

ORDER
of the Court of First Instance of the Unified Patent Court
Local Division The Hague
issued on 14/10/2024
concerning: R. 190 order to produce evidence

HEADNOTE:

Request to produce evidence on the basis of R. 190 RoP partially awarded. *Prima facie* case of infringement. Proper evaluation of non-infringement and invalidity-arguments should be done by the panel. Request too broad and therefore limited.

KEYWORDS:

Evidence, duty to produce.

Date of receipt of Statement of claim : 18.6.2024

APPLICANT/S

- 1) **Winnov Solutions Limited** Represented by Gregory
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- Milton Keynes - GB

RESPONDENT/S

- 1) **Orbisk B.V.** Represented by Roeland Griepink
(Respondent) - Kanaalweg 29 A - 3526 KM -
Utrecht - NL

PATENT AT ISSUE

Patent no.

Proprietor/s

EP3198245

Winnow Solutions Limited

No SPC details provided

DECIDING JUDGE

Presiding judge

Edger Brinkman

Judge-rapporteur

Edger Brinkman

LANGUAGE OF PROCEEDINGS: English

SUBJECT-MATTER OF THE PROCEEDINGS

Request to produce evidence as part of infringement proceedings (R. 190 RoP)

FACTS

The parties

1. Winnow Solutions Limited (“Winnow”) was established on 31 May 2013. Winnow develops and markets commercial food waste management solutions to help customers run more sustainable and profitable kitchens by reducing food waste. Winnow markets these products in UPC member states, including, inter alia, France, Germany, the Netherlands and Italy.
2. Orbisk B.V. (“Orbisk”) was established in 2019 and also markets waste management solutions for reducing food waste, in particular its food waste monitoring product under the brand “Orbi”.

The patent

3. Winnow is the sole registered proprietor of EP 3 198 245 B1, “A system and Method for Monitoring Food Waste” (“EP 245”). The application for EP 245 was filed on 21 April 2015 and was published on 29 October 2015. EP 245 claims priority from US application 61/982,012, filed on 21 April 2014. Publication of the grant of EP 245 took place on 9 December 2020.
4. EP 245 includes two independent claims 1 and 15. The first (claim 1), claims a system for monitoring food waste and the second (claim 15) claims a method for monitoring food waste. Claims 1 and 15 of EP 245 can be broken down into integers as follows:

Claim / Integer	Claim language
1	(1) <i>A system for monitoring food waste, including:</i>
	(2) <i>a floor-based weight mechanism configured for weighing a waste receptacle, wherein the waste receptacle is configured for receiving food waste from a plurality of consecutive disposal events before emptying the waste receptacle;</i>
	(3) <i>a processor configured for measuring the difference in weight of the waste receptacle between consecutive disposal events of the plurality of consecutive disposal events, calculating the weight for each of the disposal events of the plurality of disposal events based upon the measured differences, and capturing the calculated weight for each disposal event;</i>
	(4) <i>a user interface configured to receive, for each of the calculated weights, at least one indication categorising the food waste in a disposal event by a user; and</i>
	(5) <i>a processor configured for cleaning the captured calculated weights to detect and correct erroneous weights.</i>
15	(1) <i>A method for monitoring food waste, including:</i>
	(2) <i>a. A processor receiving a first weight from a floor-based weight mechanism of a waste receptacle after a first disposal event;</i>
	(3) <i>b. The processor receiving a second weight from the floor-based weight mechanism of the waste receptacle after a second consecutive disposal event disposed before emptying of the waste receptacle;</i>
	(4) <i>c. The processor determining the weight for the second disposal event based on the difference between the first and second weights;</i>
	(5) <i>d. The processor capturing the weight for the second disposal event;</i>
	(6) <i>e. A processor cleaning the captured weight to detect and correct erroneous weights; and</i>
	(7) <i>f. A user interface receiving an input from a user to categorise the food waste for the second disposal event</i>

ORDER SOUGHT

5. Winnow contends that Orbisk infringes EP 245. For this it instituted infringement proceedings at this same local division of the UPC. However, in order to obtain more evidence regarding the alleged infringement Winnow requests the court that:
- a) In accordance with Article 59 UPCA and Rule 190 RoP, in association with Article 53, and/or Rule 172 RoP, Orbisk be ordered to provide to Winnow the documents outlined at paragraphs 19-21 and 26-27 of this Application which are within Orbisk's control.
 - b) The documents to be provided in electronic format within 2 weeks of service of the Order.

- c) The written procedure in the Action not to be unduly delayed as a result of the granting and exercise of the Order.
- d) Appropriate sanctions if the evidence outlined at (a) is not produced according to the Order.

Paragraphs 19-21 of the request are as follows:

19. In order to further support its claim for infringement, Winnow requests any detailed manuals, technical specification documents and/or training materials for the Orbi System or its constituent parts that specify the information referenced in paragraph 18 above. Should there be various versions of these documents provided to, for example, users and installers, Winnow requests access to all versions.

