

procedure no. 500663/2023 - CFI no. 127



LOCAL DIVISION OF MILAN

DECISIONE EX ARTT. ARTT. 192 E SS. ROP

adopted by the judge Alima Zana on 13 June 2023 and concerning the euro patent
peo EP2145848B1 in proceeding no. 500663/2023 - CFI no. 127/2023 introduced by

OERLIKON TEXTILE GMBH & CO. KG, with registered office at Leverkuser Strasse no. 65, Remscheid,
Germany, established at X, Germany, represented and defended by Z. W .

- **APPLICANT** -

AGAINST

- **HIMSON ENGINEERING PRIVATE LIMITED**, headquartered in Survey n. 352 Hiratal Colony Ashwan
Ikumar Road, Surat, Gujarat - 395008 – India

- **RESISTANT** -

A. Indication of the complainant party's request.

By deed filed on 12.6.2023 **OERLIKON TEXTILE GMBH & CO. KG** (hereinafter

"OERLIKON") stated that he was the owner of the European patent n. EP214848B1 (hereinafter EP848)

entitled *"John"* concerning a textile machine, issued on 23.9.2011, following a

application of 23.1.2009, claiming German national priority of 19.7.2008, validated in Italy

with deposit of the translation at the Uibm (see doc. 7 and 9).

He pointed out that during the ITMA international textile sector fair being held

ment in Rho (MI) from 8.6 to 14.6.2023 had discovered that the competitor **HIMSON ENGINEERING**

PRIVATE LIMITED (hereinafter **"HIMSON"**) was exhibiting at the exhibition booth at the same

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assigned two machines, bearing the commercial names MACHINERY 2 and MACHINERY 2-TS, apparently interfering with the patent owned by him, also by virtue of a technical examination performed by a trusted patent attorney (see doc. 6.1 and 6.2).

He concluded by requesting the issuance of an order for the protection of evidence pursuant to articles 192 and ss. RoP, with the acquisition of a copy of all the technical and commercial documentation, in any format, available at the defendant's exhibition stand, with the appointment of a court expert in aid to the bailiff for the execution of the measure.

B. Main stages of the proceeding.

Given the extreme urgency of the procedure, the appeal was initially assigned to the standing judge appointed for the date of filing of the appeal.

The standing judge with provision of 13.6.2023 has referred the file to this Division Local for the further course of the proceedings.

The presiding judge of the Local Division of Milan, having regard to art. 194, paragraph 3, RoP, has designated this judge for further discussion and settlement of the proceeding as a single judge, held account of the extreme urgency and the consequent impossibility of a timely settlement e panel deliberation.

C. Reasons for the decision.

Having regard to the application filed by the appellant, the points of the decision are as follows:

1. *smoke of boni iuris*

1.1. jurisdiction

1.2. competence

1.3. identification of the future merit action based on art. 192, paragraph 2, RoP;

1.4. examination of the evidence provided by the appellant:

a) of ownership of his right

b) the violation of your right pursuant to art. 60, paragraph, UPCA

1.5. compliance with the conditions set out in article 192, paragraph 2, RoP

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2. risk in delay

2.1. The extreme urgency according to article 194, paragraph 4, RoP

2.2. The reasons for the failure to summon the respondent in advance in accordance with art. 192, comma 3, RoP

3. The payment of taxes according to art. 192, paragraph 5, RoP

4. Conclusion and methods of execution of the measure

1. The right smoke

1.1. Jurisdiction

The jurisdiction of the UPC exists as the appellant has carried out a request included between those falling within the jurisdiction of the UPC, *pursuant to* art. 32 paragraph 1 letter c), UPCA.

The patent title is a European patent and the proprietor has not exercised the right to *opt out* pursuant to of the art. 83, paragraph 3, UPCA and 5, RoP.

1.2. Competence

In the internal department of competence between the Central Division and the Local Divisions, the latter are competent in general for precautionary actions, based on the combined provisions of articles 32, paragraph 1 letter c) and 33 UPCA.

This Local Division is then territorially competent on the basis of art. 33, paragraph 1 letter a), UPCA, since in the Italian territory - in particular in the municipality of Rho (MI) - it is identified the forum *commissi delicti* or the place where it is being carried out or in any case patent infringement threatened.

Furthermore, the application for preservation of evidence appears to have been filed before the same Division with which the appellant intends to bring proceedings on the merits, in accordance with a the provisions of art. 192, paragraph 1, RoP.

