

COURT OF FIRST INSTANCE OF THE UNIFIED PATENT COURT
LOCAL DIVISION IN MILAN

ORDER NO. 59764/2024
issued on
5 November 2024

APPLICANT

PIRELLI TYRE S.P.A. - Milan, viale Piero e Alberto Pirelli 25, Italy
represented by attorneys-at-law Matteo Orsingher, Davide Graziano and Federica Franchetti, Milan,
via Fratelli Gabba 3

DEFENDANT

Tianjin Kingtyre Group Co., Ltd., with a registered office at Gulin Industrial Park, Binhai New Area, Tianjin, China, represented by its legal representative pro tempore, e-mail address: sharon@kingtyre.cn,
Kingtyre Deutschland GmbH., with a registered office at Schulstraße 33, 71155, Altdorf, Germany, represented by its legal representative pro tempore, e-mail address: info@kingtyre-deutschland.de.

DIVISION

Local Division in Milan

DECIDING JUDGE

This order is issued and signed by Alima Zana, acting as a single judge pursuant to Rules 1.2(b), 208.2, 345.5 and 351.1(a) RoP.

PATENT AT ISSUE

EP 2519412 (hereinafter EP412)

LANGUAGE OF THE PROCEEDINGS

Italian

1. Summary of facts

Pirelli Tyre s.p.a. (hereinafter “Pirelli”) is a Pirelli Group company, wholly owned by Pirelli 6 C. s.p.a.). Pirelli operates in 160 countries around the world, with 31,000 employees and recorded sales of approximately 6.5 billion euros.

The applicant holds patent EP2519412, entitled "*motorcycle tyre and pair of motorcycle tyres*," which is valid in Italy, Germany and France.

On 31 October 2024, Pirelli filed an application for provisional and protective measures under Article 62 of the UPC Agreement, requesting that such measures also be granted *inaudita altera parte*, against TIANJIN KINGTYRE GROUP CO., LTD, (hereinafter “Tianjin Kingtyre”, based in China) and KINGTYRE DEUTSCHLAND GMBH (hereinafter “Kingtyre DE”, based in Germany).

In particular, it stated that at the renowned *Esposizione Internazionale Ciclo Motociclo ed Accessori*, (International Motorcycle and Accessories Exhibition, EICMA) - the most important trade fair for the two-wheel sector worldwide, scheduled to take place from 5 to 10 November.2024 – the two defendants will exhibit products that infringe on the applicant’s industrial property rights.

It has therefore requested the imposition of an injunction assisted by a penalty, the payment of a provisional sum for costs, as well as the seizure and delivery of the infringing products.

The Presiding Judge, given the urgency, assigned the proceedings to the judge-rapporteur as Single Judge on the same date, in accordance with Rule 208(2), RoP.

The Sub-Registry has completed the verification provided for under Rule 208(2) RoP, and no protective letters have been filed.

In Preliminary Order ORD_59450/2024 dated 31 October 2024, the Court, having stated its intention not to grant the injunction *inaudita altera parte*, invited the applicant to exercise the right provided for under Rule 209(4) RoP, with the alternative possibility to: a). limit the application for protective measures solely to the seizure and delivery of the disputed property, as well as to the costs of the proceedings (see points 4 and 5 of the conclusions contained in the application); b). withdraw the application for protective measures in its entirety. This is without prejudice in any case to the right to file the application for an injunction independently through a separate application.

On 3 November 2024, Pirelli limited its application for protective measures to a sole application for seizure, delivery and costs.

The Court held that, given the extreme urgency, it was not possible to summon the applicant in light of Rule 212.2 RoP.

The applicant’s requests

Following the communication of 3 November 2024, the applicant made the following request to the Court, as outlined below.

