

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 15 July 2025
concerning an application for a review of an order to preserve evidence

HEADNOTES

- (i) When examining an Application for preserving evidence, the Court exercises its discretion by taking into account the urgency of the action (R. 194.2(a) RoP) in order to determine whether, and to what extent, it wishes to hear the defendant (R. 194.1(a) RoP), summon the parties to an oral hearing (R. 194.1(b) RoP), summon the applicant to an oral hearing without the presence of the defendant (R. 194.1(c) RoP), or decide the Application without having heard the defendant (R. 194.1(d) RoP).
- (ii) The time taken by the applicant to file the Application for preserving evidence does not, in the case at hand, cast doubt on the urgency of the action (R. 194.2(a) RoP).
- (iii) It is necessary to distinguish between the assessment of urgency in the context of an Application for preserving evidence (R. 194.2(a) RoP) and the assessment of urgency in the context of an Application for provisional measures (R. 209.2(b) RoP). In exercising its discretion to determine whether provisional measures should be ordered, the Court shall also have regard to any unreasonable delay in seeking provisional measures (R. 211.4 RoP). No such requirement is imposed either by the UPC Agreement or by the Rules of Procedure when assessing whether an Application for preserving evidence should be granted.
- (iv) The risk of the disappearance or unavailability of evidence must be assessed with reference to probability (R. 194.2(c) RoP) or to the demonstrable risk (R. 197.1 RoP) of evidence being destroyed or otherwise ceasing to be available, and not with reference to the certainty of the disappearance or the unavailability of evidence.
- (v) Unlike provisional measures (Part 3 of the Rules of Procedure), for which the Court must, among the required conditions, be satisfied – with a sufficient degree of certainty – that the patent is valid (R. 211.2 RoP), no such criterion is required within the framework of the Court’s discretion to order measures to preserve evidence. When examining an Application for preserving evidence and for inspection of premises, the Court is therefore not required to assess the validity of the patent at issue. This matter remains solely within the competence of the judge ruling on the merits or on provisional measures, except where the presumption of validity can clearly be called into question, for example, following a decision by an Opposition Division or a Board of Appeal of the European Patent Office in a parallel opposition procedure, or in revocation proceedings before another court concerning the same patent.
- (vi) The assessment of the relevance of a prior art document remains, however, within the competence of the judge ruling on the merits or, to a different extent, of the judge competent to decide on applications for provisional measures. Accordingly, it is not for the applicant seeking measures to preserve evidence, at the stage of the application, to identify and disclose prior art of which it may be aware, unless such prior art is, for specific reasons, likely to influence the *ex parte* decision to be taken. Nor is it for the judge responsible for ordering measures to preserve evidence and inspect premises to examine any prior art that may be submitted to them, unless such prior art is, for obvious reasons, likely to influence their decision.

KEYWORDS

Measures to preserve evidence and to inspect premises without hearing the defendant; request for revocation of an order.

APPELLANT (DEFENDANT IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

VALINEA ENERGIE SASU, rue du Champ du Cerf, 25200 Montbéliard, France (hereinafter referred to as “**VALINEA**”) represented by Mr. Gaston VEDEL, Attorney-at-law at the Paris Bar, BDL-IP LEGAL

RESPONDENT (APPLICANT IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

TIRU SAS, 7 rue du Docteur Lancereaux, 75008 Paris, France (hereinafter referred to as “**TIRU**”)
represented by Mr. Cyrille AMAR, Attorney-at-law at the Paris Bar, Amar Goussu Staub

PATENT AT ISSUE
EP 3 178 578

PANEL
Panel 1b, consisting of:

Klaus Grabinski, President of the Court of Appeal,
Emanuela Germano, Legally qualified judge,
Emmanuel Gougé, Legally qualified judge and Judge-rapporteur
Koen Callewaert, Technically qualified judge,
Frédéric Gaillarde, Technically qualified judge,

