



Paris Local Division

UPC_CFI_814/2024
Order
of the Court of First Instance of the Unified Patent Court
issued on 24/03/2025

on the application for review an ex parte order (R. 197.4 RoP)

APPLICANT (Defendant in the main proceedings)

VALINEA ENERGIE
rue du Champ du Cerf
25200 Montbéliard

Represented by Gaston VEDEL, Cabinet Beau de Loménie

RESPONDENT (Claimant in the main proceedings)

TIRU
7, rue du Dr Lancereaux
75008 Paris

Represented by Cyrille AMAR, law firm Amar Goussu Staub

PATENT IN SUIT

<i>Patent number</i>	<i>Owner(s)</i>
EP3178578	TIRU

JUDGE WHO RULES

COMPOSITION OF THE CHAMBER - CHAMBER MEETING IN PLENARY

Chairman and Judge-	Camille Lignieres
Rapporteur	Carine Gillet
Legally qualified judge	
Legally qualified judge	Rute Lopes

LANGUAGE OF PROCEDURE: French

ORDER

PARTIES INVOLVED

1. TIRU is the applicant for evidence preservation measures (seizure and raid on the premises). TIRU is a French company specialising in waste-to-energy plants, founded in 1922 on the initiative of the City of Paris. The company designs, builds and operates waste treatment and recovery units. Since 2021, TIRU has been a subsidiary of the PAPREC Group, a French group specialising in waste management and recovery.
2. In the present proceedings, the applicant for review of the evidence preservation measures ordered is VALINEA ENERGIE, a French company belonging to the VEOLIA Group, which is a competitor of PAPREC. Its main activity is the treatment and disposal of non-hazardous waste. In 2022, the Pays de Montbéliard agglomération awarded it a concession contract for household waste treatment.

FACTS AND PROCEDURE

3. TIRU is the holder of European patent EP 3 178 578 B1 granted on 1/08/2018 (hereinafter "EP'578), entitled "Waste incineration plant and associated process".
4. It has been justified that this patent is in force and covers France, the United Kingdom and Poland.
5. Patent EP'578 relates to a technology used in a waste incineration furnace. It protects both a waste incineration plant and an associated process.
6. On 17 December 2024, TIRU filed two parallel requests before the Paris Local Division of the UPC for preservation of evidence and inspection of premises based on its patent EP'578, one against VALINEA ENERGIE and the other against MAGUIN, prior to any proceedings on the merits.
7. In support of its claims, TIRU stated that, through a YOUTUBE video of the Agglomération du Pays de Montbéliard, it had been informed in October 2024 of the installation of an incineration furnace manufactured by MAGUIN and operated on the VALINEA ENERGIE site which appeared to infringe the characteristics of its patent EP'578, that a seizure and a visit to the site by a judicial expert were necessary to enable it to confirm the reproduction of the characteristics and that it was justified that these measures be ordered *ex-parte*.
8. On 23 December 2024, two *ex-parte* orders were issued authorising the measures to preserve the evidence requested, but limiting the scope of the measures sought to the search for evidence of infringement.
9. The seizure measures were carried out on 14 January 2025 simultaneously at the site of MAGUIN, the manufacturer of the allegedly infringing oven (2 rue Pierre Semard - 02800, Charmes, France), and at the site of VALINEA ENERGIE, the operator of the said oven (rue du Champ du Cerf - 25200 Montbéliard, France).
10. The written reports of the experts appointed for each seizure were filed on 20 and 21 January 2025. The confidentiality of the documents and information seized has been

protected by the establishment of a confidentiality circle restricted to representatives of each of the parties.