20. Winnow also requests a copy of the service level agreement, and any operational guidance or training material for annotators, between Orbisk and Sama (or between Orbisk and relevant third parties) which might assist in confirming the level and types of annotation that occur following a disposal event. Relatedly, Winnow seeks billing information in the control of Orbisk between Orbisk and Sama which might evidence the number of hours for which Orbisk may be paying Sama to classify food waste data.

21. In addition, Winnow requests access to any documents in the control of Orbisk relating to the review and classification of images by internal teams or third parties. Such documents may include a description of an interface acting to classify food images, including screenshots of how such interface functions and how data quality from annotators is monitored. Furthermore, Winnow seeks access to any internal Orbisk reporting which might contain information regarding measurement of annotator productivity and accuracy, and any other documentation of such a workflow.

Paragraphs 26-27 of the request are as follows:

26. However, given that there is limited information available which sets out how the Orbi System acts to detect and correct erroneous weights, further documentation would be beneficial. Therefore, Winnow requests documentation which confirms how this process is carried out.

27. Specifically, as above, Winnow requests any detailed manuals, technical specification documents and/or training materials for the Orbi System or its constituent parts that specify the information referenced in paragraph 25 above. Furthermore, Winnow requests any Orbisk internal documentation which sets out how the Orbi System recognises and prevents an erroneous weight, such as a bin change, being recorded as a disposal event, or processes weights to remove user error (including via deviation or pattern recognition techniques), and to the extent that it is necessary to understand the functionality of this aspect of the Orbi System, any algorithms and/or source code pertaining to the same. Winnow also requests any Orbisk internal documentation which sets out how erroneous data is cleaned by the Orbi System when weights which are not disposal events occur, such as when users kick or move the scale or user error more generally takes place, and to the extent that it is necessary to understand the functionality of this aspect of the Orbi System, any algorithms and/or source code pertaining to the same. In addition, Winnow requests documentation which relates to how the data is interpreted and processed from the scale in order to create a waste event on the Orbi System, including via use of a stability controller, and to the extent that it is necessary to understand the functionality of this aspect of the Orbi System, any algorithms and/or source code pertaining to the same.

DEFENCE

6. Orbisk argues that the request should be denied for the following reasons:
 - a) Winnow failed to present evidence reasonably available to it; and there is no - let alone sufficient likelihood that the Patent is valid and infringed);
 - b) the evidence Winnow requests access to is insufficiently specified and clearly amounts to a fishing expedition;
 - c) an order to disclose broad documentation as requested by Winnow will inevitably compromise its confidential information; and
 - d) considering the circumstances above, any order to produce evidence would be disproportionate.

For these reasons, Orbisk requests the Court to order as follows on Winnow's R. 190 Request:

- I. To reject the R190 Request in its entirety;
- II. In the alternative, to stay its decision on the R190 Request until the interim conference;
- III. In the further alternative, to stay its decision on the R190 Request until Orbisk has submitted its Statement of defence;
and, in the event that the R190 Request is granted at least in part,
- IV. To grant Orbisk a two-week period to file a motion under Rule 262A RoP;
- V. In the alternative, to order Orbisk to submit its application pursuant to Rule 262A at a time to be determined by the Court.
- VI. In the further alternative, to the extent that the R190 Request is granted without Orbisk being granted a possibility to file a motion under Rule 262A RoP, to limit access to the documents in question to the lawyers assisting Winnow;

or alternatively, to limit access to the documents in question to the lawyers assisting Winnow as well as a maximum of one natural person employed by Winnow who is established in Europe, is bound by rules of conduct applicable in Europe and has no commercial or technical position within Winnow.

GROUNDS FOR THE ORDER

7. The sections of Article 59 UPCA and Rule 190 RoP relevant to the request read as follows:

Article 59(1) UPCA

At the request of a party which has presented reasonably available evidence sufficient to support its claims and has, in substantiating those claims, specified evidence which lies in the control of the opposing party or a third party, the Court may order the opposing party or a third party to present such evidence, subject to the protection of confidential information. Such order shall not result in an obligation of self-incrimination.

Rule 190(1) RoP

Where a party has presented reasonably available and plausible evidence in support of its claims and has, in substantiating those claims, specified evidence which lies in the control of the other party or a third party, the Court may on a reasoned request by the party specifying such evidence, order that other party or third party to produce such evidence. For the protection of confidential information the Court may order that the evidence be disclosed to certain named persons only and be subject to appropriate terms of non-disclosure.

8. It follows from these provisions that the following requirements must be satisfied before the court can order any party to submit into the proceedings any evidence:
- (i) The requesting party must have presented evidence "reasonably available" to it in support of its claims;
 - (ii) the evidence to which access is requested must be "specified" and lie in control of the other party;
 - (iii) the other party's confidential information must be protected;

- (iv) based on the general rules of Articles 41(3) and 42 UPCA, as well as Article 3 of the Enforcement Directive, any order to produce evidence must satisfy the requirements of proportionality, equity, and fairness.

