



UPC\_CFI\_425/2023  
Procedural Order  
of the Court of First Instance of the Unified Patent Court  
delivered on 31/07/2024  
*concerning R. 191 RoP*

APPLICANT

- |    |   |                                       |
|----|---|---------------------------------------|
| 1) | Abbott Diabetes Care Inc.<br>1360 South Loop Road<br>94502 - Alameda - US | Represented by<br>Christian Dekoninck |
|----|---|---------------------------------------|

RESPONDENTS

- |    |   |                                   |
|----|---|-----------------------------------|
| 1) | Dexcom Inc.<br>6340 Sequence Drive<br>92121-4356 - San Diego - US       | Represented by<br>Thierry Lautier |
| 2) | Dexcom International Limited<br>Lampousas Street<br>1095 - Nicosia - CY | Represented by<br>Thierry Lautier |
| 3) | Dexcom France SAS<br>9 Rue du Quatre-Septembre<br>75002 - Paris - FR    | Represented by<br>Thierry Lautier |

## PATENT AT ISSUE

*Patent no.*

*Proprietor*

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EP3988471

Abbott Diabetes Care Inc.

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## DECIDING JUDGE

Judge-rapporteur: Camille LIGNIERES

LANGUAGE OF PROCEEDINGS: English

## ORDER

### Facts and Procedure

Abbott Diabetes Care Inc (hereinafter: ABBOTT) lodged an infringement action based on European Patent EP 3 988 471 registered on 14 November 2023 before the Paris Local Division.

A Counterclaim for revocation with Statement of Defense (SoD) was filed by DEXCOM's entities (hereinafter: DEXCOM) on 15 April 2024. ABBOTT filed a reply to the Statement of Defence and a defence to the counterclaim for revocation with an application to amend the patent on 17 June 2024.

At the same time, ABBOTT filed an application to communicate information pursuant to rule 191 RoP.

In its written application to communicate information of 17 June 2024 (hereinafter: "Application") , ABBOTT requests an order given at the interim conference:

« To order Dexcom to communicate regarding each of the Relevant Contracting Member States what the exact distribution chain of the Dexcom G6 and G7 System comprises, including the transfer(s) of ownership of the Dexcom G6 and G7 System and the various components thereof, from the moment of manufacturing until the supply to the end consumer».

A preliminary order inviting DEXCOM to provide written comments on the ABBOTT's request was issued by the judge-rapporteur on 20 June 2024.

DEXCOM lodged their written comments on 10 July 2024 and requests the judge-rapporteur to:

- ON A MAIN BASIS:

I. Dismiss Abbott's application for order to communicate information pursuant to Rule 191 RoP in its entirety

- IN THE ALTERNATIVE

II. Order that the requested information be communicated to Abbott only with the Paris Local Division's decision ruling that EP 3 988 471 is valid and infringed and the present proceedings on the merits;

III. Limit the information provided to the roles of the Defendants i.e. Dexcom Inc., Dexcom International (Cyprus) and Dexcom France, in the distribution of the G6 and G7 Systems in the Relevant Member States

IV. Order that access to the information provided shall be limited to a confidentiality club to be determined between the parties.

- IN THE FURTHER ALTERNATIVE

V. Limit the information provided to the roles of the Defendants i.e. Dexcom Inc., Dexcom International (Cyprus) and Dexcom France, in the distribution of the G6 and G7 Systems in the Relevant Member States

VI. Order that access to the information provided shall be limited to a confidentiality club to be determined between the parties.

Legal framework

Article 67 UPCA - Power to order the communication of information:

The Court may, in response to a justified and proportionate request of the applicant and in accordance with the Rules of Procedure, order an infringer to inform the applicant of: (a) the origin and distribution channels of the infringing products or processes; (b) the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the infringing products; and (c) the identity of any third person involved in the production or distribution of the infringing products or in the use of the infringing process.