May the Honourable Local Division, rejecting all other applications and objections, order against TIANJIN KINGTYRE GROUP CO., LTD. and KINGTYRE DEUTSCHLAND GMBH (hereinafter referred to as “Kingtyre DE”),

pursuant to Article 62 UPC Agreement, *inaudita altera parte*:

- the seizure and delivery up to a bailiff appointed by the applicant, at the defendant's expense, of the

contested products and tyres, both front and rear and regardless of their designation, that have the same features indicated in the application, as well as any related promotional, advertising or informational material, in the direct or indirect possession of the defendant at the *Esposizione Internazionale Ciclo Motociclo e Accessori*, in order to prevent these items from being further exhibited at the aforementioned trade fair, placed on the market and marketed through distribution channels during the trade fair. It is requested that the applicant be authorized to attend the seizure and delivery operations through its trusted legal representatives and technical advisors;

- an award of legal and ancillary costs, charged to the defendant.

It also requested authorization to serve the application together with the order and attached documents by an alternative method (specifically, immediately at the time of execution of the measures, in compliance with the regulations in force in Italy with respect to the service of judicial documents) in accordance with Rules 275(1) and 276(1) RoP.

GROUNDNS FOR THE DECISION

1. Jurisdiction

The Unified Patent Court holds jurisdiction given that the applicant:

- a- has filed an application falling among the types of application subject to the jurisdiction of the UPC under Art. 32(1)(c), and 62 UPCA;
- b- EP 412 is a European patent and the proprietor has not exercised the right to opt out under Art. 83(3) UPCA and Rule 5 RoP.

The patent title is effective, among other countries, also in Italy, as evidenced by the EPO register.

2. Competence

In the internal division of competence between the Central Divisions and the Local Divisions, the latter are generally competent for applications for protective measures, based on the combined provisions of Articles 32(1)(c) and 33 UPCA.

The Milan Local Division is competent pursuant to Article 33(1)(a) UPCA, since the *forum commissi delicti* is identified within Italian territory. This is based on the applicant's assertion that the alleged tort - specifically the exhibition at the trade fair of the products deemed to be infringing - will take place within Italian territory, and in particular at the Rho Fiera venue in Milan.

In addition, the application for protective measures was filed with the Milan Local Division, where the applicant intends to initiate the proceedings on the merits.

3. Compliance with the provisions of Rule 206(2) RoP

3.1. Contents of the application

The application for provisional measures filed by Pirelli contains:

- (a) All the detailed information required under Rule 13.1(a) - (i) RoP;
- (b) The specification of the required measures;
- (c) The reasons on the basis of which the requested measures are necessary to prevent the threat of infringing conduct or to prevent its continuation;
- (d) The facts and evidence on which the application is based.

3.2. The specification in the application of the future proceedings on the merits.

The applicant has indicated the proceedings on the merits it intends to initiate. These involve a request for a final determination of patent infringement, with the resulting measures provided for in the UPC Agreement, including injunctive relief and penalties for compliance, seizure, compensation for damages incurred, and publication of the ruling, as well as the awarding of litigation costs.

4. Burden of proof: sufficient degree of certainty (Rule 211.2 RoP).

4.1. Applicant's rights based on a valid patent (Rule 211.2 RoP)

The asserted patent: claim construction

EP 2 519 412 B1 originates from the international application PCT/IB2010/003341, filed on 23 November 2010 on behalf of Pirelli Tyre s.p.a. and claiming priority from the Italian application IT 2009RM00688 filed on 29 December 2009 (Annex 2) and from the U.S. application US 2010/0319284 P filed on 31 March 2010 (Annex 3). The international application was published under WO 2011/080566 (Annex 49) and entered the European phase at 10813110.3.

Following the grant, on 30 September 2014, the patent was validated in Italy under Article 56 of the Codice della Proprietà Industriale (Italian Code of Industrial Property) under the number 502014902297930 (Annex 9), as well as in France and Germany.

EP 412 deals with motorcycle tyres, intended to be mounted on motorcycles in the *Supersport and/or Sport Touring* segment, having large engine capacity, and also used on tracks.

