

Order
of the Court of Appeal of the Unified Patent Court
3 March 2025
on provisional measures

HEADNOTES:

- A move from a market situation where only one product is available, to one where there are two competing products, can be expected to lead not just to price pressure but to a permanent price erosion. This risk is an important factor when considering whether a provisional injunction is necessary.
- There are no transitional rules connected to Art. 34 UPCA. When a UPC Signatory State ratifies and accedes, the application of Art. 34 UPCA should be automatic and not subject to limitations, from the day of accession.
- If the Court does not see reasons to order, of its own motion, the rendering of security for enforcement of provisional measures, a defendant can still bring forward arguments and facts to support that the outcome may be different once the action on the merits is tried, and/or that there will be an undue burden in enforcing an order for compensation of injuries caused by the provisional measures if those measures are revoked. The burden of proof is then generally on the defendant. The undue burden can for example be related to the financial position of the applicant, or to the foreign law applicable and its application in the territory where the order for compensation shall be enforced.
- A cost decision should be issued in the proceedings for provisional measures, since it concludes the action.

KEYWORDS:

- Infringement, validity, skilled person, technical effect, territorial scope of injunction, necessity, urgency, security, cost decision

APPELLANT (AND RESPONDENT BEFORE THE COURT OF FIRST INSTANCE)

1. Sumi Agro Limited

2. Sumi Agro Europe Limited

both UK registered companies with registered branch offices in Allershausen, Germany
(hereinafter jointly 'Sumi Agro')

both represented by: Gareth Williams, European patent attorney (Marks & Clerk LLP, London, UK),

Johannes Heselberger, attorney at law, Dr. Axel B. Berger, European patent attorney, Dr. Kerstin Galler, attorney at law and Dr. Markus Ackermann, European patent attorney (Bardehle Pagenberg, Munich, Germany)

RESPONDENT (AND APPLICANT BEFORE THE COURT OF FIRST INSTANCE)

Syngenta Limited, Bracknell, Berkshire, UK
(hereinafter 'Syngenta')

represented by: Dr. Jörn Peters, Benjamin Grzimek and Aylin Cremers, attorneys at law (Fieldfisher, Düsseldorf, Germany), Prof. Dr. Aloys Hüttermann, European patent attorney (Michalski, Hüttermann & Partner, Düsseldorf, Germany), Dr. Filip Alois J. De Corte, and Dr. Christopher Andrews, European patent attorneys (Syngenta Crop Protection AG, Basel, Switzerland)

LANGUAGE OF THE PROCEEDINGS

English

PATENT AT ISSUE

EP 2 152 073

PANEL AND DECIDING JUDGES

This order has been adopted by the second panel consisting of
Rian Kalden, Presiding judge and legally qualified judge
Ingeborg Simonsson, legally qualified judge and judge-rapporteur
Patricia Rombach, legally qualified judge
Arwed Burrichter, technically qualified judge
Anna Hedberg, technically qualified judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

Munich Local Division, 27 August 2024, ACT_23636/2024, UPC_CFI_201/2023.

POINTS AT ISSUE

Application for provisional measures (R.211.1 RoP, R.212.3 RoP)

SUMMARY OF THE DISPUTE

The patent at issue

1. Syngenta is the registered proprietor of European patent 2 152 073, "Herbicide Compositions" ('the patent at issue' or 'the patent'). The patent application was filed on 19 May 2008, and the application was published on 17 February 2010. It claims priority from GB 0709710 (21 May 2007). The date of publication and mention of the grant of the patent was 15 April 2015.

2. The patent is in force in (inter alia) the territories of the Federal Republic of Germany, the French Republic, the Republic of Austria, the Kingdom of Belgium, the Republic of Bulgaria, the Republic of Estonia, the Republic of Latvia, the Republic of Lithuania, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Slovenia and the Italian Republic.

3. Claim 1 of the patent reads as follows:

An herbicidal composition comprising:

- a. at least one sulfonylurea herbicide;
- b. at least one HPPD-inhibiting herbicide; and
- c. at least one saturated or unsaturated fatty acid from 1% to 95% by weight.

The contested embodiment and the alleged infringement

4. The contested embodiment is a herbicide marketed under the trade name 'Kagura' or 'Genki' (hereinafter referred to as 'Kagura'). It is common ground that Kagura contains two active ingredients, mesotrione and nicosulfuron, and is sold as an oil dispersion. Kagura is registered and used for the control of weeds in maize.

5. It is common ground that Syngenta obtained a sample of Kagura in the Czech Republic in June 2023 and carried out an analysis in its own laboratories to examine the specific composition, in particular the amount of fatty acids in the product.

6. Furthermore, Syngenta asserts that it obtained another sample of Kagura in Bulgaria on 4 July 2024, and analysed the sample in the laboratory of its affiliate company. Syngenta has presented new evidence on this in the appeal proceedings, which has been allowed by the Court of Appeal.

7. Syngenta alleges that Kagura contains fatty acids from the group consisting of palmitic acid, stearic acid, oleic acid and linoleic acid, more than 1 % by weight.

8. Sumi Agro, for its part, refutes that the Kagura product actually marketed within the UPC territory contains from 1 % to 95 % by weight fatty acids. According to Sumi Agro, for the manufacture of its Kagura composition marketed in the UPC territory a rapeseed oil which contains between 0.0 % and 0.5 % free fatty acids is used as diluant, not as a stabilizer. It does not include an additional fatty acid ingredient.

Validity

9. Sumi Agro questions the validity of the patent with reference to EP 0 915 652 B1 (EP 652) (novelty, inventive step).

10. Syngenta refutes Sumi Agro's assertion that the patent is invalid.

Other points of dispute

11. The parties have opposing views when it comes to necessity of provisional measures, urgency, weighing of interests, the territorial scope of an injunction and the need for security.

THE IMPUGNED ORDER

12. Syngenta applied to the Munich Local Division for preliminary measures against Sumi Agro, holding that Kagura literally infringes claim 1 of the patent at issue. The Munich Local Division ordered provisional measures against Sumi Agro, as follows:

I. The Respondents are ordered, in the territories of the Federal Republic of Germany, the French Republic, the Republic of Austria, the Kingdom of Belgium, the Republic of Bulgaria, the Republic of Estonia, the Republic of Latvia, the Republic of Lithuania, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Portuguese Republic, the Republic of Slovenia and/or the Italian Republic, to cease and desist from manufacturing, offering, placing on the market or using, or importing or possessing for the aforementioned purposes, an herbicidal composition comprising:
at least one sulfonylurea herbicide;
at least one HPPD-inhibiting herbicide; and
at least one saturated or unsaturated fatty acid from 1 % to 95 % by weight.

II. Any failure to comply with the order under I. will render any of the Respondents liable to pay to the Court a penalty of up to 1000 EUR per item or up to 100.000 EUR per day for each day the respective Respondent fails to comply with this injunction.

III. The order to cease and desist under I. is immediately enforceable.

IV. The Respondent's request that the effectiveness of an order of injunctive relief be put under the condition precedent that Applicant has provided a security in the amount of EUR 5 Mio. is dismissed.

V. The requests by both parties to make an order in respect to who must bear the legal costs and the request by the Respondents to order the Applicant to provisionally reimburse Respondent's costs are dismissed.

