



**UPC\_CFI\_240/2023**  
**Procedural Order**  
**of the Court of First Instance of the Unified Patent Court**  
**delivered on 17/12/2024**  
Order no. ORD\_598537/2023

CLAIMANT

- 1) **Oerlikon Textile GmbH & CO KG** with the lawyers STEFANIA BERGIA and GIULIO SIRONI

DEFENDANT

- 1) **Himson Engineering Private Limited**  
With Fabrizio Jacobacci's lawyer

PATENT AT ISSUE

<i>Patent no.</i>	<i>Owner/s</i>
<b>EP2145848</b>	Oerlikon Textile GmbH & CO KG

## DECIDING JUDGE

Judge-rapporteur **Alima Zana**

## COMPOSITION OF PANEL - FULL PANEL

Presiding judge **Pierluigi Perrotti**

Judge-rapporteur **Alima Zana**

Legally qualified judge **Carine Gillet**

Technically qualified judge **Michel Abello**

LANGUAGE OF PROCEEDINGS: Italian

## ORDER

### **1. Procedural events**

The dispute commenced on 14.6.2023 with Oerlikon's application to Himson for an evidence protection order pursuant to Article 60 of the Agreement and R.o.P. Rules 192 et seq. to protect the EP '848 patent, following an exhibition at the ITMA trade show, scheduled from 8 to 14 June 2024 in Rho (Milan).

The order was granted by the Court *ex parte* and was executed on 14.6.2023: the order was not the subject of a review request by Himson.

Oerlikon instituted proceedings on the merits in a timely manner, seeking a declaration of infringement, an injunction with penalty, publication of the judgment and a recall order.

The plaintiff also sought an order against the other party pursuant to Rule No. 119 R.o.P. of a fine in the amount of €100,000.00, for costs to be incurred in the future proceedings for damages, with costs to be awarded.

Appearing on 19.12.2023, the defendant:

-did not formulate *preliminary objections*;

-introduced *the counterclaim for revocation*, challenging the validity of the patent in terms of added matter, novelty and inventive step.

The plaintiff in turn introduced seven *auxiliary requests* in its first defence (see "*Reply to the Statement of Defence, Defence to the Counterclaim and Application to Amend the Patent*", filed on 20.2.2024).

At Oerlikon's request, evidence from the emergency measure executed ante causam with an order rendered on 6.5.2024 was admitted to the file.

In the course of the proceedings, it requested permission to introduce a further, eighth, *auxiliary requests* under Rule 30(2) RoP: the Court denied permission.

At the Court's urging, the Oerlikon party also waived *auxiliary requests* Nos. 1-3 and confirmed the others.

### **2. Interim conference**

The judge rapporteur requested clarifications from the parties on the most relevant aspects, which are summarised below.

#### **1. Settlement proposals**

The plaintiff acknowledged that initial contacts were made with a view to settlement. The Judge Rapporteur invited the parties to consider an amicable settlement of the dispute and, in the event of a settlement, to immediately notify the Court of this outcome.

## 2. *The title actuated*

The parties discussed translation errors from the German to the Italian patent text, agreeing on the correct translation of the terms 'TREIBWALZE' and 'BEWEGLICHEN'.

## 3. *The counterclaim for revocation*

With respect to Himson's patent invalidity claim, the following points were addressed:

(i) Oerlikon requested that the validity attack be understood as limited to claim No. 1. Himson stated that this interpretative option can be adopted by the Court only if the counterparty's infringement claim is also to be understood as limited to claim 1. Particular reference was made to the principles expressed in some recent decisions of the Court, and in particular the so-called "*front loaded*" principle (see, in this respect, the latest decision of the Central Division in Paris, No. 571565/2023, decision adopted on 27.11.2024)

On this point, the Judge Rapporteur is of the opinion that - without prejudice to the consideration that any final assessment of the Court will have to be made in the final decision - in fact:

- the *infringement* claim in the *Statement of Claim* appears to be limited to claim no. 1 (see e.g. para. 18, pp. 16 ff., para. 19 pp. 27-31).