11. These seized documents then sorted under the aegis of an expert appointed by the Court. The so-called confidential documents and information within meaning of Article 58 UPCA and Rule 262A of the UPC Rules of Procedure (RoP) are currently only accessible to members a confidentiality circle extended to two natural persons for each of the companies designated by the order of 6 March.
12. By application of 12 February 2025, VALINEA ENERGIE sought a retraction as its principal claim and a review as a subsidiary claim (with a guarantee for an amount greater than 10,000 euros) of the evidence preservation order made on 23 December 2024, raising the following main points of law:

- The unjustified nature of TIRU's non-contradictory (ex-parte) application,
- TIRU's breach of its duty of loyalty,
- The late nature of the request.

13. In accordance with Rule 197.4 RoP, a hearing to consider the application for review was held in person at the premises of the Paris Local Division on 10 March 2025, with the representatives of each of the parties presenting their arguments orally to the panel of judges.

REASONS

Breach of the duty of loyalty :

14. Rule 192.3 RoP on the application for preservation of evidence requires that: *"3. Where the applicant requests that preservation measures be ordered without hearing the other party (hereinafter referred to as "the respondent"), the application for preservation of evidence shall also set out the reasons for not hearing the respondent having regard in particular to Rule 197. The Applicant shall disclose any material facts to it which may influence the Court's decision whether or not to make an order without hearing the Respondent.*
15. TIRU, which applied for *ex-parte* relief against VALINEA, is accused of failing to disclose to the seizing judge the information that VALINEA was aware of prior art that would destroy all the independent claims (Nos. 1 to 5) and most of the dependent claims (at least Nos. 2 to 9) of the patent, and thus of breaching its duty of loyalty.
16. VALINEA maintains in this regard that TIRU omitted to specify that the parties had had numerous exchanges on the subject of the concession contract offer concerning the renewal of the furnace from 2019 (VALINEA exhibits 8.1 to 8.5) and that, in this context, TIRU was aware of the technical information relating to the historic furnace (known as the "Laurent Bouillet furnace" from 1987) forming part of the DCE (VALINEA exhibits 6.1 to 6.4) for the project to renovate the existing furnace.

17. Lastly, VALINEA points out that TIRU's application does not detail the reasons why the latter finally ended its discussions and did not apply for the renovation project, even though everything suggests that this refusal was linked to its takeover by the PAPREC group, a direct competitor of the VEOLIA group.
18. According to VALINEA, TIRU was aware of the characteristics of the original furnace in its capacity as successor to its original designer, Laurent Bouillet Ingénierie.
19. VALINEA submits that, in the light of the diagrams in the operating manual (VALINEA exhibit 6.1) drawn up by Laurent Bouillet Ingénierie, all the features of the main claim 1 of the Patent are therefore to be found in the old "Laurent Bouillet" 1987 oven model.
20. Process claim no. 15 is not novel for the same reasons, its characteristics mirroring those of claim no. 1, and the circulation of air and waste being indicated by arrows in the above diagrams.
21. In its reply, TIRU contests, on the one hand, having had access to all the technical documentation, in particular that which has remained confidential relating to the old oven, and the other hand, the fact that the old oven predates its patent EP'578.
22. Without it being necessary to rule on the issue of the seizing party's actual knowledge all the technical documents relating to the old oven, the Court notes that, as the representative of TIRU rightly pointed out at the oral hearing, the seizing judge is not the judge of validity. Thus, the proprietor cannot be required, at the stage of the application to preserve evidence, to respond in advance to possible attacks on the validity of the patent, without prejudice, at the stage of the hearing on the merits, to discuss and decide on a possible application for revocation of the patent.
23. In the present case, none of the information and particulars communicated by TIRU in its request are contested, justifying that it is the owner of patent EP'578, that no opposition proceedings before the EPO were in progress or that court was seised a challenge the validity of the said patent, in particular for lack of novelty, on the date of the request for preservation of evidence.
24. In addition, TIRU stated in its application that it had been "approached by VALINEA in 2021 to prepare a response to the call for tenders issued by Pays de Montbéliard conurbation" (page 5, §11 and 12, on relationship between the parties) and made no secret of the fact that it had been bought out by the PAPREC group in 2021 (page 3 of the application, §6 on the presentation of the applicant), this information was sufficient for the seizing judge to be aware of the context of the market in which the application was made.
25. As a result, VALINEA has failed to demonstrate that TIRU breached its duty of loyalty under Rule 192.3 RoP when submitting its request.

