

EIP

No Declaration of Non-Infringement for Alternative Product

HL Display v. Black Sheep

UPC_CFI_386/2024 (The Hague LD), decision of 10 October 2025 [1]

Summary

The Unified Patent Court rejected Black Sheep's request for a declaration of non-infringement (DNI) for an alternative product design. The court found the request inadmissible because HL Display had not asserted infringement against the alternative design, and Black Sheep had not formally sought acknowledgment of non-infringement before filing the counterclaim.

Background

HL Display and Black Sheep Retail Products are competing producers of accessories for shop shelves, such as shelf dividers. HL Display sued Black Sheep for infringing its patent EP2432351, which covers a system for securing shelf accessories to shop shelves. The system includes front and rear securing devices and a shelf accessory designed to prevent accidental disengagement while allowing intentional release. The invention lies primarily in the configuration of the shelf accessory and the rear securing device.

Declaration of non-infringement

Along with its counterclaim for revocation, Black Sheep applied for a declaration of non-infringement (DNI) based on a proposed alternative design, which allegedly lacked a key feature of the claims.

Rule 61 RoP sets out the circumstances under which the court can provide a declaration that the performance of a specific act does not, or a proposed act would not, constitute an infringement of a patent. In particular, a DNI may be made by the court if:

- the proprietor (or their licensee) has asserted that the act is an infringement; or,
- the applicant has provided full details of the act and requested acknowledgment of non-infringement, and the proprietor (or licensee) has refused or failed to provide the requested acknowledgement within one month.

In this case, HL Display had not asserted that the alternative design infringed the patent. The court held that the assertion of the patent against the original product was not sufficient to meet the first alternative criterion above.

Black Sheep also had not made a separate request for acknowledgement of non-infringement from the HL Display. The court considered the argument that the counterclaim for a DNI was itself the request for acknowledgement of non-infringement, but ultimately decided that such an interpretation would undermine the purpose of the rule: to prevent unnecessary proceedings for a declaration of non-infringement when the proprietor or its licensee has not yet asserted the patent with respect to a certain product (or process). It would also render the relevant parts of Rule 61 redundant. The court therefore found that the counterclaim for a declaration of non-infringement was inadmissible.

Key Takeaway

A declaration of non-infringement cannot be obtained based on a modified product against which infringement has not been specifically alleged unless the applicant has already requested (and failed to obtain) acknowledgement of non-infringement from the patent proprietor. The same reasoning can presumably be extended to other potentially infringing acts based on modified methods as well as modified products.

[1][<https://www.unifiedpatentcourt.org/en/node/159498>]