UPC_CFI_400/2024
FINAL ORDER
of the Court of First Instance of the Unified Patent Court
delivered on *30/12/2024*
Order no. ORD_60558/2024

Head notes

1. In proceedings for costs decision under rules 150 RoP et seq. an already existing decision on costs in principle is required. Indeed, an application for a cost decision shall contain, inter alias, under rule 156 RoP (e) the preliminary estimate of the legal costs that the party submitted pursuant to Rule 118. 5. RoP.
2. In proceedings for costs decision, it is not for the Judge rapporteur to decide what percentage of the costs should be shared between the parties or whether they should be set off, only dealing with the fixation of the amount of compensation for costs by not with the principle decision on the costs.
3. The cost decision is binding on the cost award decision: the judge rapporteur may not apportion the costs in accordance with the quotas provided for in the cost decision, in case the latter is lacking.

Keywords: RoP 150, RoP 151, RoP156, RoP 313, RoP 314, Art. 69 UPCA

APPLICANT

1) **INSULET CORPORATION** Represented by Marc Grunwald

RESPONDENT

2.**EOFLOW CO LTD**

Represented by Martin Kohler

PATENT AT ISSUE

Patent no.	*Proprietor/s*
EP4201327	Insulet Corporation

DECIDING JUDGE

Judge-rapporteur	**Alima Zana**

COMPOSITION OF PANEL – FULL PANEL

Presiding judge	**Pierluigi Perrotti**
Judge-rapporteur	**Alima Zana**
Legally qualified judge	**Anna-Lena Klein**
Technically qualified judge	**Uwe Schwengelbeck**

LANGUAGE OF PROCEEDINGS: English

SUBJECT-MATTER OF THE PROCEEDINGS : **Proceedings for Costs decision**

1. Procedural history

On 8 July 2024 Insulet Corporation filed an application for provisional measures against Menarini Diagnostics s.r.l.- -exclusive distributor in Europe of the patch-insulin pump EOPacht - alleging the infringement of the patent EP 4201 327.

On 16 September 2024 Eoflow CO. LTD -the developer and manufacturer of the patch-insulin pump EOPacht- lodged an application to intervene pursuant to rule 313 R.o.P. in support of Menarini request to dismiss the application for provisional measures.

Eoflow specified that it is the defendant in parallel proceeding before the Milan Central Division, started by the same applicant, Insulet Corporation.

The other parties in the main proceeding were invited to lodge their comments, pursuant to rule 314 RoP.

On 1 October 2024 the Court dismissed the request of intervention (see Order no. ord_51903/2024).

On 24 October 2024 Insulet lodged an "*application for cost decision"* requesting the issuance of a formal cost decision against Eoflow and claiming compensation from Eoflow for alleged costs in the amount of 15.748,00 EUR plus interest, suffered for filling its comments pursuant to rule 314 RoP.
By order dating 11 November 2024, the judge rapporteur invited Eoflow to provide comments on Insulet's application, in accordance with rule 152.3, 156.1, 361 RoP.
Eoflow objected that the application for cost is not admissible arguing that:

(i) no article in the UPCA nor rule in the RoP directly addressing the cost issue in relation to intervener.
The doctrine explains that any cost decision against an intervener could therefore only be based on rule 315. 4. RoP in combination with art. 69 UPCA: indeed, only the order declaring the intervention admissible confers the status of party on the intervener.

There is no basis for the application for a costs decision against a person that has "attempted" to intervene;

(ii) Eoflow could be not regarded as being a "unsuccessful party", according to art. 69 UPCA and rule 156.1. RoP;

(iii) rule 150 RoP et seq. requires an already existing decision on costs in principle: this rule only deals with the fixation of the amount of compensation for costs but not with the principle decision on the costs. The order of the Court on 1 October 2024 did not contain any cost decision;

(iv) Art. 69 (1)UPCA and rule 156. 2. RoP clearly allocate the costs of a party commenting on an application to intervene to that commenting party. There is no obligation of a party at all to comment on an application to intervene. It is the sole burden of the person filing the application to intervene to plead and prove the requirements of an admissible intervention – rule 313 RoP;

(v) the extraordinary high costs are not proven either nor are these costs proportional.

