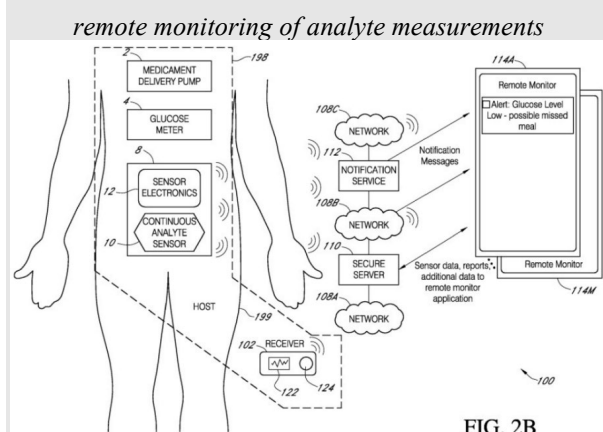


## UPC Court of Appeal, 24 January 2025, DexCom v Abbott



## PATENT LAW – PROCEDURAL LAW

### Withdrawal of action by party consent ([R. 265 RoP](#))

- With the closure of the proceedings, the impugned order will become ineffective.

Source: [Unified Patent Court](#)

## UPC Court of Appeal,

24 January 2025

(Kalden, Simonsson, Rombach)

UPC\_CoA\_840/2024

APL\_68052/2024

App\_1178/2025

App\_1568/2025

App\_2955/2025

## 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.
- 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 COUNTERDEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

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

represented by:

Anne-Charlotte Le Bihan, Attorney-at-law, and Laurent Labatte, European Patent Attorney (Bird & Bird, Paris, France), and David Sproston and Dr. Mark Jones, European Patent Attorneys (Hoffmann Eitle, Munich, Germany)

## RESPONDENTS (DEFENDANTS AND COUNTERCLAIMANTS BEFORE THE COURT OF FIRST INSTANCE)

1. Abbott Laboratories, Abbott Park, Illinois, USA
2. Abbott Diabetes Care Inc., Alameda, California, USA
3. Abbott France (S.A.S.), Rungis, France
4. Abbott (S.A./N.V.), Wavre, Belgium
5. Abbott B.V., Hoofddorp, The Netherlands
6. Abbott S.r.l., Rome, Italy
7. Abbott Scandinavia Aktiebolag, Solna, Sweden
8. Abbott Oy, Helsinki, Finland
9. Abbott Gesellschaft m.b.H., Vienna, Austria
10. Abbott Laboratories A/S, Copenhagen, Denmark
11. Abbott GmbH, Wiesbaden, Germany
12. Abbott Diagnostics GmbH, Wiesbaden, Germany
13. Abbott Logistics B.V., Zwolle, The Netherlands
14. Newyu, Inc., Abbott Park, Illinois, USA

(hereinafter jointly referred to as ‘the Abbott companies’)

all represented by: Christian Dekoninck, Attorney-at-law (Taylor Wessing, Brussels, Belgium), François Pochart, Attorney-at-law (August Debouzy, Paris, France), Wim Maas and Eelco Bergsma, Attorneys-at-law (Taylor Wessing, Eindhoven, The Netherlands), Mag. Thomas Adocker, Attorney-at-law (Taylor Wessing, Vienna, Austria), Dr. Dietrich Kamlah, Dr. Christian Lederer and Dr. Gisbert Hohagen, Attorneys-at-law (Taylor Wessing Munich, Germany)

## PATENT AT ISSUE

[EP 3 831 282](#)

## LANGUAGE OF THE PROCEEDINGS

English

## DECIDING JUDGES

This order was 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

## IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

□ [Paris Local Division, Date: 11 December 2024, ORD 63909/2024](#), action for infringement ACT\_583778/2023, UPC\_CFI\_395/2023 and counterclaim for revocation CC\_14065/2024.

## POINTS AT ISSUE

Withdrawal ([R. 265 RoP](#)) and request for reimbursement of fees ([R. 370.9 RoP](#))

## SUMMARY OF FACTS AND INDICATION OF THE PARTIES’ REQUESTS

*The impugned decision, the appeal and the application to withdraw the infringement action*

1. DexCom initiated infringement proceedings against the Abbott companies before the Paris Local Division based on the patent at issue, and was met by a counterclaim for revocation. The Paris Local Division revoked entirely the patent at issue with effect in the territories of the Contracting Member States for which it had effect at the date of the counterclaim for revocation and as specified by Abbott’s requests, dismissing all DexCom’s infringement claims based on the patent at issue and requiring DexCom to bear the costs of the proceedings.

2. DexCom appealed the decision, stating that the appeal relates only to the counterclaim for revocation and that it withdrew its infringement action.

*Withdrawal of the counterclaims for revocation*

3. On 8 January 2025 (App\_1178/2025), the Abbott companies applied to withdraw the counterclaim for revocation.

4. On 9 January 2025 (App\_1568/2025), DexCom consented to the withdrawal of the Abbott companies' counterclaim, stating that since the Abbott companies' revocation counterclaim is withdrawn, the impugned decision revoking the patent at issue loses its effect. Thus, the patent as granted is to be considered in force in all the territories designated in the decision.

5. The parties all request that the impugned decision be set aside, and that the proceedings be declared closed.

*On costs*

6. Both parties have explained that a cost decision is not requested. DexCom has added that if the Court would deem it necessary to render a decision on costs in accordance with [R. 265.2\(c\) RoP](#), the Court is requested to order that each party bears the costs it has incurred in the present appeal proceedings, including the costs of the proceedings and the fees of its counsel.

*Application for reimbursement of Court fees*

7. DexCom has also applied (App\_2955/2025) for reimbursement of 60 % of the Court fees it paid with the Statement of appeal, i.e. reimbursement of the sum of 12,000 EUR in accordance with [R. 370.9 b\) i\) RoP](#).

## **GROUND**

*Conditions for permitting the withdrawal*

8. The application to withdraw the counterclaim for revocation is admissible since there is no final decision in the action in view of the pending appeal, and the Court of Appeal is responsible for deciding on the permissibility of the application 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 order will become ineffective.

*Costs*

11. 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*

12. 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 action is withdrawn before the written proceedings have been concluded. This reimbursement is to be ordered in accordance with the application.

## **ORDER**

The Court of Appeal:

- permits the withdrawal of the action for infringement ACT\_583778/2023, UPC\_CFI\_395/2023, and counterclaim for revocation CC\_14065/2024, 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

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