UNIFIED PATENT COURT
COURT OF FIRST INSTANCE
LOCAL DIVISION OF MILAN

UPC CFI No. 127/2025

ORDER ON THE REQUEST FOR REVIEW
OF THE ORDER FOR THE PROTECTION OF EVIDENCE, INSPECTION AND SEIZURE
issued on 27 October 2025

NOTES

1. For the purposes of granting, *without hearing the other party,* the measure provided for in Articles 60 UPCA and Rules 192 et seq. RoP, namely inspection, preservation of evidence and seizure, the Court's assessment is necessarily *ex ante* and does not require, in concrete terms, proof of -certain- destruction, as it is a sort of *probatio diabolica,* the concrete statistical possibility of evidence tampering being sufficient.

2. The procedural correctness of the patent holder in urgent applications pursuant to Article 60 UPCA and Rules 192 et seq. RoP must be investigated with regard to the exclusive right being enforced before the Court and the circumstances that could affect the validity of the patent itself. The reference to the inter-proceedings followed for the granting of the corresponding US patent, which is a different title, not only in terms of territorial scope, appears irrelevant.

3. 'Pursuant to Rules 196.3 and 196.6 RoP, the adequate security required of the applicant as a condition for the enforceability of the order under Articles 60 UPCA and Rules 192 et seq. RoP for the purposes of inspection, preservation of evidence and seizure must be commensurate with the possible damages and costs of litigation.
   As regards damages, the loss suffered by the person subject to the seizure of a vehicle cannot be quantified in terms of the sale price but in terms of the marginal profit that could be obtained from the sale of the vehicle.
   As for costs, these are only those that can be assessed ex ante and are limited to the evidence-gathering phase. Projecting these costs for the entire duration of any future proceedings on the merits (at the time of filing a completely hypothetical appeal) appears to exceed the scope of the provision, also in order not to make access to judicial protection excessively difficult.

Keywords: 60 UPCA, rules 192 et seq. RoP, inspection, preservation of evidence, seizure, guarantee for damages and expenses.

APPLICANT

XELOM S.R.L.
Via Nicolò Copernico No. 6 - Bolzano - 39100 - IT
(defendant in the main proceedings)

DEFENDANT

PRINOTH S.P.A.
Via Brennero 34 - 39049 - Vipiteno - IT
represented by Renato Bocca, Stefano Grassani and Camilla Scalvini
(appellant in the main proceedings)

PATENTS AT ISSUE

Patent No.	*Owner*
EP1995159	Prinoth s.p.a.
EP2507436	Prinoth s.p.a.

DECISION-MAKING BODY
This order is adopted by the Court in the following collegiate composition

Pierluigi PERROTTI presiding judge
Alima ZANA judge rapporteur
Marije KNIJFF judge qualified in legal matters

LANGUAGE OF THE PROCEEDINGS
Italian

THE PROCEEDINGS

1. Prinoth s.p.a. is an Italian company based in Vipiteno, now part of the HTI (High Technologies Industries) group, a world leader in the sector since the 1970s, dedicated to

to the production of snow groomers (known as snowcats) and multi-purpose tracked vehicles designed to move on snow and other surfaces. In 2020, it presented the first hydrogen-powered snow groomer, the Leitwolf H2-motion, and the first electric snowcat, the Husky E-Motion, both of which are eco-sustainable, zero-emission vehicles.

2. Prinoth is the owner of EP Patents '436 - entitled *'snow groomer and related control* method' - and EP '159 - entitled 'Snow *groomer* vehicle' - otherwise known as 'snowcats', hereinafter also referred to as the Patents.

3. On 24 February 2025, Prinoth filed an appeal with the Milan Local Division pursuant to Article 60 UPCA and Rules 192 et seq. RoP for the purposes of inspection, preservation of evidence and seizure against Xelom s.r.l. - an innovative start-up established in May 2019, part of the Technoalpin group, hereinafter Xelom - requesting an order *inaudita altera parte* before the start of the proceedings on the merits.

4. The applicant stated that, during 2024, Xelom began to disseminate, through its Instagram profile and in a number of interviews, news of the development of an electric snow groomer (known as *Snow Cat*), publishing a brochure on its website.
At the end of 2024, Xelom's *Snow Cat* was granted for use to several ski resorts, in Ischgl in Austria and Oberreggen in South Tyrol; in January 2025, it was used in the Lavazè ski resort in the province of Trento, while in February 2025, it was used in the Corno del Renon ski resort, in Stockholm and in the province of Bolzano.
The applicant therefore expressed the suspicion that the characteristics of this vehicle, as partially visible in the documentary evidence filed in the case file, reproduced the teachings of its patent.

5. Prinoth then requested that evidence of the alleged infringement be obtained by means of an order to be granted *in absentia,* to be articulated in an order for inspection of the premises, protection of evidence and seizure of a specimen; the patent holder requested that the measure also be authorised at the registered office and operational headquarters of the parent company, Technoalpin s.p.a. (hereinafter Techoalpin), in order to find the components of the heads as well as the design and construction documentation under *intercompany* agreements.

6. The Presiding Judge, considering that the conditions of extreme urgency did not apply, appointed the Judge Rapporteur and proceeded with the necessary formalities for the composition of the Panel by the President of the Court.

7. By decree no. 10632/2025 of 4 March 2025, on behalf of the Panel, the Judge Rapporteur, exercising the power referred to in rule 194, para. 1, letter c. RoP, summoned only the appellant on 3 May 2025. At that hearing, he requested, in particular: (i) the production of two documents cited but not mentioned in the appeal; (ii) the indication of specific keywords through which to search for evidence; (iii) the names of the party-appointed experts authorised to attend the implementation of the measure; (iv) the specification, if any, of the name of the vehicle subject to the measure, generically referred to in the appeal as *Snow Cat*.

8. The application was therefore subsequently supplemented by Prinoth on 10 March 2025 by means of a request pursuant to Rule 9.1 RoP.

9. Following these clarifications requested from Prinoth, on 18 March 2025, the Court adopted, *without hearing the other party*, an order against Xelom for the protection of evidence, inspection and seizure of a sample of the disputed product (order no. 11002/2025).

10. The order was limited both subjectively and objectively, as the Court prescribed (i) execution exclusively at the premises of Xelom and not TechnoAlpin; (ii) the use of specific keywords in the collection of documentation; (iii) the acquisition exclusively of technical documentation relating to the *Snow Cat* electric snow groomer.

11. The Court ordered that the material found during the operations be kept secret, making it available to the applicant only from 7 May 2025, in the absence of requests for protection of confidential information by Xelom. Within that time limit, Xelom requested the protection of confidential commercial information: the related sub-proceedings (No. 21787/2025) concluded with the order adopted on 13 June 2025, which granted the protection of confidential information (Order No. 22012/2025).
The order was not appealed.

12. Meanwhile, on 30 April 2025, Xelom filed an application for review of the order to preserve evidence and grant seizure without *hearing the other party.* Xelom specifically emphasised the invalidity of the other party's patents, the lack of interference and the lack of grounds for granting the measure to collect evidence.

13. The Court set a hearing for the purpose of confirming, revoking or modifying the measure and granted the parties time to respond to each other's defences.

14. In a brief filed on 16 June 2025, Prinoth argued: (i) compliance with the duty of disclosure in relation to the validity of Patents EP'436 and EP'159; (ii) the risk of infringement of these patents by *Snow Cat*; (iii) the existence of the requirements for obtaining a ruling *in absentia*; (iv) the groundlessness of Xelom's defences.

15. The patent holder therefore concluded by requesting
'reject the request for revocation and/or review brought by Xelom s.r.l. and, as a result, confirm in full order no. 11002/2025 issued on 18 March 2025 in the ACT proceedings. No. 7838/2025, UPC CFI No. 127/2025;
all with costs and fees awarded'.

16. Xelom filed its counter-reply on 25 July 2025 and concluded, on the merits:

(i) *revoke, pursuant to Rules 197(3) and 198(2) RoP, the order for the preservation of evidence, inspection and seizure adopted on 18 March 2025 and communicated to the Defendant in the context of the operations carried out on 2 April 2025;*

in the alternative

(ii) to revoke, pursuant to Rule 197(3) RoP, at least the seizure of the electric snow groomer (Snow Cat), ordered by the order for the preservation of evidence, inspection and seizure adopted on 18 March 2025 and communicated to the Defendant at the time of the operations on 2 April 2025;

(iii) amend, pursuant to Rule 197(3) RoP, point 1(ii) of the order for the preservation of evidence, inspection and seizure, adopted on 18 March 2025 and communicated to the Respondent

at the same time as the operations carried out on 2 April 2025, excluding items (xi) and (xii) from point 3(A) as they are not relevant for the purposes of ascertaining the alleged interference between Snow Cat and Patents EP'436 and EP'159 operated by the Applicant;

(iv) to charge Prinoth with all costs, charges and fees relating to the implementation of the additional measures requested by the Applicant, if accepted, with particular reference to the weighing of the Snow Cat by crane;

in any case

(v) order the Applicant to pay Xelom's legal fees and other costs relating to these proceedings;

(vi) upon the outcome of the revocation of the order for the preservation of evidence, inspection and seizure adopted on 18 March 2025 and communicated to the Defendant at the same time as the operations were carried out on 2 April 2025, Xelom reserves the right to claim compensation for damages suffered as a result of the operations carried out pursuant to Rule 198.

REASONS FOR THE ORDER

17. This order is adopted in accordance with:
- the principles of proportionality, flexibility and fairness established in the principles set out in recital 2 of the RoP;
- Article 60 UPCA;
- RoP 192 et seq.;
- the case law of the Unified Patent Court (see, in particular, the order issued by the Court of Appeal on 15 July 2025, UPC CoA No. 327/2025).

For the sake of clarity and completeness, the individual grounds for the order issued *ex parte* on 18 March 2025, the revocation of which is sought, the criticisms raised by Xelom and the considerations of the Panel are set out below.

Jurisdiction and competence

18. In the order under appeal, the Panel ruled as follows.

The Unified Patent Court has jurisdiction over this claim, in light of Articles 32.1© and 60.1 UPCA, considering that:
a) the two titles in question are European Patents for which the owner has revoked its opt-out declaration pursuant to Article 83(3) UPCA and Rule 5 RoP;
b) the claim made here is included among those falling within the scope of Article 32(1)(c) UPCA (actions for provisional and protective measures and injunctions).
The two patents are in force, inter alia, in Italy, as evidenced by the Italian patent register (see doc. 13 for EP '436 and doc. 16 for EP '159).
The Milan Local Division has jurisdiction pursuant to Articles 32.1© and 33.1(b) UPCA, for the following reasons:
a) by virtue of the general criterion of the general jurisdiction of legal persons, since Xelom is based in Italy – in Bolzano, Via Nicolò Copernico No. 6 – and carries out its business activities here pursuant to Article 4 of EU Regulation No. 1215/2012 (document 5 of the applicant);
b) by virtue of the special criterion of the so-called forum commissi delicti, referred to in Article 7(2) of the aforementioned Regulation, since part of the counterfeiting conduct takes place in Italy.
Finally, the appeal was filed before the Local Division of Milan, where Prinoth intends to commence proceedings on the merits pursuant to Article 33.1(b) UPCA, in accordance with Rule 192.1 RoP.

19. Xelom does not dispute here the jurisdiction and competence of the Unified Patent Court, which must therefore be considered definitively established.

Compliance with the provisions of Rule 192.2 RoP

20. With regard to Rule 192.2 RoP, the Board specified the following in its order of 18 March 2025

Contents of the application
The application for preservation of evidence, seizure and inspection shall contain:
(a) the details referred to in rule 13.1(a) to (i) RoP;
(b) a clear indication of the measures requested, including the exact location of the evidence to be preserved, where known or reasonably suspected (registered office and place of business of the respondent);
(c) the reasons why the proposed measures are necessary to preserve the relevant evidence;
(d) the facts and evidence in support of the application.