2. GROUNDS FOR THE DECISION

2.1.General considerations

2.1. This decision is adopted having regards to:

(i) the following principles set out in the Preamble 2 of the RoP:

- proportionality and flexibility.
- the fairness and equity, having regard to the legitimate interests of all parties.

(ii) Rules n. 150 et seq. RoP, Rules 313 et seq. RoP.; art. 69 Agreement.

(iii) the UPC case law on the intervention and costs and in particular the following decisions.

- Munich Local Division, CFI_1532023, n. ORD_46842/2024 2 October 2024;
- Milan Central Division, CFI 380/2024, n. ORD_59988/2024, 23 December 2024.

2.2.The first point of issue concerns the admissibility of the cost award proceeding, dealt with by rule 150, para 1, RoP, against the intervener following the order refusing the intervention under rule 314 RoP, and the award of costs incurred by the parties of the main proceeding to be heard, and to oppose against the intervention under rule 314 RoP.

The proceeding for intervention by third person provides for a two-stage structure (similar to the rules of procedure rules of procedure of the Court of Justice, see chapter 4 intervention articles n 129 et seq.):

(a) The first one, on admissibility: the intervener, third person, which is only a potential party.

At this stage, under rule 314 RoP the other parties shall be given an opportunity to be heard beforehand, putting forward observations on the application to intervene or identifying secret or confidential items or documents which, if communicated to the intervener, the parties claim would be prejudicial to them (see Munich Local Division , 2 October 2024, ACT_595922/2023 UPC number: UPC_CFI_487/2023).

(b) The second one opens only if the intervention is deemed admissible: the intervener becomes a party for all purposes (see rule 315. 4. RoP *"The intervener shall be treated as a party, unless otherwise ordered by the Court"*).

Therefore, in case the intervention is not admissible, the intervener does not appear to be treated as a party, according to UPC case law (see,_CFI_153/2024, LD Munich, Order of 2 October 2024[1]) which is a necessary condition for the application of the rules on costs, in particular for it to be regarded as an unsuccessful party, under rule 156 RoP).

After the order refusing the intervention, no article in the UPCA nor rule in the RoP directly addressing the cost issue in relation to intervener.

The application or otherwise of the procedure on costs, which are only expressly allowed after the proceedings on the merits, and on damages, (see Rule 150 RoP) would require:

- to consider as *"unsuccessful party*" the refused third intervener;
- to consider as a *"decision on the merits*" under rule 150 RoP (mandatory precondition for activating the instrument of the award of costs) the order refusing the intervention, which is not even appealing. and against which the intervener was ordered to pay the costs by a judgment on the substance of the case (see rule 317 RoP).
  Lacking a expressed rule addressing the costs on intervention, treating the order refusing the intervention, not appealable under rule 317 RoP, as a decision on the merits might seem to be a contrary solution contrary to the principle ruled by article 73 Agreement , which laid down *"An appeal against a decision of the Court of First Instance may be brought before the Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of the notification of the decision"*.

A agreeable solution would be (i) to add the non-party as a party to the proceedings for the purposes of costs only (ii) to give the non party the opportunity to be heard as ruled in some national jurisdiction and decided by the Milan Central Division that motivated in depth on the status of party before the Court of the intervener, whose application was dismissed. recipient of the obligation to pay costs (UPC Milan Central Division, CFI 380/2024, ORD_59988/2024, 23 December 2024).

2.2. The second issue relates the proceeding ruled by RoP 150 et seq. requiring an already existing decision on costs in principle as inferred from rule 156, lett. e) RoP: indeed, an application for a cost decision shall contain, inter alias, the preliminary estimate of the legal costs that the party submitted pursuant to rule 118.5. RoP.
The Judge rapporteur under rule 150 RoP et seq. only deals with the fixation of the amount of compensation for costs by not with the principle decision on the costs: as recalled by the doctrine, the cost decision is binding on the cost award decision.
Therefore, in proceedings for costs decision, it is not for the Judge rapporteur to decide what percentage of the costs should be shared between the parties or whether they should be set off.

