EIP

UPC Court of Appeal sets out criteria for evidence preservation and inspection orders

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Valinea Energie SASU v Tiru SAS (UPC_COA_002/2025) and Maguin SAS v Tiru SAS (UPC_COA_327/2025)

Court of Appeal Decisions dated 15 July 2025 (PC-CoA-002/2025 and ORD_32908/2025) [1]

These decisions concern appeals against evidence preservation and inspection orders granted by the Paris CD.

Background

Valinea Energie SASU ("Valinea") operates a waste incineration furnace located in Montbéliard, France. Maguin SAS ("Maguin") is the manufacturer of the furnace.

On 17 December 2025, Tiru SA ("Tiru") filed two applications before the Paris LD for preservation of evidence and inspection of premises, one against Valinea and the other against Maguin. The requests were granted ex parte by orders dated 23 Dcember 2024[2]. The measures were carried out simultaneously against the two defendants on 14 January 2025. Subsequently, Tiru brought separate infringement actions against Valinea and Maguin on 18 February 2025.

Valinea and Maguin requested revocation, and in the alternative a review, of the measures ordered pursuant to Rules 197.3 and 197.4 RoP. They asserted in particular: (i)

lack of urgency justifying the measures granted, (ii) absence of any risk of disappearance or destruction of the evidence, and (iii) failure of the claimant to comply with its duty of candour by withholding information likely to influence the granting of these ex parte measures. The Paris LD dismissed the requests for revocation. [3]

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Valinea and Maguin appealed. They requested the Court of Appeal to: (i) overturn the appealed orders; (ii) revoke the preservation and inspection orders; (ii) order the return of all items seized; and (ii) pay them the security deposits and reimburse their costs. They submitted that:

(i) ex parte orders were not justified because there was not sufficient evidence of urgency or risk of destruction of evidence;

(ii) Tiru had failed in its duty of candour; and

(iii) Tiru could have made its applications earlier.

Tiru rejected these arguments.

Decision

The Court rejected the appeals.

~~Measures to preserve evidence and inspect premises~~

The relevant provisions are article 60 UPCA, Rules 192 to 199 RoP and also article 7 of the Enforcement Directive[4] which concerns measures for preserving evidence.

In line with article 60(1) the applicant needs to present " reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed ". Measures may be ordered without the other party being 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 " as provided by article 60(5). The application must set out the reasons for the defendant not being heard and the applicant " is under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant " (Rule 192(3)).

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The Court has a discretion whether to notify the defendant. In exercising that discretion it shall take into account (a) the urgency of the action; (b) whether the reasons for not hearing the defendant appear well-founded (Rules 192.3 and 197); and (c) the probability that evidence may be destroyed or otherwise cease to be available (Rules 194.2 and 197). In applying its discretion the court should apply the principles of the UPCA, RoP and the Enforcement Directive, in particular the principles of proportionality and efficiency.

It is for the Court of Appeal to determine whether the limits of this discretionary power have been exceeded or whether the Court of First Instance, in exercising this discretion, has made an error of law

~~The urgency of the requested (ex parte) measures~~

The Court exercises its discretion by taking into account the urgency of the action (R. 194.2(a) RoP) in order to determine whether, and to what extent, it wishes to hear the defendant (R. 194.1(a) RoP), summon the parties to an oral hearing (R. 194.1(b) RoP), summon the applicant to an oral hearing without the presence of the defendant (R. 194.1(c) RoP), or decide the Application without having heard the defendant (R. 194.1(d) RoP). The Court examines the reasons why the proposed measures are needed to preserve relevant evidence (R. 192.2(c) RoP), as well as the facts and the evidence relied on in support of the Application (R. 192.2(d) RoP)

The necessity of the ordered measures must be assessed in light of the circumstances prevailing at the time the impugned order is issued.

Tiru had submitted a YouTube video that the furnace was to be put into service in first quarter of 2025, which would involve a heat up phase in January 2025. According to the appointed expert the inspection was carried out the day before initial testing of the furnace was due to commence. It was necessary to inspect the interior of the furnace which could only be done when it was cool. Therefore the urgency had been demonstrated re Valinea. It was necessary to carry out the measures simultaneously against both defendants and so there was genuine urgency also to order the measures against Maguin to preserve digital data at its premises.

The two month period between Tiru becoming aware of the YouTube video and filing its requests appeared reasonable.

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The Court of Appeal also contrasted with the assessment of urgency for an application for provisional measures where Rule 211.4 requires the court to ' have regard to any unreasonable delay', there being no similar provision in relation to an application for preservation of evidence.

The discretion had not been exceeded.

~~The risk of destruction or unavailability of evidence~~

The Court stated that the assessment of the risk of the destruction or unavailability of the evidence must be based on the **probability** (R. 194.2(c) RoP) or the demonstrable risk (R. 197.1 RoP) of evidence being destroyed or otherwise ceasing to be available, and not on the **certainty** of its disappearance or unavailability.

Once operated, the furnace could not be inspected unless it was shut down for a period of days. Also, destruction of technical documentation could not be ruled out if the measures were not executed simultaneously. Therefore again the discretion was not exceeded.

~~The applicant's duty of candour when submitting the application~~

The applicant must bring relevant facts to the court's attention.

Unlike for provisional measures, there is no requirement for the Court to be satisfied ' to a sufficient degree of certainty' that the patent is valid. Assessment of validity is solely for the judge ruling on the merits, except where validity can clearly be called into question e.g. because of an opposition or revocation. The Court of Appeal noted that Tiru cannot be faulted for not addressing the validity of its patent in anticipation of a hypothetical future debate on the merits.

Further the prior art patent relied on was cited in the patent in issue and not something to be disclosed under the duty of candour. Other prior art alleged was a former incineration furnace dating from 1987. The mere fact that Tiru was aware of its existence (public accessibility of the furnace was disputed) is not a material fact that needed to be disclosed unless there were specific reasons it was likely to influence an ex parte decision. The Court repeated that assessment of prior art is for the judge dealing with the merits, or to a different extent, for a judge dealing with provisional measures.

Accordingly, the Court of Appeal dismissed the appeals.

[1]https://www.unifiedpatentcourt.org/en/node/136392 and https://www.unifiedpatentcourt.org/en/node/136388

[2]UPC_CFI_814/2024 https://www.unifiedpatentcourt.org/en/node/69104 and

UPC_CFI_813/2024 https://www.unifiedpatentcourt.org/en/node/69098

p5 [3] ORD_13139/2025 https://www.unifiedpatentcourt.org/en/node/78863 and ORD_9276/2025 https://www.unifiedpatentcourt.org/en/node/78874 of 24 March 2025

[4] Directive 2004/48/EC of 29 April 2004. The text of article 7 is similar in scope to Rules 1, 2 and 5 to 9 of RoP.