Rule 191 RoP – Application for order to communicate information:

The Court may in response to a reasoned request by a party order the other party or any third party to communicate such information in the control of that other party or third party as is specified in Article 67 of the Agreement or such other information as is reasonably necessary for the purpose of advancing that party's case. Rule 190.1 second sentence, .5 and .6 shall apply mutatis mutandis.

Grounds

On the admissibility of the request:

Contrary to what DEXCOM claims, the request for disclosure of information on the basis of R.191 RoP may be admissible in ongoing proceedings and even before the existence of an infringement

has been decided, should this be necessary for the investigation of the case at that stage of the proceedings.

The Court points out that UPC Dusseldorf Local division has already taken this position in these words: « *In principle, R. 191 RoP is aimed at information during the proceedings in order to compel parties to submit information with regard to submissions to be made (see Tilmann/Plassmann/Ahrens, Rule 191 para. 1 - based on the discovery procedure). However, the wording of the second alternative in particular does not preclude ordering the submission of the aforementioned information in the final decision.* » (UPC\_CFI\_7/2023 (LD Düsseldorf), Decision of 3 July 2024)

The present Court also considers that rule 191 RoP can be invoked at different stages of the procedure: during the proceedings, in order to compel parties to submit information with regard to submissions to be made, or at the stage of the final decision. Furthermore, the Court notes that it is appropriate to apply the same reasoning in relation to the right to information under EU Enforcement Directive 2004/48 (Art.8), which allows a request to be made at any stage of the procedure.

For all these reasons, ABBOTT's request is admissible.

On the «reasoned request»:

The question is whether the information requested to be communicated by the applicant is reasonably necessary for the purpose of advancing that party's case in accordance with Art. 67(1) UPCA and R. 191 RoP.

In its application, ABBOTT asks for a "communication regarding each of the Relevant Contracting Member States what the exact distribution chain of the Dexcom G6 and G7 System comprises, including the transfer(s) of ownership of the Dexcom G6 and G7 System and the various components thereof, from the moment of manufacturing until the supply to the end consumer".

DEXCOM argues that ABBOTT's request to communicate information reverses the burden of proof in that ABBOTT's claim is too broad.

The Court points out that a request for information under R. 191 RoP must be sufficiently justified and proportionate in order to be granted.

In the present case, ABBOTT chose to sue DEXCOM France, itself selected amongst the many distributors of the allegedly infringing G6 and G7 products, despite ABBOTT being aware of the existence of other distributors involved in the distribution of the allegedly infringing products, particularly in the territory of the Contracting Member States where the patent at issue is in force. Hence, disclosure of the entire distribution chain of the allegedly infringing products, in a situation where ABBOTT has deliberately chosen to act only against certain distributors, would be disproportionate and not sufficiently directly related to the present case.

Moreover, as suggested as an alternative by DEXCOM in its written comments, ABBOTT would still have the possibility of requesting the disclosure of targeted information on the role of each of the defendants in the infringement established by a decision on the merits, in order to determine the damages owed by each of the defendant entities.

Consequently, the Court considers that ABBOTT's request under R.191 RoP is not sufficiently justified as the applicant fails to demonstrate that the requested information is reasonably necessary for the purpose of advancing that party's case in accordance with Art. 67(1) UPCA and R. 191 RoP.

The request will therefore be dismissed.

FOR ALL THESE REASONS,

THE COURT OF FIRST INSTANCE – PARIS LOCAL DIVISION

orders that:

- the request from ABBOTT pursuant to R.191 RoP is dismissed,
- the present Order may be reviewed by the panel according to R. 333 RoP.

Delivered in Paris, on 31 July 2024.

Camille Lignieres, Judge-rapporteur

ORDER DETAILS

Order no. ORD\_36398/2024 in ACTION NUMBER: ACT\_587074/2023

UPC number: UPC\_CFI\_425/2023

Action type: Infringement Action

Related proceeding no. Application No.: 36267/2024

Application Type: Application for an Order to communicate information (RoP191)