UPC CFI, Local Division Munich, 27 august 2024, Syngenta v Sumi Agro

Appeal:
- IPPT20241227, UPC CoA, Sumi Agro v Syngenta

PATENT LAW – PROCEDURAL LAW

Provisional injunction: imminent danger that the Applicant's right will be infringed by the contested embodiment in the Contracting States, in particular in Germany and Bulgaria (Article 62 UPCA, R. 211 RoP)
- It is at least more likely than not that the contested embodiment, the 2023 version of KAGURA, makes literal use of the technical teaching of claim 1. The Local Division is therefore sufficiently convinced that the contested embodiment directly infringes claim 1 of the patent-in-suit as granted (Art. 62(4) UPCA, R. 211.2 RoP, Article 25 UPCA)
- In case of a product claim directed to a composition it is sufficient for the applicant to allege and prove that at the time of any act of use under Art. 25 UPCA by the respondent, the attacked composition had all the features of the patent claim or that there is an imminent danger that such an act of use directed to such a composition will be carried out by the respondent in the future. It is not on the applicant to plead and prove why the composition had all features of the patent claim.

Risk of infringement in Contracting States by distributing the 2023 product outside the Contracting States, namely in the Czech Republic, and by advertising "*KAGURA*" within the Contracting States.
- The Respondents have in any event created a risk of first infringement that patent-infringing compositions will be manufactured, advertised and distributed by them in the territory of the Contracting States in the future (Art. 25(a), 62(1) UPCA).
- In the circumstances of this case, in order to eliminate the risk of first infringement, the Respondents should have offered a cease-and-desist declaration with a penalty clause in respect of the 2023 product, as suggested by this Panel during the hearing.

In proceedings for provisional measures the number of invalidity arguments must generally be reduced to the best three (R. 211(2) RoP)
- Due to the summary nature of the validity examination in proceedings for the grant of provisional measures, a full examination of all the arguments raised, which may be numerous as in nullity proceedings, is not possible. Rather, the number of arguments raised against the validity of the patent must generally be reduced to the best three from the respondent's point of view (UPC CFI 443/2023 ACT 589207/2023 (LD Munich), order of 21 May 2024, 3rd LS). The background to this is that while a summary assessment of factual issues is conceivable, a summary examination of legal issues is not. The court can either examine a legal issue or not. If the court decides to examine the issue, it will do so comprehensively. The only way to take account of the summary nature of the procedure is therefore to reduce the number of legal issues to be fully examined in this way. This is made clear by the requirement to limit the number of arguments to three. Since it is the respondent's responsibility to challenge the presumption of validity, it is primarily the respondent's responsibility to select the three arguments to be examined in detail by the panel in summary proceedings.

Temporal urgency, unreasonable delay (R 209(2)(b) RoP, R 211(4) RoP)
- In view of the diverging case law on temporal urgency, which grants the applicant only one month, […] the Local Division Munich adheres to its case law granting two months

In view of the diverging case law, which grants the applicant only one month, e.g. in UPC CFI 452/2023 (Local Division Düsseldorf), order of 9 April 2024, GRUR-RS 2024, 7207, Rz. 128, the Local Division Munich adheres to its case law. In the context of a dispute involving more than one participating member state, the UPC representative for the applicant must be given sufficient time as a safe harbour period to prepare the written request and the accompanying evidence and to discuss the prepared documents with the client. In German national case law, this safe harbour period had been set at one month by most of the Higher Regional Courts. However, these German requests only covered the territory of Germany. In the UPC, these requests regularly cover more than one territory, and it is therefore regularly necessary to consider relevant factual or legal details or specific evidence for these territories as well. This regularly requires more time.
- In the absence of guidance from the CoA, the Local Division Munich sets this safe harbour period at 2 months for cases involving more than one participating member state and where the applicant requests a prior hearing of the respondent.
- However, if the applicant exceptionally requests provisional measures without prior hearing of the respondent, no safe harbour time limit is to be provided. The applicant will regularly expect the court to deal with

such requests at short notice and therefore such requests must be made as soon as possible with due cause.

Source: Unified Patent Law

UPC Court of First Instance
Local Division Munich, 27 august 2024
(Zigann, Schober, Pichlmaier, Dorland-Galliot)
UPC_CFI_201/2024
Order
of the Court of First Instance of the Unified Patent Court Local Division Munich
issued on 27 August 2024
HEADNOTES:
1. In case of a product claim directed to a composition it is sufficient for the applicant to allege and prove that at the time of any act of use under Art. 25 UPCA by the respondent, the attacked composition had all the features of the patent claim or that there is an imminent danger that such an act of use directed to such a composition will be carried out by the respondent in the future. It is not on the applicant to plead and prove why the composition had all features of the patent claim.
2. Distributing a patent infringing composition outside the Contracting States and advertising a composition under the same name within the Contracting States, can create a risk of first infringement that patent-infringing compositions will be manufactured, advertised and distributed in the territory of the Contracting States in the future.
3. In the circumstances of this case, in order to eliminate the risk of first infringement, the respondents should have offered a cease-and-desist declaration with a penalty clause. An actus contrarius is not sufficient.
4. In proceedings for the grant of provisional measures, a full examination of all the arguments raised against the validity of the patent-in-suit, which may be numerous as in nullity proceedings, is not possible. Rather, the number of arguments raised against the validity of the patent must generally be reduced to the best three from the respondent's point of view (UPC_CFI_443/2023 ACT_589207/2023 (LD Munich), order of 21 May 2024, 3rd LS). The background to this is that while a summary assessment of factual issues is conceivable, a summary examination of legal issues is not. The court can either examine a legal issue or not. If the court decides to examine the issue, it will do so comprehensively. The only way to take account of the summary nature of the procedure is therefore to reduce the number of legal issues to be fully examined in this way. This is made clear by the requirement to limit the number of arguments to three. Since it is the respondent's responsibility to challenge the presumption of validity, it is primarily the respondent's responsibility to select the three arguments to be examined in detail by the panel in summary proceedings.
5. In view of the diverging case law on temporal urgency, which grants the applicant only one month, e.g. in UPC_CFI_452/2023 (Local Division Düsseldorf), order of 9 April 2024, GRUR-RS 2024, 7207, Rz. 128, the Local Division Munich adheres to its case law granting two months.
KEYWORDS:
Application for provisional measures; product claim; composition; burden of pleading and proof; risk of first infringement; cease-and-desist declaration; number of arguments as to validity; temporal urgency; safe harbour period two months.
APPLICANT
Syngenta Limited, Jealott's Hill International Research Centre, RG42 6EY, Bracknell, Berkshire – GB
represented by: Dr. Jörn Peters (Fieldfisher) Prof. Dr. Aloys Hüttermann (Michalski, Hüttermann & Partner) Dr. Filip Alois J. De Corte, Dr. Christopher Andrews (Syngenta Crop Protection AG)
RESPONDENTS
1) Sumi Agro Limited, Bürgermeister-Neumeyr-Str. 7 - 85391 - Allershausen – DE
2) Sumi Agro Europe Limited, Bürgermeister-Neumeyr-Str. 7 - 85391 - Allershausen – DE
represented by: Gareth Williams (Marks & Clerk) Johannes Heselberger, Dr. Axel B. Berger, Dr. Kerstin Galler, Dr. Markus Ackermann (Bardehle Pagenberg)
PATENT AT ISSUE
European patent n° EP 2 152 073
PANEL/DIVISION
Panel 1 of the Local Division Munich
DECIDING JUDGES
This order has been issued by the presiding judge Dr. Matthias Zigann, the legally qualified judge Dr. Walter Schober, the legally qualified judge Tobias Pichlmaier, and the technically qualified judge Xavier Dorland-Galliot.
LANGUAGE OF THE PROCEEDINGS
English
SUBJECT-MATTER OF THE PROCEEDINGS
Application for provisional measures, filed by Applicant on 30 April 2024 and deemed to be served on Respondents on 20 May 2024.
ORAL HEARING
12 July 2024
SUMMARY OF FACTS
The Applicant and the Respondents are international companies active in the plant protection industry.
The applicant is the proprietor of the European patent with publication number EP 2 152 073 B1 ('the-patent-in-suit') (Exhibit FF 1), entitled 'Herbicide compositions'. The patent-in-suit was filed on 19 May 2008 claiming priority from UK application GB 0709710 of 21 May 2007. The date of publication and mention of grant was 15 April 2015. It is in force in, inter alia, the Federal Republic of Germany, Austria, Belgium, Italy and other UPC member states, as evidenced by the attached extracts from the European Patent Register and the related information on Espacenet (Exhibit FF 2). The patent-in-suit has not been the subject of opposition or other validity or infringement proceedings before national courts or the Unified Patent Court.
Claim 1 of the patent-in-suit reads as follows:
An herbicidal composition comprising:

a. at least one sulfonylurea herbicide;
b. at least one HPPD-inhibiting herbicide; and
c. at least one saturated or unsaturated fatty acid from 1% to 95% by weight.

The Applicant is headquartered in Great Britain.

The First Respondent has its principal place of business in London, United Kingdom, and the Second Respondent also has its principal place of business in London. The Respondents maintain German branches ("*Niederlassungen*") of their respective head offices in London.

The embodiment at issue is a herbicide marketed under the trade name *'Kagura'* or *'Genki'* (hereinafter referred to as *'Kagura'*). Kagura is registered and used for the control of weeds in maize. Kagura contains two active ingredients, mesotrione and nicosulfuron, and is sold as an oil dispersion. Kagura competes directly with a product sold by the Applicant under the trade name *'Elumis'*, a herbicide based on the patent in suit. Although Kagura is not an exact generic counterpart of Elumis, it shares key features with it, including the active ingredients mesotrione and nicosulfuron, and both are marketed as ready-mixed products, making them easier for users to apply. Only feature C is in dispute between the parties.

The Respondents obtained marketing authorisation for Kagura in Poland on 7 July 2022, in the Czech Republic on 13 December 2022, in Belgium on 4 April 2023, in Slovenia on 28 September 2023, in Bulgaria on 2 October 2023, in Germany on 2 August 2023, in Austria on 11 December 2023 and in Italy on 9 May 2024. The granting of marketing authorisation in each territory was public in the sense that the registration report was published by the respective national assessment authority and made available online to any interested party on or shortly after the date of grant. The Respondents started marketing activities for Kagura around December 2022/January 2023 in Poland and the Czech Republic and around December 2023 in Bulgaria and Germany. This included the inclusion of Kagura in product lists published on the Sumi Agro website and in Sumi Agro's spring catalogues. For example, the Sumi Agro spring catalogue was uploaded to the Sumi Agro website at www.sumiagro.de on 10 January 2024. Kagura was never marketed in Italy, Austria, Belgium or Slovenia. In order to facilitate the distribution of Kagura, the first Respondent operates a website, accessible via the domain https://www.sumiagro.de/, on which the embodiment at issue is offered to customers in German. On the website, Kagura is prominently listed under *'products'* and under both *'stock list'* and *'transport list'*. Screenshots of the website are submitted as exhibits FF 16, the stock list as exhibit FF 17 and the corresponding transport list as exhibit FF 18. In addition, the first Respondent distributes a catalogue for spring cultivation in 2024, which is easily downloadable by customers and in which Kagura is prominently featured as a "*new*" product. The relevant pages of this spring catalogue are produced as exhibit FF 19. The German website is also accessible in Austria (https://www.sumiagro.com/contact/, see also Exhibit FF 20).

The Applicant states that it first became aware of Kagura and the related registration and marketing activities around April 2023, when it was found in the Czech Republic (and thus outside the UPC territory). Subsequently, in June 2023, the applicant obtained a sample of Kagura in the Czech Republic and carried out an analysis in its own laboratories to examine the specific composition, in particular the amount of fatty acids in the product.

