



Divisione Locale di Milano

ORDINANZA
del Tribunale Unificato dei Brevetti
Tribunale di primo grado
Divisione Locale di Milano
depositata il 15.7.2025

ACT. n. 64443/2024
UPC CFI n. 771/2024

TIPO DI AZIONE: contraffazione
App. n. 24226/2024

TIPO DI DOMANDA: 365 ROP
ordinanza n. 24978/2025

RICORRENTE

PIRELLI TYRE s.p.a.

RESISTENTI

- KINGTYRE DEUTSCHLAND GMBH**
- TIANJIN KINGTYRE GROUP CO., LTD.**

Brevetto In Discussione

Brevetto n.	Titolare
EP2519412	Pirelli Tyre s.p.a.

COMPOSIZIONE DEL COLLEGIO

Presidente	Pierluigi Perrotti
Giudice estensore	Alima Zana
Giudice a latere	Marije Knijff

LINGUA DEL PROCEDIMENTO

Italiano

Le vicende processuali

1. In data 5 dicembre 2024, Pirelli Tyre s.p.a. (di seguito solo Pirelli) ha promosso dinnanzi a questa Divisione Locale del Tribunale Unificato dei Brevetti un giudizio di merito nei confronti di Kingtyre Deutschland GmbH e Tianjin Kingtyre Group Co., Ltd. per la contraffazione del brevetto n. EP2519412.
2. Nelle more del giudizio, Pirelli e Kingtyre Deutschland GmbH hanno sottoscritto un accordo transattivo (“Accordo Transattivo”), efficace dal 25 Febbraio 2025, volto a comporre bonariamente la controversia tra loro intercorsa, allegato sub doc. 41.
3. Alla luce degli obblighi assunti da Kingtyre Deutschland GmbH nell’Accordo Transattivo, secondo quanto ivi stabilito, Pirelli si è resa disponibile a rinunciare alle domande proposte nel presente giudizio nei confronti di Kingtyre Deutschland GmbH (senza pregiudizio per le domande proposte nei confronti di Tianjin Kingtyre Group Co., Ltd. con la quale nessun accordo è intercorso e nei cui confronti, pertanto, le domande di Pirelli sono integralmente confermate).
4. Pirelli ha dunque chiesto al Tribunale di:
 - I. di confermare l’Accordo Transattivo raggiunto tra Pirelli Tyre S.p.A. e Kingtyre Deutschland GmbH sub doc. 41, ai sensi della Rop 365, senza pronuncia sulle spese di lite tra dette parti, essendo il profilo in questione già regolato nell’Accordo Transattivo;
 - II. di mantenere, ai sensi della Rop 365 §2, confidenziale l’importo versato da Kingtyre Deutschland GmbH a Pirelli per il ristoro dei danni subiti e il rimborso delle spese legali indicato all’art. 9 dell’Accordo Transattivo;
 - III. di accogliere tutte le domande svolte da Pirelli Tyre S.p.A. nei confronti di Tianjin Kingtyre Group co., Ltd. Indicate nell’atto di citazione;
 - IV. di disporre, ai sensi della Rop 370.9 (c)(i), il rimborso delle Court Fees versate da Pirelli per il presente giudizio, nella somma ritenuta adeguata dal Tribunale, essendo l’Accordo Transattivo intervenuto prima della chiusura della procedura scritta.
5. Nessuno, nel frattempo, si è costituito per Kingtyre Deutschland GmbH.
6. Pirelli, su richiesta del Giudice relatore (cfr. ORD n. 24978/2025), ha confermato che il documento contenente l’accordo transattivo è già predisposto al documento n. 41 nella forma della cd. *redacted version*.

Motivi della decisione

7. La presente decisione viene assunta sulla base delle RoP e della giurisprudenza del Tribunale.
In particolare:
 - La regola 365.1 del RoP recita:

“1. Where the parties have concluded their action by way of settlement, they shall inform the judge rapporteur. The Court shall confirm the settlement by decision of the Court [Rule 11.2], if requested by the parties, and the decision may be enforced as a final decision of the Court”.

- La regola 11.2 del RoP recita:

«2. Pursuant to Rule 365 the Court shall, if requested by the parties, by decision confirm the terms of any settlement or arbitral award by consent (irrespective of whether it was reached using the facilities of the Centre or otherwise), including a term which obliges the patent owner to limit, surrender or agree to the revocation of a patent or not to assert it against the other party and/or third parties”.

