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Court of Appeal of the UPC considers post-filed experimental data irrelevant to claim construction

STEROS GPA Innovative S.L. v OTEC Präzisionsfinish GmbH,

UPC_CoA_579/2025, order of 7 November 2025[1]

STEROS, the exclusive licensee of European Patent EP4249647B1 ("EP'647"), lodged an application for provisional measures against OTEC before the Hamburg Local Division (Court of First Instance, herein "CFI") on 26 March 2025.

The patent relates to an electrolytic medium and claim 1 requires the presence (amongst other features) of solid particles, a conductive solution and a non-conductive fluid. The alleged infringer, OTEC, manufactures and sells electropolishing machines which include an electrolyte medium.

The dispute between the parties in relation to infringement centred on whether or not OTEC's product included a non-conductive fluid as required by claim 1 of "EP'647".

In the first instance proceedings, experimental data submitted by the parties showed that OTEC's product comprised an emulsion-based fluid. The continuous phase of this emulsion was non-conductive, whilst the emulsion as a whole had a higher conductivity. STEROS argued that the presence of the non-conductive continuous phase meant that claim 1 was infringed. The CFI agreed and ordered the provisional measures[2]. The present order relates to appeal proceedings before the Court of Appeal of the UPC (CoA).

~~Claim Construction~~

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Claim 1 of EP'647 did not specify a maximum value for the conductivity of the non-conductive fluid, but did specify a minimum conductivity of 10 µS/cm for the solid particles and conductive solution. In assessing infringement in the appeal proceedings, the CFI construed the "non-conductive fluid" feature of claim 1 as follows:

1. For an emulsion-based fluid, the conductivity of the emulsion as a whole did not need to be measured - claim 1 was satisfied when a component of the emulsion was non-conductive (as was the case for OTEC's product).
2. As claim 1 did not specify a conductivity for the non-conductive fluid, the value of 10 µS/cm (claimed in relation to the conductive solution only) should be used as the cut-off between what was considered conductive and non-conductive.

In the appeal proceedings, the CoA looked to the patent's description for justification of the CFI's approach and discussed the relevance of the experimental data.

The CoA disagreed with the CFI's reasoning in (1). The description of EP'647 referred to the conductivity of emulsion-based non-conductive fluids ~~as a whole~~ and described in detail the significance of the non-conductivity of the fluid in the form present in the final electrolyte medium. In the case of OTEC's product, this is the emulsified form. It is the conductivity of this emulsion that is described in the patent as crucial to achieving the effect of the invention. The fact that a component of this fluid is non-conductive is not relevant.

In relation to (2), the patent's description was silent on the threshold value for a non-conductive fluid. STEROS submitted post-filed data relating to a fluid described as non-conductive in the patent, including measurements showing a conductivity greater than 10 µS/cm. They argued that this justified a relative assessment of conductivity by comparing the conductive solution and non-conductive fluids. By this reasoning, if the non-conductive fluid was significantly less conductive than the conductive solution, claim 1 was infringed. Crucially, the patent specification did not include any data for this example, nor was there a description of the proposed relative assessment of conductivity.

Additionally, the CoA stated that STEROS had measured conductivity prior to making the electrolyte medium, contrary to the teaching in the patent [as discussed above in relation to (1)]. OTEC also submitted data for the same example, following the protocol stipulated by the CoA and instead showing that the fluid had a negligible conductivity well below the value of 10 µS/cm.

The CoA was therefore not convinced by this line of argument and agreed with the CFI -

the maximum value of 10 µS/cm value should be used to define non-conductivity. They further emphasised that experimental data not disclosed in the patent specification is "
p3 as a general rule, not relevant to the interpretation of the patent claims". In the present case, this was particularly important because the way in which STEROS attempted to use the post-filed data was seen by the CoA to contradict the teaching in the patent specification.

~~Summary~~

In OTEC's product, the conductivity of the emulsion-based fluid as whole was higher than 10 µS/cm and therefore was not "non-conductive". The CoA considered the patent not infringed.

As the patent was found not infringed, the CoA set aside the impugned order. The application for a provisional injunction was rejected and STEROS ordered to pay the costs of the first instance and appeal proceedings.

[1] UPC_CoA_579/2025 (Court of Appeal of the UPC, Luxembourg), https://www.unifiedpatentcourt.org/en/node/159673

[2] UPC_CFI_281/2025 (Court of First Instance, Hamburg Local Division), https://www.unifiedpatentcourt.org/en/node/125946