LANGUAGE OF PROCEEDINGS
French

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- ☐ Order of the Paris Local Division of 24 March 2025 in the main proceedings ACT_66573/2024 UPC_CFI_814/2024
- ☐ Reference numbers:

UPC_CFI_814/2024 ACT_66573/2024
ORD_13139/2025

DATE OF THE HEARING
3 June 2025

SUMMARY OF FACTS AND PROCEDURAL HISTORY

1. TIRU is the proprietor of European patent EP 3 178 578 (hereinafter referred to as the “patent at issue” or “EP’578”), based on an application filed on 8 December 2016, and granted on 1 August 2018. The patent is entitled “Waste Incineration Plant and Process”. It is in force in France, Poland and the United Kingdom. This patent has not been the subject of any opposition proceedings and, as of the date on which the proceedings underlying this appeal were initiated, it had not, according to the parties, been the subject of any legal action seeking its revocation.
2. The patent at issue contains two independent claims: claim 1, which concerns a facility for incinerating waste, and claim 15, which concerns a method for incinerating waste.
3. VALINEA ENERGIE (hereinafter “VALINEA”) operates a waste incineration furnace (hereinafter the “allegedly infringing furnace”) located in Montbéliard (France), and manufactured by the company MAGUIN SAS (hereinafter “MAGUIN”). The allegedly infringing furnace, according to TIRU, implements patent EP’578.

The measures to preserve evidence and inspect premises ordered at first instance

4. On 17 December 2024, prior to any proceedings on the merits concerning patent EP’578, TIRU filed two applications before the Paris Local Division of the Unified Patent Court (hereinafter the “Local Division”) requesting measures to preserve evidence and to inspect premises relating to the allegedly infringing furnace, to be ordered without hearing the defendants (Rules 192.3 and 197 of the Rules of Procedure, hereinafter referred to as “RoP”). One application was filed against VALINEA (ACT_66573/2024 UPC_CFI_814/2024), and the other against MAGUIN (ACT_66560/2024 UPC_CFI_813/2024).
5. By two orders issued on 23 December 2024, the Local Division authorized TIRU to preserve evidence relating to the allegedly infringing furnace and to conduct an on-site inspection at the premises of VALINEA and MAGUIN, along with

several additional measures, including detailed description measures and the physical and digital seizure of documents (TIRU v. VALINEA, ORD_67654/2024 UPC_CFI_814/2024; TIRU v. MAGUIN, ORD_67655/2024 UPC_CFI_813/2024).

6. The measures ordered were carried out on 14 January 2025, simultaneously at the premises of VALINEA (France), where the allegedly infringing furnace is located, and at the premises of MAGUIN (France), followed by the submission of a report by each expert appointed in accordance with Rule 196.4 RoP, and the implementation of confidentiality measures regarding the information obtained during the execution of these measures.
7. TIRU brought two infringement actions before the Local Division on 18 February 2025, against VALINEA (ACT_7950/2025 UPC_CFI_130/2025) and MAGUIN (ACT_7999/2025 UPC_CFI_132/2025).