On the unjustified nature of the non-adversarial procedure (ex parte) :

26. Article 60.5 UPCA on the order to preserve evidence and enter premises provides: "*5. Measures shall be ordered, where appropriate, without the other party being heard, in particular where any delay is likely to cause irreparable prejudice to the proprietor or where there is a demonstrable risk of evidence being destroyed*".
27. Rule 197 RoP on orders to preserve evidence without hearing the defendant states: "*1. The court may order measures to preserve evidence [rule 196, § 1] without the defendant, in particular where any delay is likely to*

cause irreparable harm to the applicant or where there is a demonstrable risk that the evidence may be destroyed or that it will no longer be available.

28. VALINEA maintains that recourse to an *ex parte* procedure is a derogation from the principle of a measure established in an adversarial manner and that this exception must therefore be interpreted strictly.
29. It submits that, in the present case, TIRU's application merely asserted, without justification, that there was a significant risk that the evidence would no longer be available and would be impossible to obtain.
30. VALINEA added that TIRU had argued that the allegedly infringing oven was about to come into operation in order to justify urgency of its request and therefore the need to order *ex parte* measures, but that in reality it was the applicant's failure to act promptly that had put it in a position to request urgent *ex parte* measures.
31. Lastly, VALINEA asserts that, since the oven alleged to be infringing was the subject of a concession contract, there was no risk of the related documents disappearing, since the concessionaire is obliged to keep the documentation available the local authority for the entire duration of the contract. Lastly, VALINEA maintained that it was excessive to consider the existence, by default, of a risk that digital data could be easily hidden or erased, without identifying any particular circumstances that would justify such an exclusion. VALINEA also points out that the seized party did not offer any resistance during the measurements and that no digital data useful for characterising the alleged acts of counterfeiting was found on VALINEA's site.
32. VALINEA concludes from this that there was no justification for the criterion relied on by the applicant that, on the date of the application, i.e. 17 December 2024, there was a demonstrable risk that the evidence could be destroyed or that it would no longer be available due to the fact that the allegedly infringing oven was due to be put into operation in the 1st quarter of 2025.
33. First of all, the Court considers that the behaviour of the distrainee during the execution of the measures and the fact that no useful digital documents were found by the expert during the execution of the measure are inoperative arguments in that the withdrawal must be examined on the day on which the application referred to the judge responsible for the seizure and not in the light of the measures as executed.
34. The Court also noted that VALINEA had not provided any new evidence to show that the information on imminence of the furnace's start-up was incorrect. However, the information relating to "1st quarter 2025" unquestionably meant that there was a risk that the furnace would start up at the beginning of January 2025. It was also clear that the start-up of an incinerator would have prevented or made extremely difficult the requested descriptive recording of the interior of the furnace.
35. With regard to VALINEA's complaint that the urgency of the request was created by TIRU's lack of diligence, it should be remembered that, under Article 60.1 of the UPCA, the applicant for a seizure has an obligation to present reasonably accessible evidence to support its allegations that its patent has been infringed or that infringement is imminent. In the present case, TIRU had an online report drawn up by a court commissioner on 11 October 2024, which merely noted the existence of a video publishing images of the new oven on VALINEA's website. TIRU then filed its application with this Division on

17 December 2024. This two-month period appears necessary, in the case in point, in order to use the online video showing images of the allegedly infringing oven and to build up a sufficiently well-founded case to obtain the request to preserve evidence and to visit the premises. In view of these factors, which must be assessed *in concreto*, the claimant cannot legitimately be accused of a lack of diligence or a failure to act promptly.