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1.3. Identification of the future merit action based on art. 192, paragraph 2, RoP. Oerlikon

has declared that it intends to bring an action on the merits to ascertain the counterfeiting committed by the defendant, with the adoption of the consequent inhibitory measures, fixation of penalty, seizure, compensation for damages and publication of the decision.

The condition typified by art. 192, paragraph 2, RoP.

1.4. Examination of the evidence provided by the appellant

to. the enforced right.

The appellant party has documented that he is the exclusive owner of the activated patent (see doc.7), supported by a presumption of validity.

The appellant party has acknowledged that no opposition has been proposed to date to the European Patent Office (see page 4 of the appeal).

Following a specific search carried out on the CMS database, it does not appear to have been filed by the defendant no letter of protection.

b. the violation of his right pursuant to art. 60, paragraph 1, UPCA

Oerlikon has attached copies of two brochures prepared by the respondent for presentation technical and commercial aspects of the machines deemed to be counterfeit MACHINERY 2 e MACHINERY 2-TS as well as a technical opinion drawn up by a party technical consultant (see doc. 5.1, 5.2, 6.1 and 6.2). Currently, these documents seem to offer positive elements confirmation, at least circumstantially, of the undue reproduction by the respondent of the characteristics claimed in patent EP 848, justifying the request for the measure invoked here.

1.5. compliance with the conditions prescribed by art. 192, paragraph no. 2, of the Rules.

The appellant party has fulfilled the burden of attaching and proving:

the clear indication of the measures required, including the exact location of the evidence from preserve (i.e. at the stand of the ITMA fair, currently taking place in Rho);

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the reasons why the indicated measures are necessary to preserve the evidence deemed unlawful boasts (since the evidence is necessary to establish the counterfeiting phenomenon and its extension);

the facts and evidence placed at the basis of the request) as already examined in the previous point 1.4).

2. danger in delay

2.1. extreme urgency

The requirement of extreme urgency exists, considering that the international trade fair where the counterfeiting conduct is in progress, it began on 8.6.2023 and ends tomorrow, on June 14, 2023.

2.2. The reasons for the failure to summon the respondent in advance in accordance with art.

192, comma 3, RoP

The conditions referred to in Articles are met. 197, paragraph 1, RoP and 60, paragraph 5, UPCA, for the granting of the measure without the prior hearing of the defendant, since:

- a) the time constraints do not allow the convening of the parties before the end, on the date of tomorrow, of the trade fair event;
- b) there is a risk that the evidence will no longer be accessible to the appellant once after this trade fair event, since the respondent party is based abroad and the documentation shown is easy to conceal and/or destroy.

3. payment of taxes according to article 192, paragraph 5. Rules

The Court acknowledges that pursuant to art. 371, paragraph 3, RoP, in case of urgency, when the advance payment is not possible, the defendant of the plaintiff will have to pay the fixed fee within the time limit set by the Court: in the light of this requirement, the appellant must be ordered to pay this contribution by 15 June 2023.

4. Conclusion and methods of execution of the measure

4.1. Balancing conflicting interests suggests conceding the measure, holding in consideration the potential risk of harm to each of the parties in the case of con assignment - for the respondent - or refusal of the measure - supported by the appellant.

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In fact, the criterion of proportionality between the opposing needs is respected, being prevalent, between the risk of irreparably losing the appellant's right to proof and that of the defendant to undergo the description.

In the light of the above considerations, the request for description must therefore be accepted and granted *inaudita altera parte*, in the manner indicated below.

4.2. Pursuant to art. 196, paragraph 4, RoP, the authorized measure will be carried out - according to the discipline internal national territory in whose territory the remedy is to be implemented - by an expert, appointed by this Court and indicated in the device, chosen from the list of expert technical consultants on the matter patent that usually collaborate with the Court of Milan, the choice guarantees the occurrence of the requirements of independence, autonomy and professionalism, required by art. 196, paragraph 5, of the RoPs.

The appointed professional will proceed with the support of the competent bailiff.

The appellant will be able to assist in the description operations by means of his trusted lawyers and a his trusted technical consultant, with express prohibition for other representatives, employees or employees of the appellant to be present at the execution of the measure.

The designated expert must file a written report of the activities carried out, together with copy of the documentation acquired as a result of the execution of the provision, at the Chancery of the Milan Local Division of the Unified Patent Court on the following day subsequent to the completion of the description operations.

4.3. Pursuant to articles 58 UPCA and 196, paragraph 1, RoP, it is established that the acquired documentation is accessible, until further order by the Court, only to the appellant's two lawyers and an expert trusted technician.