VI. These provisional measures will be revoked or otherwise cease to have effect, upon request of the Respondents, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days, whichever is the longer, from 27 August 2024, the Applicant does not start proceedings on the merits of the case before the Court.

VII. The value of the request and the dispute is set to EUR 5 Mio.

13. On infringement, the Local Division took as a starting point that only feature c is in dispute between the parties and held that it is at least more likely than not that the contested embodiment, the 2023 version of Kagura, makes literal use of the technical teaching of claim 1. Reasoning from the basis that claim 1 is a product claim, the Local Division noted that it is not up to the patent holder to show exactly how the fatty acids are present in the 2023 product. It is sufficient to show that they are present in the concentration required by the patent.

14. With reference to the test results presented by Syngenta, the Local Division concluded that even if these results are wholly or partly due to an increase in the percentage of free fatty acids in the composition over time due to hydrolysis, the product claim is infringed as this happened or would have happened during the shelf life of the product, which is 2 years, and Sumi Agro is at least responsible for the composition of the product at any given time during the shelf life.
15. Furthermore, the Local Division found that by distributing the 2023 product outside the Contracting Member States (CMSs), namely in the Czech Republic, and by advertising "Kagura" within the CMSs, Sumi Agro has in any event created a risk of first infringement that patent-infringing compositions will be manufactured, advertised and distributed by them in the territory of the CMSs in the future (Art. 25(a), 62(1) UPCA).
16. According to the Local Division, Sumi Agro has clearly infringed the Czech designation of the patent with the 2023 product sold in the Czech Republic. Sumi Agro has obtained identical marketing authorisations for a product with the same product name in various CMSs and has advertised Kagura in those states without indicating that - in its view - the recipe had changed due to a change in the supplier of the rapeseed oil and thus the amount of free fatty acid contained in that rapeseed oil and ultimately in the product. This behaviour constitutes at least a risk of a first infringement in the territory of the CMSs. In view of the identical marketing authorisations, the identical product name and the identical advertising, the relevant public must assume that the advertising is directed at a product which is identical to that available on the Czech market.
17. The Local Division was convinced of the novelty of the patent with the sufficient certainty required. On inventive step, the Local Division took the view that Sumi Agro had failed to provide any justification as to why the skilled person would choose prior art EP 652 as a starting point to address the task of providing a solution to the tank-mixing problem (see para 41 below) exactly in such a way as to arrive at an amount of free fatty acid in the overall composition of at least 1 % by weight.
18. Sumi Agro's arguments on insufficiency /plausibility/ AgrEvo obviousness were rejected.
19. Moreover, the Local Division considered that provisional measures were necessary to prevent the continuation of the infringement or at least to prevent an imminent infringement and that the balance of interests to be struck is also in favour of Syngenta.
20. On security, the Local Division concluded that Sumi Agro had not put forward any arguments as to how and why the enforcement of any claim for damages against Syngenta in the United Kingdom might be unsuccessful.
21. On costs, the Local Division considered that, in principle, there is no reason to make a decision on costs in proceedings for the grant of provisional measures if the summary proceedings are followed by proceedings on the merits.
22. Following the impugned order, Syngenta lodged an action for infringement against Sumi Agro with the Munich Local Division (ACT_53813/2024, UPC_CFI_566/2024). Due to an issue about payment of the Court fees, the parties are in dispute on whether this action was lodged timely.

SUMMARY OF THE PARTIES' REQUESTS

23. With the appeal, Sumi Agro is challenging the impugned order. Sumi Agro requests an order in which:
- A. the Court of Appeal set aside in part the impugned order with regard to no. I to V. and the Court of Appeal substitute its own decision;
 - B. the application for provisional and protective measures be dismissed;
 - C. Syngenta pay Sumi Agro's costs of the proceedings at first instance and on appeal;
 - D. Syngenta provisionally reimburse Sumi Agro's costs of the proceedings at first instance and on appeal.

In the alternative to B:

Ba. Syngenta be ordered to pay security as condition precedent for any provisional measures requested by Syngenta becoming effective, the amount of which shall be determined by the Court.

Sumi Agro requests an interim award of costs according to R. 211.1.d RoP. In particular, it requests an interim award in circumstances where Syngenta has been unsuccessful in its request for provisional measures.

24. Syngenta requests that the appeal be dismissed. Syngenta also requests that the Republic of Romania is added to the order at I. It refutes the requests on interim award of costs and security for enforcement and requests that Sumi Agro shall have to bear the legal costs of these proceedings for provisional measures in the first and second instance.
25. The parties have different standpoints on the interpretation of claim 1 and thus the scope of protection. They have different views on the validity of the patent. Moreover, Sumi Agro refutes that the contested embodiments realise feature c ("at least one saturated or unsaturated fatty acid from 1 % to 95 % by weight"). The existence of two different versions of Kagura, and what conclusions can be drawn from this, is another point of dispute between the parties. Finally, the parties disagree when it comes to necessity of provisional measures, urgency, weighing of interests and security for enforcement.

New evidence

26. Both parties submitted new evidence in the appeal proceedings. This was addressed by the Court of Appeal in an order of 19 December 2024. New evidence submitted by Sumi Agro was disregarded by the Court of Appeal, and so were some pieces of new evidence that Syngenta had submitted in case the Court of Appeal would allow Sumi Agro's new evidence.
27. Evidence submitted by Syngenta relating to a possible new version of Kagura was on the other hand regarded. The Court of Appeal considered that Syngenta had justified that those new submissions could not reasonably have been made during the first instance proceedings.

Sumi Agro's submissions on appeal in summary

28. Sumi Agro has maintained its positions from the first instance proceedings (except on insufficiency, see below). The grounds of appeal are in summary, and insofar as relevant, as follows.