The analysis was carried out by […] in Syngenta's Analytical & Product Chemistry Department in Greensboro, North Carolina, USA. […] reported the results of this initial analysis in December 2023 (Affidavit as Exhibit 8). This affidavit is based on the findings of […] (Exhibit FF 8).

The Applicant contacted the Respondents to inform them of the patent infringement relating to their product Kagura. During the subsequent discussions between the parties, the Respondents stated that the Kagura formulation did not contain any fatty acid component. In order to verify the Respondents' statements and to exclude the possibility that errors had been made in the first analysis, the Applicant carried out a second analysis of the same sample to confirm the accuracy of the first results. The second analysis was again carried out by […] who set out her findings in a second affidavit (Exhibit FF 8). The results of the second analysis were reported by […] in February 2024. The Applicant asked the Authorised Representatives to assess whether there was patent infringement and to summarise the findings in a memorandum. The representatives conducted a legal review and sent the memorandum to the plaintiff on 18 March 2024.

The Applicant states that, at around the same time, it became aware that the Respondents had commenced marketing activities for Kagura in Germany and other countries.

The Applicant filed the request for provisional measures with the Local Division Munich of the Unified Patent Court on 30 April 2024.

The respondents have added the following elements to the timeline of events

18 December 2023

Telephone call from […] of Syngenta, to […] of Sumi Agro Europe, in which Syngenta's infringement concerns regarding Kagura and EP 073 were first raised. Sumi Agro Europe denied infringement but agreed to investigate.

21 December 2023

Email from Charlie Balme of Marks & Clerk Law (acting for Sumi Agro Europe) to Chris Andrews, Syngenta's in-house patent counsel, confirming that Sumi Agro Europe was investigating the allegation.

9 January 2024

Email from Charlie Balme to Chris Andrews requesting a phone call to discuss the matter. Chris Andrews replies the same day confirming his availability for a call the following week on 16 January 2024.

16 January 2024

Team call between Charlie Balme and Chris Andrews in which Charlie Balme explains Sumi Agro's position on non-infringement with respect to the confidential recipe for Kagura and its position on invalidity with respect to EP 0 915 652. Email from […] to […] Syngenta's […] requesting immediate feedback from Syngenta in order to bring the matter to a timely conclusion.
17 January 2024
Email from Chris Andrews to Charlie Balme confirming that Syngenta will continue to actively review the situation internally and that he will return as soon as he is in a position to do so.
18 January 2024
Email from Chris Andrews to Charlie Balme requesting a copy of the confidential Kagura formulation so that Syngenta can further investigate its preliminary analytical results on Kagura, requesting a product sample and discussing the EP 652 prior art patent mentioned during the teams call.
23 January 2024
Email from Charlie Balme to Chris Andrews confirming Sumi Agro's agreement to share the confidential formulation for Kagura subject to Syngenta's agreement to confidentiality terms, confirming Sumi Agro's agreement to provide a product sample subject to seeing the analysis already done and further commenting on the disclosure in EP 652.
26 January 2024
Email from Chris Andrews to Charlie Balme confirming Syngenta's agreement to confidentiality terms, that Syngenta was conducting further internal investigation with its analytical team and that they may return to the product sample request once their internal investigation is complete.
26 January 2024
Email from Charlie Balme to Chris Andrews attaching the confidential recipe for Kagura and stating that Sumi Agro looked forward to hearing from Syngenta once its further internal investigation was complete.
30 April 2024
Email from […] to […] requesting a quick phone call on this matter for an update.
7 May 2024
Telephone call from […] to […] informing him that on 30 April 2024 Syngenta filed an infringement case against Sumi Agro regarding Kagura in a court in Munich.
The Applicant contends that KAGURA literally infringes claim 1 of the patent in suit.
The Applicant bases this contention on the analysis performed by […] (Exhibit FF 8).
Exhibit FF 8 sets out the results of the two analyses performed by […] with respect to feature C as follows:
The results of the first analysis conducted in December 2023 (Exhibit FF 8):

Sample	Fatty acid profile (in % w/w)			
	Palmitic acid	Stearic acid	Oleic acid	Linoleic acid
Kagura	0.73	0.44	2.27	2.23

The results showed a total fatty acid content of 5.67%.
The results of the second analysis carried out in February 2024 (Exhibit FF 8):

Sample	Fatty acid profile (in % w/w)			
	Palmitic acid	Stearic acid	Oleic acid	Linoleic acid
Kagura	0.5	1.03	1.7	0.37

The results showed a total fatty acid content of 3.6%.
The Applicant submits that although the total amount of fatty acids in the second analysis is lower than in the previous analysis, Kagura still infringes claim 1 of the patent because the total amount of fatty acids is still well above the claim's lower limit of 1% by weight. In this respect, feature C must be interpreted as covering the fatty acid content regardless of the source of those fatty acids.
The Applicant alleges that the Respondents manufacture/market Kagura, for example in Germany and Bulgaria, with a patent infringing formulation identical to that of the Czech sample.
The Respondents are of the opinion that a correct interpretation of the claim takes into account only free fatty acids (FFAs) added in addition to rapeseed oil. FFAs derived from rapeseed oil should not be considered.
The Respondents argue that they have marketed two versions of the contested embodiment, one in 2023 ("*2023 product*") - outside the UPC territory only in Poland and the Czech Republic - and one in 2024 ("*2024 product*") - inside and outside the UPC territory in Poland, the Czech Republic, Bulgaria and Germany. According to the Respondents, this distinction is highly relevant as all factual evidence provided by the Claimant regarding the fatty acid content of the attacked embodiment relates to the 2023 product, which has never been marketed by the Respondents in the UPC territory.
Respondents have summarised the differences between the 2023 Product and the 2024 Product in the following table:

	2024 Product	2023 Product
Free fatty acid content in rapeseed oil component	0 – 0.5 %	≤ 2.0 %
Rapeseed oil supplier	Croda	Cereal Docks
Marketing area	Germany and Bulgaria and outside UPC territory	Outside UPC territory (Poland and Czech Republic)

The Respondents argue that the Kagura formulation marketed in the UPC territory does not contain added FFAs. It is manufactured using a rapeseed oil which, according to its manufacturer's specification, contains between 0.0% and 0.5% FFAs. The recipe for Kagura is set out in Confidential Exhibit SA-1. A redacted version of Exhibit SA-1 is provided as Exhibit SA-1a. The formulation confirms that Kagura contains canola oil (as a diluent, not as a stabiliser), but that it does not contain any additional fatty acid ingredient. Herbicidal compositions containing mesotrione, nicosulfuron and rapeseed oil as a diluent were known in the art at the priority date of the patent in suit, with rapeseed oil typically containing up to 2% FFAs. Canola oil consists primarily of fatty acids in the form of triglycerides. Triglycerides are esters consisting of one molecule of glycerol attached to three molecules of fatty acid. Canola oil also contains free fatty acids (commonly referred to as FFAs), which are individual fatty acid molecules that are not esterified with glycerol.

The 2023 product and the 2024 product were produced according to the same formulation (recipe) as described in Confidential Exhibit SA-1, but using different rapeseed oils. In both cases, the rapeseed oil used is a standard off-the-shelf product. And in both cases no additional fatty acids were added. Therefore Respondents also dispute the accuracy of the Applicant's free fatty acid content analysis regarding the product purchased in the Czech Republic. In their opinion no reliance can be placed on these tests given the material discrepancy between the results of the first analysis compared to the second analysis (total fatty acid content: first analysis 5.67%; second analysis 3.6%), notwithstanding that exactly the same sample was tested. The Respondents consider that the Applicant's interpretation of the claims of EP 073 as extending to the FFA content irrespective of the source of those FFAs has important implications for validity. If the FFAs introduced by the rapeseed oil count as fatty acids under EP 073, then prior art compositions such as those disclosed in EP 0 915 652 ("*EP 652*"; Exhibit SA-7) would anticipate the subject matter of claim 1 of EP 073. To the extent that EP 652 does not anticipate, the defendants contend that EP 073 lacks inventive step over EP 652. In addition to the arguments on non-infringement and invalidity, the Respondents stated in their view that the provisional measures requested by the Applicant were not necessary and that the balance of interests favoured the status quo. Furthermore, the Applicant has unreasonably delayed its application by acting in a negligent and dilatory manner and without the requisite degree of urgency at every stage since it first became aware of Kagura over a year ago. Accordingly, the Respondents submit that the Court should dismiss the application irrespective of its views on non-infringement and invalidity.

The Applicant replied that in the second analysis […] ensured that any possible measurement inaccuracies from the first analysis, as well as any unintended release of fatty acids from triglycerides that may have been present in the sample, were excluded. This approach allowed her to confirm that the GC and GC-MS analysis methods did not cause any release of fatty acids from the vegetable oils. Consequently, the higher fatty acid content found in the first analysis can be attributed to measurement inaccuracies and/or accidental release of fatty acids from triglycerides present in the sample. The reason why stearic acid is the only fatty acid that increased in the second analysis compared to the first is due to differences in the way the samples were prepared and measured. In the first analysis, a sample concentration of 10 mg/ml was used and analysed by a method called GC-FID (Gas Chromatography with Flame Ionisation Detection). The results of this analysis did not take into account background values from blank injections, which can affect accuracy. The second analysis used a lower sample concentration of 3 mg/ml. This time the results were adjusted to subtract background from blank injections, making them more accurate. In addition, it can be assumed that the high sample concentration in the first analysis may have overloaded the GC-FID detector. When the detector is overloaded it can give incorrect readings, especially for stearic acid. This is less of a problem for other fatty acids such as oleic, linoleic and palmitic acids. The Applicant does not expect the Respondents to dispute the above explanations as they reflect well-known aspects of the measurement methods used. These aspects need to be taken into account when considering the results, but they certainly do not lead to an unacceptable inaccuracy of the measurements and are well within the accepted tolerances in chemical science. As […] has already stated in her affidavit (submitted as Exhibit FF 8), several samples were taken during the analysis. The results are shown in the table below:

Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Oleic acid	Average, %w/w, Oleic acid
Kagura Rep1	0.20955	0.025	10	2.5	1.39	1.7
Kagura Rep2	0.36655	0.03216	10	3.216	1.89	
Kagura Rep3	0.33101	0.03021	10	3.021	1.82	
Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Linoleic acid	Average, %w/w, Linoleic acid
Kagura Rep1	0.055352	0.025	10	2.5	0.37	0.37
Kagura Rep2	0.063365	0.03216	10	3.22	0.33	
Kagura Rep3	0.074607	0.03021	10	3.02	0.42	
Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Palimitic acid	Average, %w/w, Palimitic acid
Kagura Rep1	0.088969	0.025	10	2.5	0.71	0.5
Kagura Rep2	0.072701	0.03216	10	3.22	0.45	
Kagura Rep3	0.050027	0.03021	10	3.02	0.33	
Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Stearic acid	Average, %w/w, Stearic acid
Kagura Rep1	0.13694	0.025	10	2.5	1.12	1.03
Kagura Rep2	0.13546	0.03216	10	3.22	0.86	
Kagura Rep3	0.08263	0.03021	10	1.51	1.11	

From the table above it can be seen that even if the lowest amount of fatty acid from each repetition is taken, the total content would still be 2.91% (1.39 + 0.33 + 0.33 + 0.86), which is still almost three times higher than the patented minimum of 1%. Nevertheless, the total fatty acid content was 3.59% in the first replicate, 3.53% in the second replicate and 3.68% in the third replicate. Thus, all the repetitions resulted in a fatty acid content well above 1%.

