



Reference no.:
UPC_CoA_12/2025
APL_366/2025
App_1182/2025

Order
of the Court of Appeal of the Unified Patent Court
issued on 16 January 2025
concerning an application for suspensive effect (Rule 223 RoP)

HEADNOTES:

The requirement of exceptional circumstances justifying a request for suspensive effect under R 223 RoP has to be established by the applicant. In the present case, the applicant has not evidenced the existence of such exceptional circumstances.

KEYWORDS:

Suspensive effect of the appeal, R 223 RoP.

APPELLANT AND DEFENDANT IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE

Bhagat Textile Engineers (hereafter referred to as “**Bhagat**” or “**applicant**”),
represented by Peter FitzPatrick, Joel Coles, Rajvinder Jagdev, Niccolò Ferretti and Emanuela Gaia Zapparoli

RESPONDENT AND CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE

Oerlikon Textile GmbH & Co KG (hereinafter also referred to as “**Oerlikon**”),
represented by Stefania Bergia and Giulio E. Sironi

PATENT AT ISSUE

EP 2 145 848

LANGUAGE OF THE PROCEEDINGS

Italian

DECIDING JUDGE

Emmanuel Gougé, Legally qualified judge and judge-rapporteur

IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

- Decision of the Court of First Instance of the Unified Patent Court, Milan Local division, dated 04 November 2024
- Reference numbers:

ORD 598484/2023
ACT 549585/2023
UPC_CFI_241/2023

SUMMARY OF FACTS

1. On 12 July 2023 Oerlikon lodged an action for infringement of the patent at issue against Bhagat with the Milan Local Division. Bhagat did not file a counterclaim for revocation of said patent, nor did it file a claim for revocation of the same patent with the central division of the UPC.
2. On 04 November 2024, the Milan local division, inter alia, (i) rejected the application to stay proceedings filed pursuant to Rule 295(m) RoP, (ii) declared that Bhagat has infringed the patent at issue, (iii) prohibited Bhagat from selling, marketing and promoting the machine referred to in its decision in Italy and Germany, (iv) set a penalty payment of €12,000.00 pursuant to Article 63(2) UPCA and Rule 354 RoP, (v) ordered Bhagat to pay to Oerlikon provisional damages in the amount of EUR 15,000.00, (vi) set the value of the case at € 750,000.00 and (vii) ordered that 20% of the costs of the proceedings be borne by the parties and the remaining 80% by Bhagat (see impugned decision for further details).
3. On 06 January 2025 Bhagat filed an appeal under Rule 220.1 RoP (APL_366/2025 UPC_CoA_12/2025) against the Milan LD decision.
4. On the same day, Bhagat filed a separate R 223 RoP application for suspensive effect.

REQUEST AND SUBMISSIONS

5. Bhagat requests the impugned decision be given suspensive effect given the existence of exceptional circumstances and, in the alternative to suspensive effect for the whole of said decision, seeks suspensive effect in relation to the financial provisions thereof.
6. According to the applicant, the exceptional circumstances justifying the request for suspensive effect are that there are parallel validity proceedings in relation to the patent at issue which are expected to reach judgment very soon, that there are considerable doubts as to the validity of said patent and that the validity of the patent was not considered at first instance.
7. Concerning more specifically the parallel validity proceedings, the applicant refers to an action in which it is not a party, namely a counterclaim for revocation which was filed on 20 December 2023 by Himson Engineering (CC_596263/2023) following infringement proceedings filed by Oerlikon against Himson Engineering on 12 July 2023 with the Milan LD (UPC_CFI_240/2023, ACT_549550/2023).

REASONS FOR THE ORDER

8. The application for suspensive effect must be dismissed for the following reasons.
9. An appeal shall not have suspensive effect unless the Court of Appeal decides otherwise at the motivated request of one of the parties (Article 74.1 UPCA). According to R 223.2 RoP, the application for suspensive effect

shall set out (a) the reasons why the lodging of the appeal shall have suspensive effect and (b) the facts, evidence and arguments relied on.

10. The Court of Appeal can grant the application only if the circumstances of the case justify an exception to the principle that the appeal has no suspensive effect (UPC_CoA_388/2024, APL_39884/2024, 19 August 2024, Sibio v Abbott). Exceptional circumstances shall be assessed having regard to the relevant circumstances of the case, such as the stage of the revocation proceedings before the Court of First Instance, the stage of the appeal proceedings and the interests of the parties (UPC_CoA 227/2024, APL_26889/2024, 21 June 2024, Mala v Nokia), as well as any other relevant circumstances of the case.
11. The requirement of an exceptional circumstances has to be established by the applicant. In its application, Bhagat has not evidenced the existence of exceptional circumstances which would justify why the lodging of the appeal shall have suspensive effect.
12. Bhagat has merely claimed that the exceptional circumstances would arise out of the existence of parallel proceedings, to which it is not a party, and stated that there are “considerable doubts” as to the validity of the patent at issue without giving any indication as to the reasons for said doubts.
13. Bhagat has not given any indication as to the stage of the parallel invalidity proceedings, instead it has merely mentioned that said proceedings “are expected to reach judgement very soon”.
14. Also, in the proceedings before the CFI, Bhagat decided not to file a counterclaim for revocation of the patent at issue. As rightly pointed out by the CFI which rejected the request for suspension of the CFI proceedings on the basis of the same parallel revocation proceedings argumentation, Bhagat did not intervene in the parallel revocation proceedings of the patent in dispute to support the revocation application brought by third parties (impugned decision, p. 10, §5.5).
15. The Court does thus not consider the circumstances of the present case to be of such a nature that the interests of Bhagat outweigh the interest of Oerlikon and the principles of due process.
16. By reference to the provisions of R 223.3 RoP, according to which the Court shall decide the Application without delay, and considering that the circumstances raised by the applicant are such that they are not sufficient reasons why the lodging of the appeal shall have suspensive effect, this order is issued without the need to hear the respondent.

ORDER

The application for suspensive effect is rejected.

This order is issued on 16 January 2025.

Emmanuel Gougé
Legally qualified judge and judge-rapporteur