claim 1

a) Legal principles

36 According to Art. 69 EPC in conjunction with Art. 1 of the Protocol on its interpretation, the patent claim is not only the starting point, but the definitive basis for determining the protective scope 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 explanatory aids for the interpretation of the patent claim and not only be used to clarify any ambiguities in the patent claim. However, this does not mean that the patent claim serves only as a guideline and that its scope may extend to what, from a consideration of the description and drawings, the patent proprietor has contemplated. The patent claim is always to be interpreted from the point of view of a person skilled in the art (CoA, UPC_CoA_1/2024, Order of 13 May 2024, App_8/2024 – VusionGroup SA v Hanshow Technology Co. Ltd et al.; UPC_CoA_335/2023, Order of 26 February 2024, App_576355/2023 – 10x Genomics and Harvard/Nanostring case; Order of 11 March 2024, - Nachweisverfahren; LD Düsseldorf, UPC_CFI_452/2023, Order of 9 April 2024, p. 13, GRUR-RS 2024, 7207, para. 49). Additionally, the skilled person is taking the purpose of every patent claim into account, to provide the average person skilled in the art with a technical teaching which, when reworked, leads to the intended success of the invention.

b) Assessment

37 The following describes in more detail the aspects that are relevant to the assessment of infringement.

aa) Feature group 1.1

38 Feature group 1.1 relates to an electrolytic medium that comprises two components: feature 1.1.1 – a set of solid electrolyte particles that retain a conductive solution; feature 1.1.2 specifies that the electrical conductivity of the set of particles retaining a conductive solution is greater than 10 micronS/cm. Accordingly, the feature group 1.1 is described by its physical properties, according to which the solid electrolyte particles must be able to retain the

conductive solution and the conductivity of the set of particles and conductive solution must be greater than 10 micronS/cm.

39 The conductive solution and the function of it is explained in the patent-in-suit in para. [0049] et seq.:

> "The conductive liquid solution that is retained in the particles is a conductive liquid. The function of the conductive liquid solution in an electropolishing process is twofold: on the one hand, it conducts electricity, and on the other, it must be able to dissolve the oxides that are formed on the surface to be treated. For this reason, the composition of this liquid is key and depends on the process to which it is to be applied, on the type of surface to be treated. For electropolishing processes the conductive liquid solution can be an ionic liquid, a liquid acid, a conductive solution, a conductive liquid polymer."

40 In para. [0050] et seq. further preferred embodiments are described. The specification does not provide restrictions with regard to the conductive solution. The only requirements are that the solution is conductive and that it provides a conductivity of at least 10 micronS/cm to the set of particles retaining said solution.

bb) Feature group 1.2:

41 The question how the term "non-conductive fluid" in feature group 1.2 should be understood in the context of the patent-in-suit is the main and decisive issue in these matters and hence requires a thorough analysis. The non-conductive fluid, [which is part of feature group 1.2,] is described as non-conductive and immiscible in the conductive solution. Both, the conductivity and the immiscibility, are further defined in the sub-features 1.2.1 and 1.2.2: immiscible being understood as not forming a single phase in any proportion from 0 to 100°C and the non-conductive fluid when being at rest at room temperature not significantly conducting electric current.

42 As in feature group 1.1 with regard to the conductive solution, the term non-conductive fluid in feature group 1.2 is described solely by physical properties: immiscibility with the conductive solution and no significant conductivity. Therefore, the non-conductive fluid is not defined by a specific formula or substance class. However, the person skilled is aware that not every substance exhibiting the aforementioned physical properties is covered by the scope of protection of the patent-in-suit, but only those that are suitable for performing the function of the invention, because the technical interpretation of the terms used in the patent claim is determined primarily by the purpose of the feature described by those terms, as expressed in the patent specification. Based on the wording, the technical and functional meaning of the feature must be determined as it applies in the context of the invention. A function-based interpretation is, in any case, appropriate if the wording of the patent claim does not, on its own, allow for a clearly defined understanding. For just as with spatially and physically described features of a patent claim—where a functional interpretation cannot prevail over the spatially and physically described features—so too, in the case of features described solely by their physical properties, their technical function, as intended by the patent, may not be

disregarded. Otherwise, the scope of protection would be limited solely by the physical properties of a material specified in the claim, without it being possible to achieve the result of the invention.