8. Nel caso di specie, le parti hanno concluso un accordo transattivo in data 25.2.2025 ponendo fine al contenzioso tra loro.

La Corte non ha obiezioni a confermare tale accordo transattivo, che è allegato alla presente ordinanza.

Sulle spese

9. Per quanto riguarda le spese, la rule 365.4 RoP recita: *“4. The judge-rapporteur shall give a decision as to costs in accordance with the terms of the settlement or, failing that, at his discretion”.*

La rule 11.2 RoP infine recita: *“The parties may agree on costs to be awarded or may request the Court to decide on costs to be awarded in accordance with Rules 150 to 156 mutatis mutandis”.*

10. Nel caso di specie, l’attore ha precisato di aver concordato sulle spese e non ha chiesto alcuna decisione al riguardo.

La riservatezza dei dettagli della transazione

11. Ai sensi della rule 365.2 RoP, alcuni dettagli della transazione sono riservati su richiesta delle parti.

Qui Pirelli ha chiesto che rimanga riservato l’importo versato da Kingtyre Deutschland GmbH a Pirelli per il ristoro dei danni subiti e il rimborso delle spese legali indicato all’art. 9 dell’Accordo Transattivo.

12. La domanda merita senz’altro accoglimento.

Court Fees

13. Parte attrice ha chiesto il rimborso delle Court Fees.

Il Tribunale richiama quanto precisato dalla rule 370.9(c) RoP: *“If the parties have concluded their action by way of settlement the party liable for the Court fees will be reimbursed by: (i) 60 % if the action is settled before the closure of the written procedure”.*

14. Nel caso, in esame, il Tribunale ritiene che - essendo la causa stata promossa contro due convenuti e che le Court Fees vadano ripartite al 50% - il rimborso del 60% previsto dalla disposizione sopra citata vada calcolata sul 50%.

Le Court Fees da restituire ammontano dunque al 30% del totale.

Alla luce delle considerazioni sopra esposte, Il Tribunale adotta la seguente

ORDINANZA

1. conferma l'accordo transattivo concluso il 25 febbraio 2025 tra Pirelli Tyre s.p.a. e Kingtyre Deutschland GmbH, ferma la prosecuzione della lite tra Pirelli Tyre s.p.a. e Tianjin Kingtyre Group Co., Ltd.;
2. l'accordo transattivo nella forma *redacted* - ove sono oscurati i dati di cui al paragrafo n. 11- è allegato in calce alla decisione;
3. dispone che la versione *unredacted* della transazione rimanga riservata;
4. dà atto che le parti si sono accordate sulle spese e non chiedono alcuna condanna alle spese;
5. dispone il rimborso delle Court Fees per il 30% del totale a favore di Pirelli Tyre spa.

Così deciso in Milano, il 15 luglio 2025

Il Presidente

Pierluigi Perrotti

Il giudice estensore

Alima Zana

Il giudice giuridicamente qualificato

Marije Knijff

Il Cancelliere

* * * * *

SETTLEMENT AGREEMENT

This settlement agreement (hereinafter the **"Agreement"**) is effective as of 25 February 2025 (hereinafter the **"Effective Date"**)

Between

Pirelli Tyre S.p.A., with registered office in Viale Piero e Alberto Pirelli 25, 20126 Milano (MI), Italy, Tax n. and VAT registration n. 07211330159, represented by its legal representative (hereinafter **"Pirelli"**);

- on one side -

and

Kingtyre Deutschland GmbH, with registered office in Schulstraße 33, 71155, Altdorf, Germany, represented by its legal representative (hereinafter, **"Kingtyre"**);

- on the other side -

hereinafter, also individually the **"Party"** and jointly, **"Parties"**.

