



**Düsseldorf local division**  
**UPC\_CFI\_452/2023**

**procedural order**  
**of the Court of First Instance of the Unified Patent Court local division**  
**Düsseldorf**  
**issued on 5 August 2024**  
**concerning EP 3 466 498 B1**

LEADERSHIPS:

1. If the court grants the applicant the right to choose between a deposit and the provision of a bank guarantee with regard to the type of security to be provided and if the applicant also provides a bank guarantee following the deposit, the resulting double security may be the reason and cause for a corresponding release decision.
2. This does not mean that such an exchange of the security is in the applicant's interest in the sense that he can exercise his right of choice granted for the provision of the security as often as he wishes with the consequence that the security originally provided is always released after another security has been provided. Within the scope of the discretionary decision to be made in accordance with R. 352.2 RoP, the interests of the opposing party and the court must be taken into account in addition to the interests of the applicant in such an exchange of the security.
3. The applicant may have a recognisable interest in exchanging the security if, in the interest of a quick execution of an ex parte Order, the applicant initially decided in favour of the deposit, which in his view can be realised more quickly, but has in the meantime obtained a bank guarantee and provided this as security.

KEYWORDS:

Order for provisional measures; provision of security; exchange of security; ex parte order;

APPLICANT:

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RESPONDENTS:

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STREITPATENT:

EUROPEAN PATENT NO. EP 3 466 498 B1

Decision-making body/chamber:

Judges of the Düsseldorf local division:

This Order was issued by presiding judge Thomas as judge-rapporteur.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: R. 352.2 RoP - Application for release of a security

BRIEF DESCRIPTION OF THE FACTS:

On 11 December 2023, the Düsseldorf local division ordered *ex parte* provisional measures against the defendants. Point 5 of this Order reads as follows:

"This Order is only enforceable if the applicant has provided security in favour of the defendants in the form of a deposit or bank guarantee in the amount of EUR 500,000."

(emphasis added)

In order to comply with this, the applicant deposited an amount of EUR 500,000 as security on 15 December 2023 and enforced the Order. The same applies insofar as the Düsseldorf Local Court confirmed the ex parte Order on 9 April 2024 following an application for review by the respondents.

On 27 March 2024, the applicant sent the respondents an original surety deed by messenger, which states, among other things:

"Accordingly, [name and address of the bank] hereby assumes, on behalf of the applicant, as surety creditor vis-à-vis the respondents for all claims for damages incurred by the respondents as a result of the enforcement of Sections I. - III. of the aforementioned Order of the Court of First Instance of the Unified Patent Court, Local Chamber Düsseldorf, against the applicant, the irrevocable, unconditional, indefinite and directly enforceable guarantee, waiving the defence of failure to pursue remedies (Section 771 BGB), of avoidance and of set-off (Section 770 ZPO) up to a maximum amount of EUR 500,000.00 (in words: five hundred thousand euros) including all ancillary claims. The defendants are co-creditors pursuant to Section 432 (1) BGB."

(underlining added)

Please refer to Annex KAP Si 3 for the full content of the guarantee declaration.

After the defendants' legal representatives rejected the declaration of surety as insufficient security, the applicant served the original of the deed of surety together with the Order of 8 April 2024 by bailiff (see Annex KAP Si 4).

Against this background, the applicant is now requesting repayment of the deposited amount.

APPLICATIONS BY THE PARTIES:

The applicant requests,

to return to the applicant the security deposit of EUR 500,000 deposited with the Unified Patent Court.

The defendants have opposed this.

FACTUAL AND LEGAL ISSUES:

In the opinion of the applicant, the defendants are adequately secured by the guarantee against possible enforcement damages. Therefore, the release of the additional amount deposited as security should be ordered.

According to the Court Order, the applicant has a right to choose the form of the security, which also includes the possibility of exchanging the security already provided. Even if such an exchange required a legitimate interest - as it did not - such an interest existed in the present case. The applicant had contacted her bank immediately after the Court Order in order to instruct a surety. Due to the banks' close of business for 2023, it was not possible for the applicant to obtain a bank guarantee in time. According to the bank, such a guarantee could not be provided until 29 December 2023 at the earliest. In view of the need to execute the court order at short notice, the applicant could not have ensured that all the necessary documents would also be delivered in Switzerland in good time, i.e. within one month. Therefore, the applicant deposited the security with the Unified Patent Court on 15 December 2022 in order to instruct the service and execution of the Order on the same day. The provision of security by deposit represents a significant financial burden for the applicant, as the sum is likely to be withdrawn from business operations without interest until the final conclusion of the proceedings, although an equivalent alternative in the form of less drastic security is available to the applicant.

The defendants have opposed this.

They argue that the Rules of Procedure do not provide for an exchange of security. Once the applicant has exercised the right of choice granted to her by the local division, she is bound by it.

Moreover, the applicant was also unable to demonstrate a legitimate interest in exchanging the collateral. The provision of appropriate security by the bank could have already been initiated with the filing of the application for an Order for provisional measures. With adequate preparation, the original of a suitable deed of guarantee could have been collected directly on the day after the announcement/service.

Apart from this, the declaration of guarantee submitted did not comply with the requirements of the Rules of Procedure in any case. Firstly, the deed of guarantee did not have to be served on the defendants, but on the office of the Düsseldorf local division. Secondly, this only referred in general terms to "claims for damages which the defendants are entitled to as a result of the enforcement of items I to III [...] against the applicant". [...] against the applicant". It is not apparent that this wording covers the entire scope of liability of Rule 213.2 RoP.