The application for revocation and the impugned order

8. On 12 February 2025, VALINEA requested, pursuant to Rules 197.3 and 197.4 RoP, the revocation of the order to preserve evidence and to inspect premises issued by the Local Division on 23 December 2024, and, in the alternative, a review of the measures ordered. MAGUIN asserted, in particular: (i) the lack of urgency justifying the measures granted, (ii) the absence of any risk of disappearance or destruction of the evidence, and (iii) TIRU's failure to comply with its duty of candour by withholding information likely to influence the granting of *ex parte* measures (App_10546/2025 UPC_CFI_814/2024).
9. The Local Division ordered the dismissal of the request for revocation of the order issued on 23 December 2024 (order of 24 March 2025, ORD_13139/2025 ACT_66573/2024 UPC_CFI_814/2024, hereinafter "the impugned order") and in particular noted the following:
 - (i) No lack of candour can be imputed to TIRU with regard to the alleged withholding of information concerning its supposed knowledge of the features of a furnace dating from 1987, located on VALINEA's premises – information which might cast doubt on the validity of the patent at issue due to a lack of novelty and, consequently, might have influenced the granting of the *ex parte* measures.
 - (ii) The risk of evidence being destroyed as justification for an *ex parte* measure is sufficiently demonstrated; it is not necessary to establish certainty of the disappearance of the evidence (R. 197.1 RoP). The operations must be carried out simultaneously at the premises of MAGUIN and VALINEA – respectively the manufacturer and the operator of the allegedly infringing furnace – given the clear links between the parties subject to the measures and their aligned interests, in order to ensure the effectiveness of the measures to preserve evidence. As regards the risk of loss of digital data, such risk is assessed globally by the judge in light of the imminent risk of the furnace being put into operation and the risk of loss of technical documentation that may be stored digitally at VALINEA's premises.
 - (iii) The absence of urgency justifying the granting of the measures ordered has not been established. TIRU did not delay in requesting the measures sought. TIRU submitted the reasonably accessible evidence within two months of obtaining it (see bailiff's report dated 11 October 2024 noting the existence of a video on the YouTube platform showing images of the allegedly infringing furnace and indicating that the furnace would be put into service in the first quarter of 2025).

The appeal proceedings

10. VALINEA lodged an appeal against the impugned order (PC_CoA_002/2025).
11. VALINEA requests the Court to (i) overturn the impugned order on the request for review of an *ex parte* order, (ii) revoke the impugned order in its entirety, (iii) order the restitution to VALINEA of all items seized during the operations for the preservation of evidence (saisie) and inspection of premises conducted on 14 January 2025, and (iv) order TIRU to pay VALINEA the full amount deposited as security and to reimburse VALINEA for the costs incurred as a result of the measures to preserve evidence and to inspect premises.
12. The arguments submitted by VALINEA in its Statement of grounds of appeal focus primarily on the following points:
 - (i) The non-adversarial nature of the request for inspection measures submitted by TIRU is not justified. In the absence of a proven risk of evidence being destroyed or ceasing to be available, there is no reason to depart from the principle of an adversarial procedure. According to VALINEA, the possibility of *ex parte* measures in

accordance with the provisions of Art. 60(5) UPCA and R. 197.1 RdP constitutes an exception to the general principle of an adversarial procedure and must therefore be interpreted strictly. TIRU does not substantiate the existence of a significant risk that evidence concerning the operation of the allegedly infringing furnace would no longer be available and impossible to obtain. Furthermore, the Court of First Instance should have set out the particular disadvantages that would have arisen from authorising the operations in an adversarial setting. With regard more specifically to the risk of digital documents and data being destroyed or ceasing to be available, this is not substantiated by TIRU either.

- (ii) TIRU failed in its duty of candour by not informing the Local Division, when submitting its *ex parte* application for measures to preserve evidence, of the existence of prior art (the “Laurent Bouillet” furnace) which is prejudicial to the novelty of the independent claims (claims 1 and 15) and most of the dependent claims (at least claims 2 to 9) of patent EP’578, which VALINEA claims constitutes prior art for the entire patent EP’578. VALINEA refers to the long-standing relationship between TIRU and the designer of the “Laurent Bouillet” furnace, such that, in its view, TIRU could not have been unaware of this prior art and was familiar with its characteristics.
- (iii) TIRU, which was aware of the call for tender launched in 2021, at the end of which the allegedly infringing furnace was delivered and installed, and considering the public information available since August 2024, necessarily had knowledge of the installation of the allegedly infringing furnace and its technical characteristics as early as August or September 2024, so that the submission of a request in December 2024 is late and does not meet the requirement of urgency (R. 194.2(a) RoP).

13. TIRU, in its Statement of response, requests the Court to:

- dismiss all of VALINEA’s claims in their entirety;
- uphold the order of 24 March 2025 issued by the Local Division (ORD_13139/2025);
- order VALINEA to pay the amount of €38,000 to TIRU in respect of legal costs, subject to adjustment in accordance with the applicable scale in force on the date of the decision.