- The Local Division made an incorrect assessment about infringement.
- Sumi Agro offered a cease-and-desist declaration with a penalty clause with regard to the 2023 product during the oral hearing before the Local Division, which eliminates even the risk of repetition of an infringement.
- There is no manifest risk of first infringement in France, Portugal, Estonia, Latvia, Lithuania, Luxembourg and the Netherlands. No Kagura product has been marketed in any of these countries to date. In relation to UPC territory, the Kagura 2024 product has been marketed in Germany and Bulgaria only.
- Sumi Agro applied for marketing authorization in France and Portugal, but the applications were refused. Sumi Agro has not applied for marketing authorization in Estonia, Latvia, Lithuania and/or Luxembourg. It has applied for but not yet obtained marketing authorization in the Netherlands. At least in the states where no marketing authorization has been granted, a risk of first infringement cannot exist.
- Insufficient disclosure is no longer raised by Sumi Agro.
- On invalidity, the Local Division's findings are incorrect.
- The Local Division made an incorrect assessment about the necessity of provisional measures, urgency, weighing of interests, the territorial scope of an injunction and the need for security.
- Syngenta should have acted urgently and without any delay to obtain a sample of the Kagura 2024 product, i.e. a sample of the actual Kagura product sold in the UPC territory. This should have been done many months earlier. Syngenta has not explained what steps it took either before or since 18 March 2024 (when, according to Syngenta's own statement, it noticed that Sumi Agro had started marketing activities for Kagura in Germany) to obtain and analyse the product offered in the UPC and why it was unable to obtain and analyse such product until after conclusion of the proceedings before the Munich Local Division. Sumi Agro offered to provide Syngenta with a Kagura product sample for analysis during pre-action discussions in January 2024 (referenced on pages 5 and 6 of the impugned order). At no point did Syngenta follow up on that offer.
- The Local Division expressly defined the Kagura 2023 product to be the (only) "subject matter of the dispute". The Kagura 2024 product (see para 61 below) was not (made) the subject matter of the dispute by Syngenta. Including the Kagura 2024 product now would mean a change of claim pursuant to R. 263 RoP after the end of proceedings at first instance, and will prejudice Sumi Agro by restricting its right to be heard and hinder the conduct of its action.
- On Syngenta's analysis, the average free fatty acid content for each of the measured free fatty acids (linoleic, oleic, palmitic) is significantly less than 1 % (0.27 %, 0.79 %, 0.08 % respectively). The Kagura 2024 product therefore does not comprise "at least one" free fatty acid of 1 % (or more) by weight as required by the claim.
- If the Court interprets the claim to extend to the total free fatty acid content calculated by reference to all free fatty acids present in the formulation, Syngenta's analysis of the Kagura 2024 product has not convincingly shown content above 1 %. In particular, Syngenta presents insufficient information on the conditions under which the Kagura samples were stored prior to analysis in circumstances where storage conditions may impact degradation of the rapeseed oil component, and hence free fatty acid content. This is of critical importance given the proximity of the results relied on by Syngenta to the claim boundary of 1 %.
- Syngenta reports consistently different results each time it analyses the Kagura products (whether 2023 or 2024) which calls into question the accuracy, precision and reliability of those results.

- Adding Romania to the territorial scope of an order on provisional injunction would contradict basic principles that an appeal filed by the addressee of a provisional injunction cannot be subject to an even broader injunction as a result of lodging an appeal against the said injunction.

Syngenta's submissions in response to the appeal in summary

29. Syngenta has maintained its positions from the first instance proceedings and supported the findings of the Local Division, and has, in addition, introduced facts and evidence about the Kagura 2024 product in the appeal proceedings. Syngenta puts forward, in summary and insofar as relevant, the following.

- The Local Division did not examine an infringement by the Kagura 2024 version because the relevant data could not be produced earlier. Syngenta did not and could not know about the change of the rapeseed oil by Sumi Agro until the Objection was served in early June. However, Syngenta has now obtained a sample of the Kagura 2024 product and analysed it. The Kagura 2024 version also infringes the patent.
- Advertisement itself already constitutes an infringing act and therefore a risk of repeated infringement.
- The submissions with regard to the offer of a cease-and-desist declaration during the oral hearing on July 12, 2024, are incorrect. Sumi Agro mentioned its willingness to offer a cease-and-desist declaration, limited to the Kagura 2023 product. Syngenta asked for an abstract cease-and-desist declaration containing the wording of claim 1 of the patent-in-suit but Sumi Agro did not make such a unilateral declaration.
- Before the Local Division, Sumi Agro never specifically contested that Syngenta learned about Sumi Agro's marketing activities for Kagura in Germany around March 18, 2024. These facts are deemed to be true (R. 171(2) RoP) and Syngenta was under no obligation to produce any evidence.
- In countries where there are marketing offers and marketing authorisations for Kagura, there is a factual capability to distribute Kagura.
- In countries where there are no marketing authorisations, there is still a risk of infringement. Marketing authorisations can be obtained and furthermore, once Kagura has been sold legally in one country, the product can move and be resold and there is little control of such movements.
- It was not possible to request provisional measures in relation to Romania when the application for provisional measures was made. Romania acceded to the UPC after the impugned order was issued, and the contested embodiments are offered in Romania. In this particular case it would be a matter of economy of proceedings to allow Syngenta to add Romania to the territorial scope of the order.

GROUNDS FOR THE ORDER

Admissibility of Syngenta's claim insofar as it relates to the Kagura 2024 product

30. Syngenta's claim that Sumi Agro is infringing the patent, as set out in its application for provisional measures lodged with the Local Division, is of a general nature. Although some of the evidence presented at first instance was about the product that was later in the proceedings referred to as the Kagura 2023 product, the patent infringement claim as such was not limited in that way. When lodging the application for provisional measures, Syngenta was apparently working from the assumption that the products offered in the Czech Republic and in Germany respectively had identical formulations. Met with counter facts and counter evidence presented by Sumi Agro in the first instance proceedings to support its non-infringement arguments, Syngenta introduced new facts and evidence in the appeal proceedings. Those

facts and evidence were admitted by the Court of Appeal in the order of 19 December 2024 with reference to R. 222.2 RoP.

31. The Local Division indeed stated that Syngenta denies the existence of a second version of Kagura and relies exclusively on the 2023 product as analysed by ■■■■■ and that this defines the subject matter of the dispute (page 17). Nevertheless, the Local Division addressed the possible existence of a Kagura 2024 product in its factual assessment about two product versions, and in its assessment of the risk of infringement (pages 11 and 20). The injunction ordered by the Local Division is of a general nature.
32. Sumi Agro has been heard about the new facts and evidence presented by Syngenta, in writing, at the interim conference and at the oral hearing, and will furthermore be able to develop its reasoning in proceedings on the merits.
33. Syngenta has not changed its claim or amended its case during the appeal proceedings. The reasons for this will be explained in para 59 et seq. below, and as set out by the Court of Appeal in the order of 19 December 2024, it is relevant and in the interest of both parties that the evidence relating to the possible existence of two Kagura products, and their characteristics, be assessed on appeal.

The person skilled in the art

34. In this case both parties have realistic and largely similar views about whom the person skilled in the art should be presumed to be. In Sumi Agro's view, the skilled person is a chemist with experience in the special area of formulating herbicides. In Syngenta's view, the person skilled in the art is a chemical engineer who works in the industry of crop protection, who is familiar with herbicidal compositions effective against herbs. Furthermore, according to Syngenta, the skilled person is a formulation expert and has insights on safety issues and applicable regulations.
35. The Court of Appeal favours Sumi Agro's standpoint here, since it is closely related to the technical field in question, while Syngenta's definition, on the other hand, is somewhat broader and vaguer. The skilled person is hence a chemist with experience in the special area of formulating herbicides.

The common general knowledge of the skilled person

36. Sumi Agro has set out that it was part of the common general knowledge of the person skilled in the art at the application date that vegetable oils have certain levels of free fatty acids and that in general, the skilled person would have understood that a fatty acid is a type of molecule that is a building block of fats and knows that rapeseed oil used in herbicide formulations would typically include free fatty acid content of up to 2 %. This argument is rejected.
37. Common general knowledge is knowledge that an experienced person in the field in question is expected to have, or at least to be aware of, to the extent that he knows he could look it up in a book if he needed it.
38. Sumi Agro has referred to Exhibits SA-2, SA-3, SA-4, SA-11, SA-12 and SA-13. Exhibit SA-2 is entitled "Croda Europe rapeseed oil specification" and is a technical data sheet for the rapeseed oil which Sumi Agro states it used for the Kagura 2024 product. Sumi Agro has not advanced when or where SA-2 is

published, and it cannot be considered to form part of common general knowledge at the application date. SA-3 is a similar technical data sheet, but from another producer. It is dated in March 2022 and the same considerations apply. They apply also to SA-11 which is a data sheet for a herbicide called Raikiri, dated January 2017, for SA-12, a data sheet from 2023 for a herbicide called Callisto and for the data sheet for Syngenta's product Elumis from 2023 (SA-13). SA-4 is entitled FEDIOL rapeseed oil specification. Unlike SA-2, SA-3, SA-11, SA-12 and SA-13, it is published in 1998, so before the priority date. There is, however, no explanation why this specification from an industry association should form part of the common general knowledge of the skilled person.

