



Paris local division

UPC_CFI_397/2023
ORDER FOR PRESERVING EVIDENCE
of the Court of First Instance of the Unified Patent Court
delivered on 14th November 2023

CLAIMANT

C-KORE SYSTEMS LIMITED
(Applicant) - 3 Bramley's Barn The Menagerie,
Skipwith Road - YO19 6ET - Escrick - GB

Represented by Denis
Schertenleib

DEFENDANT

NOVAWELL
(Defendant) - 22 Allée des Caravelles - 34280 -
Carnon-Plage – FR

PATENT AT ISSUE

<i>Patent no.</i>	<i>Proprietor</i>
EP2265793	C-KORE SYSTEMS LIMITED

EP 2265793 (hereinafter referred to as EP 793)
Entitled « Subsea Test Apparatus, assembly and Method »
Date of filing: 25.02.2009 Priority to GB Patent 0803459 filed on 26.02.2008
EP 793 was granted on 1.08.2012

DECIDING JUDGE

COMPOSITION OF PANEL – FULL PANEL

Presiding judge and Judge-rapporteur	Camille Lignieres
Legally qualified judge	Carine Gillet
Legally qualified judge	Alima Zana

LANGUAGE OF PROCEEDINGS: English

ORDER

Summary of facts and Procedure

On the 2nd of November 2023, C-KORE has filed an application for preserving evidence, against NOVAWELL, before the commencement of proceedings on the merits.

C-KORE explains that he is the proprietor of EP 793, acquired in 2013 from its former parent company ZETECHTICS Ltd, and which relates to subsea apparatus and testing of such apparatus.

The patent is exploited by C-KORE through the use and marketing of the « CABLE MONITOR» product, a compact automated tool for testing subsea electrical assets, leased to contractors and companies located worldwide.

According to C-KORE, he became aware on February 2023 that NOVAWELL, one of its previous customers, had developed a competing product, named SICOM, which reproduces at least all the features of independent claims 1 and 15 and dependent claims 4, 5, 6 and 14. C-KORE argues that NOVAWELL is going (or intends) to make, store and place the SICOM product on the market, from its Montpellier facilities in France.

The Applicant is seeking an ex parte order granting measures to secure evidence of infringement.

Order sought by the Applicant

In summary, C-KORE seeks:

- a detailed description of the alleged infringing product;
- a physical seizure of the product if necessary and if any documents relating to technical and promotional documentation;
- preservation and disclosure of digital media;
- a written report, carried out by a person appointed by the Court, with if needed a locksmith or a computer specialist and Law enforcement.

POINTS AT ISSUE

1-Jurisdiction and competence

The UPC has jurisdiction with respect to the present request under Art. 32.1 (c) and 60.1 of the Unified Patent Court Agreement (UPCA), for the reasons presented above:

- the Patent at issue is a European Patent, which has not been opted-out from the UPC's exclusive jurisdiction;
- the patent is in force, inter alia, in France, as evidenced by the EP register.

The Paris Local Division has competence pursuant to Art. 32.1 (c) and 33.1 (b) UPCA, for the following reasons:

- NOVAWELL has its registered office and its principal place of business in France, in Montpellier;
- the Applicant argues that the alleged actual or threatened infringement has occurred or may occur in France;
- C-KORE intends to file a proceeding on the merits based on Art. 33.1 (b) UPCA in conformity with R. 192.1 of the Rules of Procedure (RoP).

2. Fulfilment of the provisions of R. 192.2 RoP

2.1. Content of the application

The application for preserving evidence contains:

- (a) particulars in accordance with R.13.1 (a) to (i) RoP;
- (b) a clear indication of the measures requested, including the exact location of the evidence to be preserved where it is known or suspected with good reason (domiciles of the Defendants);
- (c) the reasons why the proposed measures are needed to preserve relevant evidence;
- (d) the facts and evidence relied on in support of the application.

2.2. Concise description of the future proceeding in the merits

C-KORE explains that it intends to start proceedings on the merits with respect to the ongoing direct use of its patented invention allegedly committed by NOVAWELL relying on the evidence obtained by the present proceedings, in order to assert its rights according to Art. 25 UPCA and to prove that NOVAWELL is making, offering, placing on the market, using a product which is the subject matter of the patent at issue, importing, storing the product for those purposes through its offices located in Montpellier, France and through its website accessible in French and English languages.

Consequently, conditions as provided by R. 192.2 RoP are fully met.

3. Burden of proof for the Applicant under Art. 60 UPCA - Reasonably available evidence given by the Applicant

3.1. Rights on a valid patent

The Applicant justifies that he is entitled as the current proprietor of the patent EP 793 since he acquired the title from Zetechtics Ltd, this transfer has been filed at the national patent offices in 2019 (see Exhibits 6 and 7).

