



UPC_CFI_419/2023
Decision on the merits
of the Court of First Instance of the Unified Patent Jurisdiction, handed
down on 26/07/2024

APPLICANT

1) **CANÈ S.p.A.**
Via Cuornè 42/A
10098 - Rivoli (TO) - IT

Represented by
Konstantin Schallmoser

DEFENDER

1) **FRANCE DÉVELOPPEMENT ÉLECTRONIQUE**
46 RUE DU ZORNHOFF
67700 - MONSWILLER - EN

Represented by
Grégoire Desrousseaux

PATENT IN SUIT

<i>Patent number</i>	<i>Owner</i>
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EP3181168	CANÈ S.p.A.
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JUDGE WHO STATUTES: Single judge **Carine Gillet**

LANGUAGE OF PROCEDURE: French

DECISION ON THE MERITS

On 14 November 2023, CANE S.p.A, a company incorporated under Italian law, brought an action before the Paris Local Division of the Unified Patent Court against France Développement Electronique, a French company, for infringement of patent EP3181168, of which it is the owner.

On 26 February 2024, France Développement Electronique filed a statement of defence in which the defendant contests neither the materiality of the infringement nor the validity of the patent.

A pre-trial meeting was held by videoconference on 19 March 2024, in the presence of the parties' representatives and the Registrar, at the end of which the parties mentioned the existence of discussions between them and requested that the case be assigned to a single judge.

CANE S.p.A. was given a deadline of 15 May 2024 to respond, by order of 20 March 2024, which was extended to 31 May 2024 by message to the parties of 06 May 2024.

By order of 21 March 2024, the President of the Paris Local Division of the JUB assigned the case to a single judge.

The parties having confirmed the success of their talks and the regularisation of a protocol, a status meeting was organised on 07 June 2024, with the representatives of the parties, in the presence of the court clerk, during which the parties indicated that they had formalised an agreement, for which they would seek homologation, stating that a status conference was not necessary and that the agreement could be homologated without an oral procedure.

By memorandum of 1^{er} July 2024 (App. 38966/ 2024), the representative of CANE S.p.A. applied for approval of the agreement reached between the parties on 20 June 2024, and for publication of a redacted version of the agreement, pursuant to the provisions of R.365.2 Rdp. By order of 16 July 2024, the single judge granted this application.

CANE S.p.A. also requests that the value of the dispute be set at EUR 390,000, in agreement with the parties, that the costs of the proceedings be reduced to EUR 4,400, corresponding to 60% of the fixed fee, and that EUR 9,100 (EUR 13,500 - EUR 4,400) of the costs of the proceedings be reimbursed. It also requests that exhibits 1-4, 1-5 and 1-6 be excluded from the proceedings.

The procedure was closed on 26 July 2024.

REASONS FOR THE DECISION

Approval of the agreement and confidentiality

Pursuant to the provisions of R. 365.1 Rdp "*When the parties terminate the proceedings by means of a settlement, they must inform the judge-rapporteur. The court shall homologate the settlement by a decision [Rule 11.2], if the parties so request, and the settlement may be enforced as a decision on the merits of the case*" and R. 365.2 RoP "*At the request of the parties, the court may order that the details of the settlement remain confidential*".

R.11.2 RoP states that "*In accordance with rule 365 and if the parties so request, the court shall confirm the terms of any settlement (...) by means of a decision*".

In this case, the parties entered into a memorandum of understanding on 20 June 2024, putting an end to the dispute between them, which should be approved and which will be appended to this decision, in accordance with the terms set out in the order of 16 July 2024, with regard to the confidentiality of the transaction.

Reimbursement of expenses

Pursuant to the provisions of R.365.4 Rdp, "*The judge-rapporteur shall make a decision concerning costs in accordance with the terms of the settlement, or failing that at his discretion*".

In accordance with the provisions of R. 11.2 RoP in fine "*the parties may agree on the compensation to be awarded in respect of costs or may request the court to decide on the compensation to be awarded in respect of costs in accordance with rules 150 to 156 mutatis mutandis*".

Pursuant to R.370-9 Rdp, "*Fixed fees and fees based on the value of the dispute may be reimbursed as follows* :

(a) If the case is heard by a single judge [R.345.6 RoP], the party liable for the costs of the proceedings will be reimbursed 25% of the costs.

(b) (...)

(c) If the parties settle their case, the party liable for the procedural costs will be reimbursed the amount of :

(i) 60% if the action is settled before the close of the written procedure.