The Applicant disputes the Respondent's assertion that there are two versions of Kagura. The Applicant purchased Kagura in the Czech Republic, outside the UPC territory. However, at the time of the purchase, a product called Kagura (different or not from the product sold in the Czech Republic) was not yet sold in the UPC territory. Nevertheless, the embodiment at issue, purchased in the Czech Republic, was a suitable product to test for patent infringement. Due to the strict registration regime for plant protection products and the fact that the Applicant applied for the same product in the UPC territory, from an objective point of view there is at least a risk of first infringement. It is reasonable to assume that the Kagura sold in the Czech Republic is identical to the Kagura product that could be later sold in the UPC territory. The formulation of a crop protection product cannot be changed without affecting its registration. The Respondents' objection in this case is the first time they mention a so-called *"second version"* of Kagura, although the parties were in close dialogue about the possible infringement. Why did they not mention this before? In this context, the written testimony of […] (Exhibit SA-6) lacks credibility and is therefore not sufficient to prove the truth of the allegations. Therefore, the Respondent has not met its

burden of proof. Their submissions in this regard are merely protective assertions to wriggle out of infringement after the patent has been enforced. If the Respondents continue to assert that there are two different versions of the disputed embodiment and attempt to use this as a legitimate defence strategy, they will have to provide compelling evidence. In particular, they will need to show that
(a) There are/were indeed two versions of Kagura.
(b) The second version has a different fatty acid content to the first version, despite their claim that neither version contains added fatty acids. This is particularly significant given that both "*versions*" are based on the same regulatory registrations claiming a pH of 3.3 to 3.5, are made using essentially the same recipe and, in particular, contain phosphoric acid as a pH modifier; therefore, both recipes would be equally expected to yield products containing more than 1% by weight of fatty acids based on acid hydrolysis of the triglycerides in the rapeseed oil contained therein.
(c) The Applicant tested the "*wrong version*" of Kagura. The Applicant cannot prove that the Kagura tested contained the rapeseed oil supplied by the Cereal Docks Group.
As regards the invalidity attack, the Applicant considers that the Respondents' assumption that it can be concluded from the SA-4 that rapeseed oil can contain up to 2% free fatty acids is not correct; in almost all cases it is less than 1%. The exhibit says *"maximum 2%"* of free fatty acids. However, this value has obviously been added for safety reasons, i.e. the manufacturer or distributor of the rapeseed oil guarantees that there will never be more than 2% of free fatty acids in the oil - which does not mean that this is always the case. In fact, the content of free fatty acids in rapeseed oil is much lower, as the Respondents should have known from their own Exhibit SA-2, where the content of free fatty acids is 0.0 to 0.5. In addition, two documents are filed as Exhibits FF 22 and 23. Exhibit FF 22 is a data sheet similar to Exhibit SA-4 and also shows the analysis of a commercial rapeseed oil. Here the "*maximum content*" of rapeseed oil (i.e. the analogue to the "max 2%" in SA-4) is 1%, but the actual content is only 0.121%. Exhibit FF 23 is a scientific analysis of rapeseed oil; again, the fatty acid content is less than 1% (see Table 1). However, even if the skilled person would assume a content of 2% (which is clearly not the case) it would take two deliberate selections to arrive at claim 1, i.e:
i)Selecting rapeseed oil from a list of diluents
ii) Selecting a content of rapeseed oil between 40% and 95%.
It should be noted that all the examples in EP 915 652 do not contain any hydrophopic (oily) diluents at all. The only example that actually teaches liquid diluents (example D) is waterbased and contains only water as the liquid component. Thus, there is absolutely no incentive for the skilled person to make these two selections - but even if the skilled person did, it would not lead to the teaching of claim 1. Novelty and inventive step are therefore undoubtedly present.
Sufficiency is undoubtedly given, since the case law cited by the Respondents is more than twenty years old and has long since been declared obsolete in G1/03 (grounds 2.5.2.).
The Applicant has not delayed in bringing this action. In order to remove the degree of uncertainty as to whether Kagura contains fatty acids or not, a second analysis was necessary after the Applicant received the recipe. As soon as the Applicant became aware that the Respondents were marketing Kagura in the UPC territory, the Applicant immediately took the necessary steps to file the Application. None of the points made by the Respondents are relevant to the Applicant's knowledge of an act of infringement in the UPC territory. The Applicant did not know or could not have suspected that the Respondents would put Kagura on the market in the UPC territory. Although the parties had discussions in December 2023 and January 2024, the Respondents never mentioned that they had started marketing Kagura in Germany. The discussions only concerned the infringement based on the analysis of the Czech sample. As already stated in the application, the Applicant learned in March that the Respondents had started marketing activities in Germany as part of the UPC territory. Upon learning in March that the Respondents were promoting Kagura on the German market and in other UPC countries, the Applicant immediately took the necessary steps to prepare and file the application for provisional measures. Thus, as soon as the Applicant became aware of the Defendants' acts of infringement by advertising Kagura in a UPC Member State, it took the necessary investigative measures and obtained the documents required to support the application. In total, it took the Applicant one and a half months from the time it became aware that the Respondents were advertising Kagura in a UPC Member State to the filing of this application for provisional measures, which is well within the period required by the case law of this Court.
The Respondents replied that the Applicant has not provided any evidence as to the conditions under which the product analysed by the Applicant was transported and stored prior to analysis. However, Respondents concede that it is entirely possible, and they would say likely, that some hydrolysis occurred during storage of the sample and that this process led to an increase in the FFA content of the formulation. The effect of environmental and storage conditions on hydrolysis and therefore FFA content is not new and would affect all rapeseed oil formulations, whether made in 2007 or today.
Respondents have provided evidence from […] regarding the existence of two versions of Kagura and the similarities and differences between the 2023 and 2024 products (Exhibit SA-6). Both versions are manufactured according to the same formulation and under the same registration - see paragraph 18 of Exhibit SA-6 and paragraphs 10-11 of confidential Exhibit SA-10, which confirm that the change of supplier of the rapeseed oil component of Kagura, a product marketed

as a crop protection product, does not require a new or updated registration.
As to validity, the Respondents argue that there is no evidence to support the Claimant's assertion that in almost all cases the FFA content of rapeseed oil is less than 1%. The examples relied upon by the Respondents (Exhibits SA-3, SA-4) demonstrate that this assertion is false. Moreover, if a person skilled in the art who studies EP 652 considers the FFA content of, for example, rapeseed oil, he will recognise that it is - indisputably - up to 2%. This realisation forms part of the common general knowledge of the person skilled in the art. The person skilled in the art will, at the very least, refer to the documents discussed in these proceedings, in which, for example, an FFA content of "*up to 2%"* and *"max 2%"* is expressly stated. Even assuming for the sake of argument that these values are not achievable, the disclosure to the person skilled in the art is that they are achievable - otherwise the upper limit would be meaningless. Therefore, the disclosure to the person skilled in the art from EP 652, using his or her common general knowledge, or at least in combination with the documents discussed concerning the composition of rapeseed oil, is that the composition of EP 652 can contain up to 95% rapeseed oil, which in turn can contain up to 2% FFAs, so that the composition in total can easily contain more than 1% FFAs. A different conclusion could only be reached if it were clear beyond doubt that the person skilled in the art would not have taken the 2% upper limit seriously and would have replaced it (directly and unambiguously) by another value. In the present case, the Applicant has in no way shown that this was the case.
Given the Claimant's concern about the threat of infringement (see **Rule 206.2(c) RoP**) since at least April 2023, it is inconceivable that the Claimant did not closely monitor the registration and marketing activities for Kagura in all its key markets, including Germany, in which case it would have been aware of the marketing authorisation granted in Germany in August 2023 and the subsequent active marketing activity in Germany from early January 2024. The applicant's statement that it "*learned in March 2024 that the Respondents were advertising Kagura on the German market and in other UPC countries*" is a convenient excuse for its delay in bringing proceedings, when the applicant, by its own admission, was of the opinion that the Respondents' product Kagura infringed the patent in suit in December 2023 (see Section V of the Reply, bottom of page 16). In particular, the Applicant does not provide any evidence as to when exactly the Applicant first became aware of the marketing activities for Kagura in these countries and who exactly became aware of them. Given this vagueness and imprecision, Defendants are unable to provide a substantive response.
The application for provisional measures was filed by the Applicant on 30 April 2024 and served on the Respondents on 13 May 2024. Pursuant to **Rule 271.6(b) RoP** it is deemed to have been served on 20 May 2024. An oral hearing was held on 12 July 2024. […] testified at the hearing.
Reference is also made to the parties' exchanged written submissions and annexes.

REQUESTS

At the hearing, with the consent of the Respondents and the Court, the Applicant withdrew the request for seizure of the infringing products.

Applicant´s remaining request:

I.The Respondents are ordered, in the territories of the Federal Republic of Germany, the French Republic, the Republic of Austria, the Kingdom of Belgium, the Republic of Bulgaria, the Republic of Estonia, the Republic of Latvia, the Republic of Lithuania, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Slovenia and/or the Italian Republic, to cease and desist from manufacturing, offering, placing on the market or using, or importing or possessing for the aforementioned purposes, an herbicidal composition comprising:
at least one sulfonylurea herbicide;
at least one HPPD-inhibiting herbicide; and
at least one saturated or unsaturated fatty acid from 1% to 95% by weight.
II. Any failure to comply with the order under I. will render any of the Respondents liable to pay to the Court a penalty of up to 1000 EUR per item or up to 100.000 EUR per day for each day the respective Respondent fails to comply with this injunction.
III. The order to cease and desist under I. is immediately enforceable.
IV. The Respondents have to bear the legal costs of the proceedings.

Respondent's request:

a.Orders that the Applicant's Provisional Measures Application be dismissed;
In the alternative:
Orders the Applicant to pay security as a condition precedent for any provisional measures requested by the Applicant becoming effective, the amount of which shall be determined by the Court but shall not be less than EUR 5.000.000,00.
b.Issues a default judgment in the event that the Applicant fails to perform an act within the time limit provided for in the Rules of Procedure or set by the Court or fails to appear at a hearing after having been duly summoned;
c.Orders the Applicant to pay the costs of the proceedings.
d.Orders the Applicant to provisionally reimburse Respondents' costs of EUR 250.000,00.

GROUNDS FOR THE ORDER

The admissible application for provisional measures is well founded.

A. Standing

The applicant is entitled to file the request as the registered proprietor of the patent in suit pursuant to **Art. 47(1) UPCA** in conjunction with **R. 8.5(a) and (c) RoP**.
As the Respondents do not contest the standing of the Applicant, no further observations are necessary.

B. Infringement

The Munich Local Division is sufficiently convinced **(R. 211.2 RoP)** that there is an imminent danger that the

Applicant's right will be infringed by the contested embodiment in the Contracting States, in particular in Germany and Bulgaria. On summary examination, the contested embodiment makes direct and literal use of the technical teaching of the patent-in-suit as protected by claim 1 in the granted version **(Art. [25] UPCA).**

I. The patent-in-suit

The invention covered by the patent in suit relates to a herbicidal composition comprising a sulfonylurea herbicide and a p-hydroxyphenyl pyruvate dioxygenase (HPPD)-inhibiting herbicide. These components are each known in the art as herbicides. However, due to their inherent properties, sulfonylurea and HPPD-inhibiting herbicides are susceptible to chemical degradation, particularly when formulated as liquids. As a result, when these herbicides are to be applied simultaneously, they typically need to be combined just prior to application in a process commonly referred to as *"tank-mixing"*.

This results in undesirable complexity for the applicator, as well as the need to handle separate concentrates of a sulfonylurea and an HPPD-inhibiting herbicide, and the difficulty of preparing a stable and homogeneous tank-mix. These are not just inconveniences for the grower, as there are also transport and storage benefits, safety benefits from a reduced risk of exposure during tank-mixing, and generally the elimination of the risk of error in the tank-mixing process. Plant oil concentrates containing fatty acid alkyl esters or vegetable oils containing di- and triglycerides as diluents are known in the art, e.g. EP-A-0915652 [0001]. These enhance the efficacy of herbicides, particularly triketone herbicides. In addition, fatty acids have been shown to provide synergistic control when combined with certain herbicides, such as bensulfuron, para. [0002] of the specification.

Therefore, there was a need for a more advanced solution to the tank-mixing problem.

