



Reference numbers:
UPC_CoA_520/2024
APL_51079/2024
App_13022/2025

Order
of the Court of Appeal of the Unified Patent Court
concerning an application for reimbursement of court fees pursuant to Rule 370.11 RoP
issued on 18 April 2025

APPLICANT AND APPELLANT (DEFENDANT IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

Scandit AG, Hardturmstrasse 181, 8005 Zurich, Switzerland (hereinafter "**Scandit**")

represented by Dr. Johannes Bukow and Tonio Allendorf, attorneys-at-law, Quinn Emanuel Urquhart & Sullivan, LLP

RESPONDENT (APPLICANT IN THE PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

Hand Held Products, Inc., 855 S Mint Street, Charlotte, NC 28202, USA (hereinafter "**Hand Held Products**")

represented by Dr. Tobias Wuttke, attorney-at-law, Bardehle Pagenberg, Partnerschaft mbB Patentanwälte Rechtsanwälte,

PATENT AT ISSUE

EP 3 866 051

DECIDING JUDGE

This decision was issued by panel 1a with the participation of

Klaus Grabinski, President of the Court of Appeal,
Peter Blok, legally qualified judge,
Emmanuel Gougé, judge-rapporteur und legally qualified judge.

LANGUAGE OF PROCEEDINGS

German

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- Order of the Munich Local Division of 27 August 2024

- Reference numbers: UPC_CFI_74/2024
ACT_9216/2024
ORD_46277/2024

SUMMARY OF THE FACTS AND THE APPLICATION

1. The Court of First Instance, Munich Local Division, issued a provisional injunction against Scandit by way of an order dated 27 August 2024 for indirect infringement of claims 1 and 10 of the patent at issue. The Munich Local Division also rejected Hand Held Products' broader request for an order on provisional measures, as well as both parties' respective cost applications.
2. Scandit filed an appeal against the impugned order and set out the grounds in support thereof. Hand Held Products filed a reply.
3. The oral hearing took place on 9 January 2025.
4. By written submission dated 13 March 2025, Hand Held Products requested, pursuant to Rule 265.1 RoP, the withdrawal of the request for provisional measures and sought to have the proceedings declared closed (App_12551/2025 UPC_CoA_520/2024). Hand Held Products did not request a decision on costs.
5. Scandit consented to the withdrawal of the application for provisional measures. Scandit also did not submit a cost application.
6. By order of 31 March 2025, the Court of Appeal permitted the withdrawal of the application for provisional measures and declared the proceedings closed.
7. By written submission dated 17 March 2025, Scandit requested a 20% reimbursement of the court fees it had paid (App_13022/2025 UPC_CoA_520/2024).
8. Scandit submits that the withdrawal of the application occurred prior to the closure of the oral procedure within the meaning of Rule 370.9(b)(iii) RoP, and that the conduct of the oral hearing does not affect this assessment, as the hearing constitutes part of the oral procedure, but does not represent the final act thereof. Rather, the oral procedure concludes only with the pronouncement of the decision on the merits.

GROUNDS FOR THE ORDER

9. The application is dismissed.
10. In case of the withdrawal of an action (Rule 265 RoP), the party liable for Court fees will be reimbursed, in accordance with Rule 370.9(b) RoP, by an amount which depends on the stage of the proceedings:
(i) 60% if the action is withdrawn before the closure of the written procedure; (ii) 40% if the action is

withdrawn before the closure of the interim procedure; (iii) 20% if the action is withdrawn before the closure of the oral procedure.

11. This rule reflects the objective of an adequate contribution of the parties for the costs incurred by the Court (Article 36(3) UPCA) and takes into account the costs and workload of the Court at the time the request for reimbursement is submitted.
12. The decisive criterion for determining the reimbursement is therefore the stage of the proceedings at the time the request for withdrawal pursuant to Rule 265 RoP was filed.
13. The central issue in the present case is whether the request was filed prior to or following the closure of the oral procedure.
14. As regards procedures before the Court of Appeal (Part 4 RoP), the provisions on the oral procedure (Chapter 3 RoP, Rules 240 and 241 RoP) concern the conduct of the oral hearing, which suggests that the oral procedure is primarily, if not exclusively, limited to the oral hearing itself.
15. Although the aforementioned provisions do not explicitly define the closure of the oral procedure, the oral procedure is deemed to conclude with the closure of the oral hearing by the presiding judge, who ensures that the action is ready for decision at the end of the hearing (Rule 111(b) RoP, which is referenced in Rule 240 RoP concerning the conduct of the oral hearing before the Court of Appeal).
16. Following the closure of the oral hearing, only the Court's deliberations and the issuance of the decision remain, both of which are to take place as soon as possible after the closure of the oral hearing (Rules 344 and 118.6 RoP). Accordingly, the Rules of Procedure distinguish, in proceedings before the Court of Appeal, between the phase of the oral procedure (Part 4, Chapter 3 RoP) and the phase concerning the decision and its effects (Part 4, Chapter 4 RoP).
17. It follows that the withdrawal of an action submitted after the closure of the oral hearing does not meet the requirements of Rule 370.9(b)(iii) RoP, which provides that 20% of the court fees shall only be reimbursed if the withdrawal of the action occurs before the closure of the oral procedure.

ORDER

The application is dismissed.

This order was issued on 18 April 2025.

Klaus Grabinski, President of the Court of Appeal

Peter Blok, legally qualified judge

Emmanuel Gougé, judge-rapporteur und legally qualified judge