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UPC “saisie-contrefaçon” Part II: the “OERLIKON” case

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Having examined the UPC texts relating to UPC “saisie-contrefaçon” (see [here](#)), it’s time to look at the initial case law. Of course, the existence of only two cases is insufficient to draw general conclusions, but we can already see how the system works in practice, and draw some conclusions. The first two cases were initiated in countries with well-established seizure systems: Italy and France. Today, we will study the Italian ones (UPC, Milan Local Division, 14 June 2024, procedure n° 500982/2023 and n°498862/2023, “OERLIKON” cases).

The cases involved OERLIKON TEXTILE against HIMSON and BHAGAT GROUP, two Indian textile manufacturers. The patent in question related to a false-twisting machine (EP214848B1, “EP’848”). At a trade fair, the defendants exhibited two machines bearing the trade names “Machine 2” and “Machine 2-TS”, as well as a machine bearing the trade name Bhagat Group, which, according to the patentee, allegedly infringed EP’848.

The jurisdiction of the Italian local division was not in doubt: the seizure had to be carried out during a trade show held in Italy. This circumstance, which stems from the temporary nature of the trade show, also explains why the proof of urgency did not raise any questions either. The order was granted without the seizing party proposing a representative to attend, as a consequence only an expert was appointed.

Overall, then, there are no specific difficulties a priori, if we omit the proof of alleged infringement, on which the decision seems to me to be interesting.

It should be remembered that, in accordance with article 60.1 of the UPCA, the applicant must provide reasonably accessible evidence, in line with directive 2004/48 (art. 7). French experience has shown that this new requirement, which stems from the principle of proportionality of measures (balance of interests between the alleged infringement and the rights of the seized party), most often involves comparing the evidence held against either, at the very least, the main claim of the patent, or, if possible, against all the claims for which there is evidence of infringement. While this system may be criticized from a fundamental point of view (the proportionality check should only affect the measures and not the admissibility of the request), in practice it works well, since orders are almost systematically granted and, *de facto*, the requirement of hints of infringement (i.e., plausibility of infringement) serves only to delimit the measures, so that they are indeed proportional.

However, in contrast to this practice, the Italian local division of the UPC seems to have been satisfied with criticizable hints of infringement, without requiring any demonstration from the

applicant. In fact, the Court contented itself with the following elements: copies of four photos of machines displayed on the stand, a copy of a poster displayed on the same stand, a video of the Bhagat Machine, and a technical opinion. Unfortunately, we don't have any information on the expert's technical opinion, but I'll put forward a (highly probable) hypothesis here. We can deduce from its title that it should not be an opinion of a Patent Attorney, and therefore that it is rather a technical opinion concerning the reproduction of the applicant's machine which implements the patent. Moreover, since the applicant does not appear to have the machines in question at his disposal, since he wishes to preserve proof of infringement through seizure, he is not in a position to compare these machines either to his own machine or to the patent. In other words, the technical opinion provided should not contain any comparison of the patent with the machines in question.

Thus, the threshold for admissibility of the request is low, in line with what could be deduced from the two-stage mechanism introduced by the UPC: hints of infringement (art. 60.1 UPCA), which condition the granting of the order, followed by a balance of interests, in order to determine whether the measures granted are proportionate. Moreover, the judges appear to have based their decision on hints that did not concern patent infringement, but rather the reproduction of a machine owned by the applicant, which itself is supposed to reproduce the patent. Indeed, there seems to be confusion between the reproduction of the machine and the reproduction of the patent: common confusion of the patent with what it may lead to. No comparison is made with the patent. As a result, the judges were unable to determine whether there was any real plausibility of infringement, nor could they determine whether the measures were too extensive, or otherwise not proportional.

In the end, although French case law sometimes fails to consider the level of hints required, its result is, in the end, fair, since only the measures are limited. On the other hand, if the Italian local division of the UPC proves that, *as we might have feared*, article 60.1 makes the granting of the order conditional on hints and does not envisage them as a corrective criterion to appreciate the measures granted (as directive 2004/48 and the French judges do). However, in my view, one article should not be read in isolation from the other, and the hints of infringement should be taken seriously from article 60.1 onwards, otherwise the measures granted run the risk of being excessive and, above all, unfounded (how can a true balance of interests be established without indications making infringement more or less likely?)

It remains to be seen how the local Parisian division, with its majority of French judges, itself envisaged the UPC seizure (next episode with the next paper on UPC "saisie"...).

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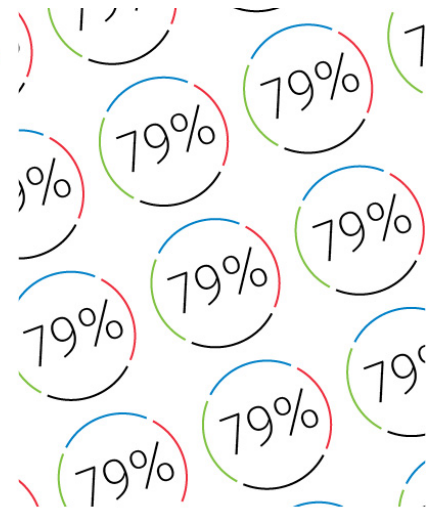
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