The proposed solution introduces a composition combining the above herbicides with fatty acids which significantly improve the chemical stability of the herbicidal compositions, enabling the skilled person to produce a stable *'ready-mix'* of the active ingredients. This has several notable advantages. In addition to the improved chemical stability and reduced risks of preparation, handling and mixing errors, the herbicidal (ready-mix) compositions according to the invention also provide comparable or superior biological performance compared to tankmixed compositions, demonstrating improved efficacy and selectivity.

1. On interpretation

a. According to **Art. 69 EPC** in conjunction with the **Protocol** on its interpretation, the patent claim is not only the starting point but also the decisive basis for determining the scope of protection of a European patent. The interpretation of a patent claim does not depend solely on its literal wording. Rather, the description and the drawings must always be consulted as aids to the interpretation of the claim and not only to clarify any ambiguities in the claim. This does not mean, however, that the patent claim only serves as a guideline and that its subject matter also extends to what is presented as the applicant's claim after examination of the description and drawings (**UPC CoA 335/2023, decision of 26 February 202[4] in conjunction with decision of 11 March 2024, GRUR-RS 2024, 2829, headnote 2 and margin no. 73 - 77 - Nachweisverfahren**; **UPC CFI 452/2023 (LD Düsseldorf), Order of 9 April 2024,** p. 13, GRUR-RS 2024, 7207, margin no. 49).

However, claim 1 protects a composition combining two herbicides with fatty acids.

Claim 1 of the patent in suit reads as follows

O An herbicidal composition comprising:

A at least one sulfonylurea herbicide;

B at least one HPPD-inhibiting herbicide; and

C at least one saturated or unsaturated fatty acid from 1% to 95% by weight.

b. The patent in suit also contains 14 dependent claims (claims 2 to 15) and one further independent claim (claim 16). Only claim 1 is asserted in this request for provisional measures. Therefore, only the features of claim 1 will be discussed further, in particular feature C, which is at the centre of the dispute between the parties.

aa) Feature 0

The herbicidal composition of claim 1 is not specifically defined in the patent in question, but it is obvious that it must be herbicidal. It may be in any of the known forms, in particular in the form of a solid formulation, such as a water dispersible granule (WG), but is preferably a liquid composition. It is also preferably an "*oil dispersion"* (OD), in particular wherein the herbicidal components are present in suspension in the fatty acid component, para. [0028].

bb) Feature A

According to paras. [0001] and [0004], the herbicidal composition comprises at least one sulfonylurea herbicide. Sulfonylurea herbicides are herbicides which inhibit acetolactate synthase (ALS). This is an enzyme (molecular biological "*machine*") that is important in plant metabolism. ALS catalyses the first step in the synthesis of branched-chain amino acids, so inhibitors of ALS slowly starve affected plants of these amino acids, eventually leading to the inhibition of DNA synthesis and ultimately to the death of the plant. Herbicidal compositions containing ALS-inhibiting herbicides and, in particular, sulfonylurea herbicides were known in the art (see paragraph [0001]). The sulfonylurea herbicide is preferably selected from the group consisting of amidosulfuron, bensulfuron-methyl, chlorimuron-ethyl, chlorsulfuron, cinosulfuron, cyclosulfamuron, ethametsulfuron-methyl, ethoxysulfuron, flaza-sulfuron, flucetosulfuron, flupyrsulfuron, foramsulfuron, halosulfuron-methyl, imazosulfuron, iodosulfuron, isosulfuron-methyl, isosulfuron-methyl, isosulfuron-methyl, isosulfuron-methyl, isosulfuron-methyl, imazosulfuron, isosulfuron-methyl, isosulfuron-methyl, isosulfuron-methyl, isosulfuron-methyl, isosulfuron-methyl, mesosulfuron-methyl, metsulfuron-methyl, nicosulfuron, oxasulfuron, primisulfuron-methyl, prosulfuron, pyrazo-sulfuron-methyl, rimsulfuron, sulfometuron-methyl, sulfosulfuron,

thifensulfuron-methyl, triasulfuron, tribenuron-methyl, trifloxysulfuron, triflusulfuron-methyl and tritosulfuron, or a salt thereof. Particularly preferred is nicosulfuron, para. [0005].

cc) Feature B

The herbicidal composition further comprises at least one p-hydroxyphenylpyruvate dioxygenase (HPPD) inhibiting herbicide, paras. [0001] and [0004]. The enzyme phydroxyphenyl pyruvate dioxygenase (HPPD) is used by plants to assist in the production of cofactors (plastoquinone and tocopherol) which are essential for plant survival. Therefore, inhibitors of HPPD have herbicidal activity. Herbicidal compositions containing HPPDinhibiting herbicides have been known in the art (see paragraph [0001]). The HPPD inhibitor is preferably selected from the group consisting of isoxazoles, triketones, pyrazoles, benzobicyclone and ketospiradox, para. [0006]. In a preferred embodiment of the invention, the HPPD-inhibiting herbicide is selected from the group consisting of mesotrione, sulcotrione, tembotrione, 4-hydroxy-3-[2-(2-methoxyethoxymethyl)-6-trifluoromethylpyridine-3-carbon-yl]- bicyclo[3.2.1]oct-3-en-2-one), isoxaflutole and pyrasulfotole. A particularly preferred HPPDinhibiting herbicide is mesotrione, para. [0024].

dd) Feature C

According to para. [0004], the herbicidal composition further comprises at least one saturated or unsaturated fatty acid from 1 to 95% by weight. The saturated or unsaturated fatty acid is preferably selected from the group consisting of lauric acid, palmitic acid, stearic acid, oleic acid, linoleic acid, linolenic acid, erucic acid, brassidic acid, caprylic acid, caproleic acid, palmitoleic acid, vaccenic acid, elaidic acid, arachidic acid and capric acid. Oleic acid is particularly preferred. The concentration of the fatty acid in the composition is from 1 to 95% by weight, preferably from 5 to 90% by weight and even more preferably from 10 to 90% by weight, para. [0026]. The saturated or unsaturated fatty acid provides improved chemical stability of both the sulfonylurea and the HPPD-inhibiting herbicide in the composition, paras. [0027] and [0039], resulting in the ability to provide these herbicides as a stable and therefore preferred [0033] "*ready-mix*" composition. A ready-mix composition is an end-user formulation that combines two or more active ingredients with different modes of action into a single composition. A *"ready-mix"* allows the user to simultaneously expose undesirable weeds to each herbicide in a readily available form and at the correct rate.

(1) Origin or nature of the fatty acid

Fatty acid (FA) can come from three origins:

• Native FA: the FA were in the rapeseed oil from the beginning (i.e. they have, for some reason, never reacted with a glycerol to form triglycerides)

• Released FA: they come from the hydrolysis of triglycerides

• Added FA: they were added…by someone

The patent does not explicitly characterise the fatty acid as added, native, released or even "*free*". Neither the claim language nor the description distinguishes between added, native, and released fatty acids which are the three sources of "free fatty acids". The terms *"free fatty acid*" or "*FFA*" are not used at all in the patent description. Feature C simply states that the composition should contain at least one saturated or unsaturated fatty acid from 1 to 95% by weight. However, it is common ground between the parties that the skilled person knows that, for example, rapeseed oil, which is mentioned in paragraph [0029] as a possible additional component, consists mainly of triglycerides. Triglycerides are esters consisting of one molecule of glycerol attached to three molecules of fatty acid. Rapeseed oil also contains free fatty acids (commonly referred to as FFAs), among them are native fatty acids which are individual fatty acid molecules that are not esterified to glycerol. The skilled person will further appreciate that, according to the working examples, compositions containing isolated or free fatty acids as the main carrier, such as oleic acid, exhibit improved stability compared to compositions containing oils, such as sunflower oil or methylated rapeseed oil (MRSO), which consist primarily of native fatty acids in the form of triglycerides. This improvement in stability is attributed to the presence of fatty acids (in significant amounts of over 63% by weight), indicating their crucial role in enhancing the efficacy of herbicidal compositions. With all this in mind, the skilled person will understand that a "fatty acid" referred to in feature C is a free fatty acid, meaning that the fatty acid according to claim 1 of the patent in suit is a single fatty acid molecule, whatever it is a native, released or added fatty acid.

(2) Source of fatty acid

The primary source of the free fatty acid proposed in paragraph [0026] of the description is lauric acid, palmitic acid, stearic acid, oleic acid, linoleic acid, linolenic acid, erucic acid, brassidic acid, caprylic acid, caproleic acid, palmitoleic acid, vaccenic acid, elaidic acid, arachidic acid and capric acid. Oleic acid is particularly preferred. As paragraph [0026] begins with the term "*preferably*", it cannot be attributed any limiting effect on the broader claim language. Therefore, all possible sources of the free fatty acid fall within the claim language. Another possible source of the free fatty acid is disclosed in paragraph [0029]. This paragraph explains that the claimed composition may further comprise a vegetable oil and/or a mineral oil and/or an alkyl ester and that examples of vegetable oils are, for example, olive oil, kapok oil, castor oil, papaya oil, camellia oil, coconut oil, sesame oil, corn oil, rice bran oil, peanut oil, rapeseed oil, cottonseed oil, soybean oil, linseed oil, sunflower oil and safflower oil and fatty acids derived therefrom and alkyl esters of the fatty acids. The paragraph then states that rapeseed methyl ester (MRSO) is particularly preferred. Further examples of mineral oils and alkyl esters are also given. According to paragraph [0030], a small amount of water and an acid may be added.

From this, the skilled person learns that the source of the free fatty acid can be selected from the examples given in [0026]. However, the source can also be fatty acids derived from e.g. rapeseed oil [0029]".

The skilled person will be aware that commercially available rapeseed oil typically contains free fatty acids in an amount of less than 2% by weight, as these free fatty acids are considered to be impurities in these products. Therefore, when finalising a formulation with a desired high free fatty acid percentage by weight, the skilled person will likely select one of the example sources disclosed in paragraph [0026]. If the skilled person further chooses to add rapeseed oil according to [0029] the skilled person will take care that the FFA present in rapeseed oil as impurities do not cause the total amount of FFA to exceed the desired value.
However, when finalising a formulation with a desired low percentage by weight of free fatty acid, the skilled person will take into account the disclosure in paragraph [0029] that the (free) fatty acid derived from e.g. rapeseed oil may be not only another but also the only source of the free fatty acid. The skilled person will appreciate that the claim language is quite broad and that the source of the FFA is by no means limited to specific sources. Still bearing in mind that the claimed maximum amount of FFA in rapeseed oil is likely to be less than 2% by weight, the skilled person, when selecting rapeseed oil as the main or sole source of FFA, will select a rapeseed oil with a sufficient amount of FFA which, by virtue of the technical teaching disclosed by the patent in suit, will then no longer be regarded as undesirable impurities but as valuable ingredients.
(3) Time factor
The claim wording does not contain a time factor in the sense that it requires the composition to contain the three ingredients from the outset in order to combat degeneration. Rather, it is sufficient that the patented composition is achieved at some point, in particular during the shelf life of the product.
It is also true that the function of the taught fatty acids is to stabilise sulfonylurea and HPPD inhibiting herbicides, as explained in paragraph [0003]. This is the essence of the claimed invention. However, the composition according to claim 1 does not include a time factor to the extent that the composition, when it leaves the factory, is to have all the features as claimed. It is sufficient for the effect of the invention that stability is provided in such a way, to such an extent and at such a time that the preferred embodiment can preferably be provided as a *"ready-mix*" formulation and thus avoid tank-mixing. This refers to a point in time much later than when the product leaves the factory. The skilled person will appreciate that stability should be provided for the shelf life of the product until it is used to control weeds in maize.
This is supported by the examples. In the examples, storage stability was tested after 8 weeks [0044] or 47 days [0051; 0052; 0053]. Nowhere in the description is there any specific information that severe degradation starts immediately after the two components are brought together. Otherwise, it would not have been necessary to wait so long to analyse the compositions. Severe degradation in this sense would cause the product to lose its herbicidal properties in maize to an extent that is undesirable in the examples.
Therefore, it is covered by the claim if the (free) fatty acid first accumulates due to degradation of the triglycerides. It may be acceptable for the herbicidal composition to be partially degraded by the time the patented range of free fatty acid percentages by weight is thus reached, provided that the herbicidal composition is still herbicidally active as required by feature 0.

