



## LOCAL DIVISION OF MILAN

### DECISIONE EX ARTT. ARTT. 192 E SS. ROP

adopted by the judge Dr. Alima Zana on 14 June 2023 and concerning the patent European Parliament EP2145848B1 in proceeding no. 500982/2023 introduced by

**OERLIKON TEXTILE GMBH & CO. KG**, con sede in Leverkusener Strasse n. 65, Remscheid, Germany, represented and defended by lawyers X and Y

- **APPLICANT** -

#### AGAINST

**BHAGAT GROUP**, con sede in NH6, Hoziwala Industrial Estate, Sachin Apparel Park SEZ, Sachin, Surat, Gujarat, 394235 - India

- **RESISTANT** -

#### A. Indication of the complainant party's request.

By deed filed on 13.6.2023 Oerlikon Textile GmbH & Co. KG (hereinafter Oerlikon) stated that he was the owner of European patent no. EP214848B1 (hereinafter EP848), titled "*false twist texturing machine*" concerning a textile machine, released on 23.9.2011, following a request 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). It highlighted that during the ITMA international textile trade fair in progress held in Rho (MI) from 8.6 to 14.6.2023 had discovered that the competitor BHAGAT GROUP was presenting at the exhibition stand assigned to him a machine, bearing the name commercial- Bhagat Textile Engineers apparently interfering with his patent

ownership, also by virtue of a technical examination carried out 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 et seq. 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 judicial officer for the execution of the measure.

### **B. Main stages of the procedure.**

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.

With a ruling dated today, the standing judge has returned the file to the present one Local Division 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, taking into account the extreme urgency and the consequent impossibility of a timely composition and deliberation of the panel.

### **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 substantive action based on the art. 192, paragraph 2, RoP;

1.4. examination of the evidence provided by the appellant:

a) of the 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

#### 2. *risk in delay*

2.1. Extreme urgency according to Article 194, paragraph 4, RoP

2.2. The reasons for the failure to convene the respondent 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 because the appellant has made 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 owner has not exercised the right to *opt out* pursuant to art. 83, paragraph 3, UPCA and 5, RoP.

### **1.2. Competence**

In the internal division 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 the 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 Italian territory - in particular in the municipality of Rho (MI) - it comes identified the forum *commissi delicti* or the place where it is taking place or in any case threatened the infringement of the patent.

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

### **1.3. Identification of future substantive action based on art. 192, paragraph 2, RoP.**

Oerlikon has declared that it intends to bring an action on the merits for the assessment of the counterfeiting committed by the defendant, with the adoption of the consequent provisions of

injunction, setting of penalty, seizure, compensation for damages and publication of the decision.

The condition typified by the art. is therefore respected. 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.

In particular, it is a machine for structuring/texturizing - false twisting - multiple rows melting processes, through texturing, heating, cooling and sti process, at the end of which the thread is wound onto a spool.

The patent title is divided into one independent claim and nine dependent claims.

In particular, the independent claim claims the fact that "*the first power supply and the second power supply are designed respectively as a winding power supply and, that the third feeder is designed as a clamping feeder*".

In this way, some disadvantages of the known technique (which used only wings) were overcome clamping or just winding food mentors, ensuring through the invention here operated: i. that the threads were structured and treated with high quality; II. that the treatment of thread took place as "uninterrupted" as possible.

The appellant acknowledged that no opposition has been lodged before 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*

attached:

· copy of four photographic reproductions that reproduce the defendant's car found to be counterfeiting performed at Bhagat Group's booth at the fair international RHO in progress (see docs. 5.1, 5.2, 5.3, 5.4 of part appellant);

- a copy of a billboard at the same stand (see Doc. 5.5. of the appellant):
- a technical opinion drawn up by a party technical consultant (see doc. 6.1 and 6.2). - a video of the Bhagat machine to which the QR code printed on the business card refers found at the Bhagat stand (see Doc. 5.6. of the appellant).

These documents, at present, seem to offer elements of positive feedback, at least in the near future circumstantial evidence of the defendant's undue reproduction of the claimed characteristics in the EP '848 patent, justifying the request for the measure invoked here.

Furthermore, it should not be forgotten that the requested measure constitutes a tool to protect on the road the -procedural- right to the trial is immediate and only indirectly the underlying patent right.

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

The appellant 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. in the stand of the ITMA fair, currently taking place in Rho);
- the reasons why the indicated measures are necessary to preserve the retained evidence relevant (since these are necessary findings to confirm the counterfeiting phenomenon and the its extension);
- the facts and evidence placed at the basis of the request as already examined in the previous point 1.4).

## **2. risk in delay**

### **2.1. extreme urgency**

The requirement of extreme urgency exists, considering that the international trade fair where the counterfeiting conduct is taking place began on 8.6.2023 and ends today on June 14, 2023.

