



Milan Local Division

UPC CFI no. 377/2025, no. 702/2025
order
issued on 22.7.2026

CLAIMANT

PRIMETALS TECHNOLOGIES AUSTRIA GMBH

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DEFENDANT

DANIELI & C. S.P.A.

via Nazionale 41, 33042 - Buttrio (UD), Italy,

represented by Giulio Enrico Sironi and Stefania Bergia, *Simmons+Simmons*, via Tommaso Grossi n. 2, 20121 - Milan, Italy;

Davide Luigi Petraz and Lorenzo Fabro, *GLP Intellectual Property Office*, via V. Hugo n. 2, 20123 - Milan, Italy

LANGUAGE OF THE PROCEEDINGS

English

DECIDING JUDGE

Presiding judge and judge rapporteur Pierluigi Perrotti

SUBJECT OF THE ORDER

Decisions of the judge rapporteur after the interim conference

ORDER

Pursuant to R. 105.5 RoP, following the interim conference, the judge-rapporteur shall issue an order setting out the decisions taken.

In the present case, an online interim conference was held via Webex on 9 July 2026 at 11:00 and was audio-recorded, according to R. 106 RoP.

The parties agreed on the main topics to be discussed at the interim conference as previously identified by the judge-rapporteur in order dated 22 June 2026.

The defendant proposes that the item '*scope of the infringement claim – limitation of the asserted claims of EP'977 to claims 1, 3, 4 and 8*' should also be included amongst the issues to be discussed.

The judge rapporteur points out that a final decision on the possible admissibility of the claimant's request based on different claims of EP'977 is reserved for the Panel; therefore, the issue raised by the defendant may be considered at this interim conference solely for the purpose of ascertaining whether the claimant is willing to limit its claim in a manner consistent with the defendant's objection.

The claimant clarifies that the only thing it mentioned in the briefs was that Primetals does not renounce on invoking sub-claims different from 3, 4 and 8 in any other stage and not in these proceedings. It is not subject of these pending proceedings to include any of these sub-claims, different from 3, 4 and 8.

The defendant takes note of the claimant's clarifications, with the result that it is now clear that, in these proceedings, the parties are only discussing claims 1, 3, 4 and 8.

The judge-rapporteur takes note of this, without it therefore being necessary to adopt any order on this point.

These are the decisions of the judge-rapporteur on the issues discussed at the interim conference.

1. Possibility of a settlement between the parties

The possibility of a settlement has been explored with the parties, without success to date. Should a concrete prospect for a settlement emerge in the future, the judge-rapporteur requested the parties to inform the Court promptly.

2. Breakdown of features of claim 1

As the parties have relied on different feature breakdowns in their respective submissions, the judge rapporteur suggests, in the interest of consistency for both the oral hearing and the subsequent decision, that the claimant's feature breakdown be adopted unless any objections are raised by the parties.

The claimant maintains its feature breakdown and observes that the defendant has put forward a different breakdown, without objecting to the one proposed by Primetals.

The defendant objects to the claimant's feature breakdown on the grounds that it constitutes a rewording of claim 1 that does not reflect either the wording of the claims or the description of the patent.

According to the defendant, its own breakdown faithfully follows the structure of claim 1, dividing the claim into individual features in the order and form in which they appear in the patent. By contrast, the claimant's breakdown is said not to be a true feature analysis, but rather a reformulation of the claim language.

First, the defendant submits that the wording "*at least one supporting drive roller which is mounted*" has been reformulated by the claimant as "*having at least one drive roller*", thereby omitting certain claim elements and altering the original wording.

Second, the defendant argues that its breakdown preserves the two-part structure of claim 1, clearly distinguishing the preamble from the characterising portion of the claim, whereas this distinction is no longer apparent in the claimant's version. In the defendant's view, this may create confusion and influence claim interpretation.

Third, the defendant contends that the claimant's reformulation of features relating to the bearing region departs significantly from the wording of the claims and description. The defendant submits that the relevant feature is drafted as a functional feature, namely that the bearing region is open so as to allow the drive roller to be introduced or removed sideways and/or upwards. According to the defendant, the claimant's breakdown instead presents sideways and upward openness as separate structural features, thereby altering the nature of the claimed subject matter.

The claimant explains that its feature breakdown groups together the claim elements relating to each component at issue, namely the supporting drive roller, the drive roller, the bearing region and the fixing mechanism. The claimant denies that its breakdown deviates from the wording of claim 1.

