Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Paris Local Division

UPC_CFI_813/2024
Order to preserve evidence (seizure) and enter premises of the Court of First Instance of the Unified Patent Court handed down on *23/12/2024*
concerning R.192 to 199 RoP

APPLICANT

TIRU
7, rue du Dr Lancereaux
75008 Paris

Represented by Cyrille AMAR, law firm Amar Goussu Staub

DEFENDER(S)

MAGUIN SAS
2, rue Pierre Semart
02800 Charmes

PATENT IN SUIT

Patent number	*Owner(s)*
EP3178578	TIRU

JUDGE WHO RULES

COMPOSITION OF THE CHAMBER - SINGLE JUDGE

Single , judgepresiding judge ***Camille Lignières***

LANGUAGE OF PROCEDURE: French

ORDER

Summary of facts and proceedings

On 17 December 2024, TIRU filed an application against MAGUIN for the preservation of evidence and a search of the premises before the proceedings on the merits began.

TIRU explains that it is the owner of patent EP 3 178 578 B1 issued on 1/08/2018 (hereinafter "EP'578), entitled "plant Waste incineration and associated process".

The applicant states that this patent is in force and covers France, the United Kingdom and Poland. It protects a technology used in a waste incineration furnace.

According to TIRU, it learned in October 2024 that MAGUIN had supplied VALINEA ENERGIE, a subsidiary of VEOLIA, with a furnace which appears to reproduce the features of independent claims 1 and 15 and dependent claims 4, 5, 6 and 14. TIRU maintains that this waste incineration furnace supplied by MAGUIN will come into operation in the 1st quarter of 2025.

TIRU states that on 11 October 2024 it had an official report drawn up online by a court commissioner to record the facts revealed by the YouTube2 video on behalf of the Agglomération du Pays de Montbéliard, illustrating the renovation of this public authority's energy recovery plant and unveiling a new waste treatment furnace equipped with air , injection suggesting that it was using the patented . technologyTIRU added that this video was accompanied by posts on the LinkedIn network by VEOLIA revealing that its subsidiary VALINEA ENERGIE had used MAGUIN to supply a new furnace and install it at the Montbéliard plant.employees

The applicant seeks an ex parte order granting measures to obtain evidence of the infringement on the MAGUIN site; this application is made in parallel with an application for measures to preserve evidence and raid the premises to be carried out on the VALINEA site where the oven is locatedin question , registered on the CMS under no. 5566573/2024 before this .court

Order requested by the applicant

In summary, TIRU is requesting:

-a physical seizure of all documents relating to the technical and promotional documentation and all accounting documents enabling the extent of the damage linked to infringement of the waste incineration furnace in question to ;be calculated

-the preservation by printing or copying of the digital media linked to the oven in question, in particular by allowing access to the defendant's computer systems;

-that the expert be authorised to carry out any questioning and any useful research with a view to establishing the origin, consistency and extent of the alleged infringement;

-that the seizure expert be assisted, if necessary, a court commissioner, a locksmith and the forces of law and order (police or gendarmerie)**;**

-a written report by the expert appointed by the Court, together with the minutes drawn up by the court commissioner.

-the protection of the confidentiality of the information gathered, which is matter of abusiness , secrecyin particular the fact that the documents seized are only communicated to TIRU representatives;

-the lodging by the applicant of a guarantee of 10,000 euros for legal costs and for compensation for any loss suffered or likely to be suffered by the defendant.

POINTS IN DISPUTE

1- Jurisdiction and competence

The Unified Patent Court (UPC) has jurisdiction to hear the present application pursuant to Articles 32.1(c) and 60.1 of the Agreement on a Unified Patent Court (UPCA) for the following reasons:

- the patent in question is a European patent, which has not been excluded from the exclusive jurisdiction of the UPC (exhibit 18);
- the patent is in force, inter alia, in France, as attested by EPO (exhibit 14).register

The Paris Local Division is competent under articles 32.1 (c) and 33.1 (b) of the UPCA, for the following reasons:

- MAGUIN's head office is in Charmes (02), France;
- the claimant argues that the alleged infringement occurred in France;
- TIRU intends to file proceedings on the merits based Article 33.1(b) of the UPCA, in accordance with Rule 192.1 of the UPC Rules of Procedure (RoP).