### **2.2. The reasons for the failure to previously summon the defendant 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 the measure without prior hearing of the defendant, since:

- a) the limited time does not allow the parties to convene 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 16 June 2023.

### **4. Conclusion and methods of execution of the measure**

4.1. Balancing conflicting interests suggests conceding the measure, holding in consideration of the potential risk of harm to each party in the event of concession - for the respondent - or denial of the measure - supported by the appellant.

And in fact the criterion of proportionality between the opposing needs was respected, being prevailing, between the risk of irreparably losing the right to proof by the appellant and that of the respondent to undergo the description.

In light of the above considerations, the request for description must therefore be accepted and granted unheard of other party, according to the methods indicated below.

4. 2. Pursuant to art. 196, paragraph 4, RoP, the authorized measure will be carried out - according to internal national regulation in whose territory the remedy must be implemented - by an expert, appointed by this Court and indicated in the device, chosen from the list of technical consultants patent experts who usually collaborate with the Court of Milan, chosen guarantees the fulfillment of the requisites of independence, autonomy and professionalism, requested by art. 196, paragraph 5, of the RoP.

The appointed professional will proceed with the support of the competent bailiff. The 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 day following the completion of the description operations.

**4.3.** Pursuant to articles 58 UPCA and 196, paragraph 1, RoP, it is established that the documentation acquired is accessible, until further order of the Court, only to the two lawyers of the appellant and a trusted technical expert.

**4.4.** The evidence acquired can only be used in the future judgment of the merits as better 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 the this provision and a hard copy of the attached documents is implemented with alternative method, based on the combined provisions of articles 275, paragraph 1 and 276, comma 1, RoP.

Indeed, there are valid reasons ("good reason") for derogating from the ordinary notification procedures of the measures, according to the methods indicated in the device taking into account (i) the extreme urgency, (ii) the need not to frustrate the surprise effect and (iii) to respect the rule established by Article 197, paragraph 2, RoP, which provides for notification of the measure immediately upon execution of the measurement.

**4.6.** Pursuant to art. 196, paragraph 6, RoP, the Court also believes that they exist particular circumstances in order not to affect the immediate effectiveness of the measure al prior deposit of a deposit by the appellant. In fact, the measure is aimed at acquiring proof of the withheld counterfeiting and therefore does not have to per se, afflictive or restrictive content for the defendant's activities. Furthermore, the appellant completed all the checks in a very short period of time - in just five days necessary for the purposes of submitting this request and the deadline of the fair is expected within a single day of the adoption of this measure, objectively compromising the possibility of its execution, where subject to payment of a deposit or the release of another equivalent guarantee. Lastly, the appellant does

presents itself as belonging to a large, capable industrial group  
therefore to repair any damage caused to the defendant in the execution of the  
present 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 e  
42, UPCA, and the comparison of conflicting interests also in the choices of  
implementation measures, taking into account that the provision must be carried out in context  
of a trade fair event open to public participation, it is specified that the official  
judicial and the expert should preferably proceed, where possible, to the  
execution at times other than those intended for opening to the public or in any case of  
lower flow at the respondent's stand.

For all the above reasons

#### **THE UNIFIED PATENT COURT - LOCAL DIVISION OF MILAN**

in acceptance of the request

1. orders the retention of evidence as requested by the appellant and, to effect,  
authorizes Oerlikon Textile GmbH & Co. KG to proceed through the officer  
territorially competent judicial body and the expert appointed below for the acquisition  
copy of all technical, promotional and/or commercial documentation, in any  
format, relating to the textile machine identified with the name Bhagat Textile  
Engineers produced and/or marketed and advertised by Bhagat Group available in  
defendant's stand at the ITMA 2023 exhibition - Rho Fiera exhibition center;
2. appoints Engineer as expert for the purpose of execution. Z with study  
in.....tel.....which -coordinating with the appellant- will make use of the officer  
territorially competent judiciary;
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 others  
representatives, employees or employees of the appellant to be present at the execution of the  
measure;
4. provides that the expert deposits a written report of the operations carried out together  
to the collected documentation, immediately after their completion e



in any case by 15.6.2023 at the registry office of the Milan Local Division of the Unified Patent Court;

5. provides that the information collected by the expert is accessible, until further notice of the judge, only to the appellant's two defenders and one of his technical experts, indicated by name in the report referred to in the previous point, with the prohibition to disclose a 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 of the Court, the result of measures to preserve evidence can only be used in substantive proceedings relating to this same case;
9. orders the appellant to notify the request for granting the measure, together with copy of this order and copy of paper documents, immediately upon execution of the measure with the observance of the regulations in force in Italy on the subject of notifications 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 engineer by telephone. Z;
12. expressly warns the defendant that he can submit a request for revision of the this order for conservation of evidence within the term of thirty days from the execution of the measure, pursuant to art. 197, paragraph 3, RoP.

Thus decided in Milan on 14 June 2023.

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