2.3. <u>The case at hand</u>

As previously stated, <u>i</u>n the case at hand Insulet- a party in the main proceeding as a claimant - requests the costs against Eoflow -the third intervener (in support to Menarini- defendant in the main proceeding) who never became a party in the strict sense, because its application on intervention was not granted.
Indeed, on 1 October 2024 the Milan Court Division denied Eoflow entry into the main proceedings for provisional measures under Rule 206 RoP taking into account:

i "the efficiency of the proceeding and the interest of a speedy decision.

[1] "By admitting the intervention, the applicant becomes a party to the proceedings and is to be treated as a party in accordance with Rule 315(4) RoP."

In the case at hand the application to intervene is lodged in a proceeding for provisional measures pursuant to rule 206 ROP. 5

Even if the interpretation would generally consider the urgent procedure compatible with the intervention of the third party:

- *the procedure to introduce the third party ruled by rule 313 ROP e segg. (first step on the admissibility and second step the filing of the statement in intervention) is not compatible to the already scheduled hearing for 15 October 2024;*
  -if the intervention was allowed, the interim injunction proceedings would be excessively slowed down.

(ii) the intervener is the defendant in the parallel proceeding before the Central Division relating to the same patent.
Therefore:
- it is likely to have been aware of the proceeding since last July 2024, but it decided to intervene only 30 days before the hearing. The application to intervene goes against the applicant's interest to a quick decision in interim injunction proceedings;
-its reasons against the patentee are already submitted to the Court in the parallel proceedings;
i the provisional measures is incidental to the main proceeding and it does not have res iudicata effects (effects arising only from judicial decisions, which become finale after all rights of appeal have been exercised or after expiry of the time-limits of appeal).

Therefore, in the case at hand the third party intervention is only direct to limit factual prejudice deriving from the judgment.
In other words, the outcome of this proceedings only affects Eoflow indirectly: it is only the supplier and the potential negative effects (an economic impairment) at this stage appears only a side effect;
Eoflow's direct interest is already overseen in the parallel proceeding pending before the Milan Central Division and there is not indivisible cause of action, with compulsory joinder of the parties" .

However, unlike the case decided by the Central Court last 23 December 2024 of Milan (in which a decision on costs was taken, at least by stating that the successful party (Insulet) could initiate the costs procedure, implicitly giving it full entitlement to costs.[2]), in the case at hand the order refusing the intervention filed on 1 October 2024 did not contain any cost decision, not deciding in principle on the obligation to bear legal costs in accordance with rule 118. 5. RoP: in fact, Insulet did not seek a decision on costs, nor did the Rules of procedure explicitly provide a costs decision at that stage. Therefore, in light of the above considerations in section 2.3., a procedural deficiency precludes the granting of application, lacking the requirement set out in rule 156, lett. e, RoP, i.e.: *"the preliminary estimate of the legal costs that the party submitted pursuant to Rule 118.5. RoP".*

Indeed, this proceeding only may deal with the fixation of the amount of compensation for costs by not with the principle decision on the costs.

2 See order no. ORD_52068/2024 UPC number: UPC_CFI_380/2024, filed on 1 October 2024 "the successful party did not make a claim for costs. Since the costs of these proceedings cannot be recovered against Menarini in the main proceedings opposing INSULET and EOFLOW, INSULET may follow Rop 151: "Where the successful party (hereinafter "the applicant") wishes to seek a cost decision, it shall within one month of service of the decision lodge an Application for a cost decision".

Therefore, Insulet application lacks an essential requirement to quantity the costs, because the Court may not apportion the costs to Insulet and Eoflow in accordance with the quotas provided for in the cost decision, that lacks.

The application may be resubmitted supported by a costs award decision.

In the light of above considerations

ORDER

The application for cost decision lodged by Insulet Corporation is dismissed.

Delivered in Milan 30 December 2024

The Judge rapporteur

Alima Zana

Alima ZANA Firmato digitalmente da Alima ZANA Data: 2024.12.30 14:27:58 +01'00'

Rule 157 – Appeal against the cost decision

The decision of the judge-rapporteur as to costs only may be appealed to the Court of Appeal in accordance with Rules 157 and 221 RoP.

ORDER DETAILS

Order no. ORD_60558/2024
UPC number: UPC_CFI_400/2024
Related proceeding no. Application No.: 40442/2024
Application Type: Application for provisional measures (RoP206)