As regards the validity of the patent at issue, it implies from Exhibit 7 that the patent is in force in France, Germany, Italy, The Netherlands, Denmark and Norway. Based on the information given to the Court, there is no opposition pending before the EPO.

Therefore, the validity of the patent at issue is sufficiently - at this early stage of the proceedings - proved.

3.2. Alleged infringement

EP 793 protects a subsea apparatus and the testing of such apparatus, and in particular, although not exclusively, to the testing of subsea interconnecting apparatus for providing electrical, optical, and/or fluid connection between one piece of subsea apparatus or equipment and another.

This patent comprises a set of 18 claims. Claims 1, 15 and 16 are independent, whereas the other claims are dependent.

Claim 1 of EP 793 as granted, protects a Subsea test apparatus (2) comprising:

a connector (20) for mating with a corresponding connector (10) of a subsea apparatus (1) to provide at least one of electrical, optical, and fluid connection between the test apparatus and the subsea apparatus; measuring means (22) connected to the test apparatus's connector and operable underwater in a measurement mode; a power supply (23) arranged to power the measuring means; and disconnection means (25) for disconnecting the test apparatus's connector from a mated subsea apparatus's connector, wherein the measuring means, in said measurement mode, is arranged to perform at least one measurement, via the mated connectors, on connected subsea apparatus, and the test apparatus further comprises indicating means (26) operable underwater and arranged to provide an indication of a result of the or each measurement.

C-KORE explains that the patent at issue EP 793 is embodied notably in its product named "CABLE MONITOR" which is a compact automated tool for testing subsea electrical assets (see Exhibit 9).

It is demonstrated that NOVWELL used to be a client of the Applicant and hired the CABLE MONITOR product in the course of 2020 following a training provided by C-KORE with documents such as the user manual and drawings. (Exhibits 4, 16, 18, 20)

The Applicant indicates that NOVWELL is currently marketing an apparatus named "SICOM ROV tool" that is highly similar to the one covered by the patent at issue.

The Applicant provides some pictures of the "SICOM" product extracted from NOVWELL's website and NOVWELL's brochure that describes SICOM ROV (remotely operated vehicle) tool as a very compact test connector allowing the direct measurement and subsea display of line continuity and insulation resistance. More precisely, it is described in NOVWELL's Webpage as "a ROV-deployed Subsea line Insulation and Continuity Measurement unit". (see Exhibits 10 and 11)

Therefore, the Applicant has sufficiently provided at this stage reasonable evidence to support that claim 1 of its patent has been infringed.

Nevertheless, the Applicant indicates that he is seeking to secure evidence of the infringement regarding the other claims of his patent. This is the reason why the Applicant needs an order for gathering more evidence for the purpose of proving the alleged infringement.

4. Requirements under R.194.2 RoP

According to R. 194.2 RoP, the Court shall take into account the urgency and the reasons to grant an ex-parte order.

4.1. Urgency

The Applicant rightly explains that the relevant market is very competitive with only a few players, and NOVWELL, a former client of C-KORE, is currently a direct competitor.

The Applicant became aware in February 2023 of the existence of the "SICOM ROV" product that was exhibited at a Scottish trade fair and sent a pre-action letter alleging an infringement as regards his rights on the GBpatent (an equivalent patent of the EP 793 at issue), a letter to which NOVWELL replied with no explanation about the alleging infringement but only declaring that the UK market is not part of his own market. (see Exhibits 8 and 12)

Regarding its European patent's rights, C-KORE was informed on the 11th of August 2023 that NOVWELL intended to expand worldwide its commercial projects from its facilities settled in France

(Exhibit 13: e-mail exchange with a client who wrote that he had an alternative product offer from NOVAWELL for a project located in Australia).

The Applicant took less than three months to file the application for preserving evidence before the UPC which is a reasonable delay in the present case, since the Applicant asked for a “standard procedure” and not for an “urgent procedure”.

4.2. Reasons to grant an order without hearing the defendants - risk of destruction of evidence

NOVAWELL operates on different projects outside of the UPC’s jurisdiction, mainly in Africa (its regional office is in Angola) and in Australia. (Exhibits 4, 12, 13 and 14), and the SICOM product is easily transportable.

Moreover, data capture is one of the Applicant’s targets and it is generally accepted that digital data can be easily hidden or erased if it is given previous notice of this kind of application.

Therefore, it is justified that evidence can easily be removed if the Defendant is informed or heard before the measure.

