



Düsseldorf local division

UPC_CFI_885/2025

Order
of the Court of First Instance of the Unified Patent Court
issued on 4 May 2026
concerning EP 2 983 864 B1

APPLICANT:

Otec Präzisionsfinish GmbH, represented by its managing directors Helmut and Nico Gegenheimer and Soran Jota, Heinrich-Hertz-Straße 24, 75334 Straubenhardt Conweiler, Germany

represented by:

Klaus Haft, Attorney-at-law; Joscha Torweihe, Attorney-at-law; Antonia Wilhelm, Attorney-at-law, HOYNG ROKH MONEGIER, Steinstraße 20, 40212 Düsseldorf and Theatinerstr. 7 / Entrance Maffeigasse, 80333 Munich, Germany

European Patent Attorney Steffen Lenz, Lichti Patentanwälte Partnerschaft mbB, Bergwaldstraße 1, 76227 Karlsruhe, Germany

Electronic service address: klaus.haft@hoyngrokh.com

RESPONDENT:

STEROS GPA INNOVATIVE S.L., Calle Maracaibo 1, Nau 2, 08030, Barcelona, Spain

represented by:

Dr Peter Koch, Attorney-at-law, PENFORCE, Gabelsbergerstraße 9, 80333 Munich, Germany

Email address: peter.koch@penforce.eu

PATENT APPLICATION: EUROPEAN PATENT NO. EP 2 983 864 B1

PANEL: Düsseldorf local division panel

JUDGES INVOLVED:

This order was issued by Presiding Judge Thomas as judge-rapporteur, legally qualified judge Dr Schumacher and legally qualified judge Dr Schober.

LANGUAGE OF THE PROCEEDINGS: German

SUBJECT: Art. 60(8) UPC Agreement, 198.1, 199.2 RoP – Application for the annulment of an order for inspection and preservation of evidence

SUMMARY OF THE FACTS:

1. On 22 September 2025, the applicant, in the run-up to an intended action on the merits, filed an application for an order for an inspection and preservation of evidence at the respondent's exhibition stand.
2. On 22 September 2025, the Düsseldorf local division ordered the following without first hearing the respondent:

“I. The applicant is permitted to have a ‘DLyte PRO500 Automated Cell’ in working order at the respondent's exhibition stand at the EMO Hannover 2025 trade fair, which takes place from 22 September 2025 to 26 September 2025 at the exhibition grounds, Hermes Allee, 30521 Hanover, Germany, and

1. commission the “DLyte PRO500 Automated Cell”, whereby the respondent is instructed to enter any necessary passwords;
2. for the purpose and duration of the measurements of the movement sequence and rotational speed of the workpiece holder of the “DLyte PRO500 Automated Cell”, to attach a smartphone to the workpiece holder;
3. to make appropriate settings on the “DLyte PRO500 Automated Cell” in order to prevent distortion of the measurement results, in particular by deactivating the container's vibration unit;
4. select and activate a programme on the “DLyte PRO500 Automated Cell” that sets the workpiece holder in motion for the purpose of measurement;
5. where provided for by the “DLyte PRO500 Automated Cell”, to configure and activate a programme yourself that sets the workpiece holder in motion for the purpose of measurement;
6. carry out the measurement whilst the “DLyte PRO500 Automated Cell” is in operation;
7. repeat the measurement process until a sufficient measurement of the rotational speed and the movement sequence of the workpiece holder of the “DLyte PRO500 Automated Cell” has been obtained.

II. Should an on-site inspection in accordance with Section I not be possible, the applicant shall be permitted to provide one copy each of a “DLyte PRO500 Automated Cell” and all technical, promotional and

commercial documents relating to the “DLyte PRO500 Automated Cell” during the EMO Hannover 2025 trade fair, which takes place from 22 September 2025 up to and including 26 September 2025 at the exhibition grounds, Hermes Allee, 30521 Hanover, Germany, and then have them inspected by an expert as described in Section I.

- III. The expert shall, within a period of two weeks following the completion of the measures referred to in Sections I and II, prepare a detailed description of the “DLyte PRO500 Automated Cell” and submit it to the Chamber, which shall contain a detailed description of the features of the “DLyte PRO500 Automated Cell” relevant for assessing an infringement of the patent in suit.
- IV. The description prepared in accordance with Section III and all other results of the inspection and preservation of evidence may only be used in main proceedings against the respondent.
- V. The following person is appointed as an expert to carry out the aforementioned measures:

Patent Attorney Stephan Freischem, Salierring 47-53, 50677 Cologne.

