

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 30 April 2025
regarding stay of proceedings (R. 295 RoP)

Headnote:

In an action for revocation, where both parties agreed to a stay, the appeal proceedings have been stayed pending the outcome of parallel opposition proceedings before the EPO Boards of Appeal, where the opposition proceedings could be expected to result in a final decision before or just after, in any case rapidly, in relation to the possible date for an oral hearing before the Court of Appeal.

Keyword:

Stay of proceedings (R. 295 RoP), parallel opposition proceedings

APPELLANT (AND DEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

Juul Labs International Inc., San Francisco, USA
(hereinafter 'Juul Labs')

represented by European Patent Attorney Bernhard Thum, Thum & Partner, Thum, Mötsch, Weickert Patentanwälte, Munich, Germany, and other representatives from that firm, as well as by representatives from Bardehle Pagenberg, Munich, Germany

RESPONDENT (AND CLAIMANT BEFORE THE COURT OF FIRST INSTANCE)

NJOY Netherlands B.V., Amsterdam, The Netherlands
(hereinafter 'NJOY')

represented by attorney-at-law Dr. Henrik Holzapfel, McDermott Will & Emery, Düsseldorf, Germany

PATENT AT ISSUE

EP 3 504 990

PANEL AND DECIDING JUDGES

Panel 2

Rian Kalden, presiding judge and legally qualified judge
Ingeborg Simonsson, legally qualified judge and judge-rapporteur
Patricia Rombach, legally qualified judge

IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

Central Division Paris, 7 February 2025, revocation action ACT_571795/2023, UPC_CFI_314/2023

LANGUAGE OF THE PROCEEDINGS

English

THE APPLICATION

1. NJOY brought an action for revocation of the patent at issue against Juul Labs before the Central Division Paris. The Central Division revoked the patent at issue with effect for the territories of Belgium, France, Germany, Italy, Luxembourg, Netherlands, Portugal and Sweden.
2. Juul Labs has appealed. With reference to parallel opposition appeal proceedings before the EPO Boards of Appeal, Juul Labs has also applied for a stay of the proceedings. Juul Labs has set forth that the parallel proceedings have been accelerated, with scheduling of the oral proceedings for 14 November 2025.
3. NJOY has agreed to a stay of the proceedings.

REASONS

4. Pursuant to R. 295(a) RoP, and in accordance with Art. 33(10) UPCA, the Court may stay proceedings where it is seized of an action relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings) before the European Patent Office or a national authority where a decision in such proceedings may be expected to be given rapidly.
5. The terms “rapid decision” and “rapidly” in these provisions must be interpreted inter alia in the light of the relevant circumstances of the case, such as the stage of the opposition proceedings and the stage of the revocation proceedings (CoA, order on 28 May 2024, APL_3507/2024, UPC_CoA_22/2024, *Carrier vs Bitzer*).
6. It can be added that pursuant to R. 298 RoP, second sentence, the Court may of its own motion or at the request of a party stay its proceedings in accordance with Rule 295(a) RoP pending the outcome of *accelerated* proceedings before the European Patent Office.
7. The present appeal concerns an action for revocation. It is in an initial stage where the Statement of appeal was lodged on 7 April 2025, the Statement of grounds of appeal would ordinarily be expected on 9 June 2025, and the Statement of response in the first half of September 2025. Application of the

normal two month notice period in R. 239.2 RoP for summoning to an oral hearing would place the hearing in the Court of Appeal around the first half of November 2025.

8. The Boards of Appeal has accelerated their appeal proceedings in view of the UPC proceedings and summoned to oral proceedings for 14 November 2025. The decision without reasons will be announced at the end of the oral proceedings and the written decision with the reasons will be published some time thereafter.
9. In view of this, the decision of the Boards of Appeal can be expected to be issued before or just after, in any case rapidly, in relation to the possible date for an oral hearing before the Court of Appeal. There are no pending infringement proceedings or other circumstances that would balance against a stay. To the contrary, it is Juul Labs – who has a primary interest in a swift decision on appeal – who requested a stay. In addition, NJOY has agreed to the requested stay.
10. Juul Labs' application to stay the appeal proceedings shall be granted.

ORDER

A stay of the revocation proceedings before the UPC is ordered until such time as the EPO Boards of Appeal has given a final decision in the opposition proceedings or those proceedings are otherwise concluded.

The parties shall inform the Court of Appeal forthwith about the outcome of the parallel proceedings.

Issued on 30 April 2025

Rian Kalden, presiding judge and legally qualified judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge