



Milan Local Division

**UPC CFI no. 377/2025, no. 702/2025
order
issued on 8.1.2026**

CLAIMANT

Primetals Technologies Austria GmbH

DEFENDANT

Danieli & C. s.p.a.

LANGUAGE OF THE PROCEEDINGS

English

PATENT AT ISSUE

EP 2 624 977 (EP'977)

DECIDING JUDGE

presiding judge and judge rapporteur Pierluigi Perrotti

LANGUAGE OF THE PROCEEDINGS

English

SUBJECT OF THE PROCEEDINGS

request for an order to produce evidence - Art. 59 UPCA and R. 190 RoP

SUMMARY OF FACTS AND REQUESTS

On 9-17.10.2025 Primetals filed an *Application for an order to produce evidence under rule 190 of the Rules of Procedure*.

The Claimant highlighted the following points.

At the end of January/beginning of February 2025, it discovered – quite by chance – that Danieli had built a plant commissioned by Hoa Phat Group that reproduced all the features claimed in the patent at issue.

There were several publicly accessible documents proving the existence of an established business relationship between Hoa Phat and Danieli, as well as showing the infringing embodiment.

In the application for preserving evidence filed against Danieli on 5 July 2024 (UPC CFI no. 337/2024), no specific objection was raised with regard to this machinery, as the circumstance was not known at the time. However, it was unusual and noteworthy that no documents relating to this plant were found following the execution of the order for preserving evidence, despite the use of general keywords during the search for digital documents. The Defendant had not provided any plausible explanation for this circumstance.

Therefore, the Claimant was entitled to request that the Court order the Defendant to produce documents and technical information that were under its control, and which would enable the Court to verify whether Danieli & C. s.p.a., or any other entity within the Danieli group, supplied, installed or commissioned machines incorporating the features claimed in EP'977 for use at Hoa Phat's facilities in Vietnam. Such disclosure was necessary to determine whether an act of infringement has occurred, or conversely, to confirm that no infringement exists.

The Claimant requested the Court to:

- (i) order the Defendant to produce, within a period of two weeks, all documents, records, and technical drawings relating to drivers for a steel strip coiling installation or any other devices of components as claimed in EP 2 624 977, which were manufactured, supplied, sold, installed, or commissioned by Danieli & C. s.p.a. or any entity of the Danieli group, in Vietnam, including but not limited to installations at Hoa Phat Group's production sites;
- (ii) order the Defendant to produce all purchase orders, invoices, delivery notes, and contracts concluded between Danieli & C. s.p.a. or any entity of the Danieli group and the Hoa Phat Group or any related entities in Vietnam relating to the supply of drivers for a steel strip coiling installation or any other devices of components as claimed in EP 2 624 977;
- (iii) order the Defendant to produce all technical documentation, drawings, specifications, and internal correspondence identifying drivers for a steel strip coiling installation or any other devices of components, as claimed in EP 2 624 977, which were supplied, sold, installed, or commissioned by Danieli & C. s.p.a. or any entity of the Danieli group in Vietnam, including but not limited to installations at Hoa Phat Group's production sites, including their model names, serial numbers, and configurations;
- (iv) order the Defendant to disclose any photographs, videos, or promotional materials depicting the machines supplied, sold, installed, or commissioned by Danieli & C. s.p.a.

or any entity of the Danieli group, in Vietnam, including but not limited to Hoa Phat Group's production sites;

- (v) order the Defendant to produce any internal or external correspondence, presentations, technical reports, minutes of meetings, or marketing materials which are related to the business or commercial relations between Danieli & C. S.p.A. (or any entity of the Danieli group) and Hoa Phat Group, or to any projects, supplies, or activities in Vietnam, and which contain any of the following keywords, whether in English, Italian, or Vietnamese: *Hoa Phat, Hoa Phat Group, Pinch roll, Top pinch roll, Bottom pinch roll, Pinch roll unit, Pinch roll change, Roll change, Fast pinch roll change, Fast change type, Danieli fast change type, QSP, Quality strip production, Rocking arm, Driver, Drive roller, Supporting drive roller, Directional driver, ROT, Run-out table, Finishing mill*
- (vi) pursuant to Rule 190, 4. b), order that the above measures be subject to a daily penalty payment of 3,000 euros per day of delay, for each day beyond the deadline fixed for the production of evidence.

Danieli responded by arguing that the documentation provided regarding the machine installed at Hoa Phat Group was generic. The documentation did not allow for verification of the presence of patented features and therefore did not meet the evidentiary threshold required to substantiate the allegation of infringement.

Given the Claimant's long-standing business relationship with Hoa Phat, dating back to at least 2021, it was not plausible to claim that Primetals was unaware of the Danieli plant in Vietnam. Therefore, the Claimant had knowledge of the plants in Vietnam as of July 5, 2024, when it filed an application to preserve evidence against Danieli (UPC CFI no. 337/2024). However, during the proceedings for preserving evidence Primetals deliberately chose not to raise any objections regarding the plants owned by the Hoa Phat Group.

Even if Primetals recently discovered these facts, negligence on its part could not be remedied by a belated request.

In any case, the application made pursuant to R. 190 RoP was overly broad and exploratory because it referred to any Danieli plant installed in Vietnam, not only the plants of the Hoa Phat Group.

GROUNDS FOR THE ORDER

Art. 59 UPCA states as follows: "*at the request of a party which has presented reasonably available evidence sufficient to support its claims and has, in substantiating those claims, specified evidence which lies in the control of the opposing party or a third party, the Court may order the opposing party or a third party to present such evidence, subject to the protection of confidential information. Such order shall not result in an obligation of self-incrimination*".