Claim construction

The patent and its technical background

39. The principles applicable to claim construction have been set out by this Court in its final order on 26 February 2024, UPC_CoA_335/2023, APL_576355/2023, NanoString Technologies et al./10x Genomics et al (*NanoString v 10 Genomics*). There is no need to repeat them here.
40. The invention covered by the patent at issue relates to a herbicidal composition comprising a sulfonylurea herbicide and a p-hydroxyphenyl pyruvate dioxygenase (HPPD-)-inhibiting herbicide. In the patent specification it is described first (para 1) that it is known in the art that the combination of nicosulfuron and mesotrione provides efficient control of weeds in maize. However, due to their respective intrinsic properties, sulfonylurea and HPPD-inhibiting herbicides are sensitive to chemical breakdown, particularly in liquid formulations, and as such these herbicides are typically mixed together just prior to application, a process known as tank-mixing (para 2).
41. As set out in the patent specification, the ability to provide these herbicides as a stable "ready-mix" composition has several significant advantages. In addition to providing improved chemical stability, the herbicidal compositions of the present invention also provide comparable or improved biological function compared to tank-mixed compositions, both in terms of efficacy and selectivity (para 3). According to claim 1 of the patent at issue, this is solved with a composition comprising:
- a. at least one sulfonylurea herbicide;
 - b. at least one HPPD-inhibiting herbicide; and
 - c. at least one saturated or unsaturated fatty acid from 1 % to 95 % by weight.
42. Paras 5 through 25 of the patent specification describe the active ingredients (features a and b; the at least one sulfonylurea herbicide and at least one HPPD-inhibiting herbicide). Feature c is described in para 26: "Preferably, the saturated or unsaturated fatty acid comprises a chain of at least 10 carbon atoms, more preferably from 10 to 20 carbon atoms, even more preferably from 12 to 18 carbon atoms. Preferably, the fatty acid is unsaturated. The saturated or unsaturated fatty acid is preferably selected from the group consisting of lauric acid, palmitic acid, stearic acid, oleic acid, linoleic acid, linolenic acid, erucic acid, brassidic acid, caprylic acid, caproleic acid, palmitoleic acid, vaccenic acid, elaidic acid, arachidic acid and capric acid. Particularly preferred is oleic acid. The concentration of the fatty acid in the composition is from 1 % to 95 % by weight, preferably from 5 % to 90 % by weight and even more preferably from 10 % to 90 % by weight."

43. The technical effect is described in para 27: "a saturated or unsaturated fatty acid provides improved chemically stability of both the sulfonylurea and HPPD-inhibiting herbicide in the formulation." The statements in paras 3, 26 and 27 capture the core of the invention.

Feature c- fatty acid

44. Like the Local Division, the Court of Appeal finds that the skilled person will understand a "fatty acid" referred to in feature c as a free fatty acid (FFA), meaning that the fatty acid according to claim 1 of the patent is an unbound (ie non-esterified) fatty acid molecule having a free carboxylic acid functionality (ie a -COOH group). Such free fatty acids can either be saturated (ie not containing any C=C double bond in the carbon chain) or unsaturated (ie containing one or more C=C double bonds in the carbon chain). The skilled person takes this from para 26 of the patent specification which reads: "Preferably, the saturated or unsaturated fatty acid comprises a chain of at least 10 carbon atoms, more preferably from 10 to 20 carbon atoms, even more preferably from 12 to 18 carbon atoms. (...)". All specific fatty acids mentioned in para 26 of the patent specification are either saturated free fatty acids ("lauric acid", "palmitic acid", "stearic acid", "caprylic acid", "arachidic acid", "capric acid"), or unsaturated free fatty acids ("oleic acid", "linoleic acid", "linolenic acid", "erucic acid", "brassicidic acid", "caprolic acid", "palmitoleic acid", "vaccenic acid", "elaidic acid"). By contrast, fatty acid molecules that are esterified, for example where a glycerol molecule is bound to three fatty acid molecules (triglycerides), are not free fatty acids. Such esters of fatty acids are referred to in paras 28 and 29 of the patent specification.

45. Sumi Agro essentially argues for a claim interpretation where there are two possible FFA components, one claimed component which is the added one, leading to improved stability, and one other component. Syngenta, on the other hand, argues that it is irrelevant whether the fatty acids are added separately or derived from the use of, for example, vegetable oil as no such a distinction is made in the patent. Equally, the purpose of adding any component is irrelevant. What matters for the purpose of the patent is solely the presence of fatty acids in the patented amount in the product.

46. The Court of Appeal considers that the claim construction relating to feature c is derived from an understanding of the core of the invention as explained previously, and from a close reading of paras 28 through 31 of the patent specification, together with examples 1 and 2.

47. Having described the technical effect, the patent specification describes how the composition of the invention may further comprise one or more additional components (paras 28-31). Para 28 states that "the composition of the present invention may further comprise one or more additional components, such as surfactants. It gives numerous examples, including fatty acid esters. Para 29 states that "the composition of the present invention may further comprise vegetable oil and/or a mineral oil and/or an alkyl ester". It also provides examples followed by "and fatty acids originated therefrom". The herbicidal composition may comprise a small quantity of water and, optionally, an acid (para 30), and further an additional pesticidal ingredient (para 31).

48. Example 1 has the heading "Stability studies", describing preparation of formulations where mesotrione and nicosulfuron are dispersed into different oil mixtures. The resulting oil dispersions contain either mineral oil, or rapeseed oil methyl ester, or sunflower oil or oleic acid. Oleic acid is a fatty acid (para 26). After 8 weeks of storage at 40° C the decomposition of mesotrione and nicosulfuron was assessed (para 46). The specification specifically states that the results show the improved stability of both mesotrione

and nicosulfuron in herbicidal compositions comprising oleic acid compared with compositions comprising mineral oil, methylated rapeseed oil or sunflower oil and that it can be seen that the stability of both the mesotrione and the nicosulfuron is markedly improved in compositions comprising oleic acid (para 47).

49. In Example 2 (paras 48—50), further experiments were conducted. Also here, the specification states that it can be seen that the stability of both mesotrione and nicosulfuron markedly improved in herbicidal compositions comprising a fatty acid, compared with compositions comprising methylated rapeseed oil or coconut oil (which comprises mostly C12 and C14 saturated triglycerides).
50. Sumi Agro argues that para 47 suggests that the patentee did not intend for the composition containing sunflower oil or methylated rapeseed oil to be construed as comprising oleic acid, and similarly, para 50 suggests that the patentee did not intend for the composition containing coconut oil or methylated rapeseed oil to be construed as comprising a fatty acid, so that a correct interpretation of claim 1 is that a composition including rapeseed oil (but with no isolated/free fatty acid added) does not comprise a “fatty acid”.
51. This line of arguments is not in accordance with the principles for interpreting a patent claim, where the patent claim is to be interpreted from the point of view of a person skilled in the art. Moreover, claim features must always be interpreted in the light of the claim as a whole (CoA, 13 May 2024, APL_8/2024, UPC_CoA_1/2024, *VusionGroup vs Hanshow*). Further, a claim must be interpreted in light of the specification as a whole.
52. Claim 1 is a product claim. Product claims confer protection to all processes for making that product. The skilled person will look at the teaching of the specification as a whole when reading the claim, rather than singling out a specific composition and draw conclusions based on separate aspects of the invention as described in the patent specification. In particular examples cannot generally be understood as limiting the scope of the claim.
53. Although a herbicidal composition pursuant to claim 1 can include vegetable oil, such as rapeseed oil, it does not necessarily need to do so, as Sumi Agro seems to suggest. In claim 1, vegetable oil is not mentioned. In para 28 of the patent specification, it is set out that the herbicidal composition of the present invention can be a “solid” formulation, for example, a water dispersible granule (WG) but is preferably a liquid composition - in particular an “oil dispersion” (OD) - especially wherein the herbicide components are present in suspension in the fatty acid component. Further, as already explained, in para 29, it is described how the composition of the present invention *may further comprise* a vegetable oil and/or a mineral oil and/or an alkyl ester (italics added). – From the wording used, the skilled person understands these components to be optional add-ons to the invention of claim 1.
54. The core of the invention is that fatty acids can significantly chemically stabilise HPPD-inhibiting herbicides in herbicidal compositions (see above). The skilled person sees from the claim and the patent specification, including the examples, a teaching that the presence of FFA in the specified range provides improved chemical stability of the sulfonylurea and HPPD-inhibiting herbicide in the formulation. This improved chemical stability will occur when there is enough FFA, regardless of whether the FFA are added separately, or as part of / originating from an additional ingredient such as vegetable oil (par 28, 29), or

- as discussed by the parties - are created through a chemical process such as hydrolysis due to the presence of water (par. 30).

Whether feature c includes different FFAs or only one FFA

55. The next question is whether feature c of claim 1 – “at least one saturated or unsaturated fatty acid from 1% to 95% by weight” – shall be interpreted so as to include different FFAs (for example linoleic, oleic, palmitic) or as only one FFA. Here, the Court of Appeal shares Syngenta’s view that the claim covers a plurality of FFAs. This stems from the wording “at least one...” and finds support in para 26 of the patent specification. The 1 % to 95 % by weight can consequently include the combination of several different FFAs.

Infringement

56. The Court of Appeal will now consider whether there is a sufficient degree of certainty for infringement, so that the Court is satisfied that on the balance of probabilities that it is more likely than not that the patent is infringed. Insofar as is relevant here, Syngenta has the burden of presentation and proof for facts establishing the infringement or imminent infringement of the patent, as well as for all other circumstances supporting its request.

57. Apart from alleging in general terms that the Local Division reached the contested order on the basis of erroneous factual assumptions with regard to infringement, and stating that it relies on the facts, evidence and submissions submitted by it before the Court of First Instance, Sumi Agro has not specifically challenged the findings of fact made by the Local Division in relation to the Kagura 2023 product.

58. On infringement, those findings were the following. The Local Division evaluated the evidence presented by Syngenta relating to Syngenta’s in-house laboratory analysis of a Kagura sample (as carried out by ■■■■■ and found that Syngenta had proven that the total fatty acid content in the Kagura 2023 product was 2.91 %, and that these results could not be attributed to any mishandling of the probes. In this context, the Local Division noted that Sumi Agro had not challenged the results of ■■■■■ analysis as such.

59. These facts can thus be considered established.

60. It is nevertheless necessary for the Court of Appeal to consider whether also the Kagura 2024 product realises the features of claim 1. In view of the uncontested contention of Sumi Agro that the Kagura 2023 is no longer on the market anywhere, it will be relevant for assessment of necessity, weighing of interest and urgency, whether the Kagura 2024 product infringes the patent or not. As will be seen, it will in addition be appropriate to review the evidence pertaining to the Kagura 2023 product for a proper understanding of the new evidence on the 2024 product.

61. Before going into detail, it is important to emphasize, when discussing the Kagura 2023 and 2024 products respectively, that it is not a matter of two distinct contested embodiments in the ordinary sense. Rather, it is a matter of a product being offered under the same brand and the same marketing authorisations and according to the same formulation (recipe), although at some point in time, Sumi

Agro begun sourcing one of the ingredients from a different supplier, and that ingredient has different characteristics. This will be explained further below.

62. Sumi Agro has set out how it has marketed two versions of Kagura, one outside the UPC territory in Poland and the Czech Republic only (the 2023 product), and one within and outside the UPC territory in Poland, the Czech Republic, Bulgaria and Germany (the 2024 product). According to Sumi Agro, the products were made according to the same formulation (recipe) but using different rapeseed oil from two different suppliers. Sumi Agro argues that the 2023 product is no longer offered anywhere and has been replaced by the 2024 product.
63. The evidence presented by Sumi Agro – witness statements by ■■■■■ and accompanying documentation – strongly supports that there are two versions or (rather) two generations of the Kagura product, where the formulation (recipe) is the same, but different rapeseed oils from two different suppliers were used in the 2023 and 2024 products respectively.
64. Proceeding from this finding, the Court of Appeal evaluates the new evidence presented by Syngenta pertaining to the Kagura 2024 product. This evidence has been questioned by Sumi Agro with regard to transport, storage, timing and test conditions for the samples, and accuracy, precision and reliability of the analysis results.
65. According to Syngenta, it purchased three 5 litre canisters of Kagura in Bulgaria on 4 July 2024. One of the three canisters was analysed at the laboratory of Syngenta's affiliate company in the US.
66. The evidence presented by Syngenta about its purchase of Kagura in Bulgaria in July 2024 and its dispatch to the laboratory in the US consists of an invoice, a statement from a notary in Basel, Switzerland, and statements made by ■■■■■. The evidence is credible. The invoice for SUMIAGRO Kagura 5l. is dated 4 July 2024. The canisters were dispatched to Syngenta in Switzerland where a notary public inspected and certified the unpacking of a parcel with sealed canisters on 26 July 2024. A canister was then dispatched to the Syngenta laboratory in the US. ■■■■■ has certified that she received the canister (“sample bottle”) on 28 August 2024, the canister still sealed and not leaking. The IDs for the sample match what was noted in Switzerland.
67. Moving forward to the result of Syngenta’s analysis of the Kagura 2024 product, the Court of Appeal notes that the same method was employed as in the second analysis of the Kagura 2023 product. This observation calls for some explanation. In the first analysis of the Kagura 2023 product carried out by ■■■■■ a total of 5.67 % FFA was found in the sample. In the second analysis, the sample concentration was reduced and the duplication increased, to increase accuracy. This second analysis showed that the same Kagura sample contained a total of 3.6 % FFAs. It is this second analysis of the Kagura 2023 product sample that is shown in the impugned decision at page 18, and where the results were considered reliable by the Local Division.
68. The results of Syngenta’s analysis of the Kagura 2024 product sample have been documented in a technical report named Fatty acid profile by GC-FID, dated 9 September 2024, and in an affidavit by ■■■■■ dated 10 October 2024. The result of ■■■■■ analysis of the Kagura 2024 product is that all six individual samples taken from the canister tested had a FFA content above 1 % and an average content

of 1.13 %. The sample analysis was performed with six replicate measurements and each replicate sample was injected twice. The standard deviation was 0.10. The method employed was gas chromatography with flame ionization detector (GC-FID) described in “Development and validation of a GC–FID method for quantitative analysis of oleic acid and related fatty acids” (Journal of Pharmaceutical Analysis 5 (2015) 223–230; Zhang et al.).