2.2. Concise description of the future judgment on the merits
The applicant intends to initiate proceedings on the merits to ascertain the infringement of the patents it holds against the defendant, based on the evidence obtained in the present proceedings, if the suspicion of patent infringement is confirmed.
The claims indicated for the future proceedings on the merits are an injunction with penalty clause, seizure, compensation for damages and publication.
Consequently, the conditions set out in Rule 192.2 RoP are fully satisfied.

21. Even with regard to these specific points, Xelom has not raised any specific objections and the relevant considerations must therefore be confirmed.

Burden of proof for the applicant under Article 60 UPCA – reasonably available evidence provided by the applicant

22. In the present case, the Court emphasised the following in the order under appeal.

Rights to valid patents
"The applicant has demonstrated that it is the current owner of patents EP '436 and EP 159 (see Annexes 13 - 16). As is well known, these patents are presumed to be valid.
Furthermore, the applicant has stated that no opposition has been filed with the European Patent Office.
Prinoth has not reported the existence of any revocation/invalidity proceedings brought before the national courts, as required by rules 13.1(h) and 192.2(a) RoP, nor of any other relevant act known to it relating to the validity of the patent in question that could influence the Court in deciding whether or not to issue an order without hearing the defendant (see Rule 192.2 RoP, second sentence).
Therefore, the Tribunal has no reason to doubt the validity of the patent in question at this early stage and that the applicant has withheld relevant information in this regard.
The Registry's examination also confirmed that no protective letters had been filed by the defendant.
Alleged infringement
Turning now to the examination of the patent titles, the following should be
noted. EP '436 protects a snow groomer:
(1) having a frame (2);
(2) an accessory (8) movably connected to the frame (2);
(3) a hydraulic unit (15) having an actuator (24) for positioning the accessory (8) and a valve (25) for controlling the actuator (24);
(4) a variable flow pump (14) for supplying the hydraulic unit (15);
(5) and a control system (21) for calculating the total flow rate requirement of the hydraulic unit (15) and for controlling the variable displacement pump (14) according to the total flow rate requirement, so that the delivery of the variable displacement pump (14) is equal to the total flow rate requirement.
The appellant stated that EP '436 allows energy consumption to be reduced because only the desired and necessary flow rate of pressurised oil is calculated and delivered by the pump, in terms of maximum efficiency.
EP '159 protects:
1. a snow groomer (1) having a frame (2) and extending along a longitudinal axis (A);

2. ten support wheels (5) connected to the frame (2) by respective axle shafts (6) to form a row of five support wheels (5) on each longitudinal side of the frame (2), each support wheel (5) on one longitudinal side of the frame (2) facing a support wheel (5) on the opposite longitudinal side of the frame (2), so that pairs of outward-facing support wheels (5) define a first (8), second (9), third (10), a fourth (11) and a fifth (12) axis;
3. two tracks (15), each wrapped around support wheels (5) aligned along a respective longitudinal side of the frame (2); a motor unit (3) of over 430 hp; and a mass distributed as follows: 16% +/-2% on the first axle (8); 20% +/- 2% on the second axle (9); 20% +/- 2% on the third axle (10); 22% +/- 2% on the fourth axle (11); and 22% +/- 2% on the fifth axle (12).
According to the applicant, EP '159 allows for the manufacture of vehicles that are both agile (able to climb steep slopes) and heavy, and therefore powerful: this is achieved through optimal weight distribution across the different axles.
Prinoth has filed extensive documentation to support its allegations of infringement, in particular:
(i) the Snow Cat Xelom user manual (doc. 25 of the applicant, A1 of the opinion of the party);
(ii) page 40 of the Snow Cat Xelom user manual in German (doc. 26 of the applicant, A1bis of the party's opinion);
(iii) page 40 of the Snow Cat Xelom user manual in Italian (doc. 27 of the applicant, A2ter of the party's opinion);
(iv) the photo of the accessory power supply unit (doc. 28 of the applicant, A2.1 of the party's opinion);
(v) the photo of the accessory power supply unit from a different angle (doc. 29 of the applicant, A2.2 of the opinion);
(vi) the photo of the hydraulic pump visible in figure A2.2 (doc. 30 of the applicant, A2.3 of the party's opinion);
(vii) the valve assembly for operating the blade (doc. 31 of the applicant, A2.4 of the opinion of the party);
(viii) the pump data sheet in figure A2.3 (doc. 32 of the appellant, A3 of the opinion);
(ix) the commercial technical data sheet for the Snow Cat Xelom (doc. 33 of the appellant, A4 of the party's opinion);
(x) the reproduction of the website https://www.pistentech.com/listings/6560004-xelom-snow-cat (doc. 34 of the applicant, A5 of the opinion);
(xi) the reproduction of the website https://www.machinio.it/annunci/99985742-2025-xelom-snow-cat-in-germania (doc. 35 of the applicant, A6 of the party's opinion);
(xii) the Snow Cat Xelom sales brochure (doc. 36 of the appellant, A7 of the opinion of the party);
(xiii) the video of the interview broadcast on RaiNews (Annex A8 Parere Studio Torta.mp4, doc. 40 of the applicant).
The party's expert considered, with regard to EP patent '436 (i) that it is likely that independent claims 1 and 9 and dependent claims 3, 4, 8, 11, 12, 16 and 17 have been infringed; (ii) that there is no clear evidence of literal infringement of claims 2 and 10, but that infringement by equivalents is plausible; (iii) that with regard to claims 5 and 13, there are only reasonable grounds for suspecting infringement; (iv) that there is no evidence with regard to the other claims nos. 6 and 14; (v) that there is a mere suspicion of infringement for claims 7 and 15 (doc. 24 and related annexes 25-36).
As for EP '195, it concluded that there was suspicion of infringement of claim no. 1 (doc. 24 and related annexes 25-36, cited above).
This was done by means of an analytical comparison between the patent claims and the evidence submitted to the court and described above.
Therefore, at this stage and subject to different evidence in subsequent stages, the applicant has provided reasonable evidence to support the well-founded suspicion that its patent has been infringed (see Milan Local Division, Primetals v. Danieli, 11 September 2024, order no. 51269/2024). This is taking into account:
- the standard of proof is modulated according to the request made, which affects a procedural right (to evidence) and not a substantive right (as in the case of injunctive relief and compensation for damages);
- the obligation of the applicant requesting the ex parte measure to present the facts truthfully, without distorting their integrity (Paris Local Division, 1 March 2024 'In support of its application, particularly in the context of ex parte proceedings, the applicant has the obligation to present the facts fairly, without distorting their integrity', order no. 9825 in Act no. 601/2024 - UPC CFI no. 397/2023);
- that, at present, the circumstantial evidence gathered does not appear to be mere assumptions or projections not based on any evidence (see Local Division of Paris, cited above).
Prinoth states that it needs an order to gather further evidence in support of the alleged infringement.
In particular, the applicant is unable to ascertain whether:

