



Düsseldorf - Local Chamber

File number: UPC_CFI_177/2023
Application number: 525740/2023
Type of request: Request for interim measures

Order of the Court of First Instance of the Unified Patent Court Local Chamber Düsseldorf issued on June 22, 2023

Date of receipt of application: June 22, 2023

APPLICANT:

myStromer AG, Freiburgstrasse 798, 3173 Oberwangen b Bern, Switzerland,

represented by: Lawyer ..., Law firm Hoyng, ROKH, Monegier, Steinstraße 20,
40212 Düsseldorf,

RESPONDENT:

Revolt Zycling AG, Allmendstraße 15, 8320 Fehralt Dorf, Switzerland,

represented by: Patent Attorney ..., Law firm Tarvenkorn, Wickord & Partners,
Bernhard-Ernst-Str. 12, 48155 Muenster,

DEPOSIT PATENT:

EUROPEAN PATENT NO. EP 2 546 134 B1

Arbitration Body/Chamber:

Arbitration body of the Düsseldorf Local Chamber

PARTICIPATING JUDGES:

This order was issued by Presiding Judge Thomas, Presiding Judge Klepsch as a legally qualified judge, and Legally qualified judge Kupecz.

BRIEF SUMMARY OF THE FACTS:

The applicant is jointly with the Fairy Bike Manufacturing Co. Ltd. (hereinafter: Fairy

Bike) co-owner of the European patent EP 2 546 134 B1 (hereinafter: patent in suit). The patent is currently in force in Germany, Switzerland, Italy, Lichtenstein and the Netherlands. It was filed on October 11, 2011, claiming priority from a Taiwanese patent application dated July 11, 2011 in the English language of the case. The notice of the granting of the injunction patent was published on March 25, 2015. No objection was lodged against the granting of the injunction patent. Furthermore, no national nullity proceedings were initiated after the objection period had expired.

The patent in suit protects a "combined structure of bicycle frame and motor hub" which, according to patent claim 1 of the patent in suit, is characterized by the following features:

1.1 Bicycle frame and motor hub combination structure, comprising:

1.2 containing a bicycle frame (1).

1.2.a a first fork (11) and a second fork (12), which are arranged opposite one another,

1.2.b wherein the first fork (11) is provided with a through hole (110),

1.2.c while the second fork (12) has a recess with an internally threaded hole (121) which axially corresponds to the through hole, and

1.2.d the first fork (11) on its inside, adjacent to the through hole (110), is provided with a positioning groove (111);

1.3 a motor hub (2) provided with a sleeve (21) at its center,

1.3.a which, with respect to a positioning end, has an end which is such that the positioning end (211) can be engaged with the positioning groove (111) of the first fork and can be stopped against it; and

1.4 an elongated shaft (3) which has a front end (31) and a rear end (32),

1.4.a wherein the rear end is externally threaded;

1.4.b the elongated shaft (3) can pass through the through hole (110) of the first fork and the sleeve (21) of the motor hub (2),

1.4.c and wherein the external thread of the rear end (32) is correspondingly engaged in and secured to the internal thread hole (121) of the second fork.

With her application for an injunction, the applicant is targeting speed pedelecs of the "...” series (hereinafter: the attacked embodiment), the delivery of which the respondent initially announced on its website for April 2023. However, the extradition was delayed, although according to the information provided by the applicant, no extradition has taken place so far. However, since June 21, 2023, the attacked embodiment can be found on the

can be test driven at the “Eurobike 2023” trade fair in Frankfurt am Main. In addition, an order form is available on the respondent's website in both German and English, through which the challenged embodiment can be ordered from the specialist retailers listed on this website.

The challenged embodiment was inspected on June 19, 2023 at the applicant's request at the respondent's Swiss headquarters. The results of this inspection have not yet been released in terms of content.

In a letter dated June 22, 2023, the applicant unsuccessfully warned the respondent.

REQUESTS OF THE PARTIES:

The applicant requests

A. to decide by way of interim measure as follows:

- I The respondent will be fined up to €250,000.00 by the German enforcement court for each case of infringement if they avoid a fine to be determined by the court for each case of infringement and in Germany if they avoid a fine of up to €250,000.00 - alternatively, detention - or detention for up to six months , in the case of repeated infringement up to a total of two years, whereby the administrative detention is to be carried out on the chairman of the respondent, prohibited during the term of the patent in suit combination structures of bicycle frame and motor hub according to the claims of the patent in suit (in particular claim 1) in the signatory member states of the EPG , insofar as the patent in question is in force in these, to offer, put on the market or use or import for the stated purposes or possess.