He may be replaced by a European patent attorney working in the same practice.

- VI. To assist the expert, the bailiff Boxhorn is appointed as the expert’s assistant.

In the event that the bailiff is unable to carry out the inspection and the measures to secure evidence, he may be replaced by a locally competent bailiff to be appointed by the applicant.

- VII. In the interests of safeguarding the respondent’s trade secrets, which may come to light during the inspection and preservation of evidence, the expert and the bailiff are instructed to maintain confidentiality both towards the applicant personally and towards third parties.
- VIII. During the enforcement of this order, in addition to the expert and the bailiff, the following representatives of the applicant shall be permitted to be present:
 1. Mr Joscha Torweihe, UPC representative and the applicant’s appointed legal representative in this matter from the law firm Hoyng ROKH Monegier, Steinstraße 20, 40212 Düsseldorf, or another Attorney-at-law from the law firm Hoyng ROKH Monegier should Mr Torweihe be unavailable;
 2. Mr Steffen Lenz, patent attorney, UPC representative and patent attorney acting in this matter at the patent law firm Lichti, Bergwaldstraße 1, 76227 Karlsruhe, may be present during the measures requested under Section I, or another patent attorney from the patent law firm Lichti should Mr Lenz be unavailable.

Representative bodies, employees or other staff of the applicant shall not be present during the execution of this order with regard to the inspection and preservation of evidence.

- IX. The respondent is ordered to cooperate in the implementation of the measures for inspection and preservation of evidence in accordance with this order and, upon request, to grant the bailiff and the expert
1. to allow them, as well as the persons authorised to be present in accordance with Section VIII, to enter the respondent's exhibition stand at the EMO Hannover 2025 trade fair, which takes place from 22 September 2025 up to and including 26 September 2025 at the exhibition grounds, Hermes Allee, 30521 Hanover, Germany, in order to carry out the inspection and preservation of evidence in accordance with this order;
 2. to grant unrestricted access to the 'DLyte PRO500 Automated Cell', including the entry of passwords;
 3. to grant access to a part of the "DLyte PRO500 Automated Cell";
 4. to put the "DLyte PRO500 Automated Cell" into operation and set it to various operating modes

and to instruct its directors and employees to comply with the requests of the bailiff or the expert.

- X. The persons involved in carrying out the inspection and the preservation of evidence, and in particular the bailiff, the expert and the applicant's legal representatives, are obliged to keep confidential from third parties and from the applicant any facts that come to their knowledge in the course of executing the entire order.

Furthermore, until the Unified Patent Court issues a release order, the aforementioned persons must not provide the applicant or third parties with any opportunity to inspect the 'DLyte PRO500 Automated Cell', any documents and products that may have been seized, or the detailed description to be prepared by the expert.

- XI. The respondent is to be requested to comment on any confidentiality interests it may have following the submission of the detailed description to be prepared in accordance with Section III by the expert appointed to carry out this order. The above-mentioned representatives of the applicant, who were permitted to be present during the inspection and preservation of evidence, are to be heard. Only thereafter shall the court decide whether and to what extent the detailed description is to be brought to the applicant's personal attention and whether the duty of confidentiality for the applicant's representatives is to be lifted.
- XII. The applicant is obliged to bear the costs of the inspection and the preservation of evidence, including the preparation of the detailed report. The applicant is required to pay the expert, prior to the commencement of the inspection, a reasonable advance on costs, the amount of which is to be determined by the expert, unless the expert waives the right to such an advance.

- XIII. In the event of a culpable breach of this order, the court may impose a penalty payment on each party for each breach, the amount of which the court may determine having regard to the circumstances of the individual case.
- XIV. The measures for inspection and preservation of evidence shall be revoked on the respondent's application or shall otherwise lapse if the applicant, within a period of no more than 31 calendar days or 20 working days, whichever is longer, after the written description of the applicant to be prepared in accordance with Section III has been disclosed or the court has decided by a final order not to grant access to that description, brings an action against the respondent.
- XV. This order shall be served in person by one of the applicant's representatives named in Section VIII, together with a copy of the application for this order, including the exhibits and other documents on which the application is based prior to or at the time of enforcement of this order, as well as the notice of provisional measures and instructions for access to the proceedings, without delay at the time of enforcement of the measures.