43 Based on this, the function of the non-conductive fluid is crucial to the case. The term “non-conductive fluid” is defined by the patent-in-suit as the “defining element of this invention” (para. [0013], [0067]). The technical function of the non-conductive fluid is explained in detail in the patent-in-suit: Without a non-conductive fluid the difference in potential applied between the electrodes causes redox reactions at the particle-metal contact points (metal roughness peaks). These metal oxides are eliminated by the particles in the form of cations, producing a polishing effect. Solid electrolyte particles conduct electricity through the contact areas between them. When the particles contact the metal surface, due to pressure, they leave acid exudates on the surface (see para. [0023]).

44 Adding a non-conductive fluid leads to several technical effects. With regard to the effect among particles the patent-in-suit describes that in contrast, to a situation without non-conductive fluid, where each particle has a part of its surface that contacts other particles and another part that contacts the gaseous medium, the non-conductive fluid contacts the surface of the spherical particles, without significantly penetrating the interior, avoiding areas where the particle contacts another particle (para. [0025]). In the particle-particle contact areas, the liquid electrolyte in the particles is concentrated and the immiscibility between the two fluids (conductive and non-conductive) makes the particle-particle conductive liquid menisci more concentrated in space, and therefore stronger. This translates into greater particle connectivity (para. [0026]).

45 With regard to the effect on the surface to be polished the patent-in-suit explains in detail that the covering of the metal surface with non-conductive fluid leads to several positive effects on the final finishes (para. [0027] and [0072]):

- Protection from localized acid attacks. As the surface is covered with immiscible liquid, the aqueous acidic exudates of the particles do not accumulate on the metal surface, which prevents pitting.
- Reduction of atmospheric oxidation, by preventing the contact of ambient oxygen with the metal.
- As the oxidation of the metal is due exclusively to the contact of the particles and the passage of electric current, the control over the electrochemical process is increased.
- The electrochemical action is concentrated where it is most effective, in the roughness peaks. If we visualize the surface roughness as a succession of peaks and valleys, the non-conductive fluid leaves the valleys inactive against the electrochemical process.
- Lower final roughness and ripple. As the fluid is preferentially distributed in the valleys, the process is able to better discern roughness and achieve smoother finishes.
- Reduction of the final ”orange peel”.
- More selective process: less metal removed to achieve the same roughness reduction.

46 Bullet point 3 emphasizes that the oxidation of the metal that causes the polishing effect, occurs exclusively where the metal is electrically connected to the particles and the electric current can flow. It is further explained – bullet point 4 – that the electrochemical action is concentrated at the peaks of the surface, whereas the valleys of the metal surface are covered by the non-conductive fluid which leaves them inactive against the electrochemical process.

47 Para. [0067] et seq. explains and further describes the non-conductive fluid:

> "(…) It is a fluid that when being at rest at room temperature does not significantly conduct electrical current. To fulfil its function it must be immiscible in the liquid electrolyte contained in the solid electrolyte articles. In this way, by affinity the liquid electrolyte is kept inside the particles and the non-conductive fluid outside. As it must withstand the presence of an electrolyte liquid that can be an acid solution, in addition to considerable voltages, the non-conductive fluid must be a compound being stable or kinetically stable under working conditions."

48 Preferred embodiments of types of non-conductive fluids that meet the necessary criteria (volatility, viscosity, toxicity etc., para. [0077]) have a common characteristic as they are non-polar. The patent-in-suit mentions hydrocarbons, organic solvents, essential oils, silicone and silicone oils, fluorinated solvents and in particular non-conductive fluids based on emulsified systems. The latter are given special emphasis.

49 For the skilled person, the term emulsion refers to a heterogenous mixture of at least two liquids which cannot be mixed in a homogenous way. An emulsion contains small droplets of one liquid ("micelles") which are dispersed in a continuous phase of another liquid. The emulsified systems are described as having a high erosion speed, high fluidity that facilitates pumping, and also provide high quality finishes. An additional advantage is the possibility to more easily adapt the formula to different needs (para. [0088]).

50 The patent explicitly describes only water-in-oil emulsions and there is no indication that oil-in-water emulsions might be included or even capable of performing the function described in the patent. Para. [0089], that makes reference to the non-conductive fluids based on emulsified systems in para. [0088], explains in this context (emphasis added):

> "These emulsions are <u>expressly a non-conductive non-polar continuous phase containing conductive polar solution micelles</u>. According to the terminology commonly used in emulsions, we are talking about water-in-oil type emulsions (w/o). The conductive polar solution of micelles has the same composition as the conductive solution that is retained by the solid electrolyte particles. As the non-polar continuous phase is non-conductive, the emulsion at rest without solid electrolyte particles is non-conductive."

