



Local Division Düsseldorf

Action no: *UPC_CFI_177/2023*

Application no: *525740/2023*

Type of application: *Application for provisional measures*

ORDER **of the Court of First Instance of the Unified Patent Court** **issued on: 22 June 2023**

Date of receipt of the application: 22 June 2023

APPLICANT:

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

represented by: Klaus Haft, Attorney, of Hoyng Rokh Monegier, Steinstrasse 20, 40212 Düsseldorf,

RESPONDENT:

Revolt Zycling AG, Allmendstraße 15, 8320 Fehraltdorf, Switzerland,

represented by: Oliver Tarvenkorn, Patent Attorney, of Tarvenkorn, Wickord & Partner, Bernhard-Ernst-Str. 12, 48155 Münster,

PATENT AT ISSUE:

EUROPEAN PATENT NO EP 2 546 134 B1

Panel/Division

Panel of the Local Division in Düsseldorf

DECIDING JUDGES:

This Order has been issued by the Presiding Judge Thomas, the Presiding Judge Klepsch as legally qualified judge, and the legally qualified judge Kupecz.

SUMMARY OF FACTS

The Applicant is co-proprietor, together with Fairly Bike Manufacturing Co. Ltd (hereinafter: Fairly Bike), of the European patent EP 2 546 134 B1 (hereinafter the patent at issue). The patent at issue is currently in force in Germany, Switzerland, Italy, Liechtenstein and the Netherlands. It was filed

on 11 October 2011 in English-language proceedings, claiming the priority of a Taiwanese patent application of 11 July 2011. The notice of grant of the patent at issue was published on 25 March 2015. No opposition was filed against the grant of the patent at issue. No national revocation proceedings were initiated after the expiry of the opposition period.

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

- 1.1 A combination structure of bicycle frame and motor hub, comprising:
 - 1.2 a bicycle frame (1), including
 - 1.2.a a first fork (11) and a second fork (12) which are oppositely arranged,
 - 1.2.b wherein the first fork (11) is provided with a through hole (110),
 - 1.2.c while the second fork (12) is recessed with an internal thread hole (121) corresponding axially to the through hole, and
 - 1.2.d the first fork (11) is provided, at its inner side adjacent to the through hole (110), with a positioning groove (111);
 - 1.3 a motor hub (2), being provided, at its center, with a sleeve (21)
 - 1.3.a having an end, related to a positioning end, such that the positioning end (211) can be engaged with and stopped at the positioning groove (111) of the first fork; and
 - 1.4 an elongated axle (3), having a head end (31) and a tail end (32),
 - 1.4.a wherein the tail end has an external thread;
 - 1.4.b the elongated axle (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 then the external thread of the tail end (32) is engaged correspondingly and fastened into the internal thread hole (121) of the second fork.

With their application for an injunction, the Applicant is challenging speed pedelecs of the "OPIUM" series (hereinafter: contested embodiment), the delivery of which the Respondent had initially announced on their website for April 2023. However, the delivery has been delayed and, according to the information provided by the Applicant, no delivery has so far taken place. However, the contested embodiment is currently – since 21 June 2023 – available for test rides at the "Eurobike 2023" trade fair in Frankfurt am Main. In addition, an order form is available in both

German and English on the Respondent's website and can be used to order the contested embodiment via the specialist dealers listed on said website.

At the request of the Applicant, the contested embodiment was inspected at the Respondent's registered office in Switzerland on 19 June 2023. The results of this inspection, in terms of content, have not yet been released.

With a brief dated 22 June 2023, the Applicant unsuccessfully issued a warning to the Respondent.