Service of these documents shall be effected by the bailiff in cooperation with the applicant's legal representative present at the inspection and preservation of evidence in accordance with Section VIII.1.

- XVI. In all other respects, the application for inspection and preservation of evidence is dismissed.
3. The order was enforced on 24 September 2025 at the respondent's exhibition stand on the grounds of the Hannover Messe, Hall 11, Stand E38.
 4. The expert appointed by the Düsseldorf local division to carry out the inspection and preservation of evidence produced the detailed description he had been requested to provide on 8 October 2025.
 5. By a procedural order dated 30 October 2025, the judge-rapporteur requested the respondent to assert any confidentiality interests by 13 November 2025.
 6. As the respondent did not make use of this opportunity, the judge-rapporteur ordered on 17 November 2025 the release of the unredacted version of the detailed description prepared by the expert, including the annexes, and the order for the protection of confidential information to be found under point X. of the order of 22 September 2025, in respect of the facts contained in the expert's written description, including the annexes, in relation to the applicant. At the same time, the judge-rapporteur informed the applicant that the measures for inspection and preservation of evidence pursuant to paragraph XIV of the order of 22 September 2025 would be revoked at the request of the respondent or would otherwise cease to have effect if the applicant has not brought an action against the respondent within a period of no more than 31 calendar days or 20 working days, whichever is longer, after the written description to be prepared by the applicant has been disclosed.

7. By document dated 4 February 2026, the respondent filed an 'Application for the revocation of the duty to inspect and preserve evidence, and for a declaration of the obligation to pay compensation'.

THE APPLICANT'S APPLICATIONS:

8. The respondent requests:
 - I. The measures for inspection and preservation of evidence ordered by the decision of the UPC (LD Regional Court) with ref. no. UPC_CFI_885/2025, issued on 22 September 2025, concerning European patent EP 2 983 864 B1, be set aside;
 - II. in the alternative (to I.), that they be declared void.
 - III. The applicant is ordered to (1) return to the respondent all evidence obtained as a result of the implementation of the ordered measures – regardless of its form – and (2) destroy any copies thereof, in particular
 - a. the English-language brochure DLYte PRO500 "Precise metal surface finishing for mass production";
 - b. the expert's written report dated 8 October 2025, together with its annexes.
 - IV. The claimant is ordered to pay the defendant reasonable compensation for the damage incurred as a result of these measures in the amount of EUR 11,390.00.
 - V. The claimant shall bear the costs of the proceedings.
9. The applicant contested the respondent's claims for compensation, restitution and destruction in a document dated 2 April 2026.

FACTUAL AND LEGAL ISSUES:

10. In the applicant's view, the revocation of the ordered measures for inspection and preservation of evidence pursuant to Art. 60(9) of the UPC Agreement, R. 198.2, 199.2, 354.2 of the UPC RoP in conjunction with Art. 7(4) of the Enforcement Directive (cf. Recital 22), the applicant is obliged to provide the defendant with appropriate compensation for the damage incurred as a result of these measures.
11. A separate proceeding (Rule 125 of the RoP) 'may' be brought to determine the specific amount of compensation. Nevertheless, it is within the court's discretion to set the relevant costs immediately. For reasons of procedural economy, the respondent considers it appropriate to rule on the application for costs at this stage.
12. On this basis, the respondent calculates its claimed costs as follows:

a) Kosten der Vertretung durch Rechtsanwälte:

Rechtsanwalt Dr. Peter Koch: 10 Arbeitsstunden à 480,00 €

(für Beratung, Analyse zu besichtigende Vorrichtung; Abgleich Patentverletzung; Durchsicht und Analyse Gutachten; Beratung zu Rechtsbestands)

RA-GESAMT = EUR 4.800,00

b) Kosten der Vertretung durch Patentanwälte:

Patentanwalt Marc Wachenhausen: 12 Arbeitsstunden à 445,00 €

für Besprechungen mit der Antragsgegnerin; Bewertung der Technologie der angegriffenen Ausführungsform; Analyse Gutachten; Besprechungen mit vertretendem RA; Bewertung Schutzbereich und Rechtsbestand)