Whereas

- A. Pirelli is a worldwide famous company in the field of tyres and rubber industry.
- B. Pirelli is the owner of the European patent No. EP2519412, titled "motorcycle tyre and pair of motorcycle tyres", which claims Italian priority no. IT2009RM00688, validated in Italy, Germany, France and UK, as well as of the corresponding patents in the United States, Brazil, Japan and China (hereinafter, jointly or severally, the **"Patents"**; and Italy, Germany, France, UK, US, China, Brazil and Japan, collectively, the **"Territories"**).
- C. On 30 October 2024, Pirelli filed an application for provisional measures without hearing the defendant pursuant to Art. 62 of the Unified Patent Court Agreement and RoP 212 against, among the others, Kingtyre before the Milan local division of the Unified Patent Court, claiming that the tyre products depicted in **Exhibit A** (jointly and severally, the **"Tyre"**) infringe the Patents. The registry attributed to the case the action number No. 59322/2024 (UPC CFI 650/2024).
- D. The Milan local division of the Unified Patent Court (single judge, Alima Zana) issued on 5 November 2024 the order no. 59764/2024, granting Pirelli, without the defendant

being heard, the seizure of the Tyre and of any related promotional material at the EICMA fair (the "Order").

- E. The Order has been enforced on 6 November 2024 at the EICMA fair, where promotional material regarding the Tyre has been seized.
- F. On 5 December 2024, Pirelli started an infringement proceeding on the merit before the Milan local division of the Unified Patent Court against, among the others, Kingtyre.
- G. Following further correspondence, the Parties agreed to amicably settle the dispute at the terms and conditions of this Agreement.

In light of the above recitals, the Parties hereinafter agree as follows.

1. The recitals are integral and substantial parts of this Agreement.
2. Kingtyre acknowledges the validity and effectiveness of the Patents and hereby undertakes and agrees not to, directly or indirectly, pursue any invalidation proceedings against, or otherwise challenge, any of the Patents before any competent administrative or judicial authority.
3. Kingtyre hereby represents and warrants to have ceased to manufacture, export, import, promote, distribute, offer for sale and sale, in the Territories, directly or indirectly, also through intermediaries, resellers and distributors, licensees or any authorized party, whether in its own name (including as a member of other entities), or in the name of a third party acting on behalf of Kingtyre, i) the Tyre and ii) any other product which reproduces the features claimed in the Patents.
4. Kingtyre represents and warrants that, at the Effective Date, Kingtyre has i) withdrawn from any third party, including resellers and distributors, the Tyres as well as any hard copy of marketing and promotional material of the Tyre, including catalogues and correspondence, available in the Territories; ii) removed said material from any digital means, including the Internet and Google indexing, and iii) destroyed such marketing and promotional material of the Tyres under items i) and ii).
5. Kingtyre will inform by no later than 3 days from signature of this Agreement its resellers and distributors to refrain from any promotion and offer for sale in the Territories of i) the Tyre and ii) any other product which reproduces the features claimed in the Patents and will procure that its resellers and distributors adopt any measures or actions for Kingtyre to comply with its obligations under Section 4.

6. Kingtyre will provide Pirelli, by no later than 5 days from the signature of this Agreement, with i) No. 3 samples for each type/product category of the Tyres (3 front and 3 rear), and ii) all relevant documents and data concerning the import and commercialization of the Tyres in the Europe (including copy of all the invoices issued and received, import-travel accompanying documentation, etc.) and of the import and distribution chain of the Tyres in Europe. The samples of Tyres shall be sent to Pirelli at the following address: **Pirelli Tyre S.p.A. Magazzino R&D piano -2**, Via Chiese, no. 51, 20126, Milano (MI), Italy, at the attention of Mr. Muniz Fabio Guerra. By no later than 10 days from the date of Pirelli's receipt of such Tyres and upon Pirelli's notice, Kingtyre undertakes and agrees to destroy, at its own care and expense and with the participation of a Pirelli's employee if requested by Pirelli, the remaining Tyres.
7. From the Effective Date, Kingtyre hereby undertakes not to manufacture, import, export, market, sell, offer for sale, distribute, promote, advertise, somehow use and/or exploit, directly or indirectly, also through intermediaries, resellers and distributors, licensees or any authorized party, whether in its own name (including as a member of other entities) or in the name of a third party acting on behalf Kingtyre, i) the Tyre, and ii) any other product which reproduces the features claimed in the Patents.
8. A penalty of Euro 5.000 will be paid by Kingtyre upon request of Pirelli for each item of either i) the Tyre, or ii) any other product which reproduces the features claimed in the Patents manufactured, imported, exported, sold, offered for sale, distributed, marketed, promoted, advertised, somehow used and/or exploited directly or indirectly by Kingtyre in breach of any of the provisions of this Agreement, without prejudice to Pirelli's rights to claim compensation for any additional damage and to take any other action to assert its rights and protect its interests to the maximum extent permitted by law and this Agreement.
9. Upon execution of this Agreement Kingtyre will pay Pirelli the amount of EUR [REDACTED] as settlement amount for the compensation of damages suffered by Pirelli and the reimbursement of Pirelli's legal costs.
10. Unless otherwise agreed in this Agreement, any payment under this Agreement shall be made by telegraphic transfer by no later than 5 days from Pirelli's request to the bank account designated in writing by Pirelli. All banking charges relating to such remittance shall be borne by Kingtyre. All payments are net of any taxes, duties and other assessments. All taxes, duties and other assessments imposed by any governmental authority on the existence and operation of this Agreement and on any sums payable to Pirelli hereunder, except income taxes imposed upon Pirelli by Italian governmental authorities, shall be paid or reimbursed by