2. Compliance with the provisions of rule 192.2 of the RoP

2.1. Content of the request

"The request for preservation evidence shall contain :
(a) the information provided for in Rule 13, §1, points (a) to (i) ;
(b) a precise indication of the measures requested [Rule 196, § 1], including the location of exact the evidence to be preserved if known or reasonably suspected ;
(c) the reasons why the proposed measures are necessary to preserve the relevant evidence; and
(d) the facts and evidence relied on in support of the request".

2.2. Concise description of future substantive proceedings

TIRU explains that it intends initiate proceedings on the merits in respect of the continued direct use of its patented invention allegedly committed by MAGUIN on the basis of the evidence obtained in the present proceedings, in order to assert its rights in accordance with the law.

to Art. 25 UPCA and to prove that MAGUIN manufactures, offers and markets a product which is the subject of the patent in question.
Consequently, the requirements of rule 192.2 RoP are met.

3. Burden of proof on the applicant Art. 60 UPCA - available provided by the applicant evidence

3.1. Owner's rights over a valid patent

The Applicant justifies that it is the current owner of patent EP'578 since 1/08/2018 (Exhibit 1).
With respect to the validity of the patent at issue, exhibit 15 shows that the patent will be in force in France in 2024. According to the information provided to the Court, no opposition is pending before the EPO.

Consequently, the validity of the patent in question is sufficiently proven procedure.- at this early stage of the

3.2. Alleged infringement

Patent EP' 578 protects both a waste incineration plant and an process.associated

Claim 1 of the patent in , as granted, teaches the following product: Waste incineration plant (1), comprising :

- a combustion cell (10) extending along a longitudinal axis between an inlet face (2a) and an outlet face (2b) and having a side wall (11), said longitudinal axis being inclined so that the face inlet (2a) has a higher altitude than the outlet face (2b), the cell (10) being adapted to oscillate about said longitudinal axis;

- means (4, 5) for introducing waste into the cell (10) via the inlet face (2a);

- means (3a, 3b) for supplying combustion and/or air to the cell (10)cooling ;

- a fume exhaust duct (6) through an opening in the side wall (11) of the cell (10);

-characterised in that it further comprises a hollow envelope (12a, 12b) arranged around the side wall (11) so as to cover at least 50% of its surface, the combustion and/or cooling air circulating in the said hollow envelope (12a, 12b) before being introduced into the cell (10),

the hollow envelope (12a, 12b) having forward channels (120a, 120b) and return channels (121a, 121b), arranged so that the air circulating in said hollow envelope (12a, 12b) passes through the forward channels (120a, 120b) and then the return channels (121a, 121b) before being introduced into the cell (10),

each return channel (121a, 121b) being arranged between two forward channels (120a,)120b.

According to claim 15 of patent EP 578, the following process is taught: Waste ,

incineration processcharacterised in it comprises the steps of :
- introduction of waste into a combustion cell (10) via an inlet face (2a), the cell (10) extending along a longitudinal axis between the inlet face (2a) and an outlet face (2b) and having a side wall (11), said axis longitudinal being inclined so that the inlet face (2a) has an elevation.

TIRU explains that it already has sufficient evidence to demonstrate that it is true that patent EP'578 is implemented by the furnace installed in Montbéliard on the VALINEA ENERGIE site.

It has also been sufficiently demonstrated that this furnace was supplied by MAGUIN, which isa competitor of TIRU in the market for the treatment of non-hazardous waste (exhibit 8).

The applicant states that this oven has similar characteristics to the product protected the patent in question in claim 1 in particular.

In support of its allegations, the claimant produced a video and detailed, commented taken from images this video, which the subject of an report (online report dated 11/10 /2024 in exhibit 2).

the light of these elements, in his application the applicant carried out a detailed and circumscribed analysis of the images of the allegedly infringing , ovenin the light of each of the characteristics of the two main claims of his patent (pages 12 to 23 of the application).

This analysis reveals the existence of elements likely to demonstrate probable re-production, in particular for the following features of main claim 1:

- 1.1 relating to a *waste incineration plant*,

-1.2 relating to *a combustion cell extending along a longitudinal axis between an inlet face and an outlet face and having a side wall*,

-1.4 relative to *the cell being adapted to oscillate about said longitudinal axis*,

-1.6 relating to the *means of supplying the cell with combustion and/or cooling air*.

It can be seen from this that the applicant has provided sufficient reasonable evidence at this stage to argue that claim 1 of his patent is likely to have been infringed, as well as for process claim 15 (mirror of claim 1).

Nevertheless, the applicant indicates that it is seeking evidence of infringement in respect of certain features of claim 1 that are not visible on the evidence already submitted, as well as for the other claims of its patent. More specifically, a visit tothe premises by a forensic expert seems necessary to confirm, in particular for claim 1, the reproduction of the features as follows:

-1.3 (*said longitudinal axis] being inclined so that the input face has a higher elevation than the output face, the cell being adapted to oscillate about said longitudinal axis)*,
-1.5 (*Means of introducing waste into the cell via the faceinlet),*

-1.7 (*a hollow envelope arranged around the side wall so as to cover at least 50% of its surface, the combustion and/or cooling air circulating in said envelope hollow before being introduced into the cell),*

-1.8 (*the hollow envelope having forward channels and return channels arranged so that the air circulating in the said hollow envelope passes through the forward channels and then the return channels before being introduced into the cell, each return channel being arranged between two forward channels).*

This is why the applicant needs an order to gather further evidence to prove the alleged infringement.

4. Requirements under rule 194.2 of the RoP

In accordance rule 194.2 of the RoP, the Court must take into account urgency and the grounds for granting an ex-parte order.

4.1. The emergency

The applicant explains that MAGUIN is a direct , competitorthat VEOLIA had it approached during the public procurement procedure and that MAGUIN won the concession (exhibit 6 on the concession notice).

In October 2024, the applicant learned of the existence of the allegedly infringing oven from a video posted on VALINEA's Montbéliard site, and also learned from the video that the oven would be put into operation in the quarter of 2025.

The applicant took two months to file the application for preservation of evidence with the UPC, which was a reasonable time in the circumstances to compile the file.

However, the Court did not agree with the applicant on the degree of urgency of his request, which submitted to the CMS with the wording "extremely urgent".

In fact, the Court considers that this is not a case of extreme urgency that would need to be dealt with immediately by the duty judge on the day of the referral, but only of urgency in accordance with the provisions of R. 194.4 RoP, criterion of urgency in this case being the risk of the furnace in question coming into operation in the 1st quarter of 2025, i.e. at the beginning of January 2025 at the earliest.

This is why the present case is not being dealt with by the duty judge, but by the President of the Local Division Paris acting as a single judge in accordance Rule R. 194.3 RoP.

4.2. Grounds for granting an order ex parte - risk of destruction of evidence

The allegedly infringing furnace cannot easily be destroyed or transported, as it is a very heavy . On the other hand, putting it into operation in the next few days (1st quarter ins- tallation2025) would make it extremely difficult, if not impossible, to carry out a descriptive seizure such as followingthe

requested in the proceedings parallel to the present case, the measures for which should be carried out concurrently.

In addition, data capture is one of the main objectives of the applicant in the present request, and itis generally accepted that digital data can be easily ca- cked or erased if the applicant is warned in advance of such a request.

It is therefore justified that the evidence could be easily deleted if the defendant is informed or heard before the measure is taken.

Consequently, this order must be made without the defendant having been heard, as there is a clear risk that evidence will be destroyed or cease to be available (Article 60(5) of the UPCA).

5. Payment of legal costs

The payment of legal costs on the grounds of urgency will only need to be justified before 31 December 2024, and the conditions set out in rule 192.5 of the RoP are therefore met.

6. Balance of interests and terms performance

6.1. Consideration of the interests of all the parties means that the measure must be granted, into takingaccount the potential risk of prejudice to each of the parties if it is granted - for the defendant - or refusal of the measure - borne bythe applicant.

According to the information provided at this stage of the proceedings, the Court notes that the case involves competing companies operating on the French waste treatment market and concerns a facility very expensive operation has a major impacteconomic .

