



UPC Court of Appeal
UPC_CoA_505/2024
APL_49883/2024
App_59638/2024
App_68655/2024
App_68657/2024
App_68679/2024

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 24 January 2025
Withdrawal pursuant to R. 265 RoP and
Application for reimbursement of Court fees (R. 370.9 RoP)

HEADNOTES:

- An application to withdraw an action pursuant to R.265 RoP can also be filed in appeal proceedings. It is only after the final decision has become legally binding that a filing of a withdrawal application is inadmissible.
- A withdrawal of a counterclaim for revocation has the effect that requests for amendment of the patent become ineffective.
- With the closure of the proceedings, the impugned decision will become ineffective.

KEYWORDS:

Application to withdraw an action (R.265.1 RoP)

APPELLANT (CLAIMANT AND COUNTERDEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

DexCom, Inc., San Diego, CA, USA (hereinafter 'Dexcom')

represented by:

Anne-Charlotte Le Bihan, Attorney-at-law, and Laurent Labatte, European Patent Attorney (Bird&Bird, Paris, France), and David Sproston and Dr. Mark Jones, European Patent Attorneys (Hoffmann Eitle, Munich, Germany)

RESPONDENTS (DEFENDANTS AND COUNTERCLAIMANTS BEFORE THE COURT OF FIRST INSTANCE)

1. **Abbott Laboratories**, Abbott Park, Illinois, USA
2. **Abbott Diabetes Care Inc.**, Alameda, California, USA
3. **Abbott GmbH**, Wiesbaden, Germany
4. **Abbott Diagnostics GmbH**, Wiesbaden, Germany
5. **Abbott Logistics B.V.**, Zwolle, The Netherlands
6. **Abbott (S.A./N.V.)**, Wavre, Belgium
7. **Abbott s.r.l.**, Rome, Italy
8. **Abbott B.V.**, Hoofddorp, The Netherlands

9. **Abbott Scandinavia Aktiebolag**, Solna, Sweden

10. **Abbott France (S.A.S.)**, Rungis, France

(hereinafter jointly referred to as 'the Abbott companies')

all represented by: Christian Dekoninck and Patricia Cappuyns, Attorneys-at-law (Taylor Wessing, Brussels, Belgium), François Pochart, Attorney-at-law (August Debouzy, Paris, France), Wim Maas and Eelco Bergsma, Attorneys-at-law (Taylor Wessing, Eindhoven, The Netherlands), Mag. Thomas Adocker, Attorney-at-law (Taylor Wessing, Vienna, Austria), Dr. Dietrich Kamlah, Dr. Christian Lederer and Dr. Gisbert Hohagen, Attorneys-at-law (Taylor Wessing, Munich, Germany)

PATENT AT ISSUE

EP 3 435 866

LANGUAGE OF THE PROCEEDINGS

English

DECIDING JUDGES

This order was issued by Panel 2

Rian Kalden, presiding judge and legally qualified judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Hergen Kapels, technically qualified judge

Udo Matter, technically qualified judge

IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

- Paris Local Division, Date: 4 July 2024, ORD_37297/2024, Infringement action ACT_546446/2023, UPC_CFI_230/2023, and counterclaims for revocation CC_586952/2023 (Abbott Laboratories), CC_586960/2023 (Abbott Diagnostics GmbH), CC_586979/2023 (Abbott Logistics B.V.), CC_586980/2023 (Abbott B.V.), CC_586981/2023 (Abbott NV / SA), CC_586982/2023 (Abbott Scandinavia Aktiebolag), CC_586983/2023 (Abbott Scandinavia Aktiebolag), CC_586984/2023 (Abbott France), CC_586988/2023 (Abbott Diabetes Care Inc.), CC_586989/2023 (Abbott S.r.l.) and CC_587002/2023 (Abbott GmbH).

POINTS AT ISSUE

Withdrawal (R. 265 RoP) and request for reimbursement of fees (R. 370.9 RoP)

SUMMARY OF FACTS (INSOFAR AS RELEVANT) AND INDICATION OF THE PARTIES' REQUESTS

The impugned decision and the appeal

1. DexCom initiated infringement proceedings against the Abbott companies before the Paris Local Division based on the patent at issue, and was met by counterclaims for revocation. The Paris Local Division revoked entirely the patent at issue with effect in the territories of the Contracting Member States for which it had effect at the date of the counterclaims for revocation and as specified by

Abbott's requests, dismissing all DexCom's infringement claims based on the patent at issue and requiring DexCom to bear the costs of the proceedings and dismissing DexCom's request for interim award of costs.

