

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 19 August 2024
concerning an application pursuant to R.223 RoP
(Application for suspensive effect)

APPELLANTS / DEFENDANTS IN THE MAIN PROCEEDINGS BEFORE THE CFI

1. **Sibio Technology Limited**, Kowloon, Hong Kong
2. **Umedwings Netherlands B.V.**, Rijswijk, The Netherlands
hereinafter also referred to as “Sibio c.s. (in singular)”

both represented by: Thomas Gniadek, Rechtsanwalt, Simmons & Simmons LLP, Munich, Germany

RESPONDENT / CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE CFI

Abbott Diabetes Care Inc., Alameda, California, USA,
hereinafter also referred to as “Abbott”

represented by: Eelco Bergsma, Attorney at law, Taylor Wessing, Eindhoven, the Netherlands

LANGUAGE OF THE PROCEEDINGS

English

PATENT AT ISSUE

EP 2 713 879

PANEL AND DECIDING JUDGES

This order was adopted by the Second Panel, consisting of:

Rian Kalden, Presiding judge and judge-rapporteur

Ingeborg Simonsson, legally qualified judge

Patricia Rombach, legally qualified judge

IMPUGNED ORDER OF THE COURT OF FIRST INSTANCE

- Date: 19 June 2024; ORD_30434/2024 in the main proceedings concerning provisional measures ACT_14944/2024
- Action number attributed by the Court of First Instance, Local Division The Hague:
UPC_CFI_130/2024

POINTS AT ISSUE

Application for suspensive effect

PROCEDURAL BACKGROUND

On 20 March 2024, Abbott filed the Application for a preliminary injunction and other provisional measures (ACT_14944/2024) with the UPC Local Division The Hague. The Court of First Instance allowed the Application in part by Order no. ORD_30434/2024. Subsequently, the Respondents lodged an appeal against this Order on 4 July 2024.

INDICATION OF PARTIES' REQUESTS

Sibio c.s. requests that the impugned order is set aside and that Abbott's request for provisional measures is rejected. In the Statement of appeal and grounds of appeal, Sibio c.s. also requested that the appeal has suspensive effect, or alternatively, that the appeal has suspensive effect to the extent that the Application for provisional measures was granted for the territory of Ireland.

Abbott requests that the appeal is dismissed. In its Statement of response Abbott also comments on Sibio's request for suspensive effect.

GROUND FOR THE ORDER

Admissibility

1. The application is admissible.
2. Abbott argues that R.223 RoP stipulates that a party may lodge a separate application for suspensive effect in accordance with Article 74 UPCA and advances that Sibio's request is inadmissible as it has not lodged the application via a separate workflow in the CMS and failed to substantiate the reasons, as well as the facts, evidence and arguments relied on.
3. This argument must be rejected.
4. Sibio relied on the reasons set forth in its Statement of appeal and grounds of appeal ("For the reasons set out above"). If the reasons are not sufficient to justify the requested suspensive effect, that will lead to a rejection, but doesn't make the request as such inadmissible.
5. It is also not a requirement that a request for suspensive effect is lodged in a separate workflow in the Court's case management system. As correctly noted by Abbott, this *may* be done separately, and is advisable if an order is required urgently. It cannot however be inferred from R.223 RoP that the lodging in a separate workflow is a requirement in order for such a request to be admissible. A request can indeed be included in the Statement of appeal and grounds of appeal. In such a case however, unless explicitly requested otherwise, such request shall follow the regular procedural regime of such Statement and the Court of Appeal shall consider the request after it has received the respondent's comments as shall be included in its Statement of response, like Abbott has done in this case. R.223.3 RoP, which stipulates that the Court of Appeal shall decide the Application without delay, does not lead to another conclusion. Since the applicant has the option of either submitting an application to the Standing Judge in case of extreme urgency, or lodging a separate application if the decision is not to be delayed until after the Statement of response is lodged, the interests of the applicant are sufficiently taken into account.

Substance

6. According to Article 74(1) of the Agreement on a Unified Patent Court (UPCA), the appeal has no suspensive effect unless the Court of Appeal decides otherwise at the motivated request of one of the parties. The Court of Appeal can therefore grant the application only if the circumstances of the case justify an exception to the principle that the appeal has no suspensive effect. It must be examined whether, on the basis of these circumstances, the Appellant's interest in maintaining the status quo until the decision on its appeal exceptionally outweighs the Respondent's interest.

7. An exception to the principle that an appeal has no suspensive effect may apply, for instance, if the order against which the appeal is directed is manifestly erroneous, or if the enforcement of the appealed order or decision would make the appeal devoid of purpose (Court of Appeal 6 November 2023, App_584588/2023, UPC_CoA_407/2023; 18 January 2024, App_100/2024, UPC_CoA_4/2024).
8. Insofar as the impugned order extends to the territory of Ireland, the Court of Appeal agrees with Sibio c.s. that this is manifestly erroneous.
9. In the Application for preliminary injunction and other provisional measures, Abbott requested a preliminary injunction “for the Contracting Member States in which the patent is in force”. According to Annex B2, an extract from the EPO Register of the Patent, the patent at issue was in force in The Netherlands, Germany, France, Ireland and the UK. In its order, the Court of First Instance reasoned:

Abbott’s application in section 7.2 sets out the following: “The Patent is valid and in force in the Contracting Member States of Germany, France, The Netherlands and also Ireland. It is also in force in the UK.”. Read together with the order sought, this entails that Abbott apparently wishes the order to also cover Ireland, which is a signatory state to the UPCA, and therefore a Contracting Member State, even though Ireland has not yet ratified the Agreement.
10. This reasoning is clearly erroneous. Only countries that have not only signed but also ratified the UPCA are Contracting Member States. ‘Contracting Member State’ is defined in the UPCA as a Member State of the European Union party to the Agreement. Art. 84.2 UPCA provides that the Agreement shall be subject to ratification in accordance with the respective constitutional requirements of the Member States. It follows that a Member State who signed can only be regarded as a Contracting Member State after ratification.
11. Ireland therefore is not a Contracting Member State and thus cannot be considered to be covered by Abbott’s request for a preliminary injunction. The Court of First Instance therefore awarded more than was requested for, which is contrary to Art. 76 UPCA.
12. The fact that Sibio c.s. did not contest the competence of the Court of First Instance with respect to Ireland doesn’t alter that. Sibio c.s. did not have to expect the Court’s erroneous interpretation of Abbott’s claim.
13. Insofar as the order does not extend to Ireland, the Court of Appeal rejects the request for suspensive effect. In that respect Sibio c.s. argues that the impugned order is factually and legally flawed, for a variety of reasons. It has not argued that these are flaws that led to a manifestly erroneous order. In addition, Sibio has failed to argue why it would have an urgent interest by suspensive effect that outweighs the Respondent’s interest. An exception to the principle that the appeal has no suspensive effect is therefore not justified.

ORDER

The Court of Appeal:

- grants suspensive effect insofar as the impugned order extends to the territory of Ireland;
- rejects suspensive effect of the impugned order insofar as the order does not extend to the territory of Ireland.

Issued on 19 August 2024

Rian Kalden, Presiding judge and judge-rapporteur

Ingeborg Simonsson, legally qualified judge

Patricia Rombach, legally qualified judge