



Düsseldorf - Local Chamber

File number: UPC_CFI_177/2023
Application number: 525740/2023
Type of request: Request for interim measures

arrangement
of the Court of First Instance of the Unified Patent Court
Local Chamber Düsseldorf
issued on June 22, 2023

Date of receipt of the application: June 22, 2023

APPLICANT:

myStromer AG, Freiburgstraße 798, 3173 Oberwangen b Bern, Switzerland,

represented by: Lawyer ..., Hoyng law firm, ROKH, Monegier, Steinstraße 20,
40212 Düsseldorf,

APPLICANT:

Revolt Zycling AG, Allmendstrasse 15, 8320 Fehraltorf, Switzerland,

represented by: Patent attorney ..., law firm Tarvenkorn, Wickord & Partner,
Bernhard-Ernst-Str. 12, 48155 Münster,

DISPOSAL PATENT:

EUROPEAN PATENT NR. EP 2 546 134 B1

Judiciary/Chamber:

Ruling body of the Düsseldorf local chamber

MIT EFFECTS RICHTER:

This order was issued by Presiding Judge Thomas, Presiding Judge Klepsch as a legally qualified judge and legally qualified Judge Kupecz.

KURZE PRESENTATION OF CONDUCT:

The applicant is jointly with Fairy Bike Manufacturing Co. Ltd. (hereinafter: Fairy

Bike) Co-owner of the European patent EP 2 546 134 B1 (hereinafter: injunction patent). The patent is currently in force in Germany, Switzerland, Italy, Lichtenstein and the Netherlands. It was filed on October 11, 2011, claiming priority from a Taiwanese patent application dated July 11, 2011 in the English language of the case. The notice of the granting of the injunction patent was published on March 25, 2015. No objection was lodged against the granting of the injunction patent. Furthermore, no national nullity proceedings were initiated after the objection period had expired.

The injunction patent protects a "combination structure consisting of a bicycle frame and motor hub", which is characterized by the following features according to claim 1 of the injunction patent:

1.1 Bicycle frame and motor hub combination structure, comprising:

1.2 containing a bicycle frame (1).

1.2.a a first fork (11) and a second fork (12), which are arranged opposite one another,

1.2.b wherein the first fork (11) is provided with a through hole (110),

1.2.c while the second fork (12) has a recess with an internally threaded hole (121) axially corresponding to the through hole, and

1.2.d the first fork (11) on its inside, adjacent to the through hole (110), is provided with a positioning groove (111);

1.3 a motor hub (2), which is provided with a sleeve (21) in the middle,

1.3.a which, with respect to a positioning end, has an end which is such that the positioning end (211) can be engaged with the positioning groove (111) of the first fork and can be stopped against it; and

1.4 an elongated shaft (3) which has a front end (31) and a rear end (32),

1.4.a wherein the rear end has an external thread;

1.4.b the elongated shaft (3) can pass through the through hole (110) of the first fork and the sleeve (21) of the motor hub (2),

1.4.c and wherein the external thread of the rear end (32) is correspondingly engaged in and secured to the internal thread hole (121) of the second fork.

The applicant's request for an injunction is directed against speed pedelecs of the "... " series (hereinafter: the attacked embodiment), the delivery of which the respondent initially announced on its website for April 2023. However, the extradition was delayed, although according to the applicant's information, no extradition has yet taken place. However, the attacked embodiment has been available on the website since June 21, 2023

can be test driven at the "Eurobike 2023" trade fair in Frankfurt am Main. In addition, an order form is available on the respondent's website in both German and English, through which the challenged embodiment can be ordered from the specialist retailers listed on this website.

The challenged embodiment was inspected on June 19, 2023 at the applicant's request at the respondent's Swiss headquarters. The results of this inspection have not yet been released in terms of content.

In a letter dated June 22, 2023, the applicant unsuccessfully warned the respondent.