The generic mention of patent infringement in the conclusions does not seem capable of supporting a different interpretation.

- the claim for invalidity in the *counterclaim for revocation* also appears to be limited to claim no. 1 (see in particular page 20, conclusions therein), to be understood also in its possible amendment

Nor have any new circumstances arisen that would have authorised the parties to request an extension of the time limit to raise their mutual objections from the first pleading.

(ii) Himson, who was asked by the Court to reduce its attacks on the inventive step to a reasonable number, declared its adherence to the Court's request. The defence should therefore be granted time as per the operative part to do so

(iii) Oerlikon requested to exclude from the file the documents DE '042 and US 795 opposed by Himson with the aim of destroying the patent, as they were not filed in time (in particular DE '042 known to Himson from the proceedings before the Office, and in accordance with the principle of 'equality of arms', considered by the Panel to reject *auxiliary* request No. 8).

The Judge Rapporteur observes that, although these documents were already known to Himson, the latter considered filing them only in response to the counterclaim AR1-7 of the other party (see "*Reply to defence to the counterclaim for revocation rejoinder to the reply to the statement of defence to an application to amend the patent*" of 19.4.2024) and not in the *counterclaim for revocation*.

Therefore, by virtue of the aforementioned principle of *front loaded*<sup>1</sup> - under which the plaintiff in infringement is obliged to concretely elaborate its arguments and evidence in the

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<sup>1</sup> The Unified Patent Court legal provisions introduce the so-called 'front loaded' procedural system whereby a claimant is required to concretely elaborate his arguments and evidence in its first written pleading. However, these provisions must be interpreted in the light of the principle of proportionality, which requires that the parties should not be burdened with tasks that are unnecessary to achieve the stated objective, and in the light of the principle of procedural efficiency, which is contrary to excessive and overly detailed allegations of facts and production of multiple documents in relation to matters that can be presumed to be

his first written pleading and the defendant may not introduce new grounds for invalidation of the challenged patent or introduce new documents deemed destructive of novelty or persuasive starting points for the assessment of the lack of inventive step in subsequent written submissions- documents DE 042 and US 795 would seem to be open to examination limited to the attack on the auxiliary requests introduced by the patent proprietor.

#### **4. Investigation activities**

With respect to the investigative activities requested by Oerlikon:

- (i) As to the witnesses' request of the persons who have redacted the videos deposited in the file by the plaintiff, the defendant's defence acknowledged that it did not contest the circumstances articulated in the relevant chapter of evidence.  
Pursuant to Rule 171, para. 2, RoP, the relevant circumstances must therefore be deemed to be admitted;
- (ii) As to the request to be allowed to provide evidence of the videos in new documents 16 and 19 for the purpose of proving the actuality of the infringement, the Him- son defence did not object.  
Therefore, such production is permitted as per the operative part;
- (iii) With regard to the appointment of a *Court Expert* under rule 185 RoP, Oerlikon itself raised this point by the Court, stating that it renounced the relevant application, following the appointment of the *Technically Qualified Judge*;
- (iv) the parties have acknowledged that their respective Experts are part of their respective defence teams as representatives. In this capacity, they may speak in support of their respective arguments at the Oral Hearing, if deemed appropriate.

#### **5. The request for information on origin and distribution channels**

As to the plaintiff's request for information regarding the origin and distribution channels, product quantities, orders received, etc., turnover generated by the machine, the identity of the third parties involved.

In this regard, the Court notes that this is a claim that may be made in any future '*procedure for the determination of damages and compensation*', with the remedies provided for that purpose. This is subject to verification, at that stage, of the fulfilment of the plaintiff's burden of proof in light of Art. 54 and 76 para. 6 Agreement, also with respect to claims such as the one examined here: here, on the one hand, the defendant has expressly confirmed that it did not sell or distribute the litigious machinery in the market covered by the patent applied for and, on the other hand, there is no evidence at this stage that Himson sold or distributed the litigious machinery in the market concerned.

In these proceedings, also in the light of the principle of proportionality (paragraph n 3. of the Preamble of the R.o.P.), the allegatory and evidentiary framework collected, such an order does not appear necessary.

