



UPC_CFI_813/2024
Order
of the Court of First Instance of the Unified Patent Court, issued on
24/03/2025
on the application for review of an ex parte order (R. 197.4 RdP)

APPLICANT (Defendant in the main proceedings)

MAGUIN SAS

2, rue Pierre Semard
02800 - Charmes - FR

Represented by Olivier DELPRAT, Casalonga law firm

RESPONDENT (Applicant in the main proceedings)

TIRU

7, rue du Dr Lancereaux
75008 Paris

Represented by Cyrille AMAR, Amar Goussu Staub law firm

PATENT IN DISPUTE

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

JUDGE RULING

COMPOSITION OF THE CHAMBER – CHAMBER SITTING IN PLENARY SESSION

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

LANGUAGE OF THE PROCEEDINGS: French

ORDER

PARTIES PRESENT

1. TIRU is the applicant for measures to preserve evidence (seizure and search of premises). It is a French company specialising in waste-to-energy conversion, created in 1922 on the initiative of the City of Paris. The company designs, builds and operates waste treatment and recovery facilities. Since 2021, TIRU has been a subsidiary of the PAPREC Group, a French group specialising in waste management and recovery.
2. In the context of the present proceedings, MAGUIN is the applicant for the review of the evidence preservation measures that have been ordered. It is a French company that develops and manufactures rotary kilns suitable for various applications, including the incineration of industrial waste.

SUMMARY OF THE FACTS AND THE PROCEEDINGS

3. TIRU is the holder of European patent EP 3 178 578 B1, issued on 1 August 2018 (hereinafter "EP'578"), entitled "Waste incineration plant and associated process".
4. It has been established that this patent is in force and covers France, the United Kingdom and Poland.
5. The EP'578 patent concerns 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 applications with the Paris local division of the JUB for the preservation of evidence and a site visit based on its EP'578 patent, one against VALINEA ENERGIE and the other against MAGUIN, prior to any proceedings on the merits.
7. In support of its requests, TIRU stated that, through a YouTube video by the Agglomération du Pays de Montbéliard, it had been informed in October 2024 of the installation of an incinerator, manufactured by MAGUIN and operated on the VALINEA ENERGIE site, which appeared to infringe the characteristics of its EP'578 patent, that a seizure and a search of the premises by a judicial expert were necessary to enable it to confirm the reproduction of the characteristics, and that it was justified for these measures to be ordered *ex parte*.
On 23 December 2024, two *ex parte* orders were issued authorising the requested evidence preservation measures, limiting the scope of the requested measures to the investigation of the infringement. (Orders No. ORD_67654/2024 UPC No.: UPC_CFI_814/2024 and No. ORD_67655/2024 UPC No.: UPC_CFI_813/2024.)
8. The seizure measures were carried out on 14 January 2025 simultaneously at the premises of MAGUIN, the manufacturer of the allegedly infringing oven (2 rue Pierre Séward – 02800, Charmes, France), and at the premises of VALINEA ENERGIE, the operator of the oven (rue du Champ du Cerf – 25200 Montbéliard, France).
9. The written reports of the experts appointed for each seizure were filed on 20 and 21 January 2025. The confidentiality of the seized documents and information was protected by the establishment of a confidentiality circle restricted to the representatives of each of the parties.

10. These seized documents were then sorted under the supervision of an expert appointed by the Court. The documents and information deemed confidential within the meaning of Article 58 AJUB and Rule 262A of the JUB Rules of Procedure (RdP) are currently accessible only to members of a confidentiality circle extended to the "legal team" and two individuals from each of the companies designated by order of 6 March.
11. In a motion dated 12 February 2025, MAGUIN requested the withdrawal of the seizure and search measures, based on the following points:
 - the absence of urgency,
 - the absence of any risk of destruction of evidence,
 - the fact that TIRU deliberately concealed information that could influence the ex parte measures (which amounts to the lack of fairness alleged by VALINEA).
12. In accordance with Rule 197.4 RdP, a hearing to consider the request for review was held in person at the Paris Local Division on 10 March 2025, with representatives of each party presenting their arguments orally before the panel of judges.