(ii) (...)

(d) only one of the rebates referred to in paragraph 9 (a), (b) and (c) shall apply per case and per party. Where more than one rebate is applicable, the largest will be applied for each party".

In this case, the case having been assigned to a single judge at the request of the parties, and the transaction having been concluded on 20 June 2024, before the close of the written procedure, the rules of the Court of Appeal apply.

370.9 (a) and (c) (i), are likely to apply and the larger 60% refund should be used.

CANE S.p.A. paid a total of 13,500 euros in procedural costs, including the fixed fee of 11,000 euros, corresponding to an infringement action (R.370.2(a) Rdp and R.15), as well as the sum of 2,500 euros, corresponding to the variable fee based on the value of the dispute initially declared to be 750,000 euros, in accordance with the table of procedural costs of the Administrative Committee of 08 July 2022 (dispute with a value of between 500,001 euros and 750,000 euros).

As the value of the dispute has been reduced to the sum of 390,000 euros, CANE S.p.A. is not liable for any amount in respect of variable rights (no amount is due in this respect for disputes with a value of less than 500,000 euros).

CANE S.p.A. is therefore entitled to reimbursement of the sum of 2,500 euros paid in this respect, as well as reimbursement of the sum of 6,600 euros, corresponding to 60% of the fixed fee paid for the infringement action (11,000 x 60%), i.e. the total sum of 9,100 euros.

Withdrawal of the exhibits from the proceedings

The parties have agreed to withdraw from the proceedings exhibits 1-4, 1-5 and 1-6, submitted by CANE.

S.p.A. (letters dated 05 November 2021, 17 December 2021 and 21 January 2022 respectively).

The request will be granted.

The courtyard

- Homologues to the transaction concluded on 20 June 2024 between CANE S.p.A and FRANCE DEVELOPPEMENT ELECTRONIQUE
- Declares that the protocol will be annexed to the decision
- Declares that the unredacted version will remain confidential
- Orders the reimbursement to CANE S.p.A. of the sum of 9,100 euros, after reduction of the fixed and variable costs of the proceedings
- Orders the withdrawal from the proceedings of CANE S.p.A exhibits 1-4, 1-5 and 1-6.
- Points out that this decision putting an end to the action may be appealed under the conditions of R.220.1 (a) Rdp.

Delivered in Paris, on 26 July 2024,

Carine GILLET, Single Judge

2024.07.26
Carine Gillet 14:36:32
+02'00'

DETAILS OF THE DECISION

Decision n° ORD_43695/2024 in ACTION N° : ACT_586601/2023

UPC n° : UPC_CFI_419/2023

Type of action: Infringement action

TRANSACTION FOR THE PURPOSES OF PROBATE

BETWEEN THE UNDERSIGNED :

CANÈ S.p.A., a company incorporated under Italian law, registered with the Chamber of Commerce of Turin under REA no. TO-629783, whose registered office is at Via Cuornè 42/A CAP 10098, Rivoli (TO), Italy, represented by Mr. Mario CANÈ, acting in his capacity as legal representative of the company,

Hereinafter referred to as "CANÈ",

on the one hand, and

FRANCE DÉVELOPPEMENT ÉLECTRONIQUE, a société par actions simplifiée (simplified joint stock company), registered in the Saverne Trade and Companies Register under number 394 872 964, with its registered office at 46 rue du Zornhoff, 67700 Monswiller, France, represented by Mr Raphaël VICO, acting in his capacity as Chairman,

Hereinafter referred to as "FDE", on the other hand,

Hereinafter together referred to as "the Parties".

THE FOLLOWING POINTS SHOULD BE NOTED:

