Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Central Division

Paris Seat

DECISION
of the Court of First Instance of the Unified Patent Court
Central division (Paris seat)
issued on 29 April 2025
concerning the application for a cost decision No. ACT_831/2025
UPC_CFI_11/2025

HEADNOTES: 1. The mere circumstance of a pending appeal against the decision on the merits does not constitute a sufficient reason to order the stay of the proceedings for cost decision.

KEYWORDS: procedure for cost decision.

APPLICANT:

Roche Diabetes Care GmbH - Sandhofer Straße 116, 68305 Mannheim, Germany

represented by Christof Augenstein, Katharina Brandt and Robert Knaps, Kather Augenstein Rechtsanwälte PartGmbB, and Thomas Kronberger, Grünecker Patent- