



Press release dated March 31, 2025

## **BARDEHLE PAGENBERG successful for TomTom against Pioneer in litigation complex regarding voice recognition and navigation**

**On February 6, 2019, Pioneer filed infringement complaints for a total of three patents: EP 2 261 877 before the Regional Court of Hamburg, and EP 2 447 941 and EP 2 447 942 before the Regional Court of Mannheim.**

**Six years later, it has now been finally established that none of the patents asserted by Pioneer is legally valid and infringed. EP 2 261 877 and EP 2 447 941 were revoked in their entirety. EP 2 447 941 and EP 2 447 942 are not infringed. Further, the European Patent Office revoked four other patents (EP 3 043 349, EP 3 618 065, EP 2 923 876, and EP 2 793 193) of Pioneer in their entirety. All decisions are final and absolute.**

**The full revocation of EP 2 447 941 is a rarity in patent law, as the German Federal Court of Justice declared the patent invalid due to an unallowable intermediate generalization.**

European Patents EP 2 447 941 and EP 2 447 942 relate to user guidance in voice recognition systems, such as those used in navigation systems. Pioneer claimed that these patents were infringed by certain TomTom navigation systems. In its decision dated November 8, 2019, the Regional Court of Mannheim dismissed the infringement complaints regarding EP 2 447 941 and EP 2 447 942 for lack of infringement (docket no.: 7 O 11/19). The Higher Regional Court of Karlsruhe also dismissed Pioneer's appeal in its judgment dated December 8, 2021 (docket no.: 6 U 123/19). Pioneer later withdrew an appeal against denial of leave to appeal to the German Federal Court of Justice (docket no.: X ZR 2/22).

European Patent EP 2 261 877 relates to route planning and processing of traffic congestion information in a navigation system. Pioneer claimed that certain TomTom navigation systems use the protected technology.

TomTom filed nullity complaints against EP 2 447 941, EP 2 447 942, and EP 2 261 877 to defend itself against the allegations. In its judgment dated December 15, 2022 (docket

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no.: 2 Ni 47/20 (EP)), the German Federal Court of Justice revoked EP 2 261 877 in its entirety. Pioneer did not lodge an appeal, and instead withdrew the infringement complaint before the Regional Court of Hamburg (docket no.: 315 O 23/19) subject to cost reimbursement.

By judgments dated May 26, 2021, the German Federal Patent Court dismissed TomTom's nullity complaints against EP 2 447 941 and EP 2 447 942 (docket nos.: 4 Ni 3/21 (EP) and 4 Ni 4/21 (EP)). In response, TomTom filed an appeal with the German Federal Court of Justice (BGH).

The German Federal Court of Justice set aside the judgment of the German Federal Patent Court with regard to EP 2 447 941, it followed TomTom's argument that the subject matter of EP 2 447 941 was intermediately generalized in an inadmissible manner, and therefore declared the patent invalid in its entirety by judgment dated January 11, 2024 (docket no.: X ZR 68/21). According to the case law of the German Federal Court of Justice, there is a strict standard for inadmissible intermediate generalizations. It is therefore a rare occurrence for a patent – as was the case here – to be revoked by the German Federal Court of Justice due to an unallowable intermediate generalization.

In its judgment dated January 11, 2024 (docket no.: X ZR 73/21), the German Federal Court of Justice deemed EP 2 447 942 to be valid, but at the same time established a claim construction according to which EP 2 447 942 was undisputedly not infringed. The non-infringement had previously been confirmed by the Higher Regional Court of Karlsruhe.

In addition, TomTom proactively filed an opposition against the two European Patents EP 3 043 349 and EP 3 618 065, which come from the same family as EP 2 447 941 and EP 2 447 942.

The competent Opposition Division of the European Patent Office revoked EP 3 043 349 in its entirety by decision dated March 9, 2022, for lack of inventive step. The Technical Board of Appeal 3.4.01 confirmed the full revocation in its decision dated October 24, 2024 (docket no.: T 1224/22). The Opposition Division considered an objection of inadmissible extension to be well-founded and therefore revoked the patent on this ground.



The competent Opposition Division of the European Patent Office also revoked EP 3 618 065 – also due to an inadmissible extension. Pioneer did not appeal this decision, so that it became final.

Finally, TomTom also attacked the two patents EP 2 923 876 and EP 2 793 193 proactively with opposition proceedings before the European Patent Office.

Pioneer limited the subject matter of EP 2 923 876 during the opposition proceedings by amending the main request. This amendment led to a lack of clarity (Art. 84 EPC) which was not overcome by any auxiliary request. The patent was therefore revoked. Pioneer did not file an appeal.

While EP 2 793 193 had been maintained to a limited extent by the Opposition Division, it was also revoked in its entirety upon appeal.

As a result, Pioneer lost six out of seven patents in their entirety. The only patent that proved to be legally valid is not infringed.

All decisions are final and absolute.

**Representatives of TomTom: BARDEHLE PAGENBERG (Munich)**

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Only regarding EP 2 923 876: Viering, Jentschura & Partner (Dresden, Germany):

Kornelia Ihle.

Only regarding EP 2 793 193: Gill Jennings & Every LLP (London): John Henry Severs.

**10<sup>th</sup> Civil Senate of the German Federal Court of Justice**

Dr. Deichfuß (Presiding Judge)

Dr. Rensen

Hoffmann

Dr. Crummenerl

Dr. Kober-Dehm

**2<sup>nd</sup> Senate of the German Federal Patent Court (regarding  
EP'877 – 2 Ni 47/20 (EP))**

Hartlieb (Presiding Judge)

Dr. Friedrich

Dr. Zebisch

Dr. Himmelmann

Dr. Kapels

**4<sup>th</sup> Senate of the German Federal Court of Justice (regarding EP'941 and  
EP'942 – docket nos.: 4 Ni 3/21 (EP) and 4 Ni 4/21 (EP))**

Grote-Bittner (Presiding Judge)

Arnoldi

Matter

Dr. Söchtig

Dr. Haupt

**Technical Board of Appeal 3.4.01 (regarding EP'349 – T 1224/22)**

P. Scriven

T. Petelski

C. Almberg



**BARDEHLE PAGENBERG** combines the professional expertise of attorneys, patent attorneys, professional representatives before the European Patent Office, specialized trademark lawyers, and qualified technical consultants. Our consulting is tailored to our clients' individual needs and the specific circumstances of each case.

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