



UPC Court of Appeal
UPC_CoA_569/2024
APL_53922/2024
App_67871/2024
App_67876/2024

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 DEFENDANT IN THE COUNTERCLAIM BEFORE THE COURT OF FIRST INSTANCE)

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

represented by: Dr. Marcus Grosch, Dr. Johannes Bukow, Dr. Jérôme Kommer, Dr. Katrin Gerstenberg, Sebastian Scholz, and Dr. Laurin Haasis, Attorneys-at-law (Quinn Emanuel, Munich, Germany) and Dr. Peter Klusmann, David Sproston and Dr. Mark Jones, European Patent Attorneys (Hoffmann Eitle, Munich, Germany)

RESPONDENTS (DEFENDANTS AND CLAIMANTS IN THE COUNTERCLAIM 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: Dr. Dietrich Kamlah, Dr. Christian Lederer and Dr. Gisbert Hohagen, Attorneys-at-law
(Taylor Wessing Munich, Germany)

for respondents 5 and 8 also: Wim Maas and Eelco Bergsma, Attorneys-at-law
(Taylor Wessing, Eindhoven, The Netherlands)

for respondents 6 and 9 also: Christian Dekoninck and Patricia Cappuyns, Attorneys-at-law
(Taylor Wessing, Brussels, Belgium)

for respondent 7 also: Mag. Thomas Adocker, Attorney-at-law (Taylor Wessing, Vienna, Austria)

for respondent 10 also: François Pochart, Attorney-at-law (August Debouzy, Paris, France)

PATENT AT ISSUE

EP 3 797 685

LANGUAGE OF THE PROCEEDINGS

English

DECIDING JUDGES

This order is 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

- Munich Local Division, Date: 31 July 2024, Infringement action ACT_547520/2023, UPC_CFI_233/2023, and counterclaims for revocation CC 586858/2023, CC 587056/2023, CC 586829/2023, CC 586900/2023, CC 587048/2023, CC 586860/2023, CC 586867/2023, CC 586841/2023, CC 586859/2023 and CC 587077/2023.

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

1. DexCom initiated infringement proceedings against the Abbott companies before the Munich Local Division based on the patent at issue. The Abbott companies lodged counterclaims for revocation of the patent. DexCom relied on two auxiliary requests in its defence against the counterclaims.
2. The Munich Local Division revoked the patent at issue entirely with effect in the territories of the Contracting Member States for which the patent had effect at the time of the counterclaims for revocation. The auxiliary requests were dismissed and all infringement claims were dismissed.
3. DexCom lodged a Statement of appeal and a Statement of grounds of appeal.
4. On 27 December 2024, DexCom submitted an application to withdraw the infringement action and declare the proceedings closed and to permit the withdrawal of the application to amend the patent and to declare the proceedings closed. DexCom has also applied for partial reimbursement of Court fees paid for the appeal in the amount of 60 %, with reference to R. 370.11 in conjunction with R. 370.9 (b) (i) RoP.
5. The Abbott companies have consented to the withdrawal of the infringement action and applied for permission to withdraw the counterclaims for revocation, and to give a decision declaring the proceedings closed.
6. DexCom has consented to the Abbott companies' applications to withdraw the counterclaims for revocation.
7. The parties have declared that a cost decision is not requested.

GROUND

Conditions for permitting the withdrawals

8. 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*).
9. 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.
10. With the closure of the proceedings, the impugned decision will become ineffective.
11. An application to amend the patent is ancillary, 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

12. Although R.265.2 (2) 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

13. 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 proceedings are withdrawn before the written proceedings have been concluded. This refund is to be ordered in accordance with the application.

ORDER

The Court of Appeal:

- permits the withdrawal of the actions ACT_547520/2023, UPC_CFI_233/2023, and counterclaims for revocation CC 586858/2023, CC 587056/2023, CC 586829/2023, CC 586900/2023, CC 587048/2023, CC 586860/2023, CC 586867/2023, CC 586841/2023, CC 586859/2023 and CC 587077/2023 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 refunded 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