a) Xelom's Snow Cat infringes the snow groomer vehicle covered by claim no. 1 (feature M5) of EP '436 due to the unavailability of the circuit diagram (hydraulic and/or electronic) and control of the hydraulic system of which the hydrostatic pump of the disputed vehicle is part;
b) the valve assemblies of Xelom's snow groomer are capable of measuring the flow rate between the valve and the actuator, and therefore whether there is an infringement (or only an infringement by equivalent) of claim no. 2 of EP '436;
c) whether or not the vehicle has a selector for flow rate partialisation;
d) the distribution of mass over the five axles of Xelom's Snow Cat follows the same percentages claimed in claim no. 1, feature N5, of EP '159.
The acquisition of evidence is therefore essential for the owner of the exclusive rights in order to confirm the interference.

23. These observations were censured by Xelom on two counts.
Firstly, the defendant pointed out that Prinoth had failed to comply with *its duty of candour*. This was because it had not attached to the appeal the procedural history of the 'parallel' US patent 7,740,094 B2, which had been granted with a narrower scope of protection than EP '159 in light of certain prior art documents that had emerged during examination before the USPTO (but not during examination before the EPO).
The turbulent US proceedings would in fact constitute a *'material* fact' that could have influenced the Court's decision on the granting of the *ex parte* measure and which, therefore, according to the provisions of Rule 192.3 RoP, had to be attached to the application for preservation of evidence.

24. On this point, the Court observes that the European patent title is different from the US one, not only in terms of territorial scope. The procedural correctness of the patent holder in the urgent application must be investigated with regard to the exclusive right that is being enforced before the Court and which could affect the judgement on its validity.
The circumstances cited by Xelom are not among those that could have influenced the Court's decision and which should therefore have been presented by the appellant.
The complaint must therefore be dismissed.

25. Xelom's second argument concerns the merits of the two patents enforced, the validity of which is denied on the basis of specific and detailed arguments.

26. In this regard, the Court refers to the clear rulings handed down at both first and second instance and, in particular, to the recent ruling of the Court of Appeal (UPC CFI No. 327/2025, 15 July 2025), which clarified the conditions for access to the remedy under consideration and the scope of the Court's jurisdiction in assessing the merits of the relevant application.

The Court of Appeal specifically emphasised that "*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.*

27. In light of this ruling, it should therefore be reiterated that in proceedings brought under Article 60 UPCA and Rules 192 et seq. RoP, the Court must not investigate the merits of the validity of the

patent title, an investigation that is necessary when the owner requests an injunction, whether in preliminary proceedings or in proceedings on the merits, affects the substantive subjective right.

This is because the right to obtain evidence is immediately and directly a procedural right, while the underlying substantive right – the right of patent exclusivity and its infringement – is only relevant in a mediated and indirect way.

In its description, the Court limits itself to assessing the existence of the formal requirements for granting and confirming the order, namely the existence of a valid patent right, the existence of apparently infringing products marketed by the defendant, and the need for the proprietor to obtain further evidence.

Entirely similar considerations also apply with regard to the issue of interference, which will only be examined in depth in the subsequent judgment on the merits (see, in this regard, the order issued by the Paris Local Division on 1 March 2024, no. 9825, in case no. 601/2024 UPC_CFI_397/2023).

28. In the present case:
(i) the applicant has claimed and documented that it is the owner of EP patents '436 and EP patent '159, currently in force;
(ii) there are no procedural events which, according to the Court of Appeal, could call into question the presumption of validity of the patent, i.e. opposition proceedings before the EPO or proceedings before a court challenging its validity;
(iii) the time that has elapsed since the granting of the patents invoked by Prinoth to the present, without the related exclusive rights ever having been challenged by any competitor, constitutes further evidence of their validity in the present proceedings.

As a result, this complaint by Xelom must also be rejected.

Requirements under Rules 194.2 and 197 RoP

29. With regard to the requirements of Rules 194.2 and 197 RoP, in its order of 18 March 2002, the Court made the following observations.

"Pursuant to Rules 194.2 and 197 RoP, the Court, in exercising its discretionary power to decide the application without hearing the respondent (Rule 194.1(d) RoP), must take into account the urgency of the application and the reasons for granting an order inaudita altera parte.
In accordance with Rule 197 RoP, the Court may order measures to preserve evidence without the defendant being heard, in particular where there is a demonstrable risk that the evidence will be destroyed or otherwise no longer be available.
The latter is the case in question, as will be explained shortly.