69. The Court of Appeal finds the analysis credible.
70. Sumi Agro has argued that the average FFA content for each of the measured FFA (linoleic, oleic, palmitic) is significantly less than 1 % (0.27 %, 0.79 %, 0.08 % respectively), but with the Court of Appeal’s claim construction it is the total FFA content that matters.
71. Syngenta has thereby fulfilled its burden – in other words, satisfied the Court that it is more likely than not – that the Kagura 2024 product contains FFA that fall within the range (1 % to 95 % by weight) protected by claim 1 of the patent. For sure it is just above the 1 % lower limit of the range, but it is still within the scope of protection. It then falls on Sumi Agro to provide evidence which makes these findings questionable to the extent that the “more likely than not” assessment will turn in Sumi Agro’s favour.
72. Here, Sumi Agro has provided the technical data sheet for the rapeseed oil which, according to the witness statement of ██████████ was used in the manufacture of the Kagura 2024 product. The data sheet lists the FFA content of the rapeseed oil as 0 – 0.5 % alongside the percentage content of the fatty acids that make up the bulk of the oil (e.g. oleic, linoleic and linolenic acid).
73. The Court of Appeal considers that the evidence provided by Sumi Agro is insufficient to call into doubt the results of the laboratory analysis provided by Syngenta, especially since Syngenta has provided evidence about the actual finished product, while Sumi Agro has provided evidence about the standard composition of only one ingredient. To convince the Court otherwise, Sumi Agro should have provided a full counter-analysis. Sumi Agro has not done so, and has not stated any specific reason for the absence of such an analysis of their own.
74. In this respect it is irrelevant whether Sumi Agro added any isolated FFA to the Kagura 2024 product as an independent component, separate from rapeseed oil, which Sumi Agro says it did not. Based on the claim construction, it is the total FFA content in the contested embodiment that matters, not where it originates from or how it was achieved.
75. The parties furthermore dispute whether Sumi Agro added phosphoric acid (pH modifier) and water to the contested embodiment, thereby creating an environment where a hydrolysis reaction in the product would lead to an indirect addition of free fatty acids, or whether hydrolysis has occurred to some degree during storage of the sample, as a result of deterioration of oils and fats. – As with the matter of added FFA (see the previous paragraph), the claim construction means that there is no need to consider whether Sumi Agro undertook any specific efforts to create hydrolysis.
76. To conclude, Syngenta has made it more credible than not that the Kagura 2024 product fulfils feature c of claim 1 of the patent. The other features are not in dispute.

Validity

77. The Court of Appeal will now consider whether on the balance of probabilities it is more likely than not that the patent is not valid. The burden of presentation and proof for facts concerning the lack of validity of the patent and other circumstances allegedly supporting Sumi Agro's position lies with Sumi Agro.
78. According to Sumi Agro, if the term “fatty acid” in claim 1 of the patent were construed as encompassing the FFA content of rapeseed oil used in Kagura, the patent would be invalid over prior art EP 652, for lack of novelty and/or inventive step.

Novelty

79. It is a prerequisite for the acceptance of lack of novelty that the claimed subject matter is directly and unambiguously derivable from the prior art. The technical disclosure in a prior art document must be considered as a whole (Final order 25 September 2024 – UPC_CoA_182/2024, APL_21143/2024 *Mammut v Ortovox* para 123).
80. Claim 1 of EP 652 reads: A herbicidally effective mixture of 2-[4-methylsulfonyl]-2-nitrobenzoyl]-1,3-cyclohexanedione and its agriculturally suitable salts with one or more herbicidal compounds selected from a) nicosulfuron, b) rimsulfuron, c) thifensulfuron methyl, d) primisulfuron methyl, e) prosulfuron, and f) halosulfuron methyl and their agriculturally suitable salts.
81. Since 2-[4-methylsulfonyl]-2-nitrobenzoyl]-1,3-cyclohexanedione is mesotrione (a HPPD inhibiting herbicide), and nicosulfuron (a sulfonyleurea herbicide) is present under a) in claim 1 of EP 652, EP 652 discloses the combination of features a and b of the patent at issue.
82. Sumi Agro's basis for saying that EP 652 anticipates feature c of the patent at issue is built on the presence of rapeseed oil as a diluent in the patent specification of EP 652. Rapeseed oil is indeed mentioned as an example of a diluent in para 24 of EP 652. Sumi Agro also points to the table in para 22 of EP 652 which lists the weight percentage for use of a diluent in suspensions, emulsions and solutions (including emulsifiable concentrates) as 40 – 95 %. Sumi Agro argues that if the diluent is rapeseed oil, the person skilled in the art knows that rapeseed oil includes a small amount (up to 2 %) of FFA.
83. Apart from the fact that this line of arguments would presuppose the choice of rapeseed oil as diluent, at the highest level within the range 40 – 95 %, and a mathematical exercise (multiplying a FFA content which is less than 2 % with, let's say, 95 %), Sumi Agro's novelty attack fails because it relies on the presence of common general knowledge with the person skilled in the art that rapeseed oil may include a small amount (up to 2 %) of FFA, which has not been demonstrated, as already discussed above (paras 36-38). There is no mentioning of FFA in EP 652, and Sumi Agro has not in any way substantiated why – and the Court of Appeal fails to see that – the skilled person would consider it implicitly disclosed. It is therefore more likely than not that the patent at issue is novel over EP 652.

Inventive step

84. In any case, says Sumi Agro, the patent lacks inventive step over EP 652. This validity attack is addressed by the Court of Appeal in the following.