II. Infringement

On the basis of this understanding, it is at least more likely than not that the contested embodiment, the 2023 version of KAGURA, makes literal use of the technical teaching of claim 1. The Local Division is therefore sufficiently convinced that the contested embodiment directly infringes claim 1 of the patent-in-suit as granted (**Art. 62(4) UPCA** in conjunction with **R. 211.2 RoP**, see **UPC_CoA_335/2023, Order of 26 February 2023, GRUR-RS 2024, 2829**, headnote 3 and margin nos. 90-94 - Proof procedure).
1. According to the applicant's statements in the pleading of 17 June 2024, page 8, the Applicant denies the existence of a second version of KAGURA and relies exclusively on the 2023 product as analysed by […]. This defines the subject matter of the dispute. The Panel must therefore assess whether there is a likelihood of repetition or a likelihood of first infringement on the basis of the product as analysed by […] (the 2023 product) and any related activities under **Art. 25 UPCA** attributable to the 2023 product.
2. The implementation of features A and B of claim 1 is rightly not in dispute between the parties, so that no further comments are necessary in this respect.
3. Furthermore, feature C is also implemented.
a) It should be noted that it is not up to the patent holder to show exactly how the fatty acids are present in the 2023 product. It is sufficient to show that they are present in the concentration required by the patent. Claim 1 is a product claim. Therefore, it is sufficient for the Applicant to allege and prove that at the time of any act of use under **Art. 25 UPCA** by the Respondents, the attacked product had all the features of claim 1 or that there is an imminent danger that such an act of use directed to such an embodiment will be carried out by the Respondents in the future.
b) This panel can leave open the question whether, in the circumstances of this case, the Respondents, as manufacturers, did not substantially dispute the presence of the amount of fatty acids in the 2023 product as claimed by the Applicant. The Respondents merely disputed the accuracy of the analysis carried out by and did not carry out their own analysis of their product, or at least did not submit any results in this respect. In any event, the Applicant proved that the total fatty acid content in the 2023 product was 2.91%, which is almost three times higher than the patented minimum of 1% (aa). And the Applicant further demonstrated that these results could not be attributed to any mishandling of the probes and thus shed light on the true ingredients of the 2023 product (bb).
aa) This is the information of the chart below, derived from the second analysis (affidavit of […] submitted as Exhibit FF 8). It is clear that even if the lowest amount

of fatty acid from each repetition is considered, the total content would still be 2.91% (1.39 + 0.33 + 0.33 + 0.86), which is still almost three times higher than the patented minimum of 1%. Nevertheless, the total fatty acid content was 3.59% in the first repetition, 3.53% in the second repetition and 3.68% in the third repetition. Thus, all repetitions resulted in a fatty acid content well above 1%:

Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Oleic acid	Average, %w/w, Oleic acid
Kagura Rep1	0.20955	0.025	10	2.5	1.39	1.7
Kagura Rep2	0.36655	0.03216	10	3.216	1.89	
Kagura Rep3	0.33101	0.03021	10	3.021	1.82	
Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Linoleic acid	Average, %w/w, Linoleic acid
Kagura Rep1	0.055352	0.025	10	2.5	0.37	0.37
Kagura Rep2	0.063365	0.03216	10	3.22	0.33	
Kagura Rep3	0.074607	0.03021	10	3.02	0.42	
Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Palimitic acid	Average, %w/w, Palimitic acid
Kagura Rep1	0.088969	0.025	10	2.5	0.71	0.5
Kagura Rep2	0.072701	0.03216	10	3.22	0.45	
Kagura Rep3	0.050027	0.03021	10	3.02	0.33	
Sample Code	Area	sample weight(g)	dilution(mL)	sample con (mg/mL)	%w/w, Stearic acid	Average, %w/w, Stearic acid
Kagura Rep1	0.13694	0.025	10	2.5	1.12	1.03
Kagura Rep2	0.13546	0.03216	10	3.22	0.86	
Kagura Rep3	0.08263	0.03021	10	1.51	1.11	

Respondents have not challenged the results of […] analysis as such. The reason why fatty acids above the patented minimum were found is irrelevant for the application of the above claim construction.

Notwithstanding this finding, having heard […] as a live witness, this panel is satisfied that this table represents accurate test results. After […] testified in open court, the Respondents conceded that they did not doubt the witness's credibility. Nor does this panel. […] carefully avoided answering questions put to her by the Party's representatives that she considered to be outside her personal field of perception, and thus refused to accept the invitation to act as an "expert witness". […] concentrated on answering questions about the two analyses she conducted and the precautions she took to avoid hydrolysis. The Panel was left with the impression that […] was an experienced scientist who was only interested in the correct scientific analysis and not in the further use of the scientific analyses she had produced.

bb) The Applicant further demonstrated that the precautions taken by […] to exclude hydrolysis were sufficient to believe the results of the second test.

(1) […] explained that and how she excluded possible measurement inaccuracies from the first analysis as well as any unintended release of fatty acids from triglycerides that may have been present in the sample during the second analysis. She testified that the reason why stearic acid was the only fatty acid to increase in the second analysis compared to the first was due to differences in the way the samples were prepared and measured. In the first analysis, a sample concentration of 10 mg/mL was used and analysed by a method called GC-FID (Gas Chromatography with Flame Ionisation Detection). The results of this analysis did not take into account background values from blank injections, which can affect accuracy. The second analysis used a lower sample concentration of 3 mg/ml instead of 10 mg/mL to avoid the overload of the column which was believed of having caused bad results in the first analysis. It is a common process to test a first concentration then to adjust it (increase if the % of the wanted product are weak in comparison to impurities due to the analysis; decreasing if there is a suspicion that the column was overloaded) This time, the results were also adjusted to subtract background from blank injections (which means subtracting the amount of inevitable impurities due to the analysis, which are measured in the blank injections), making them more accurate. In addition, it can be assumed that the high sample concentration in the first analysis (10 mg/mL instead of 3 mg/mL in the second analysis) may have overloaded the GC-FID detector. When the detector is overloaded it can give incorrect readings, especially for stearic acid. This is less of a problem for other fatty acids such as oleic, linoleic and palmitic acids. There is no doubt as to the credibility of the witness (see above).

(2) […] also described during the oral hearing the precautions taken to collect the samples and to store them during the time period between the two analyses:

- for the collection of the samples, she said that the tank of Kagura was let opened during a very short time to collect the samples, then closed right away
- and, for the storing, that the tank of Kagura was stored in her lab, at room temperature (i.e. 20-25°C) during the period of time between the two analyses. She stated that she clearly thinks that the hydrolysis of the triglycerides present in Kagura was minimal during this period and did not affect the accuracy of the result of the second analysis.

(3) These precautions taken during the two analyses and the storing between them are sufficient to consider that the amount of fatty acid present in the Kagura product before the analyses, even at the date of the first analysis, is well above the 1% claimed in claim 1 of the patent in suit.

(4) Therefore, the test results shed light on the true ingredients of the 2023 product as they could have been analysed at the time of the second test (April 2024). Even if these results are wholly or partly due to an increase in the percentage of FFA in the composition over time due to hydrolysis, the product claim is infringed as this happened or would have happened during the shelf life of the product, which is 2 years, and the Respondents are at least responsible for the composition of their product at any given time during the shelf life.

4. By distributing the 2023 product outside the Contracting States, namely in the Czech Republic, and by advertising "*KAGURA*" within the Contracting States, the Respondents have in any event created a risk

of first infringement that patent-infringing compositions will be manufactured, advertised and distributed by them in the territory of the Contracting States in the future (Art. 25(a), 62(1) UPCA).

a) According to Art. 25 (a) UPCA, a patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from: making, offering, putting on the market or using a product which is the subject-matter of the patent, or importing or stocking the product for these purposes. According to Art. 62(1) UPCA, the court may issue an order against an alleged infringer or against an intermediary whose services are used by the alleged infringer, in order to prevent an imminent infringement, to prohibit the continuation of the alleged infringement on a provisional basis and, where appropriate, subject to a periodic penalty payment, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the right holder.

b) The Respondents have clearly infringed the Czech designation of the patent in suit with the 2023 product sold in the Czech Republic. They have obtained identical marketing authorisations for a product with the same product name in various member states of the UPCA and have advertised KAGURA in those states without indicating that - in their view - the recipe had changed due to a change in the supplier of the rapeseed oil and thus the amount of free fatty acid contained in that rapeseed oil and ultimately in the product. This behaviour constitutes at least a risk of a first infringement in the territory of the Contracting States. In view of the identical marketing authorisations, the identical product name and the identical advertising, the relevant public must assume that the advertising is directed at a product which is identical to that available on the Czech market.

c) Even if it were true that there is a second version of KAGURA (the 2024 product) and that the 2024 product contains a lower amount of fatty acid than the patented range when analysed and given that the Respondents have pleaded that they will not produce, sell and put on the market the 2023 product, the risk of a first infringement has not therefore been eliminated. In the circumstances of this case, in order to eliminate the risk of first infringement, the Respondents should have offered a cease-and-desist declaration with a penalty clause in respect of the 2023 product, as suggested by this Panel during the hearing.

(1) In national case law it is generally accepted that in most cases the risk of a first infringement can be removed by an actus contrarius. In special circumstances it can only be removed by a formal cease and desist declaration, preferably with a penalty clause. There is no reason to depart from this in the context of the UPCA and the RoP.

(2) In the present case, the Respondents have clearly infringed the Czech designation of the patent in suit with the 2023 product sold in the Czech Republic. They have obtained identical marketing authorisations for a product with the same product name in different member states of the UPCA and have promoted KAGURA in those states without indicating that - in their view - the recipe had changed due to a change in the supplier of the rapeseed oil and thus the amount of free fatty acid contained in that rapeseed oil and ultimately in the product. There are therefore special circumstances which require a more formal act to end the risk of a first infringement. The Respondents should have offered a cease-and-desist declaration with a penalty clause in respect of the 2023 product. This was discussed at the Oral Hearing, but the parties did not reach an agreement. However, the Respondents could have simply offered a cease-and-desist declaration with a penalty clause. In national case law it is generally understood that a cease-and-desist declaration leads to a contract between the patentee and the infringer and that the risk of infringement ends even without a contract if the patentee should have accepted the offered cease and desist declaration. There is no reason to depart from this in the context of the UPCA and the RoP.

C. Validity of the patent-in-suit

I. The legal validity of the patent-in-suit is established to the extent necessary for the ordering of provisional measures. Even taking into account the Respondent's submissions, the Munich Local Division is convinced of the legal validity of the patent-in-suit with the *"sufficient certainty"* required under Art. 62(4) UPCA in conjunction with R. 211.2 of the Rules of Procedure. Such "*sufficient certainty*" is lacking if the court considers it more likely than not that the patent in suit is invalid (UPC_CoA_335/2023, order of 26 February 2023, GRUR-RS 2024, 2829, Principle 3 and Rz. 73 - 77 - Nachweisverfahren).

II. Having said that the Local Division assumes that the subject-matter of claim 1 will prove to be patentable with sufficient certainty.

1. European patent applications enjoy a presumption of validity from the date of publication of their grant. From that date they therefore enjoy the full protection guaranteed, inter alia, by Directive 2004/48 (ECJ GRUR Int 2020, 1071 para. 48 - Generics (UK) et al.; GRUR 2022, 811 - Phoenix Contact GmbH & Co. KG/HARTING Deutschland GmbH & Co. KG et al. para. 41).