Consequently, this order needs to be granted without the Defendant having been heard since there is a demonstrable risk of evidence being destroyed or otherwise ceasing to be available (Art. 60.5 UPCA).

5. Payment of court fees

The Court fees have been properly paid, therefore conditions under R. 192.5 RoP are fulfilled.

6. Balance of interests and modalities of execution.

6.1. The weighting up of the interest of all parties implies granting the measure, considering the potential risk of harm for each of the parties, in the case of granting - for the Defendant - or denial of the measure - borne by the Applicant.

From the information given at this stage of the proceedings, the Court notes that:

- the Applicant is a small enterprise and its most successful product is the “CABLE MONITOR” presented as the invention protected by the patent at issue acquired in 2019;
- the Defendant is a former client of the Applicant, trained by the latest in the use of the CABLE MONITOR product and that expresses in his current website the intention to expand his business worldwide with his new product “SICOM ROV tool” which looks similar to the CABLE MONITOR product.

Taking into consideration the principle of proportionality, the threat of definitive destruction of the evidence borne by the Applicant prevails over the Defendant’s exposure to the enforcement of the required measures.

In this case, the application seeking an ex-parte order for preserving evidence shall be granted partially as requested by the Applicant.

6.2. Pursuant to R. 196.4 RoP, the authorised measures will be carried out in accordance with the national law of the place where the measures are carried out - i.e. French law - by one expert, appointed by the Court and namely mentioned in the operative part, in order to proceed at the premises of the Defendant. This expert is included in the list of patent experts who are used to

cooperate with the national Courts, so that the choice guarantees expertise, independence and impartiality, as required by R. 196.5 RoP.

The appointed expert will proceed assisted by the competent bailiff, as it is appropriate and allowed under national law.

Only one representative of the Applicant, i.e. Lukasz Wlodarczyk, patent attorney and lawyer registered to the Paris Bar, may be present at the execution of these measures.

No other representative, nor any employee of the Applicant is therefore allowed to be present at the execution of these measures.

The appointed expert shall lodge a Written report, together with a full copy of all the documents and data acquired as a result of the execution of the measures, seven days after the execution of the measures, and with the bailiff's report ("*procès-verbal des opérations menées par l'expert de la Cour*") in appendix.

6.3. Confidentiality

In accordance with Art. 58 UPCA and R. 196.1 (d) RoP, the Court orders that the access to any information and document gathered by the expert in charge of carrying out the measure is limited to the representatives of the parties. It will be then settled a confidentiality club, in order to identify the relevant information for the case as well as the information considered to be "trade secret" (as defined by EU Directive n. 943/2016 on the protection of trade secrets) to be kept confidential so that access will be restricted to specific persons.

Pursuant to Art. 60.8 UPCA and R. 198 RoP, the measures to preserve evidence shall be revoked or otherwise cease to have effect, at the Defendant's request, if the Applicant does not bring action leading to a decision on the merits of the case before the Court within a time period not exceeding 31 calendar days or 20 working days, whichever is the longer, from the date of the presentation of the Written report by the expert to the Court.

6.4. The Written report and any other outcome of the measures to preserve evidence may only be used in the proceedings on the merits of the case, in accordance with R. 196.2 RoP.

6.5. Service.

Taking into account the need to ensure the surprise effect, service of the application, together with this order, shall be carried out by the Applicant at the premises of the Defendant, immediately at the time of the execution of this order, in accordance with R. 197.2 RoP.

6.6. Security.

Pursuant to R. 196.3 and 196.6 RoP, the Court orders C-KORE to provide adequate security - also as a condition to the enforceability of this order - for the legal costs and other expenses and compensation for any injury incurred or likely to be incurred by the Defendant, by deposit of the amount of Euro 20.000.

This order shall become effective only after security by deposit has been provided by the Applicant.

6.7. Review.

The Defendant may request for the review of this order according to Art. 60.6 UPCA and R. 197.3 RoP.

6.8. Appeal.

An appeal may be lodged by the parties within fifteen days of the notification of this order in accordance with Art. 73.2 (a) UPCA and R. 220.1 RoP.