1. CANÈ is the holder of European patent EP 3 181 168 ("EP' 168"), resulting from a European application filed on 16 December 2016 (under priority of an Italian application dated 17 December 2015) and granted in English by the EPO on 4 December 2020, designating in particular the Contracting States of France, Italy and Germany.
2. By a statement of claim dated 14 November 2023, CANÈ brought an infringement action against FDE before the Unified Patent Jurisdiction (hereinafter "the Jurisdiction"), seeking a declaration that FDE had committed acts of infringement of patent EP' 168 by delivering and offering to deliver in France, Germany and Italy devices called "So-Easy", in particular in order to obtain a prohibition of the acts of infringement, the recall of the infringing products and the reimbursement of its costs associated with the proceedings. The proceedings are pending under number 5486601/2023.
3. FDE filed its statement of defence on 26 February 2024 (with a correction on 27 February 2024). In this statement of defence FDE did not contest either the validity of patent EP' 168 or the acts of infringement, but it undertook to cease the acts of infringement by a unilateral undertaking dated 9 January 2024, certifying that it had not delivered any product since 15 December 2023. FDE also replied that CANÈ's claims should be dismissed in their entirety, in particular because of this undertaking. However, as the undertaking did not include a penalty payment in the event of FDE failing to comply with it, CANÈ expressed its desire to secure the undertaking by means of a homologation decision by the Court.
4. At a hearing on 19 March 2024, the Parties indicated to the Judge-Rapporteur that they were negotiating a settlement (hereinafter "the Settlement") and the Judge-Rapporteur set 15 May as the date for CANÈ's reply brief. During this hearing, CANÈ's Counsel also indicated that CANÈ
(i) would not rely before the Court on exhibits numbered 1.4, 1.5 and 1.6 filed with its statement of claim and
(ii) would request that these exhibits not be made accessible to third parties pursuant to rule 262 (2) RoP.
5. Following discussions through their Counsel, the Parties have reached an agreement. CANÈ informed the Judge-Rapporteur of this agreement by email dated 6 May 2024 and the Judge-Rapporteur, by email dated the same day, extended to 31 May 2024 the deadline granted to the Parties to finalise the Settlement.
6. Please refer to the parties' submissions to the Court for a fuller description of their respective positions and claims.
7. Having thus taken the exact measure of their disagreement, wishing to avoid the hazards and future costs of litigation and a possible appeal, the Parties have expressed their desire to put an end to their dispute through their respective Counsel and to enter into the Settlement Agreement to this end.

After discussions and mutual concessions, the Parties have come together and freely entered into the Transaction, with the assistance of their respective legal advisors and with full knowledge of the facts, without the Transaction

does not imply recognition by either party of the merits of the claims of the other party (otherwise, it does not imply recognition by either party of the merits of the claims of the other party).
as expressly indicated below).

IN VIEW OF THE ABOVE, THE FOLLOWING HAS BEEN AGREED:

Article 1 - Purpose of the Transaction

The subject matter of the Settlement is the dispute between CANÈ and FDE, as set out in the Parties' pleadings before the Court in proceedings 586601/2023, as to the infringement of patent EP' 168 by FDE's delivery and offer to deliver the So-Easy device in France, Germany and Italy.

Article 2 - Nature of the Transaction

The Settlement constitutes a "settlement" within the meaning of Article 79 of the Unified Jurisdiction Agreement (hereinafter "AJUB") and Rule 365 of the Unified Patent Jurisdiction Rules of Procedure (hereinafter "UPLR").
"RdP").

The Transaction will therefore be confirmed by the Court (AJUB, art. 79) and entered in the Court's register, subject to the confidentiality measures set out in Article 6 below.

To the extent that confirmation by the Court is expected to result in publication or public access, the Parties shall request that such publication or public access be provided on a redacted version of the Settlement Agreement which does not include :

- the amount indicated in the sixth paragraph of Article 4,
- the invoice in appendix 2.

In order to give it enforceability, the Parties also agree to jointly request homologation of the Settlement by the Court (RoP, rule 365), as set out in Article 5 below.

Article 3 - Commitments and declaration by CANÈ

CANÈ is committed:

- to withdraw the claims brought against FDE in the proceedings 586601/2023,
- not to demand any additional form of compensation from FDE for the acts of delivery and the offer of delivery by FDE of the So-Easy device, in France, Germany and Italy, committed until 15 December 2023 (inclusive),
- not to make any further claims based on patent EP' 168 against FDE's direct or indirect customers in respect of So-Easy devices supplied by FDE in France, Germany and Italy until 15 December 2023 (inclusive),
- and more generally, to no longer make any request or claim against FDE with regard to the subject of the Transaction, as defined in article 1 above,
- to apply jointly with FDE for approval of the Settlement by the Court, under the conditions of provided for in Article 5 below.

CANÈ therefore declares that it is fully discharged of its rights under patent EP' 168 against FDE and its direct or indirect customers, in respect of So-Easy devices delivered by FDE in France, Germany and Italy until 15 December 2023 (inclusive).

