

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



PATENT LAW – PROCEDURAL LAW

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

- 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
- With the closure of the proceedings, the impugned decision will become ineffective.
- The conditional application to amend the patent is ancillary to the appeal, 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.

Source: [Unified Patent Court](#)

UPC Court of Appeal, 24 February 2025

(Kalden, Simonsson, Rombach, Kapels, Matter)

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 Hohen, 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(S)

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
