



UPC_CFI_142/2025
Procedural Order
of the Court of First Instance of the Unified Patent Court
issued on 3 March 2025

Applicant

[...]

represented by: [...]

electronic address for service: [...]

Defendant

[...]

PATENT AT ISSUE: [...]

PANEL/DIVISION: Local Division in Mannheim

DECIDING JUDGE: Prof. Dr. Peter Tochtermann acting as presiding judge and judge-rapporteur

LANGUAGE OF PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Application for Preserving evidence (Saisie)

SUMMARY OF FACTS:

The applicant – as registered and sole proprietor of the Patent-in-Suit – requests under Art. 60 UPCA, R. 192 RoP to secure and preserve evidence (Saisie) based on the allegation that infringement of EP [...] were highly probable. The opt-out pertaining to the Patent-in-Suit had been withdrawn. It is in force inter alia in Germany, Italy, France and the Netherlands. Infringement is being argued as highly probable on the basis of an asserted claim combination of Claims [...] by defendant's [...] (hereinafter: Form of Infringement), which is visualized by the applicant as follows:

The asserted claim combination contains the following features:

[...]

The requests aim at an independent expert monitoring and examining at the premises of the defendant real-time operation of a full setup of the alleged Form of Infringement [...], this setup to be provided by the defendant within one month following a court order finding in the affirmative. Moreover the office is to be inspected and digital evidence to be preserved, technical documentation to be seized or copied and a written expert report to be prepared by the expert setting out the details of the functionality of the Form of Infringement and answering at least the questions laid out in Exhibit C 1 (Expert Questionnaire). The order is requested to be rendered ex parte, in the alternative after hearing defendant within not more than 10 working days.

The applicant submitted an expert opinion by [...] as Exhibit C2 in order to show that infringement of the asserted claims is highly probable.

For further details reference is made to the application and its Exhibits.

REQUESTS OF THE APPLICANT

The applicant requests:

I. The Court orders without prior notice to Defendant:

1. The preservation of evidence relating to Defendant's [...] (together: Form of Infringement) is conducted by
 - a) inspection of Defendant's [...] branch office located at [...];
 - b) seizure and real-time monitoring of a full setup of the Form of Infringement, including in particular [...]; this setup is to be provided by Defendant at its premises referred to under 1. a) within one month following the rendering of this Order;
 - c) preservation of digital evidence in the premises referred to under 1. a), i.e [...];
 - d) seizing or, in the alternative, copying of technical documentation, internal development records and manuals related to the design, configuration and deployment of the Form of Infringement;
 - e) preparing and submitting to the Court a written report (Expert Report) on the results of the measures under 1. a) to d), including a detailed description of the functionality of the Form of Infringement [...]; Applicant is obliged to bear the costs of preparing the Expert Report.

2. The Court appoints

- a) [...] as the Court Expert for carrying out the measures under 1.;
- b) in the alternative to 2. a), [...] as the Court Expert for carrying out the measures under 1.;

c) in the alternative to 2. a) and b), another independent and impartial expert with expertise in [...] as the Court Expert for carrying out the measures under 1.

The Court Expert is allowed to appoint up to two persons to assist him in carrying out the measures under 1. The locally responsible bailiffs at Defendant's premises under 1. a) are appointed as auxiliary persons to support the Court Expert and his assistant(s).

- 3. In addition to the Court Expert and his assistant(s) under 2., the following of Applicant's UPC representatives are permitted to be present during the execution of the measures under 1. a) to d):**

[...].

These UPC representatives are obliged to keep confidential from Applicant and its employees any facts concerning the business operations of Defendant which come to their knowledge during the execution of the entire order.

Representative-bodies, employees or other of Applicant's staff may not be present during the execution of the measures referred to under 1.