2. Accordingly, the burden of pleading and proving the lack of validity of the patent and other circumstances supporting the defendant's position lies with the respondent (UPC CoA 335/2023, order of 26 February 2023, GRUR-RS 2024, 2829, para. 93 - Nachweisverfahren). In this context, it is the respondent's task to present arguments based on the prior art which make the legal validity of the disputed patent appear insufficiently secured.

3. It is then up to the court to assess, on the basis of the arguments put forward by the respondent, whether the legal validity of the patent-in-suit is sufficiently assured.

This will be the case if the arguments raised against the validity of the patent-in-suit are not such as to cast significant doubt on the validity of the patent-in-suit.
However, due to the summary nature of the validity examination in proceedings for the grant of provisional measures, a full examination of all the arguments raised, which may be numerous as in nullity proceedings, is not possible. Rather, the number of arguments raised against the validity of the patent must generally be reduced to the best three from the respondent's point of view (**UPC CFI 443/2023 ACT 589207/2023 (LD Munich), order of 21 May 2024, 3rd LS**). The background to this is that while a summary assessment of factual issues is conceivable, a summary examination of legal issues is not. The court can either examine a legal issue or not. If the court decides to examine the issue, it will do so comprehensively. The only way to take account of the summary nature of the procedure is therefore to reduce the number of legal issues to be fully examined in this way. This is made clear by the requirement to limit the number of arguments to three. Since it is the respondent's responsibility to challenge the presumption of validity, it is primarily the respondent's responsibility to select the three arguments to be examined in detail by the panel in summary proceedings.
4. On the basis of the principles set out above, the validity of the patent in suit is sufficiently assured in the present case. A summary examination of the Respondent's arguments does not raise any significant doubts as to the validity of patent claim 1.
a) The subject matter of claim 1 is found to be new in the required summary examination in relation to the state of the art cited by the respondents, **Art. 54 EPC.**
aa) A technical teaching is new if it differs from the state of the art in at least one of its known features. It is anticipated if all its features can also be found in embodiments known in the state of the art (see Benkard/Melullis/Koch, European Patent Convention - EPC, 4th ed. 54, para. 22). Only that which is directly apparent to a person skilled in the art from the publication or prior use is anticipated in the state of the art. Knowledge that a person skilled in the art only acquires by further reflection or by consulting further documents or uses is not relevant for the assessment of novelty.
bb) Against this background, the following applies to the present case. The Respondents have argued that the subject matter of claim 1 is anticipated by EP 0 915 652 B1 (Exhibit SA-7). Claim 1 of EP 652 relates to a herbicidally effective mixture of 2-[4-methylsulfonyl)-2- nitrobenzoyl]-1,3-cyclohexanedione and its agriculturally suitable salts with one or more herbicidal compounds selected from (a) nicosulfuron, (b) rimsulfuron, (c) thifensulfuronmethyl, (d) primisulfuron-methyl, (e) prosulfuron, and (f) halosulfuron-methyl. According to paragraph [0050], this combination shows a safening effect on maize and at the same time very good to excellent control of Johnsongrass, which is not only valuable but also particularly surprising since both Johnsongrass and maize are grasses. This patent is cited as a prior art reference in paragraph [0001] of the patent in suit.

(1)The Respondents argue that EP 652 already disclosed the combination of a composition with fatty acids in the amount patented by EP 073 (the patent-in-suit) as paragraphs [0021, 0024] disclosed the use of e.g. rapeseed oil as a liquid agriculturally suitable carrier and the table in paragraph [0022] listed the weight percentage for the use of a diluent such as rapeseed oil in suspensions, emulsions and solutions (including emulsifiable concentrates) as 40-95%. A person skilled in the art would have known that rapeseed oil used in herbicide formulations typically contains up to 2% FFA, as shown for example in the FEDIOL rapeseed oil specification published in 1998 (Exhibit SA-4). Thus, a mesotrine/nicosulfuron formulation using rapeseed oil according to the 1998 FEDIOL specification and following the teaching in EP 652 would fall within the scope of claim 1 of EP 073.
(1)The panel is not in agreement with this line of reasoning.
–Firstly, it should be noted that the only example in EP 652 which actually teaches liquid diluents (example D) is water-based and contains only water as a liquid component. It would therefore have required two deliberate selections to arrive at claim 1, i.e. the selection of rapeseed oil with a sufficient amount of free fatty acids from a list of diluents and the selection of a "*suitable*" content of this rapeseed oil of between 40% and 95%, this "*suitable content*" should have been close to the maximum of this range (95%) to reach the 1% of free fatty acids.
-Secondly, the assumption that rapeseed oil can contain up to 2% free fatty acids is incorrect. The evidence submitted by the Respondents refers to a "*maximum of 2%"* of free fatty acids. However, this figure was apparently added for safety reasons, i.e. the manufacturer or distributor of the rapeseed oil guarantees that there will never be more than 2% of free fatty acids in the oil - which would never have been interpreted by a person skilled in the art that this is always the case. This is because FFA in rapeseed oil is generally considered to be an impurity. Therefore, the content of free fatty acids in rapeseed oil is generally much lower, as can be seen from Exhibit SA-2, also submitted by the Respondents, in which the content of free fatty acids is 0.0 to 0.5. In addition, the Applicant has filed two further documents as Exhibits FF 22 and 23. Exhibit FF 22 is a data sheet similar to Exhibit SA-4 and also shows the analysis of a commercial rapeseed oil. Here the "*maximum content*" of rapeseed oil (i.e. the analogue of the "max 2%" in SA-4) is 1%, but the actual content is only

0.121%. Exhibit FF 23 is a scientific analysis of rapeseed oil; again, the fatty acid content is less than 1% (see Table 1). So, the assumption of the Respondents that from the SA-4 it can be concluded that rapeseed oil can contain up to 2% free fatty acids is not correct, it is in almost all cases less than 1%. EP 652 itself is silent on the amount of free fatty acids in rapeseed oil. Therefore EP 652 does not directly and non-ambiguously disclose a composition containing more than 1% of fatty acid.

-Thirdly, FFA in vegetable oil were considered as impurities. Without the disclosure in the patent-in-suit, the skilled person would not have deliberately used a vegetable oil with a higher percentage of FFA if better qualities in this respect had been available on the market. Indeed, the Respondents have not provided any evidence that rapeseed oils with 1% or more FFA were actually on the market at the priority date.

-Fourthly, even if the skilled person were to choose, for example, a diluent weight percentage of 95% and a rapeseed oil diluent with an FFA content of 1% - although there is no evidence that such an oil is actually on the market - the total amount of FFA in the composition would be 0.95% and thus below the patented range. Therefore, the subject matter of claim 1 of EP 073 is not directly and unambiguously disclosed by EP 652.

-In this respect, an increase in the percentage of FFA in such a hypothetical composition over time due to hydrolysis is not to be considered as EP 652 is silent on this effect.

-The Respondents did not provide actual prior art products where this effect resulted in a composition with a percentage of FFA within the patented range.

b) According to **Art. 56 EPC**, an invention is considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. In this respect, the arguments of the Respondents are not such as to raise serious doubts as to the existence of an inventive step.

aa) Whether an inventive step is to be recognised must always be assessed on a case-bycase basis and requires a legal assessment of all the relevant facts and circumstances. An objective approach must be taken in assessing the inventive step. The subjective ideas of the applicant or inventor are irrelevant. In principle, it is also irrelevant whether the invention is the result of chance or systematic work involving (possibly costly and laborious) experimentation. What matters is what the claimed invention actually contributes to the state of the art. The inventive step is to be assessed from the point of view of a person skilled in the art, on the basis of the entire state of the art, including the general knowledge of the person skilled in the art. It is assumed that the person skilled in the art had access to the entire prior art at the relevant time. The decisive factor is whether the claimed subject matter results from the state of the art in such a way that the person skilled in the art would have found it on the basis of his knowledge and skills, for example by obvious modifications of what was already known. In order to assess whether or not a claimed invention was obvious to a person skilled in the art, a starting point in the state of the art must first be determined. It must be justified why a person skilled in the art would consider a particular part of the prior art to be a realistic starting point. A starting point is realistic if its teaching would have been of interest to a person skilled in the art who, at the priority date of the patent in question, was trying to develop a similar product or process to that disclosed in the prior art, i.e. one having a similar basic problem to the claimed invention (see **CoA Nanostring/10x Genomics**, p. 34 under "*cc*" in the original German version: "Für eine Fachperson, die sich zum Prioritätszeitpunkt des Verfügungspatents vor die Aufgabe gestellt sah, war [...] D6 von Interesse"). There may be several realistic starting points. It is not necessary to identify the "*most promising*" starting point. If the claimed subjectmatter is compared with the prior art as interpreted, the question then arises as to whether it would have been obvious to a person skilled in the art to arrive at the claimed solution on the basis of a realistic disclosure of the prior art in view of the underlying problem. If it was not obvious to arrive at this solution, the claimed subject-matter meets the requirements of **Article 56 EPC.**

In general, a claimed solution is obvious if the person skilled in the art would be motivated (i.e. would have an incentive, see reasons in **NanoString v. 10x Genomics**, p. 34) to consider the claimed solution and to implement it as the next step ("*nächster Schritt*", reasons in **NanoString v. 10x Genomics**, p. 35, second paragraph) in the development of the state of the art. On the other hand, it may be relevant whether the person skilled in the art would have expected particular difficulties in carrying out the next step or steps. Depending on the facts and circumstances of the case, it may be permissible to combine disclosures of the prior art. A technical effect or advantage achieved by the claimed subject matter over the prior art may be an indication of inventive step. A feature arbitrarily selected from several possibilities cannot generally contribute to the inventive step. Retrospective consideration should be avoided. The question of inventive step should not be answered by retrospectively searching for (combined) disclosures of the state of the art from which this solution could be derived with knowledge of the patented subject-matter or solution (**UPC CFI 1/2023 ACT 459505/2023 (Central Division Munich)**, GRUR-RS 2024, 17255).

bb) The Respondents' arguments based on EP 652 do not give rise to any significant doubts as to the inventive step.

(1) The Respondents have argued that to the extent that the subject matter of claim 1 of the patent in suit was not anticipated by EP 652, it was obvious over EP 652. In any event, the subject matter of EP 073 was at least obvious in the so-called "***AgrEvo obviousness*" sense, as**

set out in decision T0939/92 (AGREVO/Triazoles) of the Boards of Appeal of the European Patent Office, since the patent-in-suit failed to show that the claimed technical effect is achieved by all compositions covered by asserted claim 1. Examples 1 and 2 of EP 073 provided a number of formulations (referred to as F1 to F14) of different compositions. F7 contained 68.5% by weight oleic acid and, as noted in [0047], showed improved stability compared to the other compositions tested. F8 to F14 contained 63.5% by weight of either a vegetable oil (coconut oil, F8) or various saturated or unsaturated fatty acids (F9 to F14). It was clear that the patentee made a distinction between fatty acids (as used in compositions F9 to F14) and vegetable or other oils (as used in compositions F1 to F6 and F8). As noted in [0050], "*the stability of both mesotrione and nicosulfuron is significantly improved in compositions containing a fatty acid*". Examples 3 to 5 referred to similar formulations "as described above" but would not give details of the exact amount of fatty acid or oil included. Examples 6 and 7 specifically referred to F3, F9 and F14 formulations. On the basis of the examples in EP 073, it was clear that none of the tested formulations claimed to provide improved stability contained less than 63.5% by weight of fatty acid as a separate component. There was nothing in the patent in question to suggest that an effect claimed to be seen between 63.5% and 68.5% w/w fatty acid would also be seen over the whole claimed range of 1% to 95%. Given the extremely broad range defined by claim 1 of the patent in question, it must be considered that there are serious doubts as to whether the claimed improved chemical stability would be seen over the whole range. As the Board of Appeal of the EPO stated in T 939/92, *"it has long been a generally accepted legal principle that the scope of the patent monopoly should correspond to and be justified by the technical contribution to the art (see T 409/91, OJ EPO, nos. 3.3. and 3.4 of the grounds, and T 435/91, OJ EPO 1995, 188, grounds nos. 2.2.1 and 2.2.2). Whereas in the two above-mentioned decisions this general principle of law was applied with regard to the scope of patent protection justified by reference to the requirements of Articles 83 and 84 EPC, the same principle of law also governs the decision to be taken under Article 56 EPC, since "anything falling within a valid claim must be inventive"* (reasoning, 2.4.1). (Reasons, 2.4.2). The Board in T 939/92 went on to conclude that the patent application in question lacked inventive step*: "For these reasons, and on the basis of the evidence in the case, the Board is not satisfied that substantially all the compounds now claimed are likely to be herbicidally active. Since, as set out above in points 2.4.2, 2.5.4 and 2.6, only those of the claimed chemical compounds could possibly involve an inventive step which could be accepted as solutions to the technical problem of providing further herbicidally active compounds, the subject-matter of the main request extends to compounds which are not inventive and therefore does not meet the requirement of Article 56 EPC".* (Reasons, 2.7). As there was nothing in the present case to show or even suggest that substantially all preparations with a fatty acid content between 1 and 95% by weight covered by the patent would have improved stability as claimed in EP 073, the patent was therefore invalid for obviousness.

