

EIP

Orders to Preserve Evidence granted by the Unified Patent Court

Oerlikon Textile GMBH & CO KG v Himson Engineering Private Limited, Order of 13 June 2023

Oerlikon Textile GMBH & CO KG v Bhagat Group, Order of 14 June 2023

Just two weeks after the Unified Patent Court opened for litigation cases, the first orders to preserve evidence (similar to the French saisie) were granted, allowing a patentee to seize evidence at a trade fair in Milan.

Oerlikon is the proprietor of EP214848B1 relating to a “False Twist Texturing Machine”. On 12 June 2023, Oerlikon made an urgent application before the local division in Milan for preserving evidence pursuant to Rule 192 of UPC Rules of Procedure against Himson Engineering Private Limited exhibiting at the ITMA International Textile Fair being held in Milan. On 13 June, a further similar application was made against Bhagat Group.

Initially the application was sent to the standing judge, who however ruled that there was time for this to be decided by the presiding judge of the local division in Milan, and so ordered the proceedings to be forwarded there for further decision. [1]

The Milan presiding judge appointed the judge Dr Alima Zana to act as single judge to decide the applications. In two orders in similar terms against each defendant dated 13 and 14 June respectively, the measures requested were granted. [2]

The judge considered the applications under the criteria of *fumus boni iuris* and *periculum in mora*. In the first aspect, it was considered that the UPC and the specified Division were competent to decide the matter as the alleged infringement took place in

Milan within the territory of the Milan Local Division; that the patent was in effect and was not under opposition, neither were any protective letters on file; and that the evidence presented (brochures, presentations, photographs of the machines and expert opinions) was sufficient to demonstrate infringement at least provisionally. In the second aspect, the extreme urgency was justified by the fact that the fair would end on 14 June 2023. This, and the risk that the defendants might conceal evidence, warranted the applications being granted without hearing the defendants.

Accordingly, the judge appointed a named (but anonymised in the public order) expert to proceed with a competent bailiff to acquire copies of all technical, promotional and/or commercial documentation, in any format, relating to the textile machines identified at the fair. The claimant was to be represented by their attorneys and technical adviser, and initially only those people would have access to the information collected.

These orders demonstrate that provisional measures can be effectively obtained rapidly from the UPC, and act as a useful checklist of the factors that must be demonstrated in order to succeed in such an application.

[1] https://www.unified-patent-court.org/sites/default/files/upc_documents/23-06-13-ld-milan-standing-judge-order-r.-9-rop-not-extremely-urgent-498862_2023.pdf

[2] https://www.unified-patent-court.org/sites/default/files/upc_documents/23-06-14-ld-milan-decision-preserving-evidence-500982_2023-upc_cfi_141_2023-anonymized.pdf

and

https://www.unified-patent-court.org/sites/default/files/upc_documents/23-06-13-ld-milan-ord-preserving-evidence-500663_2023-anonymized.pdf