REQUESTS OF THE PARTIES

The Applicant requests:

- A. that on the question of provisional measures the panel decide as follows:
 - I. The Respondent is prohibited, during the term of the patent at issue, from offering, placing on the market or using combination structures consisting of a bicycle frame and motor hub in accordance with the claims of the patent at issue (in particular claim 1) in the contracting member states of the UPC, insofar as the patent at issue is in force in these states, or importing or possessing them for the aforementioned purposes, subject to a penalty payment, which is to be determined by the Court, for each contravention and, in Germany, subject to a fine of up to € 250 000.00 – alternatively detention – to be determined by the German enforcement court for each contravention, or detention for up to six months, in the event of repeated contraventions up to a total of two years, whereby the detention is to be enforced on the Respondent's CEO.
 - II. In particular, the Respondent is prohibited from offering, placing on the market or using, or importing or possessing for the aforementioned purposes, in Germany, the Netherlands, France and/or Italy, a combination structure consisting of a bicycle frame and motor hub, the combination structure comprising: a bicycle frame, including a first fork and a second fork which are oppositely arranged, wherein the first fork is provided with a through hole, while the second fork is recessed with an internal thread hole corresponding axially to the through hole, and the first fork is provided, at its inner side adjacent to the through hole, with a positioning groove; a motor hub, being provided, at its center, with a sleeve having an end, related to a positioning end, such that the positioning end can be engaged with and stopped at the positioning groove of the first fork; and an elongated axle, having a head end and a tail end, wherein the tail end has an external thread, and the elongated axle can pass through the through hole of the first fork and the sleeve of the motor hub, and then the external thread of the tail end is engaged correspondingly and fastened into the internal thread hole of the second fork.
 - III. The Respondent is ordered to pay an amount of € 16 000.00 as a provisional decision on the legal costs, subject to the final decision on the burden of costs.
 - IV. The Respondent is ordered to hand over to a bailiff to be appointed by the Applicant, at their expense, the products referred to under I. and II. in their direct or indirect possession or ownership at the Eurobike trade fair, in order to prevent these being further put on the market and circulated through the relevant distribution channels during EuroBike.

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

The Respondent requests, in their protective letter:

“if the presumed first Applicant (hereinafter: "Applicant #1") and/or the presumed second Applicant (hereinafter: "Applicant #2") should apply for provisional measures e.g. 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.”

POINTS AT ISSUE

The Respondent filed a protective letter with the Unified Patent Court on 19 June 2023. In it, they invoke exhaustion. In addition, they deny any infringement of the patent at issue by the contested embodiment. In particular, they argue that its second fork is not recessed with an internal thread hole corresponding axially to the through hole.

GROUND FOR THE ORDER

The admissible application for provisional measures is well-founded to the extent set out in the operative part.

I.

The Respondent has not significantly denied either out of court or in their protective letter that the contested embodiment directly and literally infringes the patent at issue. In particular, the design of the contested embodiment – as judged from the functional description thereof provided in the protective letter – wherein the internal thread is not located directly in the hole of the second fork, but in a sensor attached to it, is still covered by the protective scope of the patent at issue, which does not exclude such a multi-part design of the second fork.

II.

With regard to the Applicant's rights under the patent at issue, no exhaustion (Art. 29 UPCA) has occurred either. As the Federal Supreme Court of Switzerland already correctly stated in its injunction of 8 June 2023 (Appendix ASt 1b, p. 12, para. 11), the Respondent is not entitled, even taking into account the licence agreement submitted (Appendix ASt 3), to manufacture, using the components supplied by Fairly Bike, or distribute a combination structure falling within the protective scope of the patent at issue.

III.

The matter is also urgent (R. 209.2(b) RoP) due to the leading European trade fair "EuroBike 2023", which is already underway. It is neither submitted nor apparent that the Applicant already had knowledge of the more detailed technical design of the contested embodiment before the inspection of the contested embodiment on 19 June 2023 and thus immediately before the start of the aforementioned trade fair.

IV.

On this basis, the Court, exercising its discretion (R. 209.2 RoP), considers the issuance of a provisional prohibitory injunction as set out in the operative part to be appropriate and justified (Art. 62(1), 25 UPCA).

The seizure order is pursuant to R. 211.1(b) RoP.

In addition, the Applicant can demand an interim award of costs from the Respondent (R. 211.1(d) RoP). As the Applicant has not explained in greater detail how they arrived at the sum of EUR 16 000, the Court has granted them an interim award of costs only with regard to the court costs incurred by law.

V.