ASUBMISSIONS OFPARTICLES:

The applicant requests

A. to decide by way of interim measure as follows:

- I. If the respondent avoids a fine to be determined by the court for each case of violation and in Germany, if he avoids an administrative fine of up to €250,000.00 to be determined for each case of violation by the German enforcement court - alternatively, administrative detention - or administrative detention of up to six months, in the case of repeated infringement up to a total of two years, whereby the respondent's chairman of the board of directors is to be imprisoned, is prohibited from using combination structures consisting of a bicycle frame and motor hub in accordance with the claims of the injunction patent (in particular claim 1) in the contracting member states during the term of the injunction patent of the EPG, provided that the injunction patent is in force therein, to offer, place on the market or use or to introduce or possess for the purposes mentioned.
- II. In particular, the respondent is prohibited from offering, placing on the market or using a combination structure consisting of a bicycle frame and motor hub in Germany, the Netherlands, France and/or Italy, or from introducing or possessing it for the purposes mentioned, whereby the combination structure comprises: a bicycle frame including a first fork and a second fork arranged oppositely, the first fork being provided with a through hole, while the second fork having a recess having an internally threaded hole axially corresponding to the through hole, and the first fork is provided with a positioning groove on its inner side adjacent to the through hole; a motor hub provided at its center with a sleeve having an end relative to a positioning end such that the positioning end is engageable with and abutable to the positioning groove of the first fork; and an elongated shaft having a front end and a rear end, the rear end having external threads; the elongated shaft can pass through the through hole of the first fork and the sleeve of the motor hub can pass therethrough, and the external thread of the rear end is correspondingly engaged in and secured to the internal thread hole of the second fork.

III. The respondent is ordered to pay an amount i.e., subject to the final decision on the burden of costs. H.v. €16,000.00 to be paid as a preliminary decision on the legal costs.

IV. The respondent is ordered to hand over the products listed under I. and II in its direct or indirect possession at the Eurobike trade fair to a bailiff to be appointed by the applicant at its own expense in order to ensure their further marketing and circulation on the sales channels during EuroBike.

With regard to the wording of the auxiliary requests, reference is made to the application.

The respondent requests in her protective letter,

"if the presumed first applicant (hereinafter: "applicant #1") and/or the presumed second applicant (hereinafter: "applicant #2") should apply for provisional measures eg for the issuance of an interim injunction due to the facts reproduced below , with the literal or analogous

content,

to order the defendant to cease and desist from any such action, subject to the imposition of an administrative fine or, failing that, imprisonment,

1. To manufacture, offer for sale, place on the market, or use during trade, or either import or possess for such purposes, e-bikes with a specified bicycle frame and motor hub structure,

and/or

2. E-bikes according to the illustration below

[...]

to manufacture, offer for sale, advertise and/or place on the market in any or multiple countries in which the patent has been validated, to import, export and/or possess for the aforementioned purposes.

dismiss the request for provisional measures including an interim injunction;

in the alternative:

a) not to decide on the request for an interim injunction without prior oral proceedings (rule 212 RoP);

(b) to make the order or execution of an interim injunction conditional on the provision of adequate security by the applicant (rule 211(5) RoP)

c) to make the execution of an interim injunction conditional on the applicant serving a certified copy of the application for the injunction with the interim injunction;

FACTUAL AND LEGAL POINTS

The respondent filed a protective document with the Unified Patent Court on June 19, 2023. She cites exhaustion. In addition, it denies that the challenged embodiment violates the patent injunction. In particular, their second fork does not have a recess with an internally threaded hole that corresponds axially to the through hole.

GROUND OF THE APPLICANT

The admissible application for interim measures is justified to the extent stated.

I.

The respondent has not significantly denied the fact that the challenged embodiment directly and literally infringes the injunction patent, either out of court or in its protective document. In particular, it does not take away from the scope of protection of the patent at issue that the internal thread in the challenged embodiment is not located directly in the hole of the second fork, but in a sensor attached to it, based on the functional description of the challenged embodiment in the patent application. The injunction patent does not exclude such a multi-part design of the second fork.

II.

With regard to the applicant's rights under the injunction patent, no exhaustion has occurred, Art. 29 UPCA. As the Swiss Federal Court has already correctly stated in its order of June 8, 2023 (Appendix ASt 1b, p. 12, point 11), the respondent is not entitled, even taking into account the license agreement submitted (Appendix ASt 3), from the Fairy Bike components supplied to produce or distribute a combination structure falling within the scope of protection of the patent.

III.

The matter is also urgent due to the leading European trade fair "Euro Bike 2023" which is already underway (R. 209.2 lit. b) VerfO). It is neither stated nor apparent that the applicant had knowledge of the detailed technical design of the attacked embodiment before inspecting the challenged embodiment on June 19, 2023 and thus immediately before the start of the aforementioned trade fair.

IV.