4.4. The evidence acquired can only be used in the future judgment of the merits as best indicated in the device pursuant to art. 196, paragraph 2, of the RoP.

4.5. The Court provides that the execution of the notification of the appeal together with this prov view is implemented with an alternative method, based on the combined provisions of articles 275, paragraph 1 and 276, paragraph 1, RoP.

In fact, there are valid reasons ("good reason") for derogating from the ordinary methods of notification of measures, according to the methods indicated in the device taking into account (i) the extreme urgency,

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(ii) the need not to frustrate the surprise effect and (iii) to comply with the rule established by art. 197, paragraph 2, RoP, which provides for notification of the provision immediately upon of the execution of the measure.

4.6. Pursuant to art. 196, paragraph 6, RoP, the Court also believes that the circumstances exist details so as not to condition the immediate effectiveness of the measure on the prior filing of one bail from the appellant. In fact, the measure is aimed at acquiring proof of the considered counterfeit and therefore does not, in itself, have an afflictive or restrictive content for the activities of the resistant. Moreover, the applicant accomplished it in a very short space of time - in just five days - all the checks necessary for the purpose of submitting this request and the deadline of the fair is expected within a single day of the adoption of this provision, with objective compromising the possibility of its execution, where subject to the payment of one deposit or the issue of another equivalent guarantee. Finally, the appellant introduces himself as belonging to a large industrial group, therefore able to repair any damages caused to the respondent in the execution of this measure.

The provision is therefore immediately enforceable pursuant to art. 196, paragraph 3, RoP.

4.7. In application of the general principle of proportionality established by articles 41 and 42, UPCA, and the comparison of conflicting interests also in the choice of implementing measures, held account that the measure will have to be carried out in the context of a trade fair event open to participation of the public, it is specified that the bailiff and the expert must preferably proceed, where possible, with the execution at times other than those intended for opening to the public or in any case with a lower flow at the respondent's stand.

For all the above reasons

THE UNIFIED PATENT COURT - LOCAL DIVISION OF MILAN in
acceptance of the application

1. orders the retention of evidence as requested by the appellant and, to effect, authorizes

OERLIKON to proceed through the territorially competent bailiff e
the expert appointed below to acquire a copy of all the technical documentation,
promotional and/or commercial, in any format, relating to textile machinery
identified with the names MACHINERY 2 and MACHINERY 2-TS, produced and/or

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- marketed and advertised by **HIMSON**, which can be found at the respondent's stand at ITMA 2023 exhibition - Rho Fiera exhibition center;
2. appoints Eng. Z with studio in Milan - via,
tel.cell.....which, in coordination with the appellant, will make use of
of the territorially competent bailiff;
 3. authorizes the appellant to assist in the description operations by means of his lawyers
trust and one of its trusted technical consultants, with express prohibition for other representatives,
employees or employees of the appellant to be present at the execution of the measure;
 4. orders that the expert file a written report of the operations carried out, jointly
to the collected documentation, immediately after their completion and co
in any case by 15.6.2023 at the Registry of the Milan Local Division of the Court
Unified Patents;
 5. provides that the information collected by the expert is accessible, until further notice by
judge, only to the two defense attorneys of the appellant and one of his technical experts, names indicated
natively in the report referred to in the previous point, with the prohibition to disclose to third parties the
information acquired;
 6. the order must be executed in accordance with the execution procedures and conditions
established by the law of the Italian State, where the measure is implemented;
 7. declares this order immediately enforceable, without further conditions;
 8. orders that, in accordance with art. 196, paragraph 2, RoP, in the absence of a new order from the Tri
bunal, the result of measures to preserve evidence can only be used in the
proceeding on the merits relating to this same case;
 9. orders the appellant to notify the request for granting the measure, together with a copy
of this order, immediately upon execution of the measure with
compliance with the regulations in force in Italy regarding the notification of judicial documents;
 10. orders the appellant to deposit the fixed contribution by 15 June 2023, pursuant to art. 371,
paragraph 3, of the Rop;
 11. orders the Chancellery to notify the appointed expert by telephone Eng. Z.;

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12. expressly warns the respondent that he may submit a request for revision of this order for conservation of the evidence within the term of thirty days from the execution of the measure, pursuant to art. 197, paragraph 3, RoP. Decided in Milan on June 13, 2023.

The single judge appointed by the presiding judge *dott.ssa*
Alima Zana

Alima 
Firmatodigitalmente da Alima ZANA

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