REASONS FOR THE ORDER:

Pursuant to R. 352.2 RoP, the court may order the release of a security upon application. The requirements for such a release order are met here.

I.

Even if the provision does not directly link such a release to further conditions, but leaves the release to the discretion of the court, such a release should normally be considered if the reason for providing the security no longer exists (see Tilmann/Plassmann/Chakraborty/Schmid, Einheitspatent/Unified Patent Court, R. 352 RoP, para. 14). However, the provision is not limited to this. If the court grants the applicant the right to choose between a deposit and a bank guarantee with regard to the type of security to be provided and if the applicant also provides a bank guarantee following the deposit, the resulting double security can also be the reason and cause for a corresponding release decision.

However, this does not mean that such an exchange of the security is at the discretion of the applicant in the sense that it can exercise the option granted to it for the provision of the security as often as it wishes with the consequence that the security originally provided is always released after the provision of further security. Within the framework of the R. 352.2 RoP, the interests of the other party and the court must also be taken into account in addition to the interests of the applicant in such an exchange of the security.

II.

On this basis, the applicant has such an interest in replacing the security.

The fact that the applicant has an interest in the swift execution of the ex parte Order of 11 December 2024 and therefore also in the rapid provision of collateral is obvious. Against this backdrop, it appears understandable and justified that it initially opted for the deposit which, in its view, could be realised more quickly. Based on the processes described in detail by the applicant, it is not apparent that the applicant would have been able to obtain a corresponding surety and provide it as collateral just as quickly. In particular, contrary to the opinion of the defendants, the applicant did not have to make preventive efforts to obtain a bank guarantee prior to filing the application for an Order for provisional measures. On the contrary, it was entitled to wait for the order for provisional measures, including the order for a corresponding security, due to the costs associated with a bank guarantee.

III.

Contrary to the opinion of the defendants, the guarantee provided by the applicant as security also meets the requirements of the Rules of Procedure.

1.

Pursuant to R. 211.5 sentence 1 RoP, the court may order that the applicant must provide appropriate security for any appropriate compensation to be paid by the defendant for the damage that the defendant is likely to suffer in the event that the order for provisional measures is revoked by the court (emphasis added). The Düsseldorf local division made use of this option and provided appropriate security both in the ex parte order of 11 December 2023 and in the order confirming it of 9 April 2024.

With regard to the scope of the provision of security, R. 211.5 p. 1 RoP in connection with

R. 213.2 RoP. If provisional measures are revoked or lapse due to an act or omission by the applicant, or if it is subsequently established that there was no infringement or threatened infringement of the patent, the court may, on application by the defendant, order the applicant to pay the defendant appropriate compensation for all damages incurred as a result of these measures. The simultaneous reference to R. 354.2 RoP makes it clear that this relates to possible enforcement damages ("... appropriate compensation for damages caused by the enforcement ...").

The fact that such damages are covered by the guarantee now provided is clear from the guarantee declaration submitted. According to this, the guarantee covers "all claims for damages incurred by the defendants against the applicant as a result of the enforcement of Sections I. to III. of the aforementioned Order of the Court of First Instance of the Unified Patent Court, Düsseldorf local division". The submitted guarantee declaration is therefore sufficient in terms of content.

2.

Similarly, there is no objection to the service of the guarantee certificate on the authorised representatives of the applicants. Pursuant to R. 45 of the "Rules governing the Registry of the Unified Patent Court" (hereinafter: Registry Rules), the Sub-Registrar of the Unified Patent Court examines the bank guarantee provided ("... the Deputy-Registrar shall ... examine the bank guarantee..."). In other words, the applicant provides a bank guarantee, the validity of which is verified by the Sub-Registry.

Nothing is said about the conditions of validity of such a guarantee. This depends on the law on which the respective guarantee is based. If the applicant opts for a guarantee from a German bank, the validity of the guarantee is thus governed by Sections 765 et seq. BGB. In addition to a principal claim, the validity of the guarantee agreement therefore requires a written guarantee declaration from the guarantor, which must be received by the party entitled to the guarantee (secured party) itself or its authorised representative. The defendants rightly do not question such access in the present case. Against the background that the court has explicitly recognised the provision of security as an admissible means of security, an explicit declaration of acceptance by the defendants as the secured party is not required (cf. BeckOK ZPO, Vorwerk/Wolf/Jaspersen, status: 01.07.2024, section 108 para. 7).

III.

As the applicant has duly provided a guarantee as security, she can now demand payment of the amount also deposited as security, taking into account her interest in an exchange of the security provided. Pursuant to R. 352.2 RoP in conjunction with R. 45.3 Registry Rules. R. 45.3 Registry Rules, the court orders the Registrar to make a corresponding repayment. The present Order takes this into account.

ORDER:

1. The Registrar is ordered to return to the applicant the security deposit of EUR 500,000 deposited with the Unified Patent Court.
2. The disbursement should only take place once the deadline for requesting a review of this Order by the adjudicating body (R. 333.2 RoP) has expired without

that a corresponding request for examination was submitted by the defendants.

ORDER DETAILS:

App\_28993/2024 for  
ACT\_589655/2023 UPC number:  
UPC\_CFI\_452/2023  
Type of proceedings: Order for provisional measures

Issued in Düsseldorf on 5 August 2024 NAMES

AND SIGNATURES

Presiding judge Thomas

Ronny

Thomas

Digitally signed by Ronny  
Thomas Date: 2024.08.05  
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