The validity of the patent at issue is secured to the extent required for the issuance of a provisional Order. The notice of grant of the patent at issue was already published in 2015, without any

opposition having been filed against the patent at issue or a national revocation action having been brought to date. Nor has the Respondent been able to present relevant prior art, either before the Court or in its protective letter.

VI.

The Court has issued the provisional measures without prior hearing of the Respondent. The Applicant has credibly demonstrated that any delay is likely to cause irreparable harm to them (R. 212.1 RoP). "Eurobike 2023" is an important leading trade fair that has considerable relevance for the entire industry. It enables the Respondent to make contact with potential customers and thus establish its own market presence. It is obvious that the exhibition of the contested embodiment at this trade fair can lead to a loss of sales or market share for the Applicant that can hardly be reversed. The products of both parties are substitutable, directly competing products.

ORDER

I. The Respondent is ordered to refrain from offering, placing on the market or using, or importing or possessing for the aforementioned purposes,

in Germany, the Netherlands, France and/or Italy, combination structures consisting of a bicycle frame and motor hub,

the combination structure comprising:

a bicycle frame, including a first fork and a second fork which are oppositely arranged, wherein the first fork is provided with a through hole, while the second fork is recessed with an internal thread hole corresponding axially to the through hole, and the first fork is provided, at its inner side adjacent to the through hole, with a positioning groove; a motor hub, being provided, at its center, with a sleeve having an end, related to a positioning end, such that the positioning end can be engaged with and stopped at the positioning groove of the first fork; and an elongated axle, having a head end and a tail end, wherein the tail end has an external thread, and the elongated axle can pass through the through hole of the first fork and the sleeve of the motor hub, and then the external thread of the tail end is engaged correspondingly and fastened into the internal thread hole of the second fork.

II. The Respondent is ordered, subject to the final decision on the burden of costs, to pay an amount of EUR 11 000 as interim award of costs pending the Decision on the costs of the proceedings.

III. The Respondent is ordered to hand over to a bailiff to be appointed by the Applicant, at their expense, the products referred to under I. in their direct or indirect possession or ownership at the "Eurobike 2023" trade fair, in order to prevent these being further put on the market

and circulated through the relevant distribution channels during the "Eurobike 2023" trade fair.

- IV. In the event of contravention of point I. of the Order, the Respondent is obliged to pay to the Court a penalty payment of up to EUR 250 000 for each contravention.
- V. In all other respects, the application for provisional measures is dismissed.
- VI. This Order is provisionally enforceable.

The Applicant is ordered to provide security in favour of the Respondent within a period of 10 days from the service of this Order, in the form of a deposit or a bank guarantee in the amount of EUR 500 000. If the Applicant does not comply with this requirement within the aforementioned period, enforceability shall lapse until the security has been provided in full.

NOTE ON SERVICE:

The present Order is to be served in person at the "Eurobike 2023" trade fair in Frankfurt am Main by the Applicant's authorised representatives together with a copy of the application for the present Order, including the evidence and other documents on which the Order is based (R. 212.2, 276.1 RoP).

NOTE ON THE RIGHT TO REVIEW

The Respondent may request a review of the present Order within 30 days of the execution of the measure (Art. 62(5), 60(6) UPCA; R. 212.3, 197.3 RoP).

INFORMATION REGARDING THE APPEAL

The Respondent may appeal against this Order within 15 days of its service (Art. 73(2)(a), 62 UPCA; R. 220.1(c), 224.2(b) RoP).

NOTE THAT THE PROCEEDINGS ON THE MERITS MUST BE INITIATED WITHIN A CERTAIN TIME

If the proceedings on the merits are not initiated within a maximum period of 31 calendar days or 20 working days, whichever is the longer, from the date of service on the Respondent, the Court may, at the request of the Respondent, order that the present Order be cancelled or otherwise cease to have effect (Art. 62(5), 60(8) UPCA; R. 213.1 RoP).

Issued in Düsseldorf on 22 June 2023

NAMES AND SIGNATURES

Presiding Judge Thomas

Presiding Judge Klepsch

Legally Qualified Judge Kupecz