The claimant further argues that the defendant's objections are inadmissible because they have been raised too late in the proceedings. The claimant notes that its feature breakdown was submitted together with the statement of claim and submits that any objections should have been raised, at the latest, in the statement of defence.

The defendant disputes the claimant's objection of inadmissibility. It argues that the claimant itself expanded the scope of the dispute by raising allegations of infringement by equivalence at a later stage of the proceedings. According to the defendant, the claimant's feature breakdown was specifically designed to support those arguments based on equivalence.

In view of the foregoing, the Court adopts the following feature breakdown of claim 1, corresponding to that proposed by the defendant, as it closely reflects the literal wording of claim 1.

Claim 1 EP'977	English translation	Original German
i.	Driver (1) for a steel strip coiling installation having	Treiber (1) für eine Stahlbandhaspelanlage mit
ii.	at least one supporting drive roller (3), which is mounted on a frame (2), and	mindestens einer an einem Rahmen (2) gelagerten Stütztreibrolle (3), und
iii.	at least one drive roller (4), which can be adjusted in respect of the supporting drive roller (3) and	zumindest einer gegenüber der Stütztreibrolle (3) anstellbaren Treibrolle (4)
iv.	is mounted on at least one rocking arm (5a, 5b) connected to the frame (2),	die an zumindest einer mit dem Rahmen verbundenen Schwinge (5a,5b) gelagert ist,
v.	wherein the drive roller (4) is attached to a bearing region (7) of the rocking arm (5a, 5b), characterized in that	wobei die Treibrolle (4) an einem Lagerbereich (7) der Schwinge (5a,5b) angebracht ist, dadurch gekennzeichnet dass
vi.	the bearing region (7) is open for introducing or removing the drive roller (4) sideways and/or upwards when placing the rocking arm (5a, 5b) in the operating position, and	der Lagerbereich (7) offen ist zur Einfügung beziehungsweise zur Entnahme der Treibrolle (4) zur Seite und/oder nach oben bei Stellung der Schwinge (5a,5b) in Betriebsposition, und
vii.	the driver (1) has a fixing mechanism for fixing the drive roller (4) to the bearing region (7).	der Treiber (1) einen Fixierungsmechanismus zur Fixierung der Treibrolle (4) am Lagerbereich (7) aufweist.

The parties shall refer to this feature breakdown during the oral hearing, thereby ensuring uniform and unambiguous references to the individual sub-features.

3. Auxiliary requests

The Court notes that the purpose of the present discussion is limited to case management and does not imply any preliminary assessment of the merits or relevance of the auxiliary requests. The judge-rapporteur observes that the claimant has submitted 23 auxiliary requests. In view of their number and having regard to the requirements of procedural economy and the efficient conduct of the proceedings, the Court considers that such number is not reasonable under the applicable rules of procedure. The claimant is therefore invited to reduce the number of auxiliary requests and to identify the five auxiliary requests it considers to be the most relevant for the resolution of the dispute.

The claimant indicates that it will comply with the invitation of the judge-rapporteur.

The defendant welcomes this approach and submits that, in the interest of the orderly preparation of the oral hearing, the parties should be informed in advance of the auxiliary requests that may be the subject of discussion. According to the defendant, a substantial reduction in the number of auxiliary requests would contribute to the efficient conduct of the proceedings and facilitate the preparation of the oral hearing

With the consent of the parties, the judge-rapporteur orders the claimant to file, by 31 July 2026, a reduced set of five auxiliary requests, selected in accordance with the guidance provided by the Court. The defendant shall have until 21 August 2026 to file a written response, limited to addressing the criteria and methodology adopted by the claimant in reducing and selecting those auxiliary requests.

4. Claimant's application under R. 36 RoP for a further exchange of written pleadings concerning infringement by equivalence

The claimant refers to and relies on the arguments previously advanced in its rejoinder of 21 January 2026 in support of its application under R. 36 RoP.

According to the claimant, those arguments sufficiently justify a further and more detailed examination of infringement by equivalence within the present proceedings.

The claimant submits that the reasons why the arguments based on infringement by equivalence were raised only in the statement of reply are linked to the parties' pre-litigation settlement discussions. During those discussions, the parties exchanged, on a confidential basis, views regarding claim construction and the allegedly infringing embodiments. According to the claimant, it could not rely in the proceedings on arguments concerning claim interpretation that had been disclosed by the defendant solely for the purposes of exploring an amicable settlement. The claimant further submits that, under UPC case law, an allegation of infringement by equivalence may depend on the position adopted by the defendant in its statement of defence, since only at that stage does the claimant become aware of the claim construction advanced by the opposing party and is therefore in a position to develop an infringement case based also on equivalence.