4.1. Urgency
The disputed machinery was placed on the market very recently, with the first promotions dating back to the end of 2024, first in Ischgl in Austria (doc. 15) and then in the Latemar ski area in Obereggen, Italy, in South Tyrol (doc. 18). At the beginning of 2025, it appeared in the Lavazè ski area in the province of Trento (docs. 19 and 20) and in the Corno del Renon ski area (doc. 21) and finally in Dobbiaco, in the province of Bolzano (doc. 23).
Thus, the spread of the vehicle suspected of interference was accompanied by rapid expansion.
Prinoth has gathered all the evidence at its disposal, but has been unable to independently obtain further technical documentation, particularly with regard to the hydraulic pump(s), actuators, sensors, etc., i.e. the hydraulic, electrical/electronic circuit system of the entire snow groomer.
The applicant identifies the need for urgent action in the defendant's forthcoming participation in a trade fair, which will enable it to make further significant inroads into the market. In particular, according to the applicant, Xelom intends to present the snow groomer at the Interalpin trade fair, to be held in early May 2025 in Innsbruck, which is the most important international trade fair in the field of alpine technologies (documents 37 and 38 of the applicant).

In order to seek an injunction and in the future proceedings on the merits, the applicant needs to complete the evidence at its disposal with regard to the counterfeiting phenomenon.
Moreover, the cost of the vehicle - which Prinoth claims to be between €500,000.00 and €600,000.00 - does not allow the applicant to bear the cost of purchasing it in order to verify the counterfeiting of the individual claims, which is not easy considering that the parties to the dispute are direct competitors.

4.2. Reasons for granting an order without hearing the defendant – risk of destruction of evidence The acquisition of data is the main purpose of the applicant, and it is generally known that digital data and files are volatile and can be easily hidden or deleted if the defendant is notified in advance of the requested measure.
Therefore, there is a real and concrete possibility that the evidence could be easily removed if the defendant were informed or heard before the measure is taken.
Consequently, taking into account all relevant factors, this order must be granted ex parte, in particular since there is a demonstrable risk that the evidence will be destroyed or otherwise cease to be available (Art. 60.5 UPCA).

30. In this regard, the defendant pointed out the lack of urgent reasons justifying the request for preservation of evidence, according to Rule 192 RoP, since this initiative is exploratory in nature, in the absence of sufficient evidence to predict interference.
Xelom also pointed out the inconsistency between the measure requested (description) and the danger to which it would be preparatory, namely the prohibition of the competitor from participating in an upcoming trade fair.

31. In this case, the Court also refers to a further passage from the above-mentioned Court of Appeal ruling (15 July 2025, No. 327/2025).

(i) 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).
(ii) 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.

32. That said, it should be noted that the acquisition of evidence of infringement is an unavoidable procedural step for the patent holder when deciding whether or not to proceed with an application for an injunction, both in preliminary proceedings and in the main proceedings.
In this case, the initiative to gather and preserve evidence was closely linked, in terms of timing, to the reported counterfeiting phenomenon, which was escalating rapidly, including from a commercial point of view. This was in light of an imminent and very important trade fair organised for May 2025 in Innsbruck, namely the most important international trade fair in the field of alpine technologies.
Prinoth's procedural choices with regard to this event correctly focused, as a first step, on acquiring detailed evidence of possible interference.

33. It should also be noted that the patent holder has attached the impossibility of its consultants to confirm - by other means and with certainty the interference between Xelom's *Snow Cat* and the patents enforced by Prinoth, given the impossibility for the applicant to purchase a model of the disputed machine due to its very high sale price, a circumstance not denied by Xelom.

The granting of *the ex parte* measure

34. With regard to granting the *ex parte* measure, the Court had given the following reasons in its order of 18 March 2025.

'4.2. Reasons for granting an order without hearing the defendant - risk of destruction of evidence The acquisition of data is the main purpose of the applicant, and it is generally known that digital data and files are volatile and can be easily hidden or deleted if the defendant is notified in advance of the requested measure.
Therefore, there is a real and concrete possibility that the evidence could be easily removed if the defendant were informed or heard before the measure was taken."
Consequently, taking into account all relevant factors, this order must be granted ex parte, in particular since there is a demonstrable risk that the evidence will be destroyed or otherwise cease to be available (Article 60.5 UPCA).

35. Xelom contested the existence of the conditions for granting the order before the adversarial proceedings were initiated.

36. On this point too, the Court of Appeal provided the parameters to be followed by the Court in granting the remedy.

"(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 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.

37. Given the discretion, emphasised by the Court of Appeal, regarding the choice of method -whether anticipated or postponed- to establish the adversarial process and guarantee the right of defence, it should be noted that, from an objective point of view, using *ex ante* reasoning, the data that Prinoth requested to be acquired is, by its very nature, easy to remove, alter and/or disperse.
Particular reference is made to (i) digital documentation and (ii) the distribution of axle weight in the vehicle deemed to be interfering.
Xelom's argument that it would be unrealistic for a production line as complex as that of its Snow Cats to be modified, altered or destroyed in the short period of time between the filing of the appeal and the summoning of the parties suffers from the consideration that:

(i) the Court's assessment is necessarily *ex ante;*
(ii) there is no need for concrete proof of destruction, as this would be a kind of *probatio diabolica,* the concrete statistical possibility of alteration of the evidence being sufficient.

The relevant objection must therefore be rejected.

Payment of court fees

38. With regard to the payment of court fees, Xelom has not raised any objections, and therefore the reasoning of the order of 18 March 2025, which acknowledged their regular payment, with consequent compliance with the conditions set out in rule 192.5 RoP, must be confirmed.

Balancing of conflicting interests and methods of enforcement

1. Balancing conflicting interests

39. With regard to balancing conflicting interests, the Court ruled as follows in its order of 28 March 2025.

'The weighing of conflicting interests leads the Court to consider granting the measure, taking into account the potential risk of damage to each of the parties in the event of the measure being granted – for the defendant – or refused – for the applicant.
Taking into account the principle of proportionality, the threat of definitive destruction of the evidence against Prinoth must be considered to prevail over Xelom's exposure to the application of the requested measures, which, it should be noted, are only procedural in nature, limited to the collection of evidence and not substantive in nature, as they do not affect the defendant's subjective positions and its commercial activity.
In this case, the requests for an ex parte order for the inspection of the premises, the preservation of evidence and seizure for evidentiary purposes are, in conclusion, considered justified and should be granted.