- II. In particular, the Respondent is prohibited from offering, placing on the market or using or importing or owning a combination structure made up of a bicycle frame and motor hub in Germany, the Netherlands, France and/ or Italy, with the combination structure comprising: a bicycle frame including a first fork and a second fork arranged opposite each other, wherein the first fork is provided with a through hole, while the second fork has a recess with an internally threaded hole axially corresponding to the through hole, and the first fork at its inner side adjacent to the through hole is provided with a positioning groove; a motor hub provided at its center with a sleeve having, with respect to a positioning end, an end such that the positioning end is engageable and abutable with the positioning groove of the first fork; and an elongate shaft having a front end and a rear end, the rear end being externally threaded; the elongate shaft can pass through the through hole of the first fork and the socket of the motor hub therethrough, and the male thread of the rear end is correspondingly engaged and fixed to the female thread hole of the second fork.

III. The respondent is ordered to pay an amount i.e., subject to the final decision on the burden of costs. hv €16,000.00 to be paid as a preliminary decision on the legal costs.

IV. The respondent is ordered to hand over the products listed under I. and II in its direct or indirect possession at the Eurobike trade fair to a bailiff to be appointed by the applicant at its own expense in order to ensure their further marketing and circulation on the distribution channels during the EuroBike.

With regard to the wording of the auxiliary requests, reference is made to the application.

The respondent requests in her protective letter,

"If the presumed first applicant (hereinafter: "applicant #1") and/or the presumed second applicant (hereinafter: "applicant #2") should apply for provisional measures eg for the issuance of an interim injunction due to the facts reproduced below , with the literal or analogous

content,

to order the defendant to cease and desist from any such action, subject to the imposition of an administrative fine or, failing that, imprisonment,

1. To manufacture, offer for sale, place on the market, or use during trade, or either import or possess for such purposes, e-bikes with a specified bicycle frame and motor hub structure,

and/or

2. E-bikes according to the illustration below

[...]

to manufacture, offer for sale, advertise and/or place on the market in any or multiple countries in which the patent has been validated, to import, export and/or possess for the aforementioned purposes.

dismiss the request for provisional measures including an interim injunction;

in the alternative:

a) not to decide on the request for an interim injunction without prior oral proceedings (rule 212 RoP);

(b) to make the order or execution of an interim injunction conditional on the provision of adequate security by the applicant (rule 211(5) RoP)

c) to make the execution of an interim injunction conditional on the applicant serving a certified copy of the application for the injunction with the interim injunction;

FACTUAL AND LEGAL DISPUTES

The respondent filed a protective brief with the Unified Patent Court on June 19, 2023. She refers to it as exhaustion. In addition, it denies an infringement of the patent in use by the contested embodiment. In particular, its second fork does not have an indentation with an internally threaded hole corresponding axially to the through hole.

GROUNDS OF ARRANGEMENT

The admissible application for interim measures is justified in the tenored scope.

I

The respondent has not significantly denied the fact that the challenged embodiment directly and literally infringes the injunction patent, either out of court or in its protective document. In particular, it does not take away from the scope of protection of the patent at issue that the internal thread in the challenged embodiment is not located directly in the hole of the second fork, but in a sensor attached to it, based on the functional description of the challenged embodiment in the patent application. The patent in use does not rule out such a multi-part design of the second fork.

II.

With regard to the rights of the applicant from the patent in use, no exhaustion has occurred either, Art. 29 UPCA. As the Swiss Federal Supreme Court correctly stated in its ruling of June 8, 2023 (Annex ASt 1b, p. 12, item 11), the Respondent is not entitled, even taking into account the license agreement submitted (Annex ASt 3), from the Fairy Bike to manufacture or sell a combination structure falling within the scope of protection of the injunction patent.

III.

The matter is also urgent due to the ongoing leading European trade fair "Euro Bike 2023" (R. 209.2 lit. b) VerFO). It is neither stated nor apparent that the applicant was aware of the detailed technical design of the contested embodiment before inspecting the contested embodiment on June 19, 2023 and thus immediately before the start of the aforementioned trade fair.

IV

Based on this, the court, exercising its discretion (R. 209.2 VerFO), considers the issuance of an interim injunction to be appropriate and justified, as can be seen from the operative part (Art. 62 para. 1, 25 UPCA).