For the purposes relevant here, the patent was granted with 24 claims, including one independent claim (No. 1) concerning a method for increasing the footprint area of a motorcycle tyre during substantially straight running and one independent claim (No. 3) concerning a motorcycle tyre.

EP 412 also consists of three claims (22-24) concerning pairs of tyres suitable for mounting as the rear and front tyre of a motorcycle vehicle.

Specifically:

Independent Claim No. 1 of the patent relates to a

1. Method for increasing a footprint area of a motorcycle tyre (100) in substantially straight running, said tyre comprising a tread band (8), said method comprising:

1.A. forming in a central portion (A) of said tread band a first plurality of grooves (20) extended according to a substantially longitudinal direction and alternatively arranged at opposite sides of an equatorial plane (X-X) of said tyre, wherein each groove of said first plurality of grooves has a substantially curvilinear course such as to form a concavity,

1.B. leaving free of grooves a sub-portion of said central portion placed astride an equatorial plane (X-X) of said tyre. The Patent also includes three claims 22- 24 concerning pairs of types suitable for mounting as the rear and front tyres of a motorcycle.

Independent Claim No. 3, which is deemed interfering, protects a

3. Motorcycle tyre (100), having a tread band (8) comprising a central portion (A) and two shoulder portions (B) arranged at axially opposite sides of the central portion (A), wherein:

3A. the central portion (A) comprises a first plurality of grooves (20) extended according to a substantially longitudinal direction and alternatively arranged at opposite sides of an equatorial plane

(X-X) of said tyre, wherein each groove of said first plurality of grooves has a substantially curvilinear course such as to form a concavity;

3B. the central portion comprises a sub-portion substantially free of grooves placed astride an equatorial plane (X-X) of said tyre;

3C. each of said shoulder portions comprises a second plurality of grooves arranged obliquely relative to the equatorial plane of said tyre.

In essence, the technical solution covered by the patent provides a tyre with a central portion of the tread band in which a first plurality of grooves extended in a substantially longitudinal direction and arranged alternately on opposite sides of the equatorial plane of the tyre is provided, in which each groove of the first plurality of grooves exhibits a substantially curvilinear course so as to form a concavity. According to the invention, a sub-portion of the central portion located astride the equatorial plane of the tyre is left free of grooves.

EP 412 allows for improved road performance on dry road surfaces (in terms of stability, thrust, drivability and yielding) while maintaining the same high performance on wet grounds (in terms of traction and rain drainage).

These innovative technical solutions have been incorporated into the "ROADTEC tm M5 INTERACT" and "ROADTEC tm Z8 INTERACT tm," motorcycle tyres which are marketed by Pirelli under the historic "Metzeler" brand, which is owned by Pirelli.

The presumption of validity

Pirelli proved that it was the sole proprietor of the EP '412 patent (doc. 1 of the applicant).

The applicant is required under Rule 206(3) and (4) RoP to make a full disclosure of circumstances, including those contrary to its position, and in any case, of any factual circumstance that may be relevant to the Court's decision to issue an order *inaudita altera parte* with an obligation to disclose – in particular – the pendency and outcome of any proceedings related to the asserted patent.

Pirelli in this regard stated that:

- the patent has been granted not only by the European Patent Office but also in countries outside Europe: the U.S., China, Japan and Brazil;
- no objections have been raised;
- no legal action has been taken to challenge its validity.

Therefore, the patent is currently supported by a strong presumption of validity.