(i) reasonable evidence regarding the entitlement to the patent, the infringement and validity

9. Orbisk has not disputed Winnow's entitlement to the patent. Further, the JR is sufficiently convinced a *prima facie* case of infringement exists, as explained in the application and the SoC to which is referred. While Orbisk contests that features 1.4 and 1.5 are fulfilled, the proper evaluation of this as a principle is for the panel in the proceedings on the merits as initiated by Winnow. The JR also takes into consideration that it is for precisely those features that the evidence is requested, which implies – for the purpose of application of R. 190 RoP – that it cannot be expected from Winnow to already be conclusive in its argumentation (and evidence) on these features.
10. As to validity, it should be noted that it is up to the alleged infringer to bring forward arguments, substantiated by facts, that the patent is invalid (UPC CoA 335/2023, 11 March 2024, NanoString v/ 10x Genomics). In this respect, it is of importance that the patent was examined during prosecution by the EPO and granted. This entails a presumption of validity for the purposes of this request. Orbisk has submitted in its reply to this request, and in its SoD, various grounds for invalidity. As with infringement however, the evaluation of these arguments as a principle is for the panel in the proceedings on the merits as initiated by Winnow. It is therefore not for the JR to prelude in depth on these issues, unless there would be a clear-cut case of invalidity. Orbisk has not alleged nor has the JR identified such a case, as it currently stands.

(ii) sufficient specification of the evidence

11. The JR finds that Winnow's request is in certain respects too broad, and/or it was insufficiently made clear why it is necessary and/or whether such evidence actually exists. The JR will therefore limit the order as follows:
- *technical specification documents for the Orbi System that specify how some form of information is received regarding the disposal event that allows categorisation to be performed*
 - *technical specification documents which set out how the Orbi System acts to detect and correct erroneous weights*
12. The JR understands why this evidence is necessary as it is pertinent to the fulfilment of features 1.4 and 1.5 which has been disputed and thus far only has been supported by publicly available evidence. It is credible, and at any rate not really put into question, that such evidence exists and lies in control of Orbisk. So formulated, it is also sufficiently specific. Should Winnow, having reviewed this evidence, still reasonably need more evidence for its infringement claim, it can submit a reasoned request at the interim conference (i.e. at least two weeks before).

(iii) protection of confidential information

13. Ordered as indicated above, the JR does not follow Orbisk's argument that the request is so broad that already for that reason it would unjustifiably jeopardize the confidentiality of

such information. Since Orbisk indicated it intends to file a R. 262A RoP request, those persons that have access to it will be determined later. Incidentally, Winnow has indicated in its reply to Orbisk's objections that, as an alternative, only the external lawyers and experts will have access to the evidence of a confidential nature submitted by Orbisk. Orbisk has indicated the same, also alternatively. As the parties may be aware, the UPC has granted such a confidentiality club, excluding natural persons from the parties, if the parties agree on it. At any rate, parties are invited to agree on a proper confidentiality club.

(iv) proportionality, equity and fairness

14. The JR deems the production of evidence ordered as indicated above proportional and reasonably necessary to further the infringement case, while the interests of Orbisk to maintain confidential certain information can be properly protected. The JR incidentally remarks that there is a margin of discretion (UPC CoA 298-300/2024. 24 September 2024, Oppo v. Panasonic).

Sanctions and delay

15. Winnow has asked the JR to impose sanctions on non-compliance of the order. The JR refers to R. 190.7 RoP. It has not been made clear by Winnows why nor what more sanctioning may be necessary. In as far as Winnow requests the infringement proceedings not to be unduly delayed, this will be judged at the time any request for extension were to be filed.

ORDER

The court

- a) *In accordance with Article 59 UPCA and Rule 190 RoP, in association with Article 53 UPCA orders Orbisk to provide to Winnow:*
- *technical specification documents for the Orbi System that specify how some form of information is received regarding the disposal event that allows categorisation to be performed*
 - *technical specification documents which set out how the Orbi System acts to detect and correct erroneous weights*
- in as far as this is within Orbisk's control.*
- b) *Orders these documents to be provided in electronic format within 2 weeks of service of the order (together with – if need be – a R. 262A and/or R. 262.2 RoP request).*
- c) *Stipulates that if Orbisk fails to comply with this order, the court shall take such failure into account when deciding on the issue in question. (R. 190.7 RoP)*

ORDER DETAILS

Order no. ORD_44108/2024 in ACTION NUMBER: ACT_36388/2024

UPC number: UPC_CFI_327/2024

Action type: Infringement Action

Related proceeding no. Application No.: 38567/2024

Application Type: Application for an Order to produce evidence (RoP190)