

EIP

UPC grants provisional injunction and clarifies intermediary liability

Aesculap AG v Shanghai International Holding Corporation GmbH (Europe)
(UPC_CFI_213/2025 relating to EP2892442B1)

Order of 10 July 2025 (ORD 32728/2025 [1])

This Decision from the Düsseldorf Local Division of the Unified Patent Court relates to EP2892442B1 (EP '442). On 18 March 2025, the applicant, Aesculap AG ("Aesculap"), requested an ex parte provisional injunction against Shanghai International Holding Corporation GmbH (Europe), the EU representative of Shanghai Bojin Medical Instrument Co. Ltd ("Bojin"), arguing infringement of EP '442 (validated in Germany, France and the UK, and not opted out of the UPC) in relation to a medical instrument manufactured by Bojin, allegedly sold in Germany and France. The defendant is also responsible for maintenance of the CE marking affixed to the allegedly infringing product, which, according to EU regulations, is necessary for sale of the product.

Aesculap requested that the Court order the defendant to refrain from infringement in Germany and France, and provide information regarding manufacture, distribution and sale of the allegedly infringing products. Aesculap also requested an order for precautionary seizure of the products, pursuant to Art. 62(3) UPCA, and that the defendant is ordered to provisionally reimburse costs in the amount of EUR 33,335.70 and bear the costs of the proceedings.

Based on the arguments put forward by Aesculap, the Court decided to inform the defendant of the requested provisional injunction, pursuant to Rule 209(1)(a) RoP, following which the defendant filed its objection to the application for provisional measures. The Court decided to hear both parties, setting a date for oral proceedings to 1

July 2025.

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The defendant stated that they did not wish to be represented at the oral hearing. Accordingly, the Court stated that the absence of the defendant at the oral hearing does not preclude a substantive decision on the provisional injunction and, in particular, does not require the issuance of a mere default judgment. Therefore, the Court based its decision on the defendant's written submission, pursuant to Rule 116(3) RoP, and granted Aesculap's request for a provisional injunction.

Entitlement to bring action before the Court, urgency and balancing of interests

The Court decided that:

- as the registered proprietor of EP '442, the Aesculap is entitled to bring proceedings before the Court pursuant to Article 47(1) UPCA and Rule 8(5)(a) and (c) RoP;
- Aesculap acted swiftly in accordance with the urgency of the matter in order to prevent further damage, and it is not reasonable to expect it to wait for the main proceedings: Aesculap received a copy of the contested embodiment by a third party on 27 January 2025 and filed the application for a provisional injunction on 18 March 2025, arguing that Bojin is likely to expand its distribution and seek to gain access to the European market; and
- after weighing the interests of both parties, pursuant to Art. 62(2) UPCA and Rule 211(3) RP, the balancing of interests favoured Aesculap: Aesculap argued that it has a market share of over 50% in Germany, particularly with its ELAN 4 motor system, and that if Bojin manages to gain the trust of customers with the product in dispute, customers may also be willing to test the motor systems produced in China.

Validity

In its objection to the application for provisional measures, the defendant argued that EP '442 is to be considered invalid, based on US2003/0023256A1, which was already cited in the International Search Report. The defendant argued that some of the features of claim 1 were to be interpreted as optional, and that claimed advantages of claim 1 according to the problem-solution approach would not be achieved across the entire scope of the claim. The defendant also argued that claim 1 amounted to a mere alternative configuration of known elements, such as torque transmission sections and axial locks, which, even if novel, would not be inventive without a credible technical effect.

The Court decided that the defendant's argument was insufficient to raise serious doubts

as to the inventiveness of claim 1. The Court further explained that the lack of an indication of a starting point in the defendant's problem solution-approach made the argument unconvincing when determining the alleged lack of an inventive step. Therefore, the Court decided that the legal validity of EP '442 is sufficiently established, further stating that the grant of the contested patent was published on 11 July 2018 and no competitor lodged an opposition or initiated national revocation proceedings after the expiry of the opposition period.

Alleged infringement

In its objection to the application for provisional measures, the defendant argued that Aesculap did not specify any concrete acts of infringement, based on the absence of any evidence that the defendant imported, offered for sale or placed on the market a product. The defendant argued that Aesculap provided information about the purchase of a product, but this does not prove that the defendant was the supplier or was even involved in a commercial transaction involving the allegedly infringing product. Even if it were assumed that the defendant had enabled the CE conformity of the contested embodiment, this alone could not be interpreted as active participation in an infringing act. The defendant further argued that even if an infringing act was present, the contested embodiment did not realise the feature of a "double angle" for torque transmission.

The Court found the defendant's argument on the lack of evidence to prove infringement to be insufficient, explaining that if the defendant merely makes general statements regarding the burden of proof on the applicant, the corresponding submission of the opposing party is deemed to be undisputed, pursuant to Rule 171(2) RoP.

The Court further explained that even if the defendant's argument was successful, the defendant would still be liable as an intermediary within the meaning of Article 63(1) UPCA for the offer and distribution of the contested embodiment in the relevant Member States, and therefore eligible to be subject to provisional measures, pursuant to Article 62(1) UPCA. The Court further explained that even if the affixing of the CE marking is to be classified solely as a preparatory act, the contested embodiment has already been placed on the market, and therefore the defendant is liable as an intermediary, having made a decisive contribution by being designated as the authorised representative.

The Court also rejected the defendant's argument that the contested embodiment does not fall within the scope of claim 1, arguing that based on the skilled person's understanding of the granted German claims, the contested embodiment did in fact realise the feature argued by the defendant.

Accordingly, the Court decided that it can be established with sufficient certainty, pursuant to Rule 211(2) RoP, that Aesculap's rights are infringed by the offer and sale of the contested embodiment within the contracting member states Germany and France (Art. 25(a) UPCA).

Decision

The Court ordered the defendant to refrain from performing acts that would constitute infringement of EP '442 in Germany and France, and issued an order for precautionary seizure of products.

The Court also ordered the defendant to provide Aesculap with information regarding manufacture, distribution and sale of the infringing products.

Furthermore, the Court ordered the defendant to bear the cost of the proceedings, and made the order enforceable without security.

[1] <https://www.unifiedpatentcourt.org/en/node/136398>