In view of the principle of proportionality, the threat of definitive destruction of the evidence hanging over the applicant outweighs the exposure to defendantthe execution of the measures required. In 's this case, the application for an ex-parte order to preserve the evidence is granted in part; it will in fact be limited to the preservation of evidence of the very existence of the alleged . infringementThe 's claimantrequest to determine the origin of the infringement, its extent and the amount of damage caused by the possible infringement ; will not be grantedthis evidence will, if necessary, be provided ata later stage inthe proceedings on the merits, in particular in context of a measure of disclosure and/or separate proceedings to determine the damage suffered by the claimant if it is shown that the alleged infringement is established.

6.2. In accordance with Rule 196.4 of the RoP, the authorised measures will be carried out in accordance with the national law of the place where the measuresare carried out - .e. French law - by an expert, appointed by the Court and mentioned in particular in the operative part, in order to proceed at the defendant's premises. This expert is on the list of patent experts who used to arecooperating with the national , courtsso that the choice guarantees expertise, independence and impartiality, as required by rule 196.5 of the RoP.

The expert designated will be assisted by a competent "), insofar as this is appropriate and authorised by national law. He will also be assisted by a computer expert of his choice.huissier de justice (in this case, designated in France as a "com- missaire de justice

Only a representative of the applicant, namely Mr Olivier ROCHE, industrial property attorney and European patent attorney, may be present during the execution of these measures.
other representative or employee of the applicant is therefore authorised to be present during execution of these measures.

The appointed expert will submit a written report, together with a full copy of all documents and data acquired during the execution of the measures, seven days after the execution of the measures, as well as the minutes of the operations carried out, drawn up by the bailiff and attached.

6.3. Confidentiality
In accordance with Art. 58 UPCA and Rule 196.1 (d) RoP, the Court orders that access to any information and documents gathered by the expert in charge carrying out the measurement shall be limited to the representativesparties. ' A confidentiality , circle will then be set upidentify information relevant to the case as well as information considered a "business secret" (within the meaning of EU Directive n. 943/2016 on the protection of business) to be kept confidential so that access is limited to specific persons.

In accordance with Art. 60.8 UPCA and Rule 198 RoP, evidence preservation measures will be revoked or cease to effect, at the request of the defendant, if the plaintiffnot bring an action leading to a decision on the merits of the case before the Court within a period not exceeding 31 calendar days or 20 working , daysis longer, from the date of submission of the expert's written report to the Court.

6.4. The written report and any other results of the evidence preservation measures may only be used in the proceedings on the merits, in accordance with rule 196.2 of the RoP.

6.5. Significance.
In view of the need to ensure the effect of surprise, service of the application, together with this order, shall be effected by the applicant at the defendant's premises immediately at the time of enforcement of this order, in accordance with rule 197.2 of the RoP.

6.6. Warranty
In accordance with rules 196.3 and 196.6 of the RoP, the Court orders TIRU to provide appropriate security - also as a condition of enforcement of this order - for the legal costs and other expenses incurred or likely to be incurred by the defendant, by depositing the sum of 10,000 euros.
This Order will only take effect once the applicant has provided a guarantee in the form of a deposit of funds, to be evidenced by 31 December 2024 at the latest.

6.7. Review.
The defendant may request a review of this order in accordance with art. 60.6 UPCA and rule 197.3 RoP.

6.8. Appeal
The parties may appeal within fifteen days of notification this order, in accordance with Article 73.2 (a) of the UPCA and Rule 220.1 of the RoP.

FOR ALL THESE REASONS
THE COURT FIRST INSTANCE - PARIS LOCAL DIVISION

orders that the applicant be authorised to :

- preserve evidence and carry out an on-site inspection at the premises of MAGUIN, located at 2 rue Pierre Semart - 02800, Charmes, France by obtaining:
(a) the physical seizure or photocopying of documents relating to the incineration furnace in question or to any device infringing EP'578 or to the use of this device, and particular any documentation technical and promotional relating to the said furnace, in any format whatsoever
;

(b) a record written of any statement made by a person present at the transaction
and

(d) retaining by printing, copying or photocopying and disclosing digital and data relating to the oven in question or to any device infringing EP'578 or to the use of such device, and disclosing any password required to access it; media and submitting to the Jurisdiction a report written on evidence relating to the infringement of claims 1 to 15 of European Patent EP'578 within 7 days of the measures being carried out.retention measures