Based on this, the court, exercising its discretion (R. 209.2 VerfO), considers the issuance of an interim injunction to be appropriate and justified, as can be seen from the operative part (Art. 62 para. 1, 25 UPCA).

The seizure order is based on R. 211.1 (b) Constitutional Code.

In addition, the applicant can request a provisional reimbursement of costs from the respondent, R. 211.1 (c) VerfO. Since the applicant did not explain in more detail the amount she estimated at EUR 16,000, the court only granted her a provisional reimbursement of costs with regard to the legally applicable court costs.

v.

The legal existence of the injunction patent is secured to the extent necessary for the issuance of an interim injunction. The reference to the grant of the injunction patent was published in 2015 without any objections having been lodged against the injunction patent

or a national action for annulment has been brought. The respondent was also unable to present relevant state of the art either before the court or in its protective document.

VI.

The court issued the interim measures without first hearing the respondent. The applicant has credibly demonstrated that a delay would cause her irreparable damage (R. 212.1 VerFO). "Eurobike 2023" is an important leading trade fair that has considerable relevance for the entire industry. It enables the respondent to get in touch with potential buyers and thus build up its own market presence. It is obvious that the exhibition of the challenged embodiment at this trade fair can lead to an almost irreversible loss of sales or market share for the applicant. The products of both parties are substitutable, direct competing products.

ANORTHERN:

I. The respondent is ordered to refrain from using combination structures consisting of a bicycle frame and a motor hub,

to offer, place on the market or use in Germany, the Netherlands, France and/or Italy or to import or possess it for the purposes mentioned,

where the combination structure includes:

a bicycle frame including a first fork and a second fork disposed oppositely, the first fork being provided with a through hole, the second fork having a recess having an internally threaded hole axially corresponding to the through hole, and the first fork at its Inside, adjacent to the through hole, is provided with a positioning groove; a motor hub provided at its center with a sleeve having an end relative to a positioning end such that the positioning end is engageable with and abutable to the positioning groove of the first fork; and an elongated shaft having a front end and a rear end, the rear end having external threads; the elongated shaft can pass through the through hole of the first fork and the sleeve of the motor hub can pass therethrough, and the external thread of the rear end is correspondingly engaged in and secured to the internal thread hole of the second fork.

II. The respondent is ordered to pay an amount of EUR 11,000 as a provisional reimbursement of costs until the decision on the legal costs is made, subject to the final decision on the burden of costs.

III. The respondent is ordered to transfer the products specified under point I. in their direct or indirect possession at the "Eurobike 2023" trade fair to a person to be named by the applicant

bailiffs at their expense to prevent their further marketing and circulation on the distribution channels during the "Eurobike 2023" trade fair.

IV. In the event of a violation of the order under I., the respondent is obliged to pay the court a fine of up to EUR 250,000 for each case of violation.

V. Furthermore, the application for interim measures is rejected.

VI. This order is provisionally enforceable.

The applicant is ordered to provide security in the form of a deposit or a bank guarantee in the amount of EUR 500,000 in favor of the applicant within a period of 10 days from the delivery of this order. If the applicant does not comply with this request within the specified period, the enforceability ceases until the security has been fully provided.

NOTE ON POSITION:

This order should be served personally at the "Eurobike 2023" trade fair in Frankfurt am Main by the applicant's authorized representatives together with a copy of the application for the issuance of this order including the evidence and other documents on which the order is based (R. 212.2, 276.1 VerfO).

NOTE THIS REALLY REVIEW

The respondent can request a review of the present order within 30 days of the implementation of the measure (Art. 62(5), 60 (6) UPCA, R. 212.3, 197.3 Constitutional Code).

INFORMATION ABOUT THE CALLING

The respondent can appeal against this order within 15 days of its delivery (Art. 73 (2) (a), 62 UPCA, R. 220.1 (c), 224.2 (b) Constitutional Code).

NOTE, THAT THIS MAIN PROCEDURE WITHIN A FRIST MUST BE INITIATED

If the main proceedings are not commenced within a period not exceeding 31 calendar days or 20 working days, whichever is longer, from the time of service on the respondent, the court may, at the request of the respondent, order that the present order be set aside or otherwise expires (Art. 62 (5), 60 (8) UPCA, R. 213.1 Constitution).

Issued in Düsseldorf on June 22, 2023

NAMES AND SIGNATURES

Presiding Judge Thomas

Presiding Judge Klepsch

Legally qualified Judge Kupecz

