

SYNOPSIS
MOCK TRIAL April 2, 2015

The main procedural questions which will be developed during this Mock Trial are the following:

- the Application for an order to preserve evidence and to inspect premises (Rules 192, 195, 197 and 199): what should be indicated in the Application; how the order should be drafted by the panel; who should be in charge of the inspection; whether the European Patent Attorney of the patentee could be present during the inspection; whether a bailiff could be appointed; whether police forces could be requested to help during the operation ; how should confidential information be treated)
- the Application for provisional measures and the following procedure (Rules 206, 209, 210 and 211). The Application will follow the result of the inspection and the pending opposition procedure at the EPO will have to be considered.

The mock trial per se will comprise two oral hearings concerning respectively:

- the granting of an order to preserve evidence and to inspect the premises (without hearing the defendant)
- the granting of provisional measures in the form of a preliminary injunction (inter partes hearing)

1) Main facts and venue

The Claimant is a US company named “3 Abrasive (3A), owner of the European patent EP no. 2900000 entitled « *Flexible abrasives* ».

The Patent is valid and in force in the Contracting States designated by the Patent, including France, Germany, The Netherlands, United Kingdom and Sweden. All the Designated Contracting States of the Patent have ratified and implemented the UPC Agreement.

The Claimant exports products made according to the Patent throughout Europe, including France, Germany, The Netherlands and Sweden. Abrasive belts for polishing hard stones and manufactured according to the patented method are being sold all over Europe since more than three years.

The Patent was the subject of an opposition proceedings in the European Patent Office. In a decision dated 3 September 2014, the opposition division rejected the opposition and decided that the Patent be maintained as granted. An Appeal is pending before a Board of Appeal.

The Patent relates to flexible abrasives. It was granted in English and claims a method of forming an abrasive member with a step of electro deposition of abrasive nickel patches, the abrasive patches being maintained laterally by a resin material.

The Defendant is a French company named “La Toilemeri”.

The Defendant has a commercial activity in the field of abrasive products for industrial uses.

2) Infringement action

On 25 August 2014, La Toilemeri published on its Internet website an announcement concerning an allegedly new abrasive product.

On this web site, La Toilemeri posted a photograph of this product as well as marketing statements indicating that the advantages of the product were:

- an excellent lateral bearing of the abrasive patches,
- a reinforced securing of the abrasive patches onto the support.

In addition, the website mentioned that the abrasive patches are embedded in a non woven sheet comprising long fibers of polyamide.

3A considers that the advantages mentioned on this website can only be obtained with a product manufactured according to the method disclosed in EP Patent N° 2 900 000 .

Therefore, 3A decided to engage an infringement action against La Toilemeri, considering that this web site announcement was a clear offer to sale on the territory of the countries designated in its European patent. No Application for opt out having been filed, 3A decided to bring the action before the Paris local division since the defendant is domiciled in France. Another reason for this choice was the hope that an order for inspection at the premises of La Toilemeri would possibly be more easy to obtain from the Paris local division comprising two Judges of French nationality.

The Statement of claim has been filed on October 13, 2014, in the English language, which is one of the official languages of the EPO that the Paris local division accepts (under Art 49(2) UPCA).

The panel comprises three judges: Mr Paul Maier (FR), President, Mrs Sophie Canas (FR) and Mr Colin Birss (UK).

On October 30, 2014, the panel designated Mr Colin Birss as judge rapporteur (Rule 18)

On 18 December 2014, La Toilemeri filed a Defense challenging any evidence of infringement and a Counter claim for revocation of the Patent. Simultaneously, the Defendant filed an Intervention in the Appeal procedure which had been initiated at the EPO on 21 November 2014 by the previous Opponent. The defendant, making use of the provisions of Rule 298, also requested the Court to request that the appeal procedure at the EPO be accelerated and to stay its proceedings pending the outcome of the EPO appeal.

The local division decided, according to Article 33(3)(a) UPCA to keep the complete case (infringement and revocation) for decision and requested the President of the Court of First Instance to allocate from the Pool of Judges, a technically qualified judge with qualifications and experience in the field of materials.

Mr Kim Finnilä (FI) was consequently allocated to the panel as technically qualified judge.

3) Application for preserving evidence and inspection

Following the arguments of La Toilemeri in its Statement of defense, insisting particularly on the absence of evidence of reproduction of the claimed method of manufacturing, 3A decided to file on 29 December 2014 an Application for preserving evidence (Rule 192) with a request of an order for inspection at the premises of La Toilemeri, near Paris.

3A also requests the Court to issue this order without hearing the Defendant so as to avoid any risk of the evidence disappearing.

The oral hearing concerning this request and the Application for preserving evidence took place on 5 January 2015.

By an extraordinary special effect, we are now able to present you today this oral hearing exactly as it happened.

4) Result of the inspection

The inspection ordered by the Court at the end of the oral hearing of 5 January 2015, was performed, as determined by the Court, on 8 January 2015.

The report of the inspection made on the spot by the person nominated by the Court shows how the new product of La Toilemeri is manufactured.

In particular, the inspection revealed that the nickel mixed with diamond powder was effectively electro deposited through a layer of non woven fabric, on copper attached to the support.

The inspection allowed also to find copies of a distribution agreement for the product in Europe, with commercial indications.

Finally, a test report was found, relating to the technical effect of the non woven fabric remaining between the nickel abrasive patches. This test report, although important for the evidence of infringement, was indicated as being confidential by the employees of La Toilemeri. It was consequently sealed in an envelope kept by the person in charge of the inspection and subsequently handed to the judge rapporteur.

After study of the content of the envelope, the judge rapporteur ordered that the test report be disclosed, only to the Representatives of the parties and to two specially named persons of the Applicant i.e. the chief of the Patent Department Mr. X and a technical manager Mr. Y after those two persons had signed a declaration under oath not to take any copy, and not to disseminate the information contained in the confidential documents for a period of 4 years.

The tests report shows that, on use, in the product manufactured according to the method observed during the inspection and having a non woven material made of long fibers of polyurethane, only about 8% of the metal patches had chipped off.

3A was therefore conformed in their position concerning infringement and intended to file a reply to the statement of defense of La Toilemeri, on the basis of the evidence collected during the inspection.

5) Result of the inspection

However, on 16 January, 2015, 3A detected an announcement on the web site of La Toilemeri indicating that the product of La Toilemeri was about to be launched on a great scale as from next June 8, and presented in an international exhibition in Paris beginning May 28.

3A decided therefore to file instead an Application for provisional measures (Rule 206) in order to try stopping the acts which 3A considers infringe its European patent. This Application was filed on 26 January 2015.

La Toilemeri filed observations against this Application on 3 March 2015 (Rule 209)

The oral hearing has been scheduled for today.