14. The arguments presented by TIRU in its Statement of response focus primarily on the following points:

- (i) The *ex parte* measures ordered are justified, and the impugned order complies with the principles of effectiveness and proportionality, as it enabled TIRU to promptly obtain the missing evidence while narrowing the scope of the initial investigations and framing the measures ordered with sufficient security for VALINEA.
- (ii) The urgency of the action justifies the issuance of the measures on an *ex parte* basis:
 - The time periods allocated to *inter partes* proceedings would not have allowed for an inspection of the allegedly infringing furnace before its scheduled entry into service at the beginning of 2025, whereas the search for evidence required an examination of the furnace while it was shut down and not in operation. During the furnace’s normal operation period, such an inspection would have necessitated several days of downtime of the facility;
 - The search for evidence could not have been conducted solely on the basis of documentary research, as such elements alone were insufficient to establish that infringement had indeed taken place;
 - The simultaneous execution of the evidence preservation operations at the premises of MAGUIN and VALINEA was necessary, particularly in order to prevent the risk that evidence held by MAGUIN might disappear if it had been informed, prior to the execution of the measures to preserve evidence at its premises, that such measures were likely to be carried out against it.
 - As soon as it became aware of elements suggesting a likely infringement of patent EP’578, namely, the YouTube video referenced in the official report of 11 October 2024 (TIRU Exhibit no. 10), which contained indications regarding certain technical features of the allegedly infringing furnace, TIRU prepared its Application for preserving evidence (*saisie*) and for inspection of premises. This Application was submitted within two months of that date, which is far from constituting any culpable delay.
- (iii) The risk of the disappearance or unavailability of evidence, particularly digital evidence concerning MAGUIN, justified the issuance of the measures without MAGUIN and VALINEA being heard.
- (iv) Regarding the alleged lack of candour (R. 192.3 RoP), TIRU argues that the judge ruling on an application for preserving evidence is not competent to rule on the validity of the patent; therefore, arguments relating to patent validity are not likely to influence the decision to issue the requested order without hearing the defendant. Accordingly, TIRU rejects the invalidity arguments based on lack of novelty raised by VALINEA, which rely on a prior patent (Laurent Bouillet patent, FR 2350136, cited in the prior art section of the patent at issue

at para. [0003]) and on the technical documentation relating to the original furnace dating from 1987 (the so-called 'Laurent Bouillet' furnace), which was covered by a confidentiality agreement.

GROUNDING FOR THE ORDER

15. The appeal is admissible but rejected.

Admissibility

16. In accordance with R. 220.1(c) RoP, an appeal by a party adversely affected may be brought against orders referred to in Art. 60 UPCA, which concern the preservation of evidence and the inspection of premises.
17. The impugned order concerns measures to preserve evidence and inspect premises issued against VALINEA and affects the latter. The appeal is therefore admissible on this basis.

Measures to preserve evidence and inspect premises

18. According to Art. 60 UPCA, at the request of the applicant which has presented reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed the Court may, even before the commencement of proceedings on the merits of the case, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information (Art. 60(1) UPCA).
19. According to Art. 60(5) UPCA, measures shall be ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed.
20. These provisions of the UPCA are supplemented by those of the Rules of Procedure of the UPC, under Part 2 (Evidence), Chapter 4, which concerns orders to preserve evidence (saisie) and orders for inspection (Rules 192 to 199 RoP).
21. An Application for preserving evidence (R. 192 RoP) may be lodged before or during the proceedings on the merits. At the request of the applicant, the measures may be ordered without hearing the other party (hereinafter "the defendant"), in which case the application must set out the reasons for not hearing the defendant having regard in particular to Rule 197 (R. 192.3 RoP, first sentence). In this case, the applicant has a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant (R. 192.3 RoP, second sentence).
22. When examining the Application for preserving evidence (R. 194 RoP), the Court shall have the discretion - including where the Application is made pursuant to R. 192.3 RoP - notably to inform the defendant about the Application or to decide the Application without having heard the defendant (R. 194.1(d) RoP). In exercising its discretion, the Court shall take into account: (a) the urgency of the action; (b) whether the reasons for not hearing the defendant [Rules 192.3 and 197] appear well-founded; (c) the probability that evidence may be destroyed or otherwise cease to be available [Rule 197] (R. 194.2 RoP).
23. Finally, in the case of an order to preserve evidence issued without hearing the defendant, the Court may order measures to preserve evidence [R. 196.1] without the defendant having been heard, in particular where any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed or otherwise ceasing to be available (R. 197.1 RoP).
24. These provisions are to be read in conjunction with those of Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights (hereinafter 'Directive 2004/48'), in particular Article 7 concerning measures for preserving evidence, which provides that, even before the commencement of proceedings on the merits of the case, measures to preserve evidence must be capable of being ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed.