4.2. Suspected infringement - Rule 211.1(b) and 211.2 RoP

The Court notes that:

- Article 62(3) UPCA and Rule 211.1(b) ROP provide that the Court may order the seizure of products suspected of infringing a patent to prevent their entry into or movement within the channels of commerce;
- for the purposes of granting the seizure measure under Article 62.3 UPCA and Rule 211.1(b) RoP, a mere "suspicion" of infringement is required;
- the applicant alleges literal infringement of patent teachings by two specific tyre models:
 - the tyre model "Radial tire high speed K902" (accessible via the link: <https://it.king->

- tyre.com/sport/kingtyre-radial-tires-high-speed-k902.html, doc. 9)
- the tyre model "Motorcycle radial tyre-slick racing grade W= (accessible via the link: https://www.king-tyres.com/on_road/sport-s/motorcycle-radial-sports-tyre-speed-270.html, doc. 10 of the applicant), advertised as tyres from the defendants' "On road - Sport" line

In this light and based on the claim construction and the photographic evidence submitted, the suspicion of the alleged wrongdoing is well-founded.

Pirelli submitted an expert report (see doc. 11 of the applicant) that contains a detailed comparison table - also reproduced in the application – between the patent teachings, the patent drawings (figs. 3 and 3B of EP 412) and photographic reproductions of the disputed models (see pages 10-16 of the application).

In fact, the comparison between the patent teachings, the patent drawings (see Figures 3 and 4 of EP 412 and the photographic reproductions of the contested models (see pages 11-16 of the application and doc.c. 9 and 10 filed by Pirelli) justify the suspicion of interference with the teachings of independent claims Nos. 1 and 3 of EP 412.

Pirelli argued specifically that such infringing models will be exhibited at the renowned *Esposizione Internazionale Ciclo Motociclo ed Accessori* (EICMA), the most important trade fair event for the two-wheel sector worldwide, by the two defendants, as apparently documented by:

- an advertisement posted on Tianjin Kingtyre's website on 9 October 2024 (doc. 8 of the applicant);
- the allocation of Stand 107, Hall 14 to Kingtyre De (doc. 7 of the applicant).

It is therefore evident that there exists a risk of entry or circulation of infringing products under Rule 211.2 RoP within the channels of commerce, arising from the presentation at the trade fair expressly announced by Tianjin Kingtyre, with the purpose - inherent to this type of trade fair events - of promoting sales to international operators, among which are certainly included buyers interested in their subsequent placement within the Italian, French and German markets, i.e. in the territories of the UPC Contracting Member States where the patent enforced by Pirelli is valid and effective.

5. Plurality of defendants

At the current state of the proceedings, Kingtyre DE's involvement in the infringing conduct is limited to the proven allocation of exhibition space, which makes it appropriate, however, to order that the measures, and their subsequent enforcement, be extended to this entity as well, with a view to ensuring further protection of its rights.

6. Urgency

Pirelli only recently acquired certain knowledge of the defendants' presentation of the infringing products at the EICMA trade fair, following the publication on 9 October 2024 on the defendants' website of a special announcement. Pirelli's initiative is therefore entirely timely, including within the framework of Rule 211.4 RoP.

The trade fair where the allegedly infringing products will be displayed, (see doc. 8 of the applicant,

consisting of an announcement on Tianjin Kingtyre's website dated 9 October 2024), is scheduled for the current week, over the period between 5 and 10 November 2024.

The urgency of the adoption of the measures is therefore evident.

7. The necessity to issue an order *inaudita altera parte*

According to the combined provisions of Art. 60(5) UPCA and Art. 62(5) UPCA, similarly to Rule 212.1 RoP, it is stipulated that protective measures, including seizure shall be ordered "if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed..."

In the present case, a delay in granting the order could lead to an irreparable risk, considering that:

- before the trade fair event, it is not possible to initiate adversarial proceedings, given that the defendants are based abroad, with one defendant within an EU country (Germany) and the other in a non-EU country (China). Therefore, the prior initiation of adversarial proceedings is almost impossible before the trade fair event;
- the disputed products will be exhibited very shortly, during the period between 5 and 11 November 2024;
- the applicant's trade show exhibition, attended by buyers from all over the world, including without doubt the countries where EP '412 is in force, risks causing irreparable harm to the applicant, given that the defendants are direct competitors of Pirelli, and that the latter's tyres, which embody the patented teachings, appear to be substitutable with those deemed interfering. This creates a consequent risk of direct customer diversion and damage to the applicant's reputation.