51 Therefore, para. [0089] exclusively discloses emulsions that have a non-polar non-conductive continuous phase and a polar conductive phase which is dispersed in the continuous phase, i.e.

a water-in-oil emulsion. Emulsion of the reverse type, oil-in-water emulsions, are not mentioned anywhere in the patent-in-suit.

52 The fact that emulsion-based non-conductive fluids are limited to water-in-oil type emulsion becomes also clear taking the technical effects attributed to the non-conductive fluid into account. Para. [0027] describes the effects of the non-conductive fluid:

- covering the valleys of the metal surface to leave them inactive against electrochemical processes, and
- concentrating the interparticle connectivity due to its immiscibility in the conductive solution.

53 These technical effects could not be achieved by an oil-in-water type emulsion because the conductive continuous aqueous phase would not leave the metal surface inactive against electrochemical processes, and it would not produce a higher interparticle connectivity as the conductive continuous aqueous phase of the oil-in-water emulsion outside the particles would mix with the conductive solution inside the particles. In addition, an oil-in-water emulsion would be electrically conductive because a continuous aqueous phase conducts current, which would contradict the requirement of claim 1 that the non-conductive fluid itself must be a not significantly conducting fluid (feature 1.2).

54 The EPO also noted this in its provisional opinion on page 9 (Exhibit GRU 26) with regard to the objection of the Defendant to novelty in view of public prior use. It is of the opinion

> "(…) The skilled person would understand the term "non-conductive fluid" in the context of claim 1 as referring to the fluid phase that performs the functions attributed to it in the patent, namely forming bridges between the particles, covering the metal surface, and modifying the electrochemical interaction between the particles and the workpiece. By contrast, dispersed micelles suspended within a conductive continuous phase do not constitute such a fluid phase. Therefore, the disclosure of PL1 does not directly and unambiguously disclose the claimed non-conductive fluid. The mere presence of dispersed micelles within a conductive continuous phase is insufficient to anticipate this feature."

55 The public prior use (referred to as PL1) contained an oil-in-water emulsion, and the Opposition Division of the EPO was of the provisional opinion that this emulsion cannot perform the function claimed in the patent.

56 It cannot convincingly be argued in this regard that the water-in-oil emulsion is merely a preferred embodiment and protected by a dependent claim. Dependent claim 8, that reads as follows:

> "Electrolytic medium according to any of claims 1 to 7, wherein the non-conductive fluid is an emulsion comprising:

• a non-conductive fluid as a non-polar continuous phase selected from hydrocarbons with five to sixteen carbons, liquid silicones, or fluorinated solvents;
• a conductive solution as a dispersed polar phase, wherein the conductive solution has the same composition as the conductive solution that is retained by the solid particles; and
• a surfactant."

merely protects certain configurations of a water-in-oil emulsion, namely a non-polar continuous phase selected from hydrocarbons with five to sixteen carbons, liquid silicones, or fluorinated solvents and a conductive solution as a dispersed polar phase, wherein the conductive solution has the same composition as the conductive solution that is retained by the solid particles. In this regard, it is, of course, well established that a dependent claim merely narrows a broader main claim. Here, claim 8 relates to specific configurations of a water-in-oil emulsion wherein the oil phase is selected from three classes of compounds while the non-conductive fluid of claim 1 is defined by functional features and not restricted in terms of its chemical components. The patent otherwise provides no indication that other emulsions might also be included within the scope of the invention.

57 In light of the aforementioned, it is with regard to the question of infringement of the patent-in-suit therefore irrelevant whether the non-conductive fluid is formed by the entire emulsion, as the Court of Appeals holds, or whether the non-conductive fluid can also be formed by the non-polar continuous phase of the emulsion, as the Court of First instance held in the proceedings for provisional measures. Likewise, the disputed question between the parties—namely, what "not significantly conducting electric current" means—is irrelevant for deciding on infringement

C. Infringement

58 In light of the preceding interpretation of the term "non-conductive fluid" described in feature group 1.2, it cannot be established that the attacked embodiments fall within any of the claims of the patent-in-suit. The term "non-conductive fluid" is limited to water-in-oil emulsions and the Defendant has argued, without that being challenged by the Claimant, that the emulsion used in the attacked embodiments is an oil-in-water emulsion.

COUNTERCLAIM FOR REVOCATION

59 Since the Court did not find the patent infringed, the – in itself admissible – condition on which the counterclaim is to be decided has not been met.