GROUND

On the breach of the duty of fairness:

13. Rule 192.3 RdP on requests for preservation of evidence requires that: *"3. Where the applicant requests that measures to preserve evidence be ordered without the other party (hereinafter referred to as "the respondent") being heard, 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 must disclose any material facts known to it that could influence the Tribunal in its decision whether or not to make an order without hearing the respondent."*
14. TIRU, which requested an *ex parte* measure against MAGUIN, is accused of failing to disclose to the seizure judge the information that the latter was aware of prior art that destroyed all the claims of its EP'578 patent, thereby failing in its duty of loyalty.
15. MAGUIN argues in this regard that TIRU was fully aware that the original furnace at the Montbéliard household waste incineration site, known as the "Four Laurent Bouillet" furnace, designed in 1987, disclosed the characteristics of its EP'578 patent.
16. MAGUIN adds that TIRU was aware of the technical documents relating to the old furnace designed by LAURENT BOUILLET INGENIERIE, as TIRU succeeded this company after its liquidation. MAGUIN adds that TIRU participated in numerous exchanges with the company VALEST (later replaced by VALINEA) on the renovation of the old furnace during 2019.
17. In its response, TIRU disputes, on the one hand, that it had access to all the technical documentation, in particular that which remained confidential relating to the old furnace, and, on the other hand, the fact that the old furnace predates its EP'578 patent.

18. Without it being necessary to rule on the question of whether the applicant was actually aware of 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 judge hearing the application for seizure is not the judge ruling on validity. Thus, the patent holder cannot be required, at the stage of the application for preservation of evidence, to respond in advance to possible attacks on the validity of the patent, without prejudice, at the stage of the substantive debate, to discussing and deciding on a possible application for revocation of the patent.
19. In this case, none of the information and details provided by TIRU in its application are disputed, justifying that it is the owner of patent EP'578, that no opposition proceedings were pending before the EPO and that no court had been seized of a challenge to the validity of the said patent, in particular on the grounds of lack of novelty, on the date of the application for preservation of evidence.
20. It follows that MAGUIN fails to demonstrate a breach of the duty of loyalty provided for in Rule 192.3 RdP on the part of TIRU when submitting its application.

On the absence of a risk of destruction of evidence justifying an *ex parte* measure:

21. Section 60.5 AJUB on the order for preservation of evidence and search of 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 harm to the patent holder or where there is a demonstrable risk of destruction of evidence.*"
22. Rule 197 RdP on orders for the preservation of evidence without hearing the defendant states: "*1. The Court may order measures to preserve evidence [Rule 196, § 1] without the defendant being heard, 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 no longer be available.*"
23. MAGUIN argues that TIRU's sole argument for requesting *ex parte* proceedings is based on the risk of evidence disappearing and that the sole digital format of the data sought is not sufficient to justify non-adversarial proceedings.
24. MAGUIN adds that it is a well-established company and that the allegedly infringing furnace is the subject of a manufacturer's file, which requires the manufacturer to keep technical documents to certify the product's compliance with the regulations in force.
25. In view of these arguments, the Court notes first of all that, although the manufacturer's file requires the manufacturer to keep the technical documentation for a product in order to verify compliance with the regulations in force, this does not make it certain that this retention obligation is necessarily applied, nor does it prevent the technical documents from being even partially modified or the search for said documents from being rendered impossible on the day of the seizure. However, the legal texts on *ex parte* seizure proceedings within the JUB do not require proof of the certainty of loss or destruction of evidence in adversarial proceedings, but only the existence of a risk of even partial loss of evidence.
26. The Court follows MAGUIN's reasoning that the digital format of the data sought is not sufficient in itself to demonstrate the existence of a risk of destruction or loss, as has already been ruled in the decision C-KORE v NOVAWELL (UPC_CFI_397/2023, LD Paris, 1^{er} March 2024, page 7: in this case, the risk of removal

of the product alleged to be counterfeit, but also the risk of loss or alteration of the digital data).