4. Defendant is ordered to

a) allow the Court Expert, his assistant(s) and Applicant's UPC representatives listed under 3. to enter Defendant's premises referred to under 1. a);

b) provide within one month following the rendering of this Order, at Defendant's premises referred to under 1. a), a full setup of the Form of Infringement as described under 1. b) and to allow and assist the Court Expert to monitor the real-time operation of the Form of Infringement in this setup, focusing on the functionality laid out in the Expert Questionnaire (Exhibit C 1);

c) provide digital evidence, i.e. [...] related to the Form of Infringement and to disclose any passwords or certificates necessary to monitor the functionality of the Form of Infringement and to access the digital evidence and to [...];

d) hand the Court Expert technical documentation, internal development records and manuals related to the design, configuration and deployment of the Form of Infringement, or in the alternative, to allow the Court Expert to make copies of these documents;

- 5. The Court Expert and his assistant(s) are obliged to maintain confidentiality towards third parties. If the Court Expert uses an external testing laboratory as part of the preparation of the Expert Report, he must take appropriate measures to comply with his confidentiality obligation.**

Defendant is requested to comment on possible interests in confidentiality after the Expert Report has been presented. Applicant's UPC representatives referred to under 3. are given the opportunity to comment on Defendant's statement.

Thereafter, the Court decides whether and to what extent the Expert Report and the preserved evidence should be brought to the attention of Applicant personally and whether the confidentiality obligation for Applicant's UPC representatives referred to under 3. should be lifted.

6. The Expert Report and all other results of the preservation of evidence may only be used in main proceedings against Defendant and affiliated companies.
 7. In the event that the provision of a security for the legal costs and other expenses and compensation for any injury incurred by Defendant which Applicant may be liable to bear is considered necessary by the Court, Applicant is obliged to provide a security of EUR 25,000 or, in the alternative, another amount the Court deems to be appropriate.
 8. This Order shall be served personally to Defendant in its premises referred to under 1. a) by one of Applicant's UPC representatives referred to under 3. together with a copy of this Application including its Exhibits, as well as the notice of interim measures and instructions for access to the procedure (provided by the CMS) promptly at the time of execution of the measures under 1.
 9. Upon request of Defendant, this Order ceases to have effect without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days, whichever is longer, from the date the Expert Report was presented, Applicant does not start proceedings on the merits before the Court.
- II. In the alternative, should the Court deem measures without prior hearing of Defendant inappropriate, Defendant is granted a response period regarding this Application of not more than 10 working days and the measures requested under I. 1. are conducted in expedited proceedings thereafter.

GROUNDS FOR THE ORDER:

1. The order is to be rejected as the applicant failed to set out that there is a sufficient degree of probability that infringement of the asserted claim combination can be found. That such probability can be found, has to be established with a sufficient degree of substantiation. Art. 60 UPCA as well as Art. 7 Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (enforcement directive) are to be understood so as to have as inherent prerequisite that an order to preserve evidence and to inspect premises can only be rendered, if the applicant establishes a certain degree of plausibility of infringement or the threat thereof. In consequence, mere allegations of infringement as such are insufficient (cf. Tilmann, Art. 60 UPCA, para. 17 et seq. arguing with good reasons that omitting the word "sufficient" in Art. 7 of the enforcement directive opposed to Art. 6 is an obvious drafting error). Ordering an inspection based on mere allegations of there being infringement without examining why infringement is probable, were disproportionate and therefore counter to Art. 42 (1) UPCA and recital 3 preamble of the RoP. This means that it is insufficient just to set out why infringement cannot be excluded. Rather, facts have to be submitted which establish a certain probability to be evaluated on the instant facts that infringement can be found (cf. Local Division Paris 14.11.2023 – UPC_CFI_397/2023, GRUR-RS 2023, 40562 paras. 22 et seqq. confirmed in Local Division Paris 1.3.2024 – UPC_CFI_397/2023, GRUR_RS 2024, 7142 para 40). Therefore,