PA-GESAMT = EUR 5.340,00

c) Auslagen:

Übersetzungskosten: 1.250,00 € (Antragsschrift)

Auslagen -GESAMT= EUR 1.250,00

GESAMTKOSTEN = EUR 11.390,00

13. In the applicant's view, the respondent has not suffered any damage eligible for compensation under R. 198.2 RoP or Art. 60(9) of the UPC Agreement. The legal costs claimed do not constitute damage in this sense. Furthermore, the amount claimed by the applicant is also not comprehensible.
14. In so far as the respondent demands the return of all evidence obtained and the destruction of copies, this application is unfounded simply because there is no legal basis for it. Furthermore, the applicant has not substantiated its claim in this regard.

REASONS FOR THE ORDER:

15. The order for revocation is based on Art. 60(8) of the UPC Agreement, R. 198.1, R. 199.2 of the RoP.
16. Under Article 60(8) of the UPC Agreement, the court shall ensure that the measures for the preservation of evidence are revoked or otherwise set aside on the defendant's application, without prejudice to any claims for damages, if the applicant does not, within a period – not exceeding 31 calendar days or 20 working days, whichever is the longer – brings an action before the court leading to a decision on the merits.
17. Rule 198.1 of the RoP, which applies mutatis mutandis pursuant to Rule 199.2 RoP applies mutatis mutandis to the order for an inspection, specifies that an order for the preservation of evidence, made on the respondent's application, shall be set aside or otherwise rendered ineffective, without prejudice to any claims for damages, if the applicant does not, within a period of 31 calendar days or 20 working days – whichever is the longer – from the date specified in the court order, taking due account of the date by which

the report is to be submitted in accordance with R. 196.4 RoP – the applicant initiates the main proceedings in the matter before the court.

18. The conditions for setting aside the order pursuant to these provisions are met.
19. Pursuant to paragraph IVX of the order of 22 September 2025 and paragraph III of the order of 17 November 2025, the time limit referred to in Rule 198.1 of the RoP begins to run upon disclosure of the detailed description. This took place with the disclosure order of 17 November 2025.
20. The period of 31 calendar days or 20 working days therefore expired on 18 December 2026 without the applicant having brought an action on the merits.
21. On this basis, the order pursuant to R. 198.1, 199.2 RoP was to be set aside. The order for the return and destruction or deletion of the detailed description and the prospectus referred to in the operative part serves to remedy the consequences. It essentially follows the respondent's application and is likewise based on the aforementioned provisions.
22. In so far as the respondent, in its application for revocation, simultaneously seeks payment of reasonable compensation, such a claim may find its basis in Article 60(9) of the UPC Agreement in conjunction with Rule 198.2 of the RoP. Accordingly, in the event of the annulment of an order for the preservation of evidence, the court may order the applicant to pay the defendant reasonable compensation for all damages incurred as a result of these measures. However, the applicant has failed to specify such damages in concrete terms. In so far as she instead refers in this context to the costs allegedly incurred by her in the course of the proceedings for the preservation of evidence, these are costs which must be claimed in proceedings for the assessment of costs pursuant to Rule 151 et seq. of the RoP, but not damages in the aforementioned sense. The Chamber has, in accordance with Rule 118.6 of the RoP, issued the preliminary decision on costs necessary as the basis for such a cost assessment procedure in the present decision.

ORDER:

- I. The order for inspection and preservation of evidence dated 22 September 2025 is set aside.
- II. The applicant and her legal and patent attorneys are ordered to return to the respondent all evidence obtained as a result of the implementation of the measures ordered – regardless of its form – and to destroy any copies, including all copies in their possession and those obtained in the course of the preservation of evidence and inspection, of the English-language brochure “DLYte PRO500 Precise metal surface finishing for mass production”, as well as to irrevocably delete all digital copies of the aforementioned detailed description.
- III. The costs of the proceedings for the preservation of evidence and inspection shall be borne by the applicant.
- IV. In all other respects, the application for annulment is dismissed.

Issued on 4 May 2026 NAMES
AND SIGNATURES

Presiding Judge Thomas	
Legally qualified judge Dr Schumacher	
Legally qualified judge Dr Schober	
for the Deputy-Registrar	