40. Xelom contested the Court's decision to seize a sample of the vehicle for evidentiary purposes, emphasising that this would be a measure:

- excessive, in light of the serious commercial damage resulting from the seizure of the machinery, as it is impossible to offer it for sale until it is released. This results in the loss of investments and costs for its design and construction. In this regard, the price of the vehicle has been quantified at approximately €500,000.00-600,000.00;
- disproportionate, also taking into account the long period of time during which the measure is likely to remain in force and the risk of the vehicle becoming obsolete in the meantime. This resulted in the loss of the opportunity to place it back on the market following the outcome of the proceedings on the merits;
- unnecessary, since the technical documentation acquired by other means would be sufficient to meet Prinoth's evidentiary requirements, whose interest in acquiring the evidence would already have been fully satisfied.

41. In this regard, the Court observes:

- With regard to the excessiveness of the damage caused by the vehicle being off the road and the failure to market the machine, the Court ordered Xelom to provide security as a condition for proceeding with enforcement, the amount of which was paid by the patent holder within the time limit set in the order. With regard to the quantification of the security, the considerations set out below apply.

- as regards non-proportionality:

    - with regard to the length of time the vehicle was immobilised in relation to the underlying evidentiary need, it suffices to note that any adjustment regarding the inspection of the machinery and the crystallisation of the evidence, prior to its release from seizure, is left to the merits phase;
    - with regard to the specific machinery seized, Prinoth stated that during the operations, Xelom was given the right to choose the specific *Snow Cat* from

subject to a restriction on disposal. This assertion has not been specifically and effectively contested;

- with regard to the costs of seizure, the machinery has been kept at Xelom's premises and, therefore, no additional costs are foreseeable;
- with regard to the alleged possible obsolescence, the machinery does not appear to be designed for a single seasonal launch, as it could well be offered for sale during the next sales campaigns.
- As for the necessity of the seizure, Prinoth requested to acquire specific evidence, namely to carry out a check of the weight distribution on the axles using a bridge crane and a load cell. In this regard, the need to inspect the vehicle, if necessary by dismantling it, was highlighted. These are activities which, if permitted (the first) or if deemed necessary by the Court Expert (the second), could certainly not have been carried out in a single visit. As a result, in the interval between the first and subsequent visits, Xelom could theoretically have made adjustments to the snow groomer, completely negating the surprise effect of the measure.

42. Balancing the conflicting interests, and taking into account that this was a measure granted *inaudita altera parte* and that these tests and checks were not carried out, it is even more appropriate to confirm the seizure of a snow groomer, given that, at this point, it will be necessary to wait for the judgment on the merits in order to carry them out.

2. Objective and subjective limitation of the measure

43. As regards the subjective and objective limitation of the measure, the Court ruled as follows.

'The Court considers that the measure should be granted:
- limited to technical documentation, excluding accounting documentation, since the application is primarily aimed at verifying and substantiating suspicions of counterfeiting, purely as a preliminary step to a subsequent, further and possible claim for compensation and liquidation of damages, for which the request for the acquisition of accounting documentation is instrumental. Furthermore, the accounting record-keeping obligations for Italian companies, together with the failure to indicate the risk of destruction, suggest
- in accordance with the conflicting interests - to limit the measure to the investigation of evidence relating to counterfeiting;
- excluding the request referred to in point 8 of the application for interim relief, which appears to require particularly invasive operations (the use of a bridge crane and a load cell) that are not immediately instrumental to the purpose of the measure requested without hearing the other party.
- only against Xelom, with enforcement at its registered office or local offices and not at the premises owned or belonging to the third party Interalpin s.p.a., parent company and controller of Xelom, a party to which the applicant has decided not to extend the proceedings, even though it has already been identified in the application as an operator involved at least in marketing and which, according to the applicant's submission, would suffer the effects of the measure without, however, benefiting from the guarantees of the right of defence granted to the defendant;
- with the exclusion of the software referred to in point (V) of point 3(a) of the applications for interim relief (pages 33), which is not immediately protected by the patents at issue in the case.

44. On this point, the defendant – while acknowledging that the Court had limited the measure both objectively and subjectively, excluding software, accounting documentation and the third party's premises from the scope of the description – considered that the order should nevertheless be further limited by eliminating:
(i) advertising documentation;

(ii) point 3(a)(xi) and (xii) relating to contracts and commercial documentation in general.

45. In this regard, the Court notes, as already observed in its order issued on 13 June 2025 (in the sub-proceedings brought by Xelom for the protection of its confidential information), that:

- in the grounds for the order of 18 March 2025, the acquisition of evidence was limited solely to technical documentation. (..) *'with the exception of accounting documentation, since the application is primarily aimed at verifying and substantiating suspicions of counterfeiting, purely as a preliminary step to a subsequent, further and possible claim for compensation and liquidation of damages, for which the request for the acquisition of accounting documentation is instrumental. Furthermore, the accounting record-keeping obligations for Italian companies, together with the failure to indicate the risk of destruction, suggests - in accordance with the conflicting interests - limiting the measure to the investigation of evidence relating to counterfeiting'.*
- In the operative part, due to a mere clerical error, commercial documentation was also included.

The necessary coordination between the two parts of the order requires, confirming the extension of the acquisition to technical documentation only, that it be specified that commercial documentation is not included in the measure at issue here, except to the extent that it reproduces technical elements necessary to ascertain the alleged infringement.

46. It should also be noted that this clerical error did not affect the execution of the order, as the Court's expert correctly interpreted the measure, limiting the acquisition to technical patent documentation only. Commercial data was not acquired independently; some of it was occasionally included in the technical documentation and was temporarily redacted.