FOR ALL THESE REASONS

THE COURT OF FIRST INSTANCE – PARIS LOCAL DIVISION

orders that the Applicant is allowed to:

- preserve evidence at the NOVAWELL's premises, 385 Rue Alfred Nobel, ZA Techniparc Millénaire, 34000 Montpellier, France by obtaining:

(a) a detailed description of the product "SICOM ROV Tool" or any device infringing EP 2 265 793;

(b) in the event the description and the seized documentation do not provide sufficient information to characterize the infringement, a physical seizure of the SICOM product "SICOM ROV Tool" or any device infringing EP 2 265 793, against payment of the price at the Applicant's expense;

(c) the physical seizure or photocopy of documents relating thereto, and notably all technical and promotional documentation, in any format, relating to the "SICOM ROV Tool" or any device infringing EP 2 265 793 or the use of said device;

(d) the written record of any statement made by a person present during the operations; and

(e) the preservation by print, copy or photocopy and disclosure of digital media and data relating to the product "SICOM ROV Tool" or any device infringing EP 2 265 793 or the use of said device, and the disclosure or any passwords necessary to access them;

and to present a Written report to the Court on the measures to preserve evidence with regard to the infringement of claims 1 to 18 of European patent EP 2 265 793.

-The Written report and any other outcome of the measures to preserve evidence:

(a) may only be used in the proceedings on the merits of the case;

(b) will only be accessible to and discussed by the representatives of the Applicant and the representatives of the Defendant on terms to be set up by the Court;

- As expert to carry out this order, Jérôme SARTORIUS, Cabinet NONY, 3 rue de Penthièvre, 75008 Paris, France, Phone: +33 1.43.12.84.60, Mobile: +33 6.24.58.25.69, Email: jsartorius@nony.fr, is appointed, with the assistance of a territorial competent bailiff,

- As representative of the Applicant, Lukasz Wlodarczyk, patent attorney (qualified before the EPO, INPI and USPTO) and lawyer registered to the Paris and California Bar, 90, boulevard Saint-Germain, 75005 Paris, France, upc@infin-ip.com, +33 (0) 1 73 54 36 68, is allowed to be present during the execution of this order with regard to the preservation of evidence.

-Lukasz Wlodarczyk is obliged to keep secret facts which come to his knowledge in the course of the execution of this order, also from the Applicant and its employees.

- The employee or director of the Applicant are not allowed to be present during the execution of this order with regard to the preservation of evidence.
- Defendant is ordered to allow the person appointed to carry out this order:
 - (a) to enter the aforementioned premises or local situations of the Defendant, to preserve evidence as determined in the aforementioned order;
 - (b) to take photographs or films for documentary purposes relevant to the ordered preservation of evidence and to use a dictation device for taking notes;
 - (c) to hand over to the person appointed to carry out this order all documents relating "SICOM ROV Tool" or any device infringing EP 2 265 793 or the use of said device, and notably all technical and promotional documentation, in any format, relating to the "SICOM ROV Tool" or any device infringing EP 2 265 793 or the use of said device.
- In case the Defendant does not allow the person appointed to carry out this order, the person appointed is authorized to call in a locksmith or a computer specialist to enforce the provisions of this order.
- Law enforcement could be present during the enforcement of this order to ensure the safety of the persons appointed in this order.
- It is ordered to the appointed expert to present to the Sub-Registry of the Paris Local Division of the Unified Patent Court a Written report on the measures to preserve evidence with regard to the alleged infringement of EP 793, enclosing all the collected documents, once the required activities will have been completed and, in any case, no later than seven days from the date of execution of the present order; and also simultaneously to communicate this Written report to the representatives of the parties according to the "Confidentiality club" modalities;
- Access to the Written report's expert and its attachments is limited to the representatives of the parties;
- The Written report and any other outcome of the measures to preserve evidence may only be used in the proceedings on the merits of the case;
- The measures to preserve evidence shall be revoked or otherwise cease to have effect, at the Defendant's request, if the Applicant does not bring action leading to a decision on the merits of the case before the Court within a period not exceeding 31 calendar days or 20 working days, whichever is the longer, from the date of the presentation of the Written report by the expert to the Court;
- This order, together with a copy of the application and its exhibits as well as the instructions for access to the proceedings via the CMS, shall be served by the Applicant at the premises of the Defendant immediately at the time of the execution of this order, complying with the French law in regard to service of judicial documents;
- This order is enforceable under condition of recorded payment by the Applicant of a security by deposit of 20.000 Euro;
- The decision on costs is stayed until the main proceedings;

- The Defendant may request a review of this order within thirty days after the execution of the measures, pursuant to R. 197.3 RoP;
- An appeal may be lodged by the parties within fifteen days of the notification of this order in accordance with Art. 73.2 (a) UPCA and R. 220.1 (c), 224.2 (b) RoP.

Delivered in Paris, on the 14th November 2023.

Signed by

Presiding judge C.LIGNIERES

Legally qualified judge C. GILLET

Legally qualified judge A.ZANA

ORDER DETAILS

UPC number: UPC_CFI_397/2023

Related proceeding no. Application No.: 583867/2023

Application Type: Application for preserving evidence pursuant to RoP192