

Kluwer Patent Blog

UPC “saisie-contrefaçon” Part III: the “C-Kore” case

Matthieu Dhenne (Dhenne Avocats) · Friday, March 22nd, 2024

Earlier this week, we examined the UPC’s first case on UPC “saisie-contrefaçon” (or “SC”, see [here](#)). Today, we turn our attention another order of this type, which has been rendered by the Paris local division.

In this case, C-KORE had a SC carried out at the premises of its competitor NOVAWELL. C-KORE holds a patent relating to underwater equipment and the testing of such equipment (*Paris Local Division, 14 November 2023, UPC_CFI_397/2023*). The applicant claims that its “CABLE MONITOR” product, a compact automated tool for testing underwater electrical equipment, constitutes an exploitation of its patent. C-KORE claims to have learned in February 2023 that NOVAWELL, one of its former customers, had developed a competing product, called “SICOM”, which reproduces at least all the features of independent claims 1 and 15 and dependent claims 4, 5, 6 and 14. C-KORE maintains that NOVAWELL will (or intends to) manufacture, stock and market the SICOM product from its Montpellier facility in France.

The jurisdiction of the French court was not in doubt: the aim was to carry out a seizure at the alleged infringer’s manufacturing premises, which are in France. As for urgency, this was simply justified by the existence of few players on the relevant market, which was described as highly competitive. As for the balance of interests, it is simply noted that the applicant is a small company, whose most successful product is the CABLE MONITOR, which reproduces the patent, while the defendant is one of its former customers. These elements were sufficient for the applicant to conclude that, in terms of the principle of proportionality, the threat of destruction of the parts outweighed the risks incurred by the applicant. The measures requested were granted by *ex parte*. An expert was appointed, and a representative of the applicant was authorized to attend the seizure.

Overall, as in the first case commented on, there are no specific difficulties either, except as regards proof of alleged infringement, where the decision is just as interesting as the first.

First of all, it should be noted that the applicant’s representative before the UPC and the one present during the seizure operations were different: one might think that this choice resulted from the dual (technical) qualifications of the representative on site (who is a lawyer at the Paris bar, but also a European Patent Attorney), or, more probably, that the representative before the court (who also holds a dual technical competence) wished to have this duplication to avoid mixing genres, no doubt a “French” prudence, since under French law an applicant’s Counsel cannot attend the seizure. In any case, this is the first case where an expert acts in concert with the representative during the seizure operations (on the potential drawbacks of this system, see [here](#)).

Secondly, in the same way as OERLIKON before the Italian local division, C-KORE develops very little of the reasonably accessible evidence and, above all, makes no real comparison with the claims. In contrast to the first case, reference is made to the claims and their reproduction by the allegedly infringing device. However, the claimant not only confines himself to asserting said reproduction, but also merely bases it on the similarity of the two companies' devices. In so doing, the applicant confuses the invention as claimed in the patent with the device purporting to reproduce it. In fact, the question is whether there is reasonable evidence of infringement (of the patent) and not of reproduction of a device that would implement it.

As a consequence, the measures required are *de facto* granted on the basis of elements relating to the allegedly infringing device and its resemblance to the device offered by the applicant: evidence that the seized person was a customer of the seizing company (and therefore possesses training provided, the user manual and drawings of the applicant's machine); the applicant asserts that the SICOM product "*is very similar to the one covered by the patent in question*"; NOVAWELL's brochure, which describes the SICOM ROV (*remotely operated vehicle*) tool as a very compact test connector that enables direct measurement and underwater display of line continuity and insulation resistance, and is described on NOVAWELL's web page as "*an ROV-deployed underwater line insulation and continuity measurement unit*". The applicant considers that these elements are sufficient to demonstrate at least the reproduction of claim 1.

While it is true that the applicant must provide a certain number of reasonably accessible elements, the fact remains that the duplication between the requirement to provide such elements (art. 60.1 UPCA) and the balance of interests continues to raise a problem that could be fundamental. When article 60.1 requires reasonably accessible elements, said elements relate to infringement, which should imply comparing these elements with the content of the asserted patent (i.e., one or more claims). Here, the claimant starts from this idea and falls back on it by mentioning claim 1 in his request, but in the meantime, he returns to the reproduction of his device, which would reproduce the patent by the device marketed by his competitor. In fact, it is once again the applicant's machine (and more precisely its success) that will be put forward in the balance of interests, a balance that in this case is barely sketched out with two findings unconnected with the conclusion that the principle of proportionality is respected.

Ultimately, as in the Italian case, compliance with the principle of proportionality continues to raise questions, so that the conformity of such decisions with European law arises ([Directive 2004/48, art. 7](#)). As a reminder, the principle of proportionality implies, first and foremost, that measures must be proportionate to the evidence available to the applicant of a violation of his or her rights. It is therefore imperative that the magistrate be able to form an idea of the likelihood of infringement to determine whether measures can be granted and, above all, to determine the extent of such measures. In the case under review, this comparison, in my view imperative, seemed even more necessary as the applicant provided virtually no information on the balance of interests (contrary to what seemed to be the case in [OERLIKON](#)).

In conclusion, this C-KORE case proves, in any case, once again, that UPC "saisie-contrefaçon" can be effective. All that remains now is to examine how this tool can be used properly and integrated into a Global/European litigation strategy (more on this in the next posts!).

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).

Kluwer IP Law

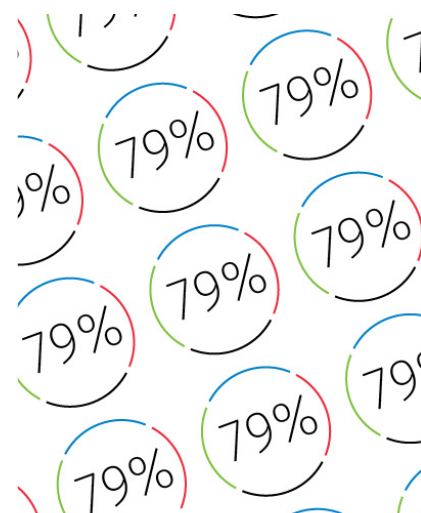
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Friday, March 22nd, 2024 at 10:49 am and is filed under [UPC](#). You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. Both comments and pings are currently closed.