The defendant disputes the claimant's position. It submits that the claimant did not become aware of the potentially relevant embodiment only during the settlement discussions.

According to the defendant, the embodiment on which the claimant's allegation of infringement by equivalence is based is depicted in a photograph taken by the claimant itself and filed as part of Annex 7 to the statement of claim. The defendant therefore argues that the claimant possessed all information necessary to advance an allegation of infringement by equivalence several months, if not years, before commencing the present action, irrespective of any exchanges that may have taken place during the confidential negotiations.

The defendant further maintains the request already made at page 40 of its rejoinder of 22 December 2025, whereby it sought leave to file an additional document, subject to confidentiality

restrictions, which, in its submission, would demonstrate conclusively that all elements underpinning the claimant's equivalence case were known to the claimant well before the commencement of these proceedings.

The Court notes, on the one hand, that the parties' discussion has largely focused on the admissibility and timeliness of the arguments concerning infringement by equivalence, which were introduced by the claimant for the first time in the course of the proceedings in its statement of reply of 20 October 2025. That issue may, for the time being, be left open, and any decision thereon is reserved to the panel following the oral hearing.

In any event, the Court considers that the claimant has not established the existence of circumstances preventing a full presentation of its case on infringement by equivalence during the written procedure. According to the claimant's line of argument, the need to raise this issue arose only after it had reviewed the defendant's statement of defence. However, there appears to have been no obstacle to a full discussion of the issue within the ordinary framework and timetable of the written procedure, with the claimant being able to address the matter—as indeed occurred—in its statement of reply, followed by the defendant's opportunity to respond in its rejoinder to the reply to the statement of defence.

In light of the foregoing, the claimant's request for a further exchange of written pleadings pursuant to R. 36 RoP in relation to infringement by equivalence is dismissed.

5. Substantive law applicable to the alleged acts of infringement

The Court draws the parties' attention to the appropriateness of a further exchange of written submissions on the issue of the substantive law applicable to the alleged acts of infringement. The judge-rapporteur emphasises that this direction is not intended to express, nor should it be understood as expressing, any preliminary view of the Court on the matter. Rather, in the context of efficient and proactive case management, it is intended to provide the Parties with an opportunity to further develop their submissions on a point of law which may be relevant to the determination of the case.

The parties jointly request the court to address this point of law by further exchange of written submissions.

The judge-rapporteur therefore sets the same deadlines as those established in point 3. above, namely:

- for the claimant, until 31 July 2026, to lodge a written submission on this specific point of law; and
- for the defendant, until 21 August 2026, to lodge its response.

For reasons of procedural efficiency and economy, each party may file a single written submission within the respective deadline addressing both the issue of the auxiliary requests (see point 3. above) and the issue of the substantive law applicable to the alleged acts of infringement.

6. Value of the actions

The parties agree to set the value of the infringement action at EUR 1,250,000 and the value of the counterclaim for revocation at EUR 1,875,000.

Accordingly, the value of the infringement action is set at EUR 1,250,000.

The value of the counterclaim for revocation is set at EUR 1,850,000.

7. Legal costs

Both parties had submitted estimated costs.

The judge-rapporteur invites the parties to consider the possibility of reaching an agreement on the predetermined amount payable by whichever party is unsuccessful at the outcome of these proceedings, thereby allowing a significant saving of procedural resources for both the parties and the Court in the subsequent phase concerning the precise quantification of legal costs.

The parties state that they are willing to explore the possibility of reaching an agreement on this specific point and, should they do so, to inform the Court promptly.

8. Preparation for the oral hearing

The oral hearing is confirmed to take place in person at the Milan Local Division on 20 October 2026 at 10 a.m. As previously clarified, validity and infringement will be addressed together.

For the oral hearing, the parties may use slides to present their case, provided they rely solely on arguments already set out in their written submissions and introduce no new matter. The slides shall be exchanged by e-mail, copying the Milan Local Division at contact_milan.loc@unifiedpatentcourt.org, no later than 13 October 2026, so that all parties may review them in advance.

Milan, 22 July 2026.

Pierluigi Perrotti
presiding judge and judge rapporteur