(2) The so-called *"AgrEvo obviousness" argument* is dealt with below.

(3) In relation to the general argument of lack of inventive step, it must be noted that the Respondents have failed to provide any justification as to why the skilled person would choose EP 652 as a starting point to address the task of providing a solution to the tank-mixing problem.

(4) In any event, the Respondents have not explained why the skilled person, taking EP 652 as a starting point, would have had the incentive to carry out the selections described above (choosing rapeseed oil as diluent with a sufficient percentage of FFA and using it in the overall composition at the maximum of the disclosed range) exactly in such a way as to arrive at an amount of FFA in the overall composition of at least 1% by weight. This would have meant that the person skilled in the art would have had to understand that FFA in rapeseed oil is not a nuisance but an advantage and that it would therefore be necessary to buy rapeseed oil with a sufficiently high percentage of FFA on the market and, if this was not available, as suggested by the fact that the Respondents have not provided any evidence that rapeseed oil with 1% or more FFA was actually available on the market, to persuade the producers to produce rapeseed oil with a higher percentage of FFA. None of this has been pleaded by the Respondents, as can be seen from the text above, which is a true copy of all the Respondents' pleadings in this respect.

c) Insufficiency / Plausibility/ AgrEvo obviousness

aa) In addition to the arguments relating to the so-called *"AgrEvo obviousness"*, the Respondents have argued that the examples of EP 073 only provide information on compositions with an extremely narrow range of fatty acid content (63.5%-68.5%) as opposed to the broader range of 1-95% claimed. Under Article 138(1)(b) EPC, a patent may be revoked on the grounds that “the

European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". This corresponds to **Art 83 EPC**, which imposes the same requirements on the European patent application. The case law on Art 83 EPC is therefore equally relevant to Art 138(1). As stated in **T 939/92 (see above)**, it is a generally accepted principle that the scope of a patent monopoly must be commensurate with the contribution made to the art. The case law of the EPO Board of Appeal makes it clear that this can be taken into account under **Article 83 EPC**. This principle has been recognised, for example, in **T 409/91**, point 3.5 of the grounds for the decision: "*Although the requirements of Art. 83 and Art. 84 are directed to different parts of the patent application, since Art. 83 relates to the disclosure of the invention, whilst Art. 84 deals with the definition of the invention by the claims, the underlying purpose of the requirement of support by the description, insofar as its substantive aspect is concerned, and of the requirement of sufficient disclosure is the same, namely to ensure that the patent monopoly should be justified by the actual technical contribution to the art."* This decision was referred to with approval in **T 694/92** (paragraph 5 of the grounds of the decision): *"Article 83 EPC requires an invention to be disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. As made clear in **T 409/91 (OJ EPO 1994, 653**, see in particular points 3.3 to 3.5 of the Reasons), the extent to which an invention is sufficiently disclosed is highly relevant when considering the issue of support within the meaning of Article 84 EPC, because both these requirements reflect the same general principle, namely that the scope of a granted patent should correspond to its technical contribution to the state of the art*." In the patent in suit, it was clear that the technical disclosure of the specification was limited to compositions having a fatty acid content of between 63.5% and 68.5% by weight, and that there was absolutely no teaching relevant to the portions of the wider range of 1%-95% outside that range. It was therefore concluded that the scope of the monopoly was not justified by the contribution to the state of the art. This could only lead to the conclusion that the patent is insufficiently disclosed under **Articles 83** and **138(1) EPC**, in line with previous decisions of the EPO Boards of Appeal.

bb) It should first be noted that the case law cited by the Respondents is more than twenty years old and has long since been declared obsolete in **G1/03** (grounds 2.5.2.). It is quoted from the case law of the Boards of Appeal of the EPO (10th edition, 10 July 2002):

"On the relationship between an objection under Art. 56 EPC and one under Art. 83 EPC, see also T 1099/16 (use of a known compound performing a new function), in which it was held, in line with G 1/03, that, if an effect is expressed in a claim [as in the case in hand, adhesion enhancer], there is a lack of sufficient disclosure [which was not a ground for opposition in the case in hand]. Otherwise, i.e. if the effect is not expressed in a claim but is part of the problem to be solved, there is a problem of inventive step."

T 2182/11 stated:

"*In as far as the objection was to be considered under Article 83 EPC, the mere fact that a term is broad does not prevent a skilled person from carrying out the invention."*

T 409/17 stated:

"Finally, the Board emphasises that the question whether it is clear which embodiments actually solve the claimed problem does not concern the sufficiency of disclosure under Article 83 EPC [...]"

cc) In **G 2/2021** the Enlarged Board of Appeal of the European Patent Office further explained:

"92. The term "plausibility" that is found in the case law of the boards of appeal and relied upon by the referring board in questions 2 and 3 of the referral and the reasons for it, does not amount to a distinctive legal concept or a specific patent law requirement under the EPC, in particular under Article 56 and 83 EPC. It rather describes a generic catchword seized in the jurisprudence of the boards of appeal, by some national courts and by users of the European patent system.

93. The relevant standard for the reliance on a purported technical effect when assessing whether or not the claimed subject-matter involves an inventive step concerns the question of what the skilled person, with the common general knowledge in mind, would understand at the filing date from the application as originally filed as the technical teaching of the claimed invention. The technical effect relied upon, even at a later stage, needs to be encompassed by that technical teaching and to embody the same invention, because such an effect does not change the nature of the claimed invention.

94. Hence, a patent applicant or proprietor may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would consider said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention."

dd) According to the EPC, "*plausibility*" is not a requirement for patentability, as there is not a single article in the EPC dealing with it. Thus, the problems related to the catchword "plausibility" have to be solved in the context of **Art. 56** or **83 EPC**.

ee) According to **Art. 83 EPC**, the European patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The invention of claim 1 of the patent in suit is a composition containing a fatty acid of 1-95% by weight. As explained above, this can be easily made by the skilled person, as the skilled person only has to select a

suitable source for the fatty acid. The skilled person may choose one of the examples disclosed in paragraph [0026] or rely on the free fatty acids originating from e.g. rapeseed oil as disclosed in paragraph [0029], in particular if the skilled person aims to have a rather low amount of FFA in the overall composition.

ff) According to **Art. 56 EPC**, an invention is considered to involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. In this respect, the arguments of the Respondents are not such as to raise significant doubts as to the existence of an inventive step.

(1) As explained above, the Respondents have not provided sufficient arguments that the invention of the patent in suit is obvious over EP 652.

(2) Even if the UPC were to apply the obviousness test as set out in the recent case law of the EBoA in Mn. 93, the validity of the patent-in-suit would not be called into question. The person skilled in the art at the filing date would have understood from the application as originally filed, as the technical teaching of the invention as claimed in claim 1, that by adding FFA, previously considered as impurities or nuisances when using vegetable oil as a diluent, in the amount of (preferably) 1-95% by weight in compositions comprising herbicides according to features A and B, , wherein the FFA can be selected from the examples disclosed in paragraph [0026] or one can rely on the free fatty acids originating from e.g. rapeseed oil as disclosed in paragraph [0029], in particular if the skilled person aims to have a rather low amount of FFA in the overall composition, the two herbicides can be significantly chemically stabilised and thus a "ready-mix" composition can be provided and in addition comparable or improved biological functions can be provided compared to a tank-mix composition [0003]. While the prior art, including EP 652, may have indirectly disclosed the use of fatty acids at volumes well below 1% by weight as an ingredient supporting the effectiveness, e.g. when adding rapeseed oil as a diluent, as rapeseed oil consists not only of esterified fatty acids but may also contain FFA, the present invention discloses the use of FFA at a much higher volume for a stabilising effect. This previously unknown technical effect forms the core of the present invention. That this effect can be achieved not only with high percentages of FFA, as shown in the examples of the patent in suit, but also with quite low percentages has been demonstrated by the Respondent's product KAGURA, a ready-mixed composition, since in KAGURA the percentage of FFA present is about 2-4% by weight and the Respondents have admitted at the oral hearing that the shelf life of KAGURA is two years. Therefore, the invention of claim one of the patent-in-suit is not obvious over EP 652, even if the EboA test is applied. Therefore, the Panel can leave open the question of whether this test should be applied.

D. Necessity

The order of provisional measures is necessary to prevent the continuation of the infringement or at least to prevent an imminent infringement (see **R. 206.2 (c) RoP).**

I. According to the Rules of Procedure, both temporal and factual circumstances are relevant to the necessity of ordering provisional measures. The relevance of temporal circumstances follows not only from **R 209 no. 2 (b) RoP** ("*urgency*"), but also in particular from **R 211 no. 4 RoP**, according to which the court shall take into account an unreasonable delay in applying for provisional measures. The fact that the decision on the granting of provisional measures must also take account of factual circumstances is apparent, for example, from **R. 211 no. 3 RoP,** according to which the potential damage that may be suffered by the applicant must also be taken into account in the decision on the application for provisional measures. On the other hand, the potential damage to the respondent has to be taken into account in the balancing of interests (**UPC_CFI_2/2023 (LD Munich), order of 19 September 2023, GRUR 2023, 1513, 1525 -Nachweisverfahren**).

II. In view of the circumstances, the granting of the provisional measures applied for is urgent (**R. 209.2 (b) RoP).**

1. The temporal urgency required for the grant of provisional measures is lacking only if the injured party has been so negligent and dilatory in pursuing its claims that, from an objective point of view, it must be concluded that the injured party is not interested in the speedy enforcement of its rights and that it is therefore not appropriate to grant it interim relief. (see also **UPC CFI 2/2023 (LD Munich), Order of 19 September 2023, 1513, 1524 – Nachweisverfahren**).

Pursuant to **R. 213.2 RoP,** the court may, in the course of its decision, order the applicant to submit any reasonably available evidence in order to satisfy itself with a sufficient degree of certainty that the applicant is entitled to institute proceedings under **Art. 47 UPCA**, that the patent in question is valid and that the applicant's right is being infringed or is likely to be infringed. In summary proceedings, the applicant must respond to such an order within short time limits, which requires adequate preparation of the case. Therefore, in general, the applicant need not apply to the Court until it has a reliable knowledge of all the facts which make an action for interim measures likely to succeed, and if it can make those facts credible. The applicant may prepare for any possible procedural situation that may arise in the circumstances in such a way as to be able to submit the requested information and documents to the court upon an appropriate order and to successfully respond to the opposing party's submissions. In principle, it is not possible to point out to the applicant that further investigations can only be carried out during ongoing

proceedings and that necessary documents can only be obtained retrospectively, if at all. On the other hand, the applicant must not delay unnecessarily. As soon as it becomes aware of the alleged infringement, it must investigate it, take the necessary steps to clarify the matter and obtain the necessary documents to support its submission. In doing so, the applicant must pursue the necessary steps with determination and bring them to a conclusion. Once the applicant is in possession of all the knowledge and documents that are reasonably likely to lead to a successful prosecution of the case, it must normally file an application for provisional measures within two months if the dispute involves more than one participating Member State and the applicant requests the respondent to be heard in advance (**UPC_CFI_443/2023 ACT 589207/2023 (LD Munich), LS 1**).