27. In this case, the request for seizure at the site of the manufacturer MAGUIN cannot be separated from the request made at the same time before the same judge for seizure at the site of the operator VALINEA. It was necessary for the operations to take place simultaneously on both the manufacturer's site and the operator's site, given the obvious links between the parties subject to seizure and their converging interests. The link between these two requests and their simultaneous nature was expressly mentioned in the contested order (see UPC_CFI_813/2024, LD Paris, 23 December 2024, page 7 of the said order).
28. The seizure judge therefore assessed the overall effectiveness of the measures requested to support a future infringement action. The search for technical documentation at the manufacturer's premises (actual seizure) was linked to the descriptive seizure of the furnace manufactured by MAGUIN and installed at the VALINEA site. However, TIRU justified the imminent commissioning of the said furnace and it was obvious that the commissioning of an incinerator would have prevented or made extremely difficult the descriptive seizure requested, which mainly concerned the interior of the furnace to which the most important features of TIRU's patent refer (see grounds for rejection of the request for withdrawal of the seizure VALINEA order no. ORD_13139/2025).
29. In the present case, ensuring the effectiveness of the measures to preserve evidence (pursuant to the principle of effectiveness, point 4 of the preamble to the RdP) justified the simultaneous execution of said measures at the site of the manufacturer and at that of the operator of the furnace alleged to be counterfeit.
30. The principle of effectiveness, which justified an *ex parte* measure, was applied in accordance with the principles of justice, fairness and proportionality (points 3 and 5 of the preamble to the RdP) by strictly limiting the scope of the search for evidence to the characterisation of the infringement alone and by rejecting all requests relating to the search for the extent of the infringement, as well as by establishing in advance the most restricted circle of confidentiality possible.
31. It follows that the applicant has sufficiently demonstrated the existence of a risk that the evidence may no longer be available or may be impossible to obtain, as provided for in Article 60.5 AJUB and Rule 197.1 RdP, thus justifying the ordering of non-adversarial measures.

On the lack of urgency:

32. MAGUIN asserts that there was no urgency on its part to order the measures, arguing that the allegedly counterfeit oven was not on its premises and that the inspection could have been carried out at its premises at any time, whether or not the oven was in operation.
33. MAGUIN adds that TIRU, as a professional in a highly competitive market, must have been aware of the video on YouTube, which was the subject of the October 2024 report, as soon as it was first broadcast in August 2024.
34. As stated above, it was precisely in the context of an extremely competitive market that the effectiveness of the measures requested justified their simultaneous implementation at both sites (see UPC_CFI_813/2024, LD Paris, 23 December 2024, page 7).

35. Regarding TIRU's alleged knowledge of the YouTube video prior to October 2024, the Court notes that even if it is established that the video was first published on social media in August 2024, it did not receive a large number of views ("77 views" see Exhibit 2: TIRU's report), which means that it was not widely distributed. In this context, it has not been proven that TIRU was aware of it before October 2024.
36. TIRU's request was filed two months later, on 17 December 2024. However, a period of two months to compile the application file for the preservation of evidence appears reasonable, as the applicant for the seizure is required under Article 60.1 of the AJUB to present reasonably accessible evidence to support their allegations that their patent has been infringed or that infringement is imminent.
37. In view of these factors and in the context of the two concurrent seizure requests, the standard urgency as analysed by the seizure judge, who rejected the "extreme urgency" alleged by the applicant, was sufficiently characterised in the contested order.
38. Consequently, none of the arguments raised by MAGUIN can be upheld and its application for the withdrawal of the contested measure must be dismissed.

ON THESE GROUNDS

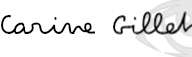
39. The Court orders that MAGUIN's application for revocation of the order to preserve evidence and search the premises issued on 23 December 2024 be dismissed,
40. Declares that this order is subject to appeal under the conditions provided for in Article 73.2 (a) AJUB and rules 220.1 (c) and 224.2 (b) RdP.

Issued in Paris on 24 March 2025.

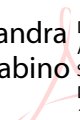
C. Lignières, Presiding Judge

 Date: 24 March
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C. Gillet, Qualified Judge

 24 March 2025
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R. Lopes, Qualified judge

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Alexandra Da
Silva Sabino Lopes
Data: 24 March 2025
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DETAILS OF THE ORDER

Order No. ORD_9276/2025 in ACTION No.: 66560/2024 UPC No.: UPC_CFI_813/2024 Type of action: Request for an order of seizure and search of premises under Rules 192 et seq. and 199 of the Rules of Procedure

Related proceedings No. 7220/2025

Type of application: Application for review of an *ex parte* order (R. 197.4 RdP)