-The written report and any other results of evidence preservation measures :
(a) may only be used in the context of the proceedings on the merits of the case ;
(b) shall be accessible to and discussed only by the representatives of the claimant and the representatives of the respondent, in a manner to be determined by the court;

- **Mr Edern TRANVOUEZ, 64 Rue Tique- tonne 75002 Paris ; Email :Edern.tranvouez@brandon-ip.com ; Telephone : 06.62.04.07.53/01.44.91.68.60 ;** is appointed as expert for the enforcement of this order, with the assistance a territorially competent , and an IT expert of his choice;court commissioner

- As representative of the applicant, Mr Olivier ROCHER, Industrial Property Attorney and AttorneyEuropean Patent, Cabinet LAVOIX, 2 Place d'Estienne d'Orves, 75441 Paris cedex 09, France, Email : orocher@lavoix.eu, Telephone: +33 (0) 1 53 20 14 20, is authorised to be present during the execution of this order as regards the preservation of evidence.

- Mr Olivier ROCHER is required to keep secret the facts of which he has knowledge in the context of execution of this order, including with regard to the applicant and his employees.
- The applicant's employee or manager is not authorised to be present during the execution of this order with regard to the preservation of evidence.

- The defendant is ordered to allow designated person to execute this order:

(a) to enter the aforementioned premises or the local premises of the defendant, in order to preserve the evidence determined in the order aforementioned and, in particular, to give him access to the defendant's computer systems;

(b) to take photographs or films for documentary purposes as part of the orderly collection of evidence and to use a dictation machine to take notes;

(c) hand over to the person appointed to enforce this order documents relating to the oven in question or to any device infringing EP'578 or to the use of the said device, and in particular all technical and promotional documentation, in form, relating to the "oven" or to any device infringing EP'578 or to the use of the said device.

- If the defendant does not allow the person designated enforce this order, the designated person is authorised to call in a locksmith or computer specialist to enforce the provisions of this order.

- The police could be present during the execution of this order to ensure the safety of the persons designated in the order.

- The designated expert is ordered to submit to the Registry of the Paris Local Division of the Unified Patent Court a written report on the measures taken to preserve evidence concerning the alleged infringement of patent EP'578, attaching all the documents collected, the required activities have been completed and, in any event, no later than seven days from the date of execution of this order; and also simultaneously to communicate this written report to the representatives of the parties in accordance with the terms of the "circle of confidentiality";

- Access to the expert's written report and its annexes is limited to the representatives of the parties;

- The written report and any other results of the measures to preserve evidence may only be used in the proceedings on the merits ;

- The measures for the preservation of evidence shall be revoked or cease to have effect, at the request of the defendant, if the applicant does not institute proceedings leading to a decision on the merits of the case before the Tribunal within a period not exceeding 31 calendar days or 20 working , daysis the , longerfrom the date of submission of the expert's to the Tribunal;written report

- This order, together with a copy of the application and its exhibits and instructions how onto access the proceedings via the CMS, shall be served by the applicant at the defendant's premises immediately upon execution of this order, in accordance with French law on the service of judicial documents;

- This decision is enforceable subject to payment by the claimant of costs and a deposit of 10,000 euros to be justified before 31 December 2024 ;

- The measures to preserve the evidence and raid the site must be completed by 17 January 2025 at the latest;

- The decision on costs is suspended pending the main proceedings;
- The defendant may request a review of this order within thirty days of the execution of the measures, in accordance with rule 197.3 of the RoP ;

- The parties may appeal within fifteen days of notification of this order, in accordance with art. 73.2 (a) UPCA and R. 220.1 (c), 224.2 (b) RoP.

Rendered in Paris on 23 December 2024.

Signed by
The Presiding Judge, C.LIGNIERES

The Registrar, M. BRASSEUR

DETAILS OF THE ORDER
Order no. ORD_67655/2024 UPC no.:
UPC_CFI_813/2024
Application number : 66560/2024
Type of application: Application for an order to enter the premises under Rules 192 to 199 of the Rules of Procedure