#### **6. The recall request**

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known to the opposing party and not to be disputed by them. 2. In revocation actions, the claimant is required to specify in detail the grounds of invalidity that allegedly affect the contested patent, as well as the prior art documents relied upon to support any allegation of lack of novelty or inventive step. Consequently, the claimant cannot introduce new grounds of invalidity of the attacked patent or introduce new documents considered novelty destroying or convincing starting points for the assessment of lack of inventive step in subsequent written acts. 3..

The judge rapporteur notes that at this stage there appears to be no evidence, not even circumstantial, of the marketing of the disputed machinery in the territory covered by the patent.

Each request must therefore be evaluated in the following steps.

**7. *The amount of the penalty, quantified at € 12,000.00***

The judge rapporteur asked for clarification of the amount of the penalty.

The plaintiff invoked the principle of equitable liquidation, a principle to which Himson's defence stated that it had no objection.

**8. *The defendant's request to be ordered to pay € 100,000.00 pursuant to rule 119 RoP.***

The judge notes that apparently no evidence was attached or proved of any concrete injury suffered by the plaintiff, which could in any event lead the Court to quantify this amount. Any appreciation is, however, reserved to the Court in its final decision.

**9. *The value of the case***

The plaintiff quantified the value of the dispute for the determination of recoverable costs. at €750,000.00.

18.11.2024). The defendant set the value at €2 ,000,000.00 (cf. authorised statement of the

judge asks the parties whether they agree on this amount,

At the request of the rapporteur judge, the parties indicated their agreement to that range. The value of the case, taking into account the request of the parties, the claims made - of infringement with ancillary declarations, of invalidity of the patent and of amends to the patent - should be set at up to and including 2,000,000.00, using the *Administrative Committee's "Scale of ceilings for recoverable costs"*.

**10. *Costs***

The judge rapporteur asked the parties to take a position on the litigation costs mutually submitted by the plaintiff and the defendant.

The parties have stated that they do not raise any issues in this respect.

**3. SUBSEQUENT PROCEDURAL STEPS**

the parties agreed to grant, following the Interim Conference and the pro- ceedings needs highlighted above, a double deadline to their respective defences.

All of the above

**CONCEDES**

1 deadline until 28 February 2024, 3 p.m., to file:

-from Oerlikon, the new videos (16.-19) allegedly indicating continued promotion in the patent-protected space of the litigious machines;

-by the defendant's defence, a note containing the validity attachments to the patent that are maintained.

2. deadline until *31 March 2025*, 3 p.m., to file by both parties:

- comments with respect to the opposing submissions, as no further documents were allowed to be produced;
- a summary of the case that does not, however, introduce any new facts or evidence. The summary shall have a maximum length of 7,500 words.

A complete list of all documents filed by each party must be submitted together with the summary to enable the Court to refer to them during the hearing.

#### **FIX**

The date of the Oral Hearing before the Court for **11.6.2025, 10.30 a.m. Noting that**

-in the course of the hearing:

(i) videos filed by the Oerlikon defence may be shown with the aid of media provided by the plaintiff's defence;

(ii) materials -such as posters- may be used to better explain the parties' defences to the Court with media provided by the defences themselves.

Inform the parties that it is the Court's intention to conclude the Oral Hearing in one day.

#### **FIX**

the value of the case up to and including €2,000,000.00 for the purpose of applying the scale of maximum reimbursable costs, without prejudice to any different assessment by the Court, also in the light of the documents whose filing has been authorised.

#### **INVITE**

The parties to notify the Office promptly of the reaching of any settlement agreements.

#### **Acknowledges**

Thus decided in  
Milan, on 17  
December 2024  
Alima Zana

**Alima**  
**ZANA**

Digitally signed  
by Alima ZANA  
Date: 2024.12.17  
12:56:29 +01'00'

#### ORDER DETAILS

Order no. ORD\_598537/2023 in ACTION NUMBER: ACT\_549550/2023

UPC number:Action type:

InfringementAction