47. With regard to the objective limitation of the measure, Prinoth in turn insisted on extending the measure to the software.
In this regard, the Court notes that Prinoth is not entitled to request a modification of the order of 18 March 2025 by extending its scope, as it did not lodge an appeal.

3. Method of enforcement

48. As regards the methods of execution of the measure, the Court ruled as follows.

Pursuant to Rule 196.4 RoP, the authorised measures must be enforced in accordance with the national law of the place where the measures are enforced, i.e. Italian law, by an expert appointed by the Court and specifically mentioned in the operative part.
This expert is included in the list of patent experts who regularly collaborate with national courts, so that the choice guarantees competence, independence and impartiality, as required by rule 196.5 RoP. The expert will be supported by an assistant of his choice, specifically two experts in computer forensics, in order to proceed simultaneously at the two locations of the defendant, as already provided for by this Office in similar cases (see Milan Local Division, order no. 51269/2024 of 11 September 2024, Act. no. 36483/2024 - UPC CFI No. 337/2024).
The search and copying of digital documents on media, devices and storage devices used by the defendant shall be carried out on the basis of the list of keywords indicated by the claimant in the supplementary brief filed on 10 March 2025. This excludes the keywords referred to in points 9, 12, 16, 17, 18 and 19 on page 3 of the aforementioned supplementary note (namely: 'Software Use Case Definition', 'software logic', 'software interface', 'source code', 'code', 'software', 'manual', 'guide', 'control', and related traditions in

English and German) that are overly generic or refer to software that is not the immediate subject of the measure. This limitation is necessary to protect the defendant's position, which must be restricted to the minimum extent possible and only to the extent necessary, avoiding exploratory investigations, in comparison with the applicant's need to acquire evidence.
This method of data selection is intended to ensure the maximum probability of actual relevance and correlation between the documents retrieved and the alleged infringement.
The assistants will operate under the direct control and responsibility of the expert and are subject to the same professional confidentiality obligations in relation to all information to which they have access in the performance of their duties.
The appointed expert shall proceed with the assistance of the competent bailiff or bailiffs. Only the representatives of the applicant, up to a maximum of two for each location to be inspected, may be present during the execution of these measures. Their names are indicated in the operative part of this order. No other representatives or employees of the applicant are therefore authorised to be present during the execution of these measures.
The appointed court expert shall submit a written report, together with a complete copy of all documents and data acquired as a result of the execution of the measures, immediately and no later than two days after the completion of the execution of the measures.

6.4. Confidentiality
As already specified by this Court (order no. 51269/2024 of 11 September 2024, Act. no. 36483/2024 - UPC CFI No. 337/2024), fully incorporating the principles established by the Court of Appeal in its decision of 23 July 2024 (Apl. No. 20002/2024 - UPC CoA No. 177/2024):
An application for the preservation of evidence or inspection of premises within the meaning of Article 60 UPCA and rules 192 et seq. RoP implies a request to disclose to the applicant the outcome of the measures, including the report written by the person who carried out the measures. This follows from the fact that the legitimate purpose of the measures is the use of the evidence in proceedings on the merits of the case (Rules 196(2) and 199(2) RoP), which includes the use of the evidence to decide whether to initiate proceedings on the merits and to determine whether and to what extent the evidence will be submitted in these proceedings.
Disclosure of the evidence to the applicant or to certain persons acting on behalf of the applicant is indispensable for that purpose. Moreover, rules 196.1 and 199.1 RoP provide that the Court may decide in its order that the evidence shall be disclosed to certain named persons and shall be subject to appropriate terms of non-disclosure. This confirms that the procedure initiated by an application under Article 60 UPCA aims not merely at the preservation of evidence and the inspection of premises as such, but also at the disclosure of the evidence to the applicant.
However, the granting of an application for preservation of evidence or inspection of premises does not imply an unconditional order to disclose the evidence to the applicant. Pursuant to Article 60(1) UPCA, the order must be subject to the protection of confidential information (see also Article 7(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights). Where the evidence may contain confidential information, this entails that the Court must hear the other party before deciding whether and to what extent to disclose the evidence to the applicant. In this context, the Court must give the other party access to the evidence and must provide that party with the opportunity to request the Court to keep certain information confidential and to provide reasons for such confidentiality. If the other party makes such a confidentiality request, the Court must provide the applicant with the opportunity to respond in a manner that respects the potential confidentiality interests of the other party. The Court may do this, for example, by granting access only to the representatives of the applicant whom the Court, pursuant to rule 196.3(a) RoP, has authorised to be present during the execution of the measures and subject to appropriate terms of non-disclosure.
The opportunity for the other party to make a confidentiality request must be distinguished from the remedies available against the order for the preservation of evidence or the inspection of premises, such as the review of an order for preservation of evidence without hearing the defendant pursuant to rule 197.3 RoP. Therefore, the Court must hear the other party on the request for disclosure even if this party has decided not to file a remedy against the order to preserve evidence or inspect premises. For the same reasons, failure to apply for a review of an order for the preservation of evidence or for the inspection of premises cannot be considered as tacit approval of the disclosure of evidence. 4. Pursuant to Article 60(8) UPCA, the Court shall ensure that measures to preserve evidence or to inspect premises are revoked or otherwise cease to have effect, at the defendant's request, if the applicant does not bring, within a period not exceeding 31 calendar days or 20 working days, whichever is longer, action leading to a decision on the merits of the case before the Court (see also Article 7(3) of Directive 2004/48/EC and Article 50(6) of the Agreement on Trade-Related Aspects of Intellectual Property Rights). Rules 198.1 and 199.2 RoP specify that the time period runs from the date specified in the Court's order, taking into account the date when the report referred to in rule 196.4 RoP is to be presented. These rules must be interpreted in the light of the purpose of the measures for the preservation of evidence or inspection of premises,