In view of the diverging case law, which grants the applicant only one month, e.g. in **UPC_CFI_452/2023 (Local Division Düsseldorf), order of 9 April 2024**, GRUR-RS 2024, 7207, Rz. 128, the Local Division Munich adheres to its case law. In the context of a dispute involving more than one participating member state, the UPC representative for the applicant must be given sufficient time as a safe harbour period to prepare the written request and the accompanying evidence and to discuss the prepared documents with the client. In German national case law, this safe harbour period had been set at one month by most of the Higher Regional Courts. However, these German requests only covered the territory of Germany. In the UPC, these requests regularly cover more than one territory, and it is therefore regularly necessary to consider relevant factual or legal details or specific evidence for these territories as well. This regularly requires more time. In the absence of guidance from the CoA, the Local Division Munich sets this safe harbour period at 2 months for cases involving more than one participating member state and where the applicant requests a prior hearing of the respondent. However, if the applicant exceptionally requests provisional measures without prior hearing of the respondent, no safe harbour time limit is to be provided. The applicant will regularly expect the court to deal with such requests at short notice and therefore such requests must be made as soon as possible with due cause.

2. On the basis of these principles, the Applicant has treated the matter with the necessary urgency. The request concerns the territory of more than one Contracting State and the applicant has indicated that the Respondents should be heard before an order is made. Therefore, a safe harbour period of two months is provided.

a) In the present case, those two months began to run on 18 March 2024, when the Applicant became aware of the Respondents' marketing activities targeting the German and Romanian markets. The Respondents have not provided any evidence of actual prior knowledge. The knowledge of the Respondents' infringing activities in non-UPC countries is irrelevant, as the Applicant could not have foreseen that the Respondents would start such activities during the ongoing discussions with the Respondents concerning the Applicant's allegation that KAGURA sold in the Czech Republic and Poland infringed the patent-in-suit. Therefore, the Applicant cannot be blamed for not having discovered these activities earlier.

b) The request had been filed on 30 April 2024 and thus in time.

III. The order of provisional measures is also necessary in view of the harm threatened to the Applicant by the Respondents' offer of infringing products.

The Applicant would be threatened with considerable damage if it were only able to assert its claim for injunctive relief in the main proceedings. The Applicant's own product Elumis and the Respondents' Kagura compete in the same market and target the same customers, namely maize farmers. The Respondents sell Kagura at a much lower price than the Applicant sells Elumis. It is therefore not foreseeable that the Applicant could easily regain the market shares it has already lost and will lose in the 2025 season without provisional measures being ordered by this Court now in 2024. The product is regularly used by farmers in spring and is therefore produced and sold several months in advance. A main action commenced on 30 April 2024 would not be able to stop production and sales for the 2025 season, as a hearing on the merits will not be scheduled until at least nine months after the application is filed.

E. Weighing of interests

The balance of interests to be struck is also in favour of the applicant.

I. According to **Art. 62(2) UPCA** (**R. 211(3) RoP**), the court shall, in its discretion, weigh the interests of the parties in making the order or in refusing the application, taking into account all relevant circumstances, in particular the possible prejudice that the order or the refusal of the application may cause to the parties. In exercising its discretion, the degree of probability with which the court is satisfied that each of the circumstances to be taken into account exists is also relevant. The more certain the court is that the right holder is claiming infringement of a valid patent, that the facts and circumstances of the case make it necessary to issue the order, and that this is not precluded by the possibility of harm to the opponent or other legitimate objections, the more likely it is that an injunction will be justified. On the other hand, the earlier there are uncertainties with regard to the individual circumstances relevant to the balancing of interests that weigh against the court's conviction, the more the court will have to consider allowing the alleged infringement to continue, subject to the provision of security, or even rejecting the application (**UPC_CFI_2/2023 (LD Munich), order of 19 September 2023, 1513, 1525 et seq. – Nachweisverfahren**).

II. Against this background, the balance of interests is in favour of the applicant. Reference is made to the above findings, in particular that a main action filed on 30 April 2024 would not have had a significant impact on the 2025 season. A further relevant factor in this case is the fact that the patent in suit expires in 2028. Denying the

plaintiff provisional measures and thus allowing the defendants to market Kagura in 2025 would deprive the plaintiff of 20% of the remaining monopoly on the patented composition, a substantial part of the commercial value. On the other hand, the defendants' arguments regarding reputational and commercial damage are pure speculation. The restrictions on the defendants' activities on the market following the enforcement of this order are simply a consequence of the rule of law that an infringer is excluded from the market if the patentee applies for a (preliminary) injunction and a court finds infringement.

F. Legal consequences

The Local Division is satisfied, with the degree of certainty required for the ordering of provisional measures, that there is at least an imminent danger that the Respondents will unlawfully make direct use of the technical teaching protected by claim 1 of the patent-in-suit within the Contracting States. The validity of the patent-in-suit is also secured to the extent necessary for the ordering of provisional measures. Since the granting of provisional measures is also necessary in terms of time and substance, and since the balance of interests is also in favour of the Applicant, the legal consequences are as follows:

I. The court, in the exercise of its discretion **(R. 209.2 RoP),** considers the issuance of a prohibitory injunction to be appropriate and justified (**Art. 62(1), 2[5](1) UPCA).** Only a prohibitory injunction takes into account the Applicant's interest in effective enforcement of the patent in question. The Respondent's interest in continuing to operate on the market - even if security is provided - must, for the reasons given, take second place.

II. The threat of penalty payments in the event of non-compliance is based on **R. 354.3 RoP.** The number of days is already a fixed value for the calculation of penalties. However, the setting of a maximum amount per day of infringement gives the Local Division the necessary flexibility to take into account the behaviour of the offender in the event of an infringement and, on that basis, to set an appropriate penalty payment in accordance with **R. 354.4 RoP.**

G. Security

I. Pursuant to **R. 211.5 RoP, p. 1 RoP,** the court may require the provision of adequate security to compensate the respondent for the damage which it is likely to suffer and which the court may order the applicant to pay in the event that the order is set aside. According to the case law of the Local Division Munich, e.g. in the case 10x Genomics vs. NanoString, there is no reason for this in a two-sided interim injunction procedure if no particular difficulties are to be expected in connection with the enforcement of a possible claim for damages with regard to both the economic constitution of the applicant and the enforcement law in the home country (**UPC_CFI 2/2023 (LD Munich), order of 19 September 2023, 1513, 1524 - Nachweisverfahren**).

II. In the present case, the Respondents argued that there was no reason not to order security. This falls short of the standard set out above. The Applicant is based in the United Kingdom, a country with which the Respondents are familiar. The Respondents have not put forward any arguments as to how and why the enforcement of any claim for damages against the Applicant in the United Kingdom might be unsuccessful.

H. Costs

In principle, there is no reason to make a decision on costs in proceedings for the grant of provisional measures if the summary proceedings are followed by proceedings on the merits - as is the case here **(Rule 213.1 RoP).** Since the Applicant's partial withdrawal is not of significant economic importance, no exception to this principle should be made in the present case. This also applies to the request for a provisional order for reimbursement of costs.

I. Although the Court of Appeal has not yet had to deal with the question of reimbursement of costs in summary proceedings, it has already recognised that a decision on costs is not necessary in every case. Where a decision is not a "*final order*" or a "*final decision*", the Court of Appeal considers that it is only in the context of a subsequent final decision that the court can determine whether and to what extent a party must bear the costs of the other party because it has been unsuccessful within the meaning of **Art. 69 UPCA** (**[…] UPC_CoA_438/2023, Order of 3 April 202**3, paragraph 2). Such a procedure is also indicated at least where - as here - the summary proceedings are followed by main proceedings. For an analogous application of **R. 118.5 RoP,** the absence of an unintentional loophole is a basic requirement for such an application (**UPC_CFI_452/2024 (LD Düsseldorf), Order of 9 April 2024**, headnote 2 and p. 34 f., GRUR- RS 2024, 7207, Rz. 161 - 163; a.A.: **UPC CFI 249/2023 (LD Munich), order of 19 December 2023, headnote, GRUR-RS 2023, 40572**).

II. In the present case, the Applicant has partially withdrawn its application for the seizure of goods. However, the application for an injunction based on the threat of direct infringement of claim 1 was successful. Therefore, the partial withdrawal is not economically significant. It can therefore be expected that the Respondent will wait for the main proceedings. I. The value of the application and the dispute

1. The value of the application and the dispute was estimated by the Applicant at EUR 5 million. That value represented slightly less than 10% of the annual turnover of the Applicant's own product "*Elumis*", which incorporates the patent in suit and is sold in the countries in respect of which the injunction is sought.

2. The Respondents have contested this assessment, arguing that they are not in a position to obtain marketing authorisation in all countries and that a reduction of 15-20% should therefore be applied.

3. However, in Estonia, Latvia, Lithuania and Luxembourg the Respondents can apply for marketing authorisations at any time. In the Netherlands, where the Respondents have applied for but not yet received a marketing authorisation, the authorisation can be granted at any time. As regards France and Portugal, the Respondents could at any time submit a new application

for marketing authorisation and subsequently market Kagura. As the request still covers all Contracting States, no reduction is justified.

ORDER

I. The Respondents are ordered, in the territories of the Federal Republic of Germany, the French Republic, the Republic of Austria, the Kingdom of Belgium, the Republic of Bulgaria, the Republic of Estonia, the Republic of Latvia, the Republic of Lithuania, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Slovenia and/or the Italian Republic, to cease and desist from manufacturing, offering, placing on the market or using, or importing or possessing for the aforementioned purposes, an herbicidal composition comprising:
at least one sulfonylurea herbicide;
at least one HPPD-inhibiting herbicide; and
at least one saturated or unsaturated fatty acid from 1% to 95% by weight.

II. Any failure to comply with the order under I. will render any of the Respondents liable to pay to the Court a penalty of up to 1000 EUR per item or up to 100.000 EUR per day for each day the respective Respondent fails to comply with this injunction.

III. The order to cease and desist under I. is immediately enforceable.

IV. The Respondent's request that the effectiveness of an order of injunctive relief be put under the condition precedent that Applicant has provided a security in the amount of EUR 5 Mio. is dismissed.

V. The requests by both parties to make an order in respect to who must bear the legal costs and the request by the Respondents to order the Applicant to provisionally reimburse Respondent`s costs are dismissed.

VI. These provisional measures will be revoked or otherwise cease to have effect, upon request of the Respondents, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days, whichever is the longer, from 27 August 2024, the Applicant does not start proceedings on the merits of the case before the Court.

VII. The value of the request and the dispute is set to EUR 5 Mio.

INFORMATION ABOUT APPEAL IN CASE OF ON ORDER FALLING UNDER ART. 73(2)(A) UPCA:

An appeal against the present Order may be lodged by any party which has been unsuccessful, in whole or in part, in its submissions at the Court of Appeal within 15 days of service of this Order (Art. 73(2)(a), R. 220.1(c), 224.1(b) 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 order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR

DETAILS OF THE ORDER

Order no. ORD_47657/2024
ACTION NUMBER: ACT_23636/2024
UPC number: UPC_CFI_201/2024
Application Type: Application for provisional measures (RoP206)