However, it is expressly agreed that these undertakings and this declaration shall not have the effect of granting FDE or its customers any right whatsoever arising from patent EP' 168, for So- Easy devices (or for similar or identical devices) delivered by FDE after 15 December 2023 in France, Germany or Italy.

Article 4 - Concessions, commitments and declarations by FDE

FDE gives up:

- any claim against CANÈ in relation to the action brought by CANÈ before the Court under number 586601/2023,
- and, more generally, any claim relating to the subject of the Transaction, as defined in article 1 above.

FDE hereby acknowledges having infringed patent EP' 168 by delivering and offering to deliver the So- Easy device in France, Germany and Italy.

FDE hereby confirms the undertaking given before the Court (exhibit 2 attached to the Statement of Defence), which is attached as Appendix 1. It declares and confirms that this undertaking was signed by its Chairman, Mr Raphaël VICO. FDE therefore undertakes to cease all acts of infringement and to cease all advertising in France, Germany and Italy concerning the So-Easy device. This undertaking is irrevocable and is given, for each of these designated States, for the period during which the European patent EP' 168 will remain in force in the State concerned.

FDE confirms by the Settlement Agreement that as soon as the Court approves the Settlement Agreement, its undertakings will be enforceable, entailing the possibility of being sanctioned by a penalty payment to be paid to the Court in accordance with Article 82(4) AJUB, if FDE does not comply with the terms of the Settlement Agreement.

FDE acknowledges the validity of patent EP' 168 and refrains from initiating either invalidity proceedings in respect of any national part of patent EP' 168 or revocation proceedings in respect of patent EP' 168.

FDE undertakes to pay CANÈ the sum of [REDACTED], as a fixed and final transactional indemnity, in payment of the invoice issued by CANÈ attached in Appendix 2. This sum shall be paid by FDE by transfer to the bank account indicated on the invoice in Appendix 2, the transfer order by FDE being made within seven calendar days following the entry into force of the Transaction. FDE will spontaneously provide CANÈ with proof of this transfer order.

FDE declares that it no longer has any claim against CANÈ for the exercise by CANÈ of the rights arising from patent EP' 168 against FDE, in respect of the So-Easy devices delivered by FDE in France, Germany and Italy until 15 December 2023 (inclusive).

Article 5 - Certification

The Parties undertake to jointly apply to the Court for a decision approving the Settlement, in order to make it enforceable.

Article 6 - Confidentiality

FDE undertakes not to request any measure of confidentiality in respect of the decision of the Court to be taken to record the end of the proceedings: accordingly, this decision of the Court recording the agreement of the Parties will be published in accordance with the AJUB and the RoP.

However, the Parties agree that the amount of the compensation paid by FDE to CANÈ pursuant to the sixth paragraph of Article 4 is confidential. The Parties therefore undertake to request the Court (jointly) that the amount of the Transaction and the invoice in Appendix 2 remain confidential by application of Rule 262 (2) RoP, and to provide the Court with a version of the Transaction in which this information is redacted. The Parties undertake to keep this amount confidential.

This confidentiality undertaking is valid for a period of five years from the latest of the dates of expiry or lapse of the EP' 168 patent in the designated contracting states (France, Italy and Germany).

CANÈ also undertakes, as it indicated to the Judge-Rapporteur at the hearing on 19 March 2024, to ask the Court that the exhibits numbered 1.4, 1.5 and 1.6 annexed to its statement of claim remain confidential, in their entirety, by application of Rule 262 (2) RoP.

Lastly, pursuant to rule 11 (3) of the Rules of Procedure, the Parties expressly agree that the Transaction may be used as evidence before the Court or any other jurisdiction, subject to the above confidentiality undertaking.

Article 7 - Costs

With the exception of the payment provided for in the sixth paragraph of Article 4, each of the Parties shall be responsible for all of the costs of lawyers, advisors, procedural costs and legal costs that it may have incurred in relation to the object indicated in Article 1, in particular with regard to (i) the proceedings before the Court (including the approval of the Settlement Agreement and the applications made pursuant to rule 262 (2) RoP) and (ii) the negotiation and signature of the Settlement Agreement.

It is expressly specified that the provisions of the preceding paragraph do not prevent CANÈ from requesting reimbursement of the costs of the proceedings from the Court in accordance with Rule 370.
(9) RdP.

Article 8 - Completeness

The terms of the Transaction constitute the entire agreement between the Parties with respect to the subject matter set forth in Article 1 above.