2. DexCom appealed the decision. When it lodged its Statement of grounds of appeal it included an application for a subsequent conditional request to amend the patent (App_59638/2024).

Withdrawal of the infringement action

3. On 30 December 2024 (App_68655/2024), DexCom submitted an application to withdraw its infringement action and its conditional application to amend the patent, pursuant to R. 265 RoP.

Withdrawal of the counterclaims for revocation

4. On the same day (App_68657/2024), the Abbott companies agreed to DexCom's withdrawal of the infringement action. They request for their own part that the withdrawal of the counterclaims for revocation be permitted.
5. DexCom consents to the concomitant withdrawal of all the Abbott companies' counterclaims, stating that since the Abbott companies' revocation counterclaims are withdrawn, the impugned decision revoking the patent at issue loses its effect. Thus, the patent as granted is to be considered in force in all the territories designated in the decision.
6. The parties all request that the impugned decision be set aside, and that the proceedings be declared closed.

On costs

7. The parties have explained that a cost decision is not requested. DexCom has added that if the Court would deem it necessary to render a decision on costs in accordance with R. 265.2 (c) RoP, the Court is requested to order that each party bears the costs it has incurred in the present appeal proceedings, including the costs of the proceedings and the fees of its counsel.

Application for reimbursement of Court fees

8. DexCom has also applied (App_68679/2024) for reimbursement of 60 % of the Court fee it paid with the Statement of appeal, i.e. reimbursement of the sum of 34,200 EUR in accordance with R. 370.9 (b) (i) RoP.

GROUNDS

Conditions for permitting the withdrawals

9. The applications to withdraw the infringement action and the counterclaims for revocation are admissible since there is no final decision in the actions in view of the pending appeal, and the Court of Appeal is responsible for deciding on the permissibility of the applications for withdrawal (CoA, 15 January 2025, APL_58979/2024, UPC_CoA_637/2024, APL_58989/2024, UPC_CoA_638/2024, APL_59000/2024, UPC_CoA_639/2024, *Avago vs Tesla* and CoA, 15 January 2025, APL_58696/2024,

UPC_CoA_629/2024, APL_58707/2024, UPC_CoA_631/2024, APL_58726/2024, UPC_CoA_632/2024, *Avago Technologies International Sales vs Tesla Germany and Tesla Manufacturing Brandenburg*).

10. In view of the parties' consents, they cannot be considered to have a legitimate interest in the actions being decided by the Court, and the applications to withdraw the actions can thus be permitted.
11. With the closure of the proceedings, the impugned decision will become ineffective.
12. The conditional application to amend the patent is ancillary to the appeal, and withdrawal of the counterclaim for revocation has the effect of rendering requests for amendment of the patent ineffective. In view of this, there is no need for an order in relation to the withdrawal of the request for amendment of the patent.

Costs

13. Although R.265.2 (c) RoP provides that a decision on costs is to be taken in accordance with Part 1, Chapter 5, no decision on costs is required here, since both parties have declared that a cost decision is not requested.

Reimbursement of Court fees

14. In the event of the withdrawal of the action (R.265 RoP), the party obliged to pay the Court fees shall receive a refund of 60 % in accordance with R.370.9 (b) (i) RoP if the action is withdrawn before the written proceedings have been concluded. This reimbursement is to be ordered in accordance with the application.

ORDER

The Court of Appeal:

- permits the withdrawal of the actions ACT_546446/2023, UPC_CFI_230/2023, and counterclaims for revocation CC_586952/2023, CC_586960/2023, CC_586979/2023, CC_586980/2023, CC_586981/2023, CC_586982/2023, CC_586983/2023, CC_586984/2023, CC_586988/2023, CC_586989/2023 and CC_587002/2023 and declares the proceedings closed;
- orders that this decision shall be entered on the Register;
- declares that there is no need for a cost decision;
- orders that 60 % of the appeal Court fees be reimbursed to DexCom.

Issued on 24 January 2025

Rian Kalden, presiding judge and legally qualified judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Hergen Kapels, technically qualified judge

Udo Matter, technically qualified judge