In analogous terms, R. 190 RoP stipulates that “*where a party has presented reasonably available and plausible evidence in support of its claims and has, in substantiating those claims, specified evidence which lies in the control of the other party or a third party, the Court may on a reasoned request by the party specifying such evidence, order that other party or third party to produce such evidence. For the protection of confidential information the Court may order that the evidence be disclosed to certain named persons only and be subject to appropriate terms of non-disclosure*”.

In accordance with the case law of the Court of Appeal of the UPC (UPC CoA no. 298, 299 and 300/2024, order 24 September 2024; see also UPC CFI no. 846/2024, Munich LD, order 3.4.2025; UPC CFI no. 471/2023, Mannheim LD, order 20.10.2024) the following principles apply to a request under R. 190 RoP.

R. 190 RoP implements and must be interpreted in accordance with Art. 6(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.

As a rule, an order to produce evidence presupposes that there is a fact that is relevant to the substantiation of claims (or defences) and that the fact requires proof by the party who is making the application. To this end, the applicant must set out in the application which fact it wishes to prove by which means of evidence and for what reason. No evidence is required for a fact that is not (specifically) contested (see R. 171.2 RoP). If a fact is not relevant to the claims (or defences) being pursued, ordering the production of evidence for such a fact is generally at least disproportionate.

An applicant for an order pursuant to R. 190 RoP must have presented reasonably available and plausible evidence in support of its claims (or defences) before an application under R. 190 RoP can be granted. Whether the applicant has met this requirement and, as a result, whether an order to evidence against the opponent or a third party can be considered is at the discretion of the Court.

When exercising this discretion, the circumstances of the individual case must be considered, taking into account the mutual interests and the principle of efficient conduct of proceedings.

In addition, with regard to the case management powers of the judge-rapporteur, the presiding judge or the panel, there is a margin of discretion when adjudicating on a request for an order to produce evidence which also includes determining the order in which points in dispute are to be decided. In exceptional cases, an oral hearing may be adjourned in accordance with R. 114 RoP in order to invite further submissions of evidence.

The burden of presentation and proof for the existence of the prerequisites for an order to produce evidence, lies with the applicant.

In the case at hand, Claimant's request raises a critical admissibility issue related to the existence and outcome of the proceedings to preserve evidence that Primetals brought against Danieli with an application filed on 5.7.2024 (UPC CFI no. 337/2024).

In that application, the Claimant made no reference to the plant built by Danieli at Hoa Phat. During these proceedings, the Claimant stated that it only discovered the plant's existence at a later date, purely by chance, at the beginning of 2025. To support this claim, the Claimant filed written statements made by employees and collaborators who had obtained this information unexpectedly.

Regardless of the actual probative value of these statements, it is doubtful that Primetals was unaware of Danieli's machinery in Vietnam by July 2024.

From a general point of view, the reference market has a very particular connotation. It is a highly specialized and technological sector in which a limited number of competitors operate. These competitors sustain very high investments for the constant innovation of the solutions offered. Consequently, they tend to monitor the market and the conduct of competitors very carefully. This is also to preserve the value of the aforementioned investments.

Primetals' submission of the application to preserve evidence is consistent with this analysis. The Claimant thoroughly inquired about all the features of the plant at the Nucor Steel facility in the United States. Only after these verifications did the claimant submit the request pursuant to R. 192 et seq. RoP in July 2024.

Therefore, it is highly unlikely that Danieli's machinery in Vietnam escaped constant market monitoring, especially since articles in the case repeatedly praise its formidable production capacity.

This conclusion is further confirmed by the proven existence of solid and ongoing commercial relations between Primetals and Hoa Phat since at least 2021, as evidenced by publicly available information disclosed by the Claimant on its website (see doc. 26, Defendant, Article dated February 14, 2024, entitled *Primetals Technologies to Streamline Hoa Phat's Production Management*). Given this context, it is highly doubtful that Primetals did not have the opportunity to acquire direct knowledge of Danieli's plant from the same Vietnamese business partner.

Even if the Claimant's argument were accepted, the late discovery of this circumstance would mainly be due to negligence, which cannot be remedied by the request pursuant to Art. 59 UPCA and R. 190 RoP, that essentially duplicates what was requested in the previous application to preserve evidence.

Despite the above observations regarding inadmissibility, the Claimant's request is deemed unfounded because it did not provide reasonably available or plausible evidence to support its claims.

The business relationship between Danieli and Hoa Phat is documented by two articles published by Danieli on its website (see Annex BBY 24 and Annex BBY 25). The Defendant does not contest this fact. The existence of a plant built by Danieli at Hoa Phat's facilities in Vietnam is also proven (see Annexes BBY 21 and 22). This fact is also undisputed.

In support of its patent infringement claim, Primetals referred to photographs of the plant found online and accessible to the public and to technical analysis made by the inventor of EP'977 and the head of Primetals' IP Department with reference to these images.

In the court's opinion, the photographs do not provide sufficient evidence of patent infringement, nor has an adequate technical analysis been provided to support the allegation.

This is because the technical observations were made solely by Primetals employees.

Furthermore, the Claimant itself has explicitly expressed a doubtful position on the possible infringement, stating that "*such disclosure was necessary to determine whether an act of infringement has occurred, or conversely, to confirm that no infringement exists*".

In light of the above considerations, the Claimant's request to produce evidence is rejected as inadmissible or, in any event, unfounded.

ORDER

Claimant's request made in the application dated 9-17.10.2025 is rejected.

Any party may request that this order be referred to the panel for a review pursuant to R. 333 RoP.

Milan, 8 January 2026.

Pierluigi Perrotti
presiding judge and judge rapporteur