



Milan Local Division Grants Inspection Order

The Milan Local Division has granted an inspection order^[1] pursuant to Rules 192-199 RoP, the first order granted by the UPC allowing inspection of a defendant's premises. Previous orders to preserve evidence have related to evidence obtainable at an exhibition.

The Patentee Progress Maschinen & Automation AG obtained the order against AWM S.R.L. and its parent company Schnell S.P.A., both Italian companies. The Local Division in Milan considered itself competent as both Defendants had their main place of business in Italy.

The patent at issue EP 2726230 was considered by the court to be sufficiently proved valid for the purposes of the request since oppositions to the patent (albeit by different parties) had been rejected by the EPO Boards of Appeal. The subject matter of the patent is a method and apparatus for continuously producing a lattice girder.

The Applicant had provided evidence including a YouTube video showing that the Defendants' apparatus reproduced many of the features of the claim, but certain features were not visible. Accordingly, the Court accepted that an order for gathering more evidence was needed.

Moreover, the Court accepted that an ex parte order was appropriate because there was a demonstrable risk of evidence being destroyed or otherwise ceasing to be available.

Therefore, the Court granted an order for two independent experts (one for the premises of each Defendant) assisted by the competent bailiff to inspect each location to obtain a detailed description and photos of the "Girderflex" and/or "Girderflex Vsx" machines, and all the technical, promotional and commercial documentation relating to these (and these only). To maintain surprise, service of the order could take place immediately prior to execution. The independent experts were required to submit a report to the Court

including all the documents and data acquired. It allowed only two representatives of the Applicant – an attorney and a party expert – to be present at each location. In order to preserve confidentiality, these representatives were obliged to keep confidential, even from the Applicant, all information coming to their knowledge during the execution of the order. Whether or not the Defendants wished to apply for review of the order (the Defendants have the right to request review an ex parte order to preserve evidence within 30 days of its execution pursuant to Rule 197(3) RoP in order to seek modification or revocation of the order), they were invited to comment on the confidentiality issue, following which the Court would decide how to handle any confidentiality issues, for example by setting up a confidentiality club of specific persons. In the absence of any such comments, the Court would assume approval for full disclosure of the contents of the independent experts' report and annexes to the Patentee, without limitations or any other condition.

The Applicant was required to bring a patent infringement claim at the same division of the UPC within 31 calendar days or 20 working days, whichever is longer, of a final determination of any request for review, or of the deadline (30 days from execution) for filing a request for review if no such request was filed, failing which the order would be revoked, pursuant to Rule 198(1) RoP. The evidence obtained could only be used in these proceedings.

The Applicant was required to pay €50,000 into court as security for costs.

This ruling has meticulously considered all of the requirements of the Rules of Procedure relating to inspection of premises and preservation of evidence, and demonstrates that in appropriate circumstances such orders can be obtained relatively easily, even on an ex parte basis.

[1] https://www.unified-patent-court.org/sites/default/files/upc_documents/2023-09-25-ld-milan-upc_cfi_286-2023-ord_576298-2023-app_565446-2023-anonymized.pdf