if a certain technical result can be achieved in multiple ways, the applicant will have to submit facts supporting that the technical result is achieved by applying the technical solution as enshrined in the features of the patent claim. At least, the Applicant will have to set out that there are factual circumstances, which point into the direction of the patented solution being implemented. This requires, if multiple ways are equally open to achieve the technical result, that facts are submitted which suggest that the result is being achieved by using the solution as patented and/or elaborating on alternative solutions and explain why it is rather to be excluded that these solutions are being implemented. These standards are of tantamount relevance in cases like the present one, where the application had been lodged before bringing an action on the merits of the case so that the court cannot refer to the main briefs to inform itself upon the arguments exchanged on infringement (cf. R. 192.2 RoP).

2. It was neither necessary to hear the applicant, nor the defendant before issuing the present order, as the order is not to the detriment of the defendant and as claimant presented its case comprehensively without there being a need for further clarification. Still, the arguments submitted do not justify ordering as requested. In addition, the court is not obliged to indicate up-front how it will decide upon an application.
3. The Patent-in-Suit and its asserted claim combination of claims [...] protect a specific system applying a specific method as specified in [...].

Whereas the applicant sets out in a sufficient manner that the Form of Infringement fulfils features [...], considerable doubts remain, if there is a sufficient degree of probability that features [...] are fulfilled. Rather the question is completely open:

a) [...]

If that specific condition is met, appears to be completely open in the present case. Applicant's expert describes under [...] that to confirm the implementation of feature [...] a test has to be performed. In that test [...]. Through that test it could be derived whether or not [...]. The expert report as well as the Application itself however fail to submit facts, which suggest that – amongst all other possible forms of implementation – such a scenario is more likely than not. Whether or not this is the case appears to be completely open. Such probability can also not be derived from the fact that according to the Applicant's allegations [...] as this may as well result from different circumstances. Also the Application itself only alleges it were highly probable that [...] without elaborating further, which factual circumstances lead to that conclusion. The mere fact that [...] alone is insufficient to establish a high probability that [...].

Furthermore, [...].

- b) The same is true for the question, whether or not [...] (feature [...]). Again, the expert report suggests that [...]. The report however again fails to set out, why there is a sufficient degree of probability that this may be the case. Further, the Application remains silent on that point but only sets out that [...] without explaining why there is a sufficient probability for this. From the quote contained in [...], it cannot be derived as likely that [...] as set out in feature [...].
4. Additionally, its appears highly questionable, if the request aiming at the defendant actively participating in the envisaged preservice of evidence by setting up a whole test

environment as described by the applicant's expert at its premises at its costs can be based on Art 60 UPCA, R. 192 RoP. Both provisions point into the direction of the defendant only having to tolerate that inspection is being done without demanding any essential active participation and/or preparation on his part so as to examine whether there is infringement or not, here by setting up a whole test environment including [...]. If such active role – which goes beyond granting access to the premises, switching on electricity, supplying necessary consumables or entering passwords so as to start a machine or process, R. 196.1 (d) RoP – were to be accepted at all, the likelihood of infringement at least had to be even higher.

5. Finally, it is not being explained sufficiently, why it is necessary to inspect the premises of Defendant's [...] Branch office located in [...]. The application does not explain why it is probable that the evidence to be preserved and seized can be found there. [...].
6. Ultimately, as the order seeks to have the setup to be provided by Defendant within one month, there would not have been room for an ex-parte order on the instant facts as Defendant would have been warned anyway, if the order had been allowed.

ORDER:

1. The application to preserve evidence of 19 February 2025 is rejected.
2. The applicant bears the costs of the application.

Issued in Mannheim on 3 March 2025

NAME AND SIGNATURE

Prof. Dr. Peter Tochtermann
Acting as judge-rapporteur

INFORMATION ABOUT APPEAL (Art. 73(2)(a), 60 UPCA, R. 220.1(c), 224.2(b) RoP)

The Applicant may bring an appeal against the present Order within 15 days of service of this Order.