The seizure order is based on R. 211.1 (b) VerFO.

In addition, the applicant can request a provisional reimbursement of costs from the respondent, R. 211.1 (c) VerFO. Since the applicant did not explain in more detail the amount she estimated at EUR 16,000, the court only granted her a provisional reimbursement of costs with regard to the legally applicable court costs.

V

The legal validity of the patent in use is secured to the extent required for the issuance of a preliminary injunction. The reference to the granting of the patent in suit was already published in 2015 without any objection being filed against the patent in suit

or a national action for annulment has been brought. The Respondent was also unable to present any relevant prior art either before the court or in its protective brief.

VI.

The court issued the interim measures without first hearing the respondent. The applicant has made it credible that a delay would cause irreparable damage (R. 212.1 VerfO). The "Eurobike 2023" is an important leading trade fair that is of considerable relevance for the entire industry. It enables the Respondent to get in touch with potential buyers and thus build up their own market presence. It is obvious that exhibiting the contested embodiment at this trade fair can lead to a loss of sales or market share for the applicant that can hardly be reversed. The products of both parties are substitutable, direct competing products.

ARRANGEMENT:

I The Respondent is instructed to refrain from combining structures
bicycle frame and motor hub,

to offer, place on the market or use in Germany, the Netherlands, France and/or Italy
or to import or possess it for the purposes mentioned,

where the combination structure includes:

a bicycle frame including a first fork and a second fork arranged opposite each other, wherein the first fork is provided with a through hole, while the second fork has a recess with an internally threaded hole axially corresponding to the through hole, and the first fork at its inner side adjacent to the through hole is provided with a positioning groove; a motor hub provided at its center with a sleeve having, with respect to a positioning end, an end such that the positioning end is engageable and abutable with the positioning groove of the first fork; and an elongate shaft having a front end and a rear end, the rear end being externally threaded; the elongate shaft can pass through the through hole of the first fork and the socket of the motor hub therethrough, and the male thread of the rear end is correspondingly engaged and fixed to the female thread hole of the second fork.

II. The respondent is ordered to pay an amount of EUR 11,000 as a provisional reimbursement of costs until the decision on the legal costs is made, subject to the final decision on the burden of costs.

III. The respondent is ordered to transfer the products specified in point I. in their direct or indirect possession at the "Eurobike 2023" trade fair to a person to be named by the applicant

bailiffs at their own expense in order to prevent their further marketing and circulation on the distribution channels during the "Eurobike 2023" trade fair.

IV. In the event of an infringement of the order under I., the respondent is obliged to pay the court a fine of up to EUR 250,000 for each case of infringement.

V. Furthermore, the application for interim measures is rejected.

VI. This order is provisionally enforceable.

The applicant is ordered to provide security in the form of a deposit or a bank guarantee in the amount of EUR 500,000 in favor of the applicant within a period of 10 days from the delivery of this order. If the applicant does not comply with this request within the specified period, the enforceability ceases until the security has been fully provided.

NOTICE ABOUT DELIVERY:

This order should be served personally at the "Eurobike 2023" trade fair in Frankfurt am Main by the applicant's authorized representatives together with a copy of the application for the issuance of this order, including the evidence and other documents on which the order is based (R . 212.2, 276.1 VerfO).

NOTICE OF RIGHT TO REVIEW

The respondent can request a review of the present order within 30 days of the implementation of the measure (Art. 62(5), 60 (6) UPCA, R. 212.3, 197.3 Constitutional Code).

INFORMATION ABOUT THE APPOINTMENT

The respondent can appeal against this order within 15 days of its delivery (Art. 73 (2) (a), 62 UPCA, R. 220.1 (c), 224.2 (b) Constitutional Code).

NOTICE THAT THE MAIN PROCEEDINGS MUST BE INITIATED WITHIN A PERIOD OF TIME

If the main proceedings are not instituted within a period not exceeding 31 calendar days or 20 working days, whichever is longer, from the time of service on the respondent, the court may, at the request of the respondent, order the present order to be set aside or otherwise expires (Art. 62 (5), 60 (8)

EPGÜ, R. 213.1 VerfO).

Issued in Düsseldorf on June 22, 2023

NAMES AND SIGNATURES

Presiding Judge Thomas

Presiding judge Klepsch

Legally qualified Judge Kupecz