36. Finally, as regards the risk of loss digital data relating in particular to the technical documentation of the oven, the Court notes that the measures requested by TIRU on the VALINEA site did not relate solely to the actual seizure of digital technical documents but essentially to the descriptive seizure of the allegedly infringing oven. The criterion of the risk of destruction of the evidence was therefore assessed globally by the judge in the light of the imminent risk of the oven being put into operation and also the risk of loss of the technical documentation likely to be held digitally on the VALINEA site. The risk of loss of evidence in this case was not characterised solely by the fact that the documentation was in digital format.
37. As a result, the seizing party has sufficiently demonstrated the existence of a risk that the evidence will no longer be available or will be impossible to obtain, as provided for Article 60.5 UPCA and Rule 197.1 RoP, justifying that non-contradictory measures be or- given.

Late application :

38. VALINEA states that TIRU, in a context of strong competition between the parties, and because of the discussions that took place in 2021 in response to call for tenders issued by the Pays de Mont- béliard Agglomération, certainly kept a watchful eye on market developments and communications relating to the renovation of the site. VALINEA refers to publications on social networks in April and July 2024 relating to the project and the existence of the new furnace on VALINEA site. It also states that the video that was the subject of the official report 11 October 2024 was put online on 19 August 2024 and broadcast on the Pays de Montbéliard Agglomération Youtube channel. It concludes from this that TIRU was informed of the situation before October 2024 and that TIRU itself artificially created the emergency situation, by waiting until the last day before the furnace was to carry out the measures to preserve evidence and raid the site, and that the plaintiff therefore did not act with the required speed.
39. The Court notes that the publications on social networks prior to the Youtube video, which was the subject of the official , did not very precise information about the oven. In addition, the said video, which was broadcast for the first time in August 2024, was not viewed very often ("77 views", see exhibit 2 in support of the request seizure: TIRU's official report), which means that it not very widely distributed. In this context, it has not been shown that TIRU was aware of it before October 2024.
40. The Court refers to the reasons set out *above* concerning the urgent nature of need for *ex parte* measures. The period for compiling the file requesting the preservation of evidence appears reasonable, and TIRU cannot therefore be criticised for the late nature of its request, in view of the circumstances of the case.

41. As a result, none of the arguments raised by VALINEA can be accepted and its request to withdraw the contested measure must be rejected.

On the subsidiary application for review :

42. VALINEA requests that the security deposit proposed by TIRU and ordered by the judge for an amount of 10,000 euros in the operative part of his decision, be revised upwards, arguing that a security of 50,000 euros would be appropriate in the case.
43. In accordance with Rules 196.3 and 196.6 RoP, the Court may order appropriate security for legal costs and other expenses incurred or likely to be by the defendant.
44. VALINEA in no way justifies TIRU's financial fragility, which would justify a guarantee more than 10,000 euros. In addition, this guarantee concerns the only measure for preserving evidence, the confidentiality of which was ensured as soon as the measures were carried out, since seizure order provided for access restricted at least to the parties' representatives. Nothing prevents VALINEA from requesting a more appropriate guarantee in the context of the actions on the merits that followed the seizures.
45. For these reasons, the application for review must be dismissed.

FOR THESE REASONS

46. The Court orders that VALINEA ENERGIE's applications for retraction and review of the order for preservation of evidence and inspection of the premises issued on 23 December 2024 be dismissed,
47. Declares that this order may be appealed in accordance with Article 73.2 (a) UPCA and Rules 220.1 (c), 224.2 (b) RoP.

Issued in Paris on 24 March 2025.

C. Lignières, Presiding Judge

Date :
Camille Lignières 2025.03.24
15:20:02 +01'00'

C. Gillet, legally qualified judge

R. Lopes, legally qualified judge

DETAILS OF ORDER

Order n° ORD_13139/2025 in ACTION N°: 66573/2024 UPC n°: UPC_CFI_814/2024 Type action:
Application for an order for seizure and entry on premises Rules 192 et seq. and R. 199 of the
Rules of Procedure

Related proceedings no. 10546/2025

Type of request: Request for review an *ex parte* order (R. 197.4 RoP)