25. The application of these provisions must be carried out in accordance with the general principles set out in the UPC Agreement and the Rules of Procedure, as well as in the aforementioned Directive, and in particular with the principles of proportionality and efficiency.
26. Pursuant to the aforementioned texts, the Court of First Instance may exercise discretion, particularly when examining an Application for preserving evidence (R. 194 RoP). In that context, it is for the Court of Appeal to determine whether the limits of this discretionary power have been exceeded or whether the Court of First Instance, in exercising this discretion, has made an error of law.

The urgency of the requested (ex parte) measures

27. When examining an Application for preserving evidence, the Court exercises its discretion by taking into account the urgency of the action (R. 194.2(a) RoP) in order to determine whether, and to what extent, it wishes to hear the defendant (R. 194.1(a) RoP), summon the parties to an oral hearing (R. 194.1(b) RoP), summon the applicant to an oral hearing without the presence of the defendant (R. 194.1(c) RoP), or decide the Application without having heard the defendant (R. 194.1(d) RoP).

In exercising its discretion, the Court examines the reasons why the proposed measures are needed to preserve relevant evidence (R. 192.2(c) RoP), as well as the facts and the evidence relied on in support of the Application (R. 192.2(d) RoP).

28. The necessity of the ordered measures must be assessed in light of the circumstances prevailing at the time the impugned order is issued.
29. In the present case, TIRU submitted, in its Application for preserving evidence, certain elements (in particular, Exhibit no. 10 submitted by TIRU, a YouTube video presenting the allegedly infringing furnace) which support the finding that certain features of the allegedly infringing furnace, notably the means for supplying combustion and/or cooling air, as well as the circulation of air within the hollow envelope of the furnace, likely reproduced claims 1 to 15 of European Patent EP'578.
30. TIRU also reported, based on the information presented in the aforementioned YouTube video, that the allegedly infringing furnace was scheduled to be put into service in the first quarter of 2025 – an assertion which is not disputed by VALINEA. This entry into service involved a heat-up phase beginning in January 2025, which was moreover confirmed by the appointed expert (Mr. Sartorius), who was tasked with inspecting the allegedly infringing furnace at VALINEA's premises. During the execution of his assignment on 14 January 2025, he reported that the measures to preserve evidence and inspect the premises were carried out the day before the initial testing of the allegedly infringing furnace, which was scheduled to begin on 15 January 2025 (TIRU Exhibit no. 21, p. 2).
31. Under these circumstances, given that the measures to preserve evidence required an inspection of the interior of the furnace, requested descriptive seizure would have been impossible once the furnace had been brought online. Only a shutdown of the incineration furnace for several days would have allowed the court-ordered measures to be carried out, given the need for immobilisation that made a short-term shutdown of the facility unlikely.
32. In light of the foregoing, the urgency of the requested measures without hearing the defendant was duly demonstrated by TIRU, given the need to carry out an inspection of the allegedly infringing furnace.
33. The effectiveness of the requested measures also required that access to, and preservation of, the technical documentation relating to the operation of the disputed furnace, or to any device infringing patent EP'578, or to the use of said device, including in digital format, be ordered simultaneously at the premises of both VALINEA and MAGUIN.
34. Contrary to VALINEA's assertions, the time taken by TIRU to file the Application to preserve evidence does not cast doubt on the urgency of the action (R. 194.2(a) RoP). The decisive element that led TIRU to suspect that the features of its patent EP'578 had indeed been reproduced by the allegedly infringing furnace is the YouTube video recorded in the official report dated 11 October 2024 (TIRU Exhibit no. 10). Considering that the two-month period which followed, in order to allow TIRU to prepare and file its applications before the Local Division on 17 December 2024, appears