Kingtyre. In the event that the laws applicable to Kingtyre provide for any compulsory withholding tax on the sums due and payable to Pirelli hereunder, the related amounts shall be correspondingly increased to result in a net payment in the amount stated in this Article. If Kingtyre is required to apply a withholding tax, Kingtyre shall apply that withholding tax and any payment required in connection with that withholding tax within the time allowed and in the amount required by law. Within 30 (thirty) days of applying a withholding tax (and, whether applicable, making any payment required in connection with that withholding tax), Kingtyre shall provide Pirelli with evidence reasonably satisfactory to Pirelli that the withholding tax has been applied and paid to the relevant tax authority.

11. Kingtyre declares it has nothing to claim against Pirelli in connection with the facts and circumstances described in this Agreement. As a result of the full compliance with the obligations set forth by this Agreement by Kingtyre, and without prejudice to Pirelli's right to raise any claim against Tianjin Kingtyre Group Co., Ltd., including for the Tyres sold to Kingtyre in Germany, Pirelli will withdraw its claims in connection with the facts and circumstances described in this Agreement, including the claims brought against Kingtyre in the infringement proceeding on the merit pending before the Milan local division of the Unified Patent Court. In case of non-compliance with any provision of this Agreement by Kingtyre, Pirelli will have the right to enforce the provisions of this Agreement in addition to any claims related to the facts and circumstances described in this Agreement.
12. **The invalidity or ineffectiveness of any provision of this Agreement shall not affect the validity and enforceability of any other provision hereof. Any such invalid or unenforceable provision shall be modified to the extent and in the sense necessary for it to be valid and enforceable in accordance with the presumed common intention of the Parties.**
13. Any amendment to this Agreement shall be agreed to in writing and shall be evidenced by a document signed by or on behalf of the Party against whom the amendment is invoked.
14. Any delay or omission by either Party in asserting any right or exercising any power vested in it hereunder shall in no event be construed as a waiver or relinquishment of such right or power at a later date.
15. This Agreement shall inure to the benefit of and be binding upon both Parties hereto and their respective successors in interest, officers, directors, agents, servants, partners, employees, Affiliates, subsidiaries, representatives, distributors, licensees, franchisees, successors, heirs, assigns, purchasers and other related entities (jointly, the **"Third Parties"**). **"Affiliate"** of a Party means any entity that directly or indirectly controls, is controlled by, or is

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Erstellt: 25.02.2025
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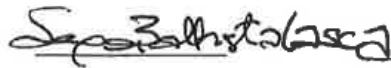
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under common control with that Party or is affiliated with said Party, pursuant to Art. 2359 of the Italian civil code.

16. This Agreement is neither novative nor confidential in nature.

17. For the sake of clarity Pirelli reserves any and all intellectual property rights, other than the Patents, held or which in the future may be held by Pirelli.

18. This Agreement shall be governed by and construed and interpreted in accordance with the laws of Italy without reference to any conflict law rules. The Parties hereby submit to the exclusive jurisdiction of the Court of Milan, Italy, any dispute arising from and/or otherwise in connection with this Agreement.



PIRELLI TYRE S.p.A.

For acceptance



Kingtyre Deutschland GmbH

Exhibit A


KINGTYRE

Casa Chi Siamo Prodotti Notizie Esposizione Contattaci Inchiesta

Keywords

Casa > Prodotti > SPORT

PERCORSO
CITTA
DA CORSA
SPORT
PERSONALIZZATO
K90



Kingtyre Radial Tyres High Speed K902

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RACING
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Motorcycle Radial Tyre-Slick Racing Grade W

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28.02.2025 - Altdorf

H. Folz