LEGAL CONSEQUENCES

60 The infringement action is dismissed.

61 The Claimant shall bear the costs of the infringement action, the parties shall bear their own costs with regard to the counterclaim for revocation, Art. 69 (1) UPCA.

62 There is yet no established case law regarding how the costs of such conditional counterclaims for revocation are handled if no decision is rendered on the conditional counterclaim and the parties have not agreed upon the costs. The LD Munich (UPC_CFI_628/2024, decision of 13 January 2026) found that the Defendant has to reimburse the Claimant for the corresponding costs of the counterclaim for revocation, because the Defendant is responsible that no decision is to be made on the counterclaim. The LD Mannheim and the LD Paris, on the other hand, (UPC_CFI_706/2025, decision of 23 October 2026; UPC_CFI_301/2025, decision of 19 August 2026) took the view that the Claimant has to bear the costs of the conditional counterclaim for revocation since the Claimant is considered to be the unsuccessful party, even though the conditional counterclaim for revocation remains undecided. It was reasoned in those decisions that: "This is because the Defendant prevailed with its primary argument/defence (non-infringement) yet was forced to file the conditional counterclaim to challenge the validity of the patent-in-suit as a secondary argument in case the Court finds infringement. However, if the Court finds that the patent-in-suit is not infringed, in line with Defendant's primary defence, it is justified to view the Claimant as the unsuccessful party with respect to both proceedings, since the only reason why the conditional counterclaim for revocation remains undecided is the lack of infringement."

63 Unlike in the cases referred to above, the members of the panel of the LD Hamburg consider it appropriate that the parties bear their own costs of the counterclaim. In the event that a conditional counterclaim is not decided because the condition has not been fulfilled, the court does not regard either party as the winning or losing party. The Defendant, on the one hand, felt compelled, as a result of the Claimant's infringement action, to bring the counterclaim in order to have a further line of defence. However, no ruling is being made on this counterclaim because the condition has not been fulfilled. On the other hand, because the counterclaim was made subject to a condition, the Claimant had no influence over its outcome and thus over the allocation of costs. In this case, if the counterclaim is not to be decided none of the parties win or lose and therefore have to bear their own costs. The above principles apply, at least, if the counterclaim for revocation is made conditional upon a finding of infringement from the outset, i.e. when filing the conditional counterclaim for revocation with the statement of defence.

64 The values of dispute for the infringement action and for the counterclaim for revocation are not disputed.

Decision:

1. The infringement action is dismissed.
2. The costs of the infringement action are to be borne by the Claimant.
3. The parties shall bear their own costs in respect of the counterclaim for revocation.
4. The value in dispute for the infringement action is set at EUR 500.000. The value in dispute for the counterclaim for revocation is set at EUR 500.000.

Sabine Klepsch Presiding Judge und Judge-rapporteur	SABINE MARIA KLEPSCH Digital unterschrieben von SABINE MARIA KLEPSCH Datum: 2026.11.01 10:49:14 +01'00'
Dr. Stefan Schilling Legally qualified Judge	STEFAN SCHILLING Digital signiert von STEFAN SCHILLING DN: cn=STEFAN SCHILLING, c=DE, email=stefan.schilling@unifiedpatentcourt.org Datum: 2026.11.01 19:05:42 +01'00'
Petri Rinkinen Legally qualified Judge	Digitally signed Rinkinen Petri Olavi 2026-11-01 12:47:37 +0100 Unified Patent Court Einheitliches Patentgericht Juridiction unifiée du brevet
Rudi Goedeweeck Technically qualified Judge	Rudi Auguste B Goedeweeck Digitally signed by Rudi Auguste B Goedeweeck Date: 2026.11.01 22:21:27 +01'00'
For the sub-registry	Digitally signed Ewers Carolin 2026-11-04 12:16:45 +0100 Unified Patent Court Einheitliches Patentgericht Juridiction unifiée du brevet

Information on appeal

An appeal against this decision may be brought before the Court of Appeal by any party whose claims have been unsuccessful, in whole or in part, within two months of service of the decision (Art. 73(1) UPCA, R. 220.1 (a) RoP, 224.1 (a) RoP).

This decision was announced in public session on 04 November 2026

STEFAN SCHILLING Digital signiert von STEFAN SCHILLING DN: cn=STEFAN SCHILLING, c=DE, email=stefan.schilling@unifiedpatentcourt.org Datum: 2026.11.04 12:07:11 +01'00'