

Milan Local Division



ACTION N.: 45469 /
2024;65482/2024

UPC_CFI N: 472/2024, CFI 181/2025

TYPE OF ACTION: action for
infringement ad revocation action

APPLICATION N.: 24798/2024,
24801/2024 24803/2024; 25321/2025

TYPE OF APPLICATION: rule 295,lett. d
ROP

ORDER N.: ORD_26013/2025

ORDER

of the Court of First Instance of the Unified Patent Court

Milan Local Division

issued on 2 June 2025

concerning a joint request for stay of proceedings

HEADNOTES:

1. Where all parties request the stay of proceedings pursuant rule 295, lett. d, RoP, the Court has no discretion, but It must order the stay. despite the use of the word ‘may’ at the beginning of the Rule.

This interpretation is based on the following principles: the parties are free to determine the subject matter of their case (Art 43 UPCA); the Court must decide in accordance with the requests submitted by the parties (Art 76(1) UPCA).

2. These conclusions also apply to only one of the two patents involved. The proceedings may continue in respect of the other patent, in respect of which infringement proceedings are pending and in relation to which the parties have an interest in concluding the written procedure within the time limits set.

KEYWORDS: RULE 295, LETT. D), RoP, ART. 43 UPCA

APPLICANTS

All parties in the proceedings brought by

Dainese S.p.A.

Claimant

against

Alpinestars S.p.A.

Defendant 1

Alpinestars Research S.p.A.

Defendant 2

Motocard Bike S.l.

Defendant 3

PATENT AT ISSUE:

Patent no. Proprietor/s

EP4072364 Dainese S.p.A.

EP3498117 Dainese S.p.A.

DECIDING JUDGE

Judge rapporteur, Alima Zana after consulting the panel

LANGUAGE OF PROCEEDINGS:

English

ORDER

Summary of facts

1. On 8 August 2024, Dainese spa filed an infringement action against six defendants, claiming that the products "Tech Air 3 System" and "Tech Air 10 Race System" fall within the scope of protection granted by the patents n. EP 3498117 ("EP '117") and EP 4072364 ("EP '364").
2. Claimant withdrew the action against Defendants 3), 4) and 5), and the Court declared the proceedings closed in respect of such parties.
3. Defendants 1), 2) and 6) each filed a counterclaim for revocation against both EP '117 and EP '364.
4. By decision of 13 February 2025, the Board of Appeal of the EPO ordered that EP '117 is maintained in an amended form and remitted the proceedings to the Opposition Division to allow Dainese to adapt the description of the patent in accordance with the amended claims.
5. On 27 February 2025, the Claimant filed an application under R. 263(3), requesting the Court's leave to limit a claim by excluding all the arguments, requests and pleadings related to the alleged infringement of EP '117.
6. By order n. 10964/2025, on 7 April 2025 the Court granted the Claimant's request, thereby excluding all the arguments, requests and pleadings related to the infringement of EP '117.
7. Therefore, as regards EP '117 the proceedings before this Court are now limited to the revocation counterclaim.
8. On 23-27 May 2025 all Parties filed an application under rule 295, lett. D, RoP requesting the Court to order that:
 - The proceedings CC_65482/2024, CC_67493/2024 and CC_9997/2025, as well as the corresponding applications to amend the patent are stayed, insofar as they concern EP '117 (and not EP '364). The deadlines for filing arguments, requests and pleadings related to the infringement and the validity of EP '364 shall remain unchanged.
 - The stay shall remain in effect until either party notifies the Court of the final decision issued by the Opposition Division of the EPO.

General considerations

This Order is adopted having regards to:

- (i) the following principles set out in the Preamble 2 of the RoP
 - proportionality, flexibility and fairness;
- (ii) the article 43 UPCA (Case management “The Court shall actively manage the cases before it in accordance with the Rules of Procedure without impairing the freedom of the parties to determine the subject-matter of, and the supporting evidence for, their case”;
- (iii) The Rule 295 (d) RoP “(the Court may stay the proceedings "*at the joint request of the parties*)", including with respect to only one of the two patents involved in the case.

According to the doctrine, where all parties request the stay of proceedings, the Court must order the stay. despite the use of the word ‘may’ at the beginning of the Rule, It has no discretion .

This interpretation is based on the following principles:

- a. the parties are free to determine the subject matter of their case (Art 43 UPCA);

- b. the Court must decide in accordance with the requests submitted by the parties (Art 76(1) UPCA).

When jointly requesting a stay of proceedings, the parties state that they have no interest in the proceedings continuing at that time. The Court is bound to act according to the request

A joint declaration of the parties or the submission of a request by one party referring to the corresponding request of the other party is necessary.

- (iv) The UPC case law under R 295(d) ROP (see, *inter alia*, case n. CT_590145/2023, 29 October 2024, *Dolby v HP*, LD Düsseldorf).

The case at hand

11. The Court notes that:

- a stay of the counterclaim proceedings and of the applications to amend the patent EP '117 is enable a more efficient management of the proceedings and avoid unnecessary activities by the parties and the Court.
- All Parties agreed that the exchange of further briefs concerning the validity of EP '117 and the auxiliary requests filed by the Claimant in relation to EP '117 would be premature and inefficient at this stage;
- There are no pending infringement proceedings or other circumstances that would balance against a stay.

12. These conclusions also apply to only one of the two patents involved in the case, here EP '117 and not EP '364.

13. Indeed, only EP '117 is not yet in its final version, since the Claimant will have to adapt the description of the patent before the Opposition Division of the EPO in a manner consistent with the decision of the Boards of Appeal. Specifically, by 13 July 2025, the Claimant will have to file an amended version of the description of the patent (see the decision of the EPO Opposition Divisi; opponent. Alpinestars S.p.A. will then be allowed to file its observations, and the Opposition Division will issue its decision.

14. This situation does not apply to EP '364, for which infringement proceedings are pending, in respect of which the parties have an interest in concluding the written procedure within the time limits set.

15. The Court notes that:

- A partial stay of the counterclaim proceedings and of the applications to amend the patent EP '117 is enable a more efficient management of the proceedings and avoid unnecessary activities by the parties and the Court.
- All Parties agreed that the exchange of further briefs concerning the validity of EP '117 and the auxiliary requests filed by the Claimant in relation to EP '117 would be premature and inefficient at this stage;
- There are no pending infringement proceedings or other circumstances that would balance against a stay.

- Whether or not a stay is granted depends on the balance of interests of the parties and the specific circumstances of the case.

16. it follows that the deadlines for filing arguments, requests and pleadings related to the infringement and the validity of EP'364 shall remain unchanged.

17. In view of the specified circumstances of the case, the application to stay proceedings shall be granted.

ORDER

the Court to order that:

1. The proceedings CC_65482/2024, CC_67493/2024 and CC_9997/2025, as well as the corresponding applications to amend the patent are stayed, insofar as they concern EP '117 (and not EP '364).

2 The stay shall remain in effect until either party notifies the Court of the final decision issued by the Opposition Division of the EPO.

3. The deadlines for filing arguments, requests and pleadings related to the infringement and the validity of EP'364 shall remain unchanged.

Issued on 2 June 2025

The Judge rapporteur

Alima Zana