necessary in light of the circumstances of the case (see impugned order, para. 35), the Local Division did not exceed the limits of its discretion.

35. In this respect, it is necessary to distinguish between the assessment of urgency in the context of an Application for preserving evidence (R. 194.2(a) RoP) and the assessment of urgency in the context of an Application for provisional measures (R. 209.2(b) RoP). In exercising its discretion to determine whether provisional measures should be ordered, the Court shall also have regard to any unreasonable delay in seeking provisional measures (R. 211.4 RoP). No such requirement is imposed either by the UPC Agreement or by the Rules of Procedure when assessing whether an Application for preserving evidence should be granted.
36. In application of the foregoing, the Court made proper use of its discretion in assessing the urgency of the requested measures and, in view of the specific facts of the case, duly justified its decision to depart from the principle of *inter partes* proceedings.

The risk of destruction or unavailability of evidence

37. The risk of the destruction or unavailability of the evidence, as a criterion for assessing the merits of *ex parte* measures (R. 194.2(c) and 197.1 RoP), concerns both access to the allegedly infringing furnace and the associated technical documentation. The assessment of the risk in question must be based on the probability (R. 194.2(c) RoP) or the demonstrable risk (R. 197.1 RoP) of evidence being destroyed or otherwise ceasing to be available, and not on the certainty of its disappearance or unavailability.
38. With regard to the allegedly infringing furnace, the Local Division rightly exercised its discretion in considering that putting it into operation would have made it extremely difficult to carry out the measures. As the preservation of evidence required access to the interior of the allegedly infringing furnace, such evidence would no longer have been available – unless a complete shutdown of the furnace was scheduled (which undisputedly requires several days of facility downtime), or only during the next scheduled maintenance period.
39. With regard to the technical documentation, the Local Division did not exceed the limits of its discretion in considering that the risk of its destruction could not be ruled out if the measures concerning MAGUIN had not been ordered simultaneously with those issued against VALINEA. Moreover, the fact that the allegedly infringing furnace is operated under a public service concession, which, according to VALINEA’s unsubstantiated claims, would require the technical documentation to be made available to the public authority granting the concession and returned at the end of the concession, is not sufficient to rule out the risk of destruction or unavailability of the evidence.

The applicant’s duty of candour when submitting the application

40. Where the applicant requests that measures to preserve evidence be ordered without hearing the other party (hereinafter “the defendant”), the Application for preserving evidence shall set out the reasons for not hearing the defendant having regard in particular to Rule 197 (R. 192.3 RoP, first sentence). The applicant shall be under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant (R. 192.3 RoP, second sentence).
41. The applicant must therefore, in its application, bring to the attention of the Court the relevant facts relating to the criteria the Court must consider in ruling on the application, namely: (a) the urgency of the action; (b) whether the reasons for not hearing the defendant appear well-founded; (c) the probability that evidence may be destroyed or otherwise cease to be available (R. 194.2 RoP).
42. Unlike provisional measures (Part 3 of the Rules of Procedure), for which the Court must, among the required conditions, be satisfied – with a sufficient degree of certainty – that the patent is valid (R. 211.2 RoP), no such criterion is required within the framework of the Court’s discretion to order measures to preserve evidence. When examining an Application for preserving evidence and for inspection of premises, the Court is therefore not required to assess the validity of the patent at issue. This matter remains solely within the competence of the judge ruling on the merits or on provisional measures, as rightly pointed out by the Local Division in the impugned order (para. 18), except where the presumption of validity can clearly be called into question, for example, following a decision of an Opposition Division or a Board of Appeal of the European Patent Office in a parallel opposition procedure, or in revocation proceedings before another court in respect of the same patent.