Article 9 - Settlement

This Settlement Agreement, concluded on the basis of Articles 2044 to 2052 of the French Civil Code, settles definitively between the Parties all disputes relating to the subject matter defined in Article 1 above and precludes the commencement or continuation between the Parties of legal proceedings having the same subject matter.

Article 10 - Applicable law, successors and disputes

The Transaction is governed by and construed in accordance with French law.

The Agreement applies not only to the Parties, but also to their successors in title. Each of the parties undertakes to ensure compliance with the Agreement by his or her successors in title.

The Parties undertake, prior to any recourse to the courts, to seek an amicable solution to any dispute relating to the existence, validity, application and/or interpretation of the Transaction or which may arise during its performance. In the event that the Parties fail to reach an amicable solution within a period of three months, the Parties agree that the Unified Patent Jurisdiction shall have exclusive jurisdiction to settle any dispute relating to the existence, validity, application and/or interpretation of the Transaction or which may arise during its performance.

If such a dispute does not fall within the jurisdiction of the Court, the Parties agree that the Paris Court shall have exclusive jurisdiction to hear it.

Article 11 - Entry into force and duration

The Transaction will come into force on the date of its confirmation and homologation by the Court.

Article 12 - Signature

The Parties agree to sign the Transaction electronically in accordance with Articles 1367 et seq. of the French Civil Code. To this end, the Parties agree to use the online platform DocuSign www.docusign.com. Each of the Parties declares and accepts (i) that the electronic signature they affix to the Transaction has the same legal value as their handwritten signature and (ii) that the technical means used for this signature give the Transaction a date certain.

Each of the Parties acknowledges that the signature process chosen by the Parties to sign the Transaction on an electronic medium enables each of them to have a copy of the Transaction on a durable medium or to have access to it, in accordance with article 1375 al. 4 of the French Civil Code.

<p>For CANÈ</p> <p>DocuSigned by: <i>M. Mario CANÈ</i> 5592D23065C549A...</p> <p>Mr Mario CANÈ</p>	<p>For France DÉVELOPPEMENT ÉLECTRONIQUE</p> <p>DocuSigned by: <i>M. Raphaël VICO</i> Mr Raphaël VICO</p>
<p>Date</p>	<p>Date</p>

Appendices :

- Appendix 1: FDE's undertaking of 9 January 2024 (exhibit 2 attached to the statement of defence),
- Appendix 2: Invoice from CANÈ to FDE, with CANÈ's bank details.

**Annex 1 - FDE's undertaking of 9 January 2024
(exhibit 2 attached to the statement of
defence)**



Juridiction Unifiée du Brevet
Division Centrale de Paris
5 Rue Saint-Germain l'Auxerrois
75001 PARIS

Numéro d'affaire : 586601/2023

Par les présentes, la société par actions simplifiée France Développement Electronique – F.D.E. s'engage à ne pas procéder à des livraisons ou à des offres de livraison du produit « extracteur universel pour réservoir », actuellement référencé « SO EASY », en France, en Allemagne ou en Italie.

Cet engagement irrévocable est souscrit, pour chacun de ces Etats désignés, pour la durée pendant laquelle le brevet européen EP-B-3 181 168 restera en vigueur dans l'Etat concerné.

La société atteste aussi n'avoir procédé à aucune vente, ni aucune livraison du produit « extracteur universel pour réservoir », actuellement référencé « SO EASY » en France, en Italie ou en Allemagne, depuis le 15 décembre 2023 et jusqu'à ce jour.

Fait à Monswiller, le 9 janvier 2023

46 rue du Zornhoff - MONSWILLER
BP 30080 - 67702 SAVERNE CEDEX
Tél. : 03 88 91 87 55 - Fax 03 88 71 28 88
SAS au capital de 234 000 €
RCS de Saverne - SIRET n° 394 872 964 00041
TVA INTRACOMMUNAUTAIRE : FR 02 394 872 964

SAS FRANCE DEVELOPPEMENT ELECTRONIQUE au capital de 234 000 €
46 rue du Zornhoff - MONSWILLER - BP 30080 - 67702 SAVERNE CEDEX
Tél : 03 88 91 87 55 - Fax : 03 88 71 28 88 - Email : contact@fde.fr - Site : www.fde.fr
N° TVA intracommunautaire : FR02394872964
RCS : SAVERNE TIB 394 872 964 - SIRET 394 872 964 00041 - APE7112B Lieu de juridiction : SAVERNE

Appendix 2 - Invoice from CANÈ to FDE