85. According to Sumi Agro, the skilled person following the teaching in EP 652 does not have to make modifications to the disclosed formulations in order to fall within claim 1. On the contrary, the skilled person merely has to follow the teaching in EP 652 and select a standard, off the shelf rapeseed oil to fall within claim 1, an entirely obvious step to take.
86. When assessing the prerequisites for provisional measures, the Court of Appeal is unconvinced by this. The invention in EP 652 relates to synergistic effects of combinations of herbicides (see paras 2, 36, 42 and 43). Leaving aside whether EP 652 is a reasonable starting point, EP 652 is altogether silent about FFA and, apart from a reference to prior art in para 25, silent on stability of herbicidal compositions. Contrary to what Sumi Agro suggests, there is no pointer to follow which would lead the skilled person to choose a rapeseed oil with sufficient FFA content in order to arrive at a chemical stabilization of the sulfonylurea and HPPD-inhibiting herbicide in a herbicidal composition by fatty acid from 1 % to 95 % by weight. The mere chance that the skilled person could choose such an ingredient is insufficient for a finding of lack of inventive step.
87. Sumi Agro further states that when considering inventive step Syngenta cannot rely on the claimed technical effect, arguing, in essence, as follows. The patent at issue asserts that the use of at least one saturated or unsaturated fatty acid from 1 % to 95 % by weight is able to chemically stabilise herbicidal compositions comprising sulfonylurea and a HPPD-inhibiting herbicide. However, the patent at issue fails to demonstrate that this alleged technical effect is achieved by all the compositions covered by the asserted claim 1. Based on the examples of the patent, it is clear that none of the tested formulations said to provide improved stability included less than 63.5 % by weight of fatty acid as a separate component. There is nothing in the patent to indicate that an effect seen with between 63.5 % and 68.5 % by weight fatty acid would also be seen across the whole claimed range of 1 % to 95 %. According to Sumi Agro, the Local Division incorrectly relied on Kagura as demonstrating that the effect underlying the claimed invention can be achieved at low FFA concentrations. The assumption that a mesotrione and nicosulfuron combination without any FFA would not have a shelf life of two years is mistaken.
88. This argument must be rejected. Sumi Agro – who bears the burden of presentation and proof in this respect – has not substantiated that the skilled person, despite the explicit disclosure (which in this respect is not suggested or shown to be different in the patent application relative to the specification) that a saturated or unsaturated fatty acid provides improved chemical stability of both the sulfonylurea and HPPD-inhibiting herbicide in a formulation (see para 27 of the specification), taking into account the patent specification as a whole, in particular the examples, would have reason to believe that this technical effect is not achieved over the whole claimed range of 1 % to 95 % by weight. This technical effect must therefore be considered to be encompassed by the technical teaching and embodied by the originally disclosed invention and may thus be relied upon by Syngenta when considering inventive step.
89. On this assessment, Sumi Agro has not advanced any arguments that could call into question the inventiveness of the patent. The Court of Appeal concludes that it is more likely than not that the patent at issue is valid.

Necessity (R. 206.2(c-d) RoP) and weighing of interests (Art. 62.2 UPCA and R. 211.3 RoP)

90. An applicant for provisional measures must provide reasons why such measures are necessary, as well as the facts and evidence relied on in support of the Application, including evidence to support the claim

that provisional measures are necessary (R. 206.2(c-d) RoP). In taking its decision the Court shall in the exercise of its discretion weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction (Art. 62(2) UPCA and R. 211.3 RoP).

91. Syngenta argues, without being contradicted, that its own product Elumis is the only ready-made product available on the relevant market for this type of herbicide, that the sale of a much – 60 % - cheaper priced Kagura product would significantly cut into the market share and that the market is worth €50 million per season.
92. Since the Court of Appeal has found a sufficient degree of certainty for infringement, necessity will be assessed from the starting point that Syngenta's product Elumis and Sumi Agro's product Kagura are directly competing. It has been argued credibly that the commercial advantage of the invention lies in the ready-made composition. It is precisely this advantage that is achieved with the contested embodiments, because the FFA stabilise the mesotrione and nicosulfuron in the mixture.
93. It goes without saying that price competition is of central importance for a herbicidal composition for agricultural use. Moreover, a move from a market situation where only one ready-made product is available, to one where there are two such competing products, can be expected to lead not just to price pressure but to a permanent price erosion, as put forward by Syngenta. A price drop such as the one described can consequently be expected to prove detrimental, not just momentarily but long-run, for the profitability of Elumis, even if a permanent injunction would eventually be obtained after proceedings on the merits. Furthermore, the products are used in the spring and a decision on the merits cannot be expected until later in 2025.
94. Given these economic incentives, the prospect of a permanent injunction following proceedings on the merits cannot be expected to be sufficient to prevent the continuation of the infringement (R. 206.2(c) RoP). On the contrary, a provisional injunction is needed.
95. Sumi Agro has argued that Syngenta should be required to demonstrate and quantify how sales have been affected during the time when both products (Elumis and Kagura) were on the market. The Court of Appeal does not concur with this view.
96. Art. 62(1) UPCA gives the Court the discretion to grant injunctions against (insofar as is relevant here) an alleged infringer, intended to prevent any imminent infringement, or to prohibit the continuation of the alleged infringement. The term infringement is to be understood here in relation to Art. 25 UPCA, which confers on the patent proprietor the right to prevent not just the placing on the market of a product which is the subject-matter of the patent, but also acts of infringement which typically precede or supplement actual sales, namely making, offering, or importing or storing the infringing product for those purposes. If quantification was generally required in the way suggested by Sumi Agro, the Court would always have to wait with provisional measures until infringing products have been placed on the market and sold to such an extent and for such a period that actual effects could be observed and measured.
97. Furthermore, R. 206.2(c) RoP requires the applicant in proceedings for provisional measures to set out the reasons why provisional measures are necessary to prevent a threatened infringement or the

continuation of an alleged infringement. If a provisional measure would only be deemed necessary after the fact, threatened infringements could not be prevented.

98. For the reasons set out here, provisional measures are necessary.

Urgency

99. The parties dispute whether Syngenta delayed its application unreasonably and without the required degree of urgency, since first becoming aware of Kagura, before lodging the application for preliminary measures. The Court of Appeal will address this matter in reverse order by starting with Syngenta's actions related to the Kagura 2024 product.

100. Syngenta lodged the application for provisional measures on 30 April 2024. Sumi Agro lodged its defence, on 4 June 2024, setting out how it had marketed two versions of Kagura. Sumi Agro put forward that the Kagura 2023 product was no longer offered anywhere and was replaced by the Kagura 2024 product. Sumi Agro's use of a different ingredient from one point in time for a composition product marketed under one brand and under one set of marketing authorisations, cannot reasonably have been visible to Syngenta. The fact that Syngenta obtained information from Sumi Agro about the formulation for Kagura in early 2024 did not change this, since the same formulation was used for the 2023 and 2024 products, only the rapeseed oil was substituted by rapeseed oil from another supplier.

101. According to the findings of the Court of Appeal (para 66 above), Syngenta purchased a sample of the 2024 Kagura product in Bulgaria on July 4, 2024, one month after the said submissions of Sumi Agro. The one month time period for finding the product, commercialised in the CMSs, and purchase it, must be considered plausible. The Court of Appeal accepts Syngenta's explanation that a herbicidal composition is a toxic regulated substance which requires customs clearance, so that the sample arrived in the US in late August 2024. The analysis was completed and documented on 9 September 2024. At this point in time, Syngenta could not know if it would need the new evidence, since this depended on whether Sumi Agro would appeal the order of the Local Division. Sumi Agro lodged its Statement of appeal and grounds of appeal on 18 September 2024. Following a response to a request for correction, the formal checks of the appeal were completed on 27 September 2024. Next, Syngenta submitted its Statement of response on 11 October 2024, and brought the new evidence in the same submission.