43. Accordingly, TIRU cannot be faulted for not addressing the validity of its patent at the stage of submitting the requested measures, in anticipation of a hypothetical future debate on the merits. This is all the more true given that VALINEA has neither demonstrated that the patent at issue has been the subject of an opposition procedure before the European Patent Office, nor that it has been challenged through legal proceedings seeking its revocation. Nor does VALINEA provide any evidence of possible exchanges (letters, meeting reports, or otherwise) between itself and TIRU alerting the latter to the alleged invalidity of its title. Accordingly, MAGUIN has not established that TIRU was aware of any risk concerning the validity of its patent that could constitute a “material fact” which might influence the Court in deciding whether to make an order without hearing the defendant (R. 192.3 RoP).
44. The prior facts which, according to VALINEA, should have been brought to the Court’s attention when TIRU submitted its Application, are, in reality, items of information that were not required to be disclosed to TIRU under R. 192.3 RoP.
45. They consist mainly of: (i) a prior patent cited in the patent at issue, and (ii) technical specifications relating to the former incineration furnace that was replaced by the allegedly infringing furnace at the same operating site.
46. The prior patent FR 2 350 136, filed on 5 May 1976, was cited in the patent at issue at paragraph [0003] as an example of known prior art relating to oscillating furnaces designed for the combustion of solid waste with variable energy characteristics. Aside from the fact that this question pertains to a substantive discussion regarding the assessment of the validity of the patent, a document expressly cited in the patent at issue cannot be regarded as one that must be disclosed under the duty of candour set out in R. 192.3 RoP.
47. With regard to the former incineration furnace, dating from 1987 and referred to by the parties as the “Laurent Bouillet” furnace (MAGUIN exhibit no. 22), VALINEA claims that it teaches the features of the patent at issue, a claim contested by TIRU. The assessment of the relevance of a prior art document remains, however, within the competence of the judge ruling on the merits or, to a different extent, of the judge competent to decide on applications for provisional measures. Accordingly, it is not for the applicant seeking measures to preserve evidence, at the stage of the application, to identify and disclose prior art of which it may be aware, unless such prior art is, for specific reasons, likely to influence the *ex parte* decision to be taken. Nor is it for the judge responsible for ordering measures to preserve evidence and inspect premises to examine any prior art that may be submitted to them, unless such prior art is, for obvious reasons, likely to influence their decision.
48. The mere fact that TIRU was aware of the existence of the Laurent Bouillet furnace – the public accessibility of which is disputed – is not sufficient to establish that its features, which VALINEA claims may anticipate patent EP’578, constitute a “material fact” (R. 192.3 RoP) that TIRU had a duty to disclose at the time of its Application. Notwithstanding VALINEA’s detailed arguments regarding the lack of novelty of patent EP’578, it has not demonstrated any specific circumstance that would justify requiring TIRU to disclose the existence and features of the Laurent Bouillet furnace.
49. It follows from the foregoing that VALINEA fails in its application for the revocation of the impugned order.

Reimbursement of costs

50. As this order does not bring the proceedings to a close, it is not for the Court of Appeal to rule on the reimbursement of the costs incurred by the parties in the present order.

ON THESE GROUNDS

The Court of Appeal rejects the appeal.

Order issued in Luxembourg on 15 July 2025

On behalf of the President of the Court of appeal Klaus Grabinski, in his absence

Emmanuel Gougé, Legally qualified judge and Judge-rapporteur

Emanuela Germano, Legally qualified judge,

Koen Callewaert, Technically qualified judge,

Frédéric Gaillarde, Technically qualified judge.