which is to use the outcome of these measures in the proceedings on the merits of the case (rules 196.2 and 199.2 RoP). In view of this, the Court must, as a general principle, specify in its order a time period that starts to run from the date of disclosure of the evidence to the applicant or from the date on which the Court has made a final decision not to grant the applicant access to the evidence" (Local Division of Milan, 11 September 2024, Act. No. 36483/2024 - UPC CFI No. 337/2024, Order No. 51269/2024).
Considering that the application under Article 60 UPCA and Rule 192 RoP implies a request for disclosure of the outcome of the measures to the applicant, the latter is not required to submit further requests. The report and its annexes will be filed by the expert with the Registry of the Milan Local Division and the applicant will have full access to them from 7 May 2025, unless the defendant avails itself of the possibility of requesting confidentiality, regardless of whether other remedies, such as review or appeal, are actually proposed.
The applicant shall have access by collecting a copy (previously made available by the expert, as already provided for in this order) at the Registry, under the supervision of the judge-rapporteur and with the assistance of a registrar. The activities shall be recorded in a specific report, which shall then be uploaded to the CMS.
If, by 7 May 2025, the respondent has actually submitted a request for protection of confidential information, the Court shall determine by specific order, after consulting the parties, whether, to whom and to what information access will be granted.
The request for review and appeal may be submitted independently (see paragraphs 6.7 and 6.8 below) and the outcome of any such remedies must be respected.
Pursuant to Article 60.8 UPCA and Rule 198 RoP, measures for the preservation of evidence, inspection of premises and seizure shall be revoked or otherwise cease to have effect, at the request of the defendant, if the claimant does not bring an action on the merits before the Court within a period not exceeding 31 calendar days or 20 working days, whichever is longer, starting from the date of disclosure of the evidence to the claimant or the date on which the Court made its final decision not to grant the claimant access to the evidence.

6.5. Restrictions on the use of the written report
The written report and any other results of the measures of inspection of premises, preservation of evidence and seizure may only be used in the proceedings on the merits of the case, in accordance with Rules 196.2 and 199 RoP.

6.6. Notification
Taking into account the need to ensure the element of surprise, the notification of the appeal together with this order shall be effected by the applicant at the respondent's place of business immediately upon the execution of this order, in accordance with Rule 197.2 RoP, in accordance with domestic law.

49. No specific objection has been raised in this regard by Xelom. The relevant orders are therefore confirmed.

4. Security

50. With regard to the guarantee, the Tribunal has ruled as follows.

"Pursuant to Rules 196.3 and 196.6 RoP, the Court orders Prinoth to provide adequate security - also as a condition for the enforceability of this order - for legal costs and for any compensation for any damage suffered or that may be suffered by the defendant, by depositing the amount of EUR 75,000.00.
This amount is quantified taking into account:
- both previous orders of the same nature adopted by the Court with particular regard to security for costs (see Local Division of Milan, Primetals v. Danieli, 11 September 2024, No. 51269/2024);
- the seizure of a vehicle, the market value of which has been identified by the applicant as between €500,000 and €600,000, and taking into account the amount of possible profits not made by the defendant due to its temporary unavailability and consequent failure to market it.
This order shall only become effective after the guarantee has been provided by the applicant.

51. On this point, Xelom requested an increase in the *security* imposed on Prinoth, taking into account the costs of litigation in the event of the latter's defeat and the possible damage caused by the vehicle being immobilised: it therefore requested that the amount be at least tripled.

52. Prinoth pointed out that the case in question is worth €2 million, meaning that the recoverable costs amount to €200,000.

53. The Court notes that RoP 196.6 refers to possible damages and litigation costs.

As regards damages, it should be noted that the loss suffered by the person subject to the seizure measure cannot be quantified in terms of the sale price but in terms of the marginal profit obtainable from the sale, which in this case has been prudently quantified in favour of Xelom at a percentage greater than 10% of the sale price.
It was incumbent upon Xelom itself, where its marginal profit was higher than that of this type of product and than the fair assessment made by the Court, to submit evidence in its favour, by virtue of the distribution of the burden of proof and the principle of proximity of evidence.

As for the costs, these are only those that can be assessed *ex ante* and are limited to the stage of gathering evidence.
The projection for any future judgment on the merits (at the time of filing the entirely contingent appeal) appears to exceed the scope of the rule, also in order not to make access to judicial protection excessively difficult.
Moreover, the defendant has at its disposal a specific means of protection against the risk of difficulty in paying the costs of the losing party, namely the application for security for costs, to be brought in the proceedings on the merits already pending between the same parties.

Prinoth's request

54. Prinoth nevertheless insisted on accessing the software, which was not granted at first instance. Prinoth is not entitled to make such a request, as it did not lodge a timely appeal, as already stated in point 47.

Conclusions

55. There are no significant reasons to revoke or modify the order to preserve evidence issued on 18 March 2025, except for the clarification of the clerical error contained in the operative part, as explained in point 45.

Information on the possibility of appealing

56. Pursuant to Articles 73(2)(a) and 60 UPCA, R. 220.1(c) and 224.2(b) RoP, the unsuccessful party may appeal against this order within 15 days of notification of this order,

for all these reasons

the Unified Patent Court - Court of First Instance - Local Division of Milan:

- rejects in its entirety the application for revocation of the order to preserve evidence adopted on 18 March 2025, specifying that letters xi and xii (referred to in point 3(A) of the appeal) relating to contracts and commercial documentation in general shall be excluded from the operative part of paragraph I, point (ii), first subparagraph;
- the costs of the present review proceedings shall be settled in the proceedings on the merits already pending.

Milan, 27 October 2025.

Pierluigi Perrotti
President

Pierluigi Perrotti

Digitally signed by Pierluigi Perrotti
Date: 24 October 2025, 14:44:09 +02'00'

Alima Zana
Presiding Judge

Alima ZANA

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Date: 24 October 2025, 08:56:44 +02'00'

Marije Knijjff
assistant judge

Marije Knijff

Digitally signed by Marije Knijff Date: 27 October 2025 09:11:19 +01'00'

For the Registrar

MADDALENA FERRETTI
MINISTRY OF JUSTICE
27.10.2025 09:21:17
GMT