102. The Court of Appeal considers that Syngenta acted with the urgency required after becoming aware of the Kagura 2024 product. For this reason, there is no need to assess Syngenta's actions in relation to the 2023 product.

The territorial scope of the order

103. According to Art. 34 UPCA, decisions of the Court shall cover, in the case of a European patent, the territory of those CMS for which the European patent has effect. This means that injunctions, as a rule, will cover all those CMSs. A restriction would require the presence of certain circumstances, such as when a claimant has restricted the territorial scope of its action (Art. 76(1) UPCA).

104. Sumi Agro holds marketing authorisations for Kagura in several CMSs (Austria, Belgium, Bulgaria, Germany, Italy and Slovenia) and started marketing activities for Kagura around December 2023 in Bulgaria and Germany. The fact that Sumi Agro holds no marketing authorisations for Kagura in some other CMSs, and has not marketed Kagura there, does not negate the risk that it could later obtain marketing authorizations and begin marketing.
105. Romania deposited its instrument of ratification on 31 May 2024 acceded to the UPCA on 1 September 2024. For this reason it was not possible for Syngenta to request, with reference to Art. 34 UPCA, that a provisional measure should encompass the territory of Romania when it lodged its application on 30 April 2024. Neither had the UPCA entered into force in Romania when the Local Division issued the impugned order.
106. Sumi Agro argues that adding Romania to the territorial scope of the impugned order would contradict basic principles that an appeal filed by the addressee of a provisional injunction cannot be subject to an even broader injunction as a result of lodging an appeal against the said injunction.
107. It is set out in Art. 34 UPCA that decisions of the Court shall cover, in the case of a European patent, the territory of those CMS for which the European patent has effect. This provision is visible to all actual and potential parties to proceedings before the UPC, and so is the fact that several EU Member States have signed the UPCA but not yet ratified and acceded to the UPCA. There are no transitional rules connected to Art. 34 UPCA. When a UPC Signatory State ratifies and accedes, the application of Art. 34 UPCA should be automatic and not subject to limitations, from the day of accession.
108. According to R. 222.2 RoP requests which have not been submitted by a party during proceedings before the Court of First Instance may be regarded by the Court of Appeal. When exercising discretion, the Court shall in particular take into account whether a party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First instance (a), the relevance of the new submission for the decision on the appeal (b); the position of the other party regarding the lodging of the new submissions (c). From the wording (“party”) is clear that R. 222.2 RoP not only applies to requests of the Appellant or Cross-appellant. In view of the general rule in Article 34 of the UPCA, the Court exercises its discretion to allow the application with regard to Romania in the appeal proceedings.
109. For the reasons set out, the order shall cover the territory of those CMS for which the patent at issue has effect, including Romania.

Security for enforcement

110. Where appropriate, the enforcement of a decision may, pursuant to Art. 82.2 UPCA, be subject to the provision of security or an equivalent assurance to ensure compensation for any damage suffered, in particular in the case of injunctions. For provisional measures, this is reflected in R. 211.5 RoP, first sentence, which states that the Court may order the applicant to provide adequate security for appropriate compensation for any injury likely to be caused to the defendant which the applicant may be liable to bear in the event that the Court revokes the order for provisional measures. Furthermore, according to R. 352.1 RoP, decisions and orders may be subject to the rendering of a security (whether by deposit or bank guarantee or otherwise) by a party to the other party for legal costs and other

expenses and compensation for any damage incurred or likely to be incurred by the other party if the decisions and orders are enforced and subsequently revoked.

111. Where provisional measures are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, upon request of the defendant, to provide the defendant with appropriate compensation for any injury caused by those measures (R. 213.2 RoP). Pursuant to R. 354.2 RoP, where during an action an enforceable decision or order of the Court is subsequently varied or revoked, the Court may order the party which has enforced such decision or order, upon the request of the party against whom the decision or order has been enforced, to provide appropriate compensation for any injury caused by the enforcement.
112. The rendering of security is not conditioned on an application by a party. Where interim measures are ordered without the defendant having been heard, the Court shall order the applicant to provide adequate security, unless there are special circumstances not to do so (R.213.2 RoP, second sentence). While security shall thus normally be ordered for *ex parte* measures, the Court has discretion (“may” in R. 211.5 RoP, first sentence, referred to above) for provisional measures when the defendant is heard (*inter partes*).
113. Under the circumstances of the case, the Court of Appeal does not see reason to order security.
114. If the Court does not see reasons to order, of its own motion, the rendering of security for enforcement of provisional measures, a defendant can still bring forward arguments and facts to support that the outcome may be different once the action on the merits is tried, and/or that there will be an undue burden in enforcing an order for compensation of injuries caused by the provisional measures if those measures are revoked. The burden of proof is then generally on the defendant. The undue burden can for example be related to the financial position of the applicant, or to the foreign law applicable in the territory where the order for compensation shall be enforced, including the application of that foreign law.
115. Sumi Agro argues that an order on provisional measures inherently involves uncertainties, and moreover that Syngenta has its principal place of business in the UK and that there is no international treaty in place with the UK that would allow Sumi Agro to enforce a UPC decision on damages, which also causes uncertainty. Sumi Agro has not substantiated what the uncertainties inherent in these provisional measures would be, and, apart from blank statement that there is no international treaty in place, has not put forward facts about any undue burden that could be envisaged if Sumi Agro would try to enforce, in the UK, an order by the UPC that Syngenta shall compensate Sumi Agro for injury caused by the enforcement of an order on provisional measures. Such facts can for instance be related to legislation or absence thereof, but also to case-law and actual practice of UK authorities and courts on enforcement of foreign judgments (see order of 29 November 2024, APL_52969/2024, UPC_CoA_548/2024, *Aarke v Sodastream*).
116. Furthermore, and similar to the assessment made by the Local Division, the Court of Appeal makes the observation that both Syngenta and Sumi Agro are UK registered companies. Any future enforcement of the kind discussed here would thus be between UK companies, in the UK.

117. For these reasons, the Court of Appeal does not consider it appropriate to order Syngenta to provide security for the purpose of enforcement.

Costs

117. Unlike the Local Division, the Court of Appeal considers that a cost decision should be issued in *inter partes* proceedings for provisional measures, since it concludes the action (see, among other cases, order of 6 August 2024, App_22399/2024, UPC_CoA_335/2024, *10x Genomics et al v NanoString*, para 29, and *Mammut v Ortovox*).

Conclusions

118. It is more likely than not that the patent is valid and infringed. The requirements of necessity, weighing of interests and urgency are met. There is no reason to order the patent holder to provide security for enforcement. A cost decision should be issued in the *inter partes* proceedings for provisional measures.

ORDER

1. The Court of Appeal rejects the appeal (except insofar as is ordered in para 2 below) and adds the Republic of Romania to the impugned order under I. and specifies the date referred to in R. 213.1 RoP regarding this amendment at 31 calendar days after service of this order.
2. The Court of Appeal reverses the impugned order under V and orders that Sumi Agro shall bear the reasonable and proportionate legal costs and other expenses incurred by Syngenta both at first instance and on appeal.
3. All other requests are dismissed.

Issued on 3 March 2025

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Rian Kalden, Presiding judge and legally qualified judge

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