

EIP

UPC grants two orders to seize suspected infringing motorcycle tyres

Pirelli Tyre S.P.A. v Tianjin Kingtyre Group Co., Ltd. and Kingtyre Deutschland GmbH
. (UPC_CFI_650/2024 relating to EP2519412B1)

Pirelli Tyre S.P.A. v Sichuan Yuanxing Rubber Co., Ltd. and China Council for the Promotion of International Trade, Automotive Sub Council (UPC_CFI_649/2024 relating to EP3519207)

Orders of 5 November 2024 (ORD_59764/2024 [1] and ORD_59754/2024 [2])

These Decisions from the Local Division of the Unified Patent Court in Milan relate to EP2519412B1 and EP3519207. The Applicant, Pirelli Tyre S.P.A. (“Pirelli”), requested two separate provisional injunctions to prevent the showcasing and sale of allegedly infringing products at the “International Motorcycle Exhibition” (“EICMA”) between 5 and 10 November 2024: one against Tianjin Kingtyre Group Co., Ltd. and Kingtyre Deutschland GmbH (“Kingtyre”), and one against Sichuan Yuanxing Rubber Co., Ltd. (“Helios”) and China Council for the Promotion of International Trade, Automotive Sub Council (“CCPIT”). Pirelli filed both applications on 31 October 2024, five days ahead of EICMA 2024.

The Court indicated that it was not minded to grant the requests for provisional injunctions on an ex parte basis (ORD_59450/2024 and ORD_59449/2024 of 31 October 2024), and instead offered Pirelli the option of limiting the applications to the seizure of allegedly infringing goods.

Urgency

Pirelli came to suspect potential acts of infringement after Kingtyre and Helios posted advertisement material on their respective websites earlier in October 2024. Pirelli suspected infringement by two of Kingtyre's products: Radial tire high speed K902 and Motorcycle radial tyre-slick racing grade W, both advertised on Kingtyre's website. Pirelli also suspected infringement by two of Helios' products: HA-51R and HA-51F, both advertised on Helios' website.

Both Kingtyre and Helios were assigned a stand at EICMA 2024, held in Milan between 5 and 10 November 2024. Pirelli argued the potential presence of acts of infringement on Italian territory, thereby justifying the hypothesis of a risk of entry or circulation of infringing products under Rule 211.2 RoP within the channels of commerce.

Pirelli claimed that EICMA was the most important trade fair event for the motorbike market worldwide, justifying that the allegedly infringing acts would have significantly affected Pirelli's market share. The Court decided that Pirelli's interest in obtaining the seizure measure appeared to outweigh the potential harm to the defendants, in accordance with Rule 211.3 RoP: Kingtyre and Helios would have still been able to attend EICMA 2024 retaining the ability to promote and sell other products.

Pirelli's application was considered timely, in accordance with Rule 211.4 RoP, and the case was regarded as "extremely urgent". Because of the time-sensitive nature of the case, the Court issued an order ex parte, pursuant to the provisions of Articles 60.5 and 62.5 UPCA as well as Rules 212.1 and 197 RoP.

The two Applications for Provisional Measures were decided by a single judge, in accordance with the provisions of Rule 208(2) RoP.

Validity

Both of Pirelli's patents were presumed to be valid by the Court, on the grounds that:

- EP2519412B1 had been granted not only by the European Patent Office but also in the U.S., China, Japan and Brazil; no objections had been raised and no legal action had been taken to challenge its validity;
- EP3519207 had not been opposed before the European Patent Office and no revocation actions had been brought before National Courts.

Suspected infringement

In both cases, Pirelli submitted an expert report including a comparison table between the patent teachings and photographic reproductions of the allegedly infringing products. Pirelli stated that the aforementioned Kingtyre products likely infringed claims 1 and 3 of

EP2519412B1, while the aforementioned Helios products likely infringed EP3519207.

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Based on the evidence of infringement provided by Pirelli, the Court decided that Pirelli's case did not meet the threshold for an ex parte provisional injunction. However, the Court decided that the case advanced by Pirelli was sufficient to grant seizure of the allegedly infringing products under Art 62(3). The Court noted that seizure of products to prevent their entry into channels of commerce under Art 62(3) requires only suspicion of infringement, a lower threshold than is required for a provisional injunction under Article 62(1). Both decisions also make reference to Article 60 and associated rules (seizure of products as an evidence preservation measure), which only requires presentation of reasonably available evidence to support a claim of infringement.

Decision

In both cases the Court authorised the seizure order to be carried out at EICMA 2024, accordingly requiring the defendants to deliver up to the bailiff the allegedly infringing products and related promotional material, and authorised Pirelli's representatives and technical advisers to attend the seizure and delivery operations. The order would be served at the time of execution.

The time constraints were considered "special circumstances" under Rule 211.5 RoP, so the Court did not make the provisional measures conditional to the provision of a security deposit by Pirelli.

These are the second and third Decisions reached by the Local Division of the Unified Patent Court in Milan on 5 November 2024 (together with *Cardo v ASMAX* ORD_59913/2024 [3]). All three cases involved ex parte Decisions, with each Decision issued by a separate judge following the time sensitivity associated with potential infringements at EICMA 2024.

[1] <https://www.unified-patent-court.org/en/node/1294>

[2] <https://www.unified-patent-court.org/en/node/1293>

[3] <https://www.unified-patent-court.org/en/node/1307>