8. Balancing of interests

Rule 211.3 RoP states that "[i]n taking its decision the Court shall in the exercise of its discretion weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction."

In the present case, given the presumption of validity and the likely infringement – alleged to be literal - of the teachings, the measure of seizure appears to be a balanced solution. The trade fair is the most important in the industry, where the defendants are direct competitors of Pirelli and the disputed product is entirely substitutable for the applicant's product. This poses a significant risk of losing substantial market share for the patent proprietor.

Pirelli's interest in obtaining the seizure measure appears, in short, to outweigh that of the defendants. The inability to continue to offer the allegedly infringing products at the trade fair only partially impacts their participation in the event, as they retain the ability to engage in sales and promotional activities with other products that they seemingly intend to advertise at the same event.

In the light of the foregoing considerations, Pirelli's interest in obtaining the seizure measure appears to outweigh that of the defendants' interest in not having its active participation in the fair hindered, given the limited impact of the seizure measure in relation to this latter expectation.

9. Security

In the present case, the “special circumstances” under Rule 211.5 RoP exist to avoid making the granting of the measures conditional on the provision of security, in view of the very tight timeline for the execution of the measures, which would objectively hinder its execution if it were subject to the provision of security or the issuance of an equivalent guarantee.

In addition, Pirelli - part of the eponymous group, an undisputed international leader with a solid entrepreneurial foundation - appears solvent in the event of being ordered to pay compensation for harm caused by the execution of the measures (Local Division of Milan, IFC 177/2023, 13 June 2023).

The measures are therefore immediately enforceable.

10. Payment of court fees

On 31 October 2024, the applicant informed the Sub-Registry that it had paid the court fees due for the present proceedings, attaching the bank receipt proving payment.

It is not possible at present to verify the successful completion of the payment.

Therefore, based on the current state of the proceedings, the Court acknowledges that payment has been made solely on the basis of the statement made by Pirelli, under its direct responsibility.

12. Method of execution of the measures

Execution and service of the measures

The extreme urgency and the limited time available for service, combined with the need to ensure the element of surprise of the measures and the need to comply with the provisions of Rule 206.3 in conjunction with Rule 197(2) RoP, necessitate ordering that service be carried out - as expressly requested by Pirelli (see p.21 of the application) - at the initiative of the applicant, through a bailiff at the location where the trade fair is being held, immediately at the time of the execution of the measures.

This is in compliance with Rules 275.1 and .2 and 276.1 RoP.

The applicant is authorized to participate in the seizure and delivery operations with its representatives and technical experts for the specific purpose of identifying the products subject to the measures.

The custody of the seized property

According to national rules, seized property must be entrusted to a custodian until further order of the court.

In the present case, the choice of custodian shall be made by the applicant, who will bear responsibility for custody. The applicant is required to inform the Court of the custodian’s identity and the location where the goods are held within 5 days of the execution of these measures.

Preferred hours

In applying the principle of proportionality established in Articles 41 and 42 UPCA, including in the choice of execution measures, and taking into account that the measures will be enforced within the

context of a trade fair event open to public participation, it is specified that the bailiff should, preferably and where possible, proceed with the execution during hours other than those designated for public attendance or during periods of lower foot traffic at the defendants' stand.

13. Review

The defendants may request a review of this order within a period of thirty days commencing from the date of execution of the measures, in accordance with the provisions of Rules 212.3, 197.3 and 197.4 RoP.

14. Appeal

The parties may file an appeal within a period of fifteen days from the service of this order, in accordance with the provisions of Article 73(2)(a) UPCA and Rules 220.1(c) and 224.2 (b) RoP.

ORDER

The Court

1. authorizes the seizure and delivery requested by the applicant, which shall be carried out at the Esposizione Internazionale Ciclo e Motociclo e Accessori (EICMA) trade fair event to be held in Rho Fiera (Milan), Italy, from 5 to 10 November 2024 and, accordingly:

- orders the defendants to deliver to the territorially competent bailiff in charge the following:
 - a. The disputed tires identified as:
 - the "Radial tire high speed K902" model;
 - the "Motorcycle radial tyre-slick racing Grade W" model;or otherwise identified - whether prior or subsequently - that have the same features as indicated in the narrative, insofar as they replicate the features of Claims Nos. 1 and 3 of Patent EP 2519412;
 - b. Any promotional, advertising or informational materials relating to the aforementioned tyres;
- 1. authorizes the applicant to attend the seizure and delivery operations through its representatives and technical experts;

2. Orders that the seized products be placed in the custody of a custodian to be identified by the applicant in accordance with the provisions of Italian national law on the execution of protective measures, with the applicant required to notify the Court - within 5 days of the execution of the measures - of the custodian's identity and the location where the products are being held.

3. Orders the service of a copy of this order and the documents attached to it, as well as the letter for service and instructions for access to the proceedings via the CMS by an alternative method. This service shall be carried out by the bailiff identified by the applicant itself at the trade fair stand assigned to the defendants within the framework of the *Esposizione Internazionale Ciclo e Motociclo e Accessori* (EICMA) trade fair to be held at Rho-Fiera (Milan) from 5 to 10 November 2024, immediately at the time of execution of the measures in accordance with the applicable provisions under Italian law on the service of judicial documents;

4. Orders that in the event that the defendants fail to voluntarily comply with the protective order, the

bailiff shall be authorized, if deemed necessary, to request the assistance of law enforcement authorities, in accordance with the provisions of Italian law regarding the enforcement of judicial measures;

5. Declares that these measures shall be immediately enforceable;

6. Orders that the proceedings on the merits shall be initiated within 31 calendar days or 20 working days from the date of service to the defendants, noting that the seizure shall be revoked or otherwise become ineffective, at the request of the defendants, if the applicant does not commence the proceedings on the merits before the Unified Patent Court within that timeframe;

7. Orders that this order may be subject to review and appeal according to the instructions below;

8. Declares that the costs of the proceedings shall be determined in the proceedings on the merits. Thus decided in Milan on 5 November 2024

Single judge

Alima Zana

Alima

ZANA

Digitally signed by
Alima ZANA
Date: 2024.11.05
11:00:44 +01'00'

The Clerk

Maddalena Ferretti



FERRETTI MADDALENA
MINISTRY OF JUSTICE
05.11.2024 10:03:58
UTC

Service

This Order shall be served in person at the EICMA trade fair in Milan (Rho) through a bailiff designated by the applicant's representatives authorized for this purpose under national law, including the application and any attached documents (Rules 212.2 and 276.1 RoP)

Right to review

The defendants may request a review of this order within 30 days of the issuance of the measures (Art. 62 (5); 60 (6) UPCA, Rules 212.3, 197.3 RoP)

Right to appeal

Parties may appeal this order within 15 days of service (Arts. 73(2), 62 UPCA, R. 220.1(c), 224(b) RoP)

Notice that the proceedings on the merits must be initiated within a certain period of time

If the proceedings on the merits have not been initiated within the maximum period of 31 calendar days or 20 working days, whichever is longer, from the date of service on the defendants, the Court may, upon the Defendant's request, order that this order be revoked or otherwise cease to have effect (Art. 62(5),60(8) UPCA, R. 213.1 RoP).

ORDER DETAILS

Order no. ORD_59764/2024 in ACTION NUMBER: Not provided

UPC number: UPC_CFI_650/2024

Related proceeding no. Application No.: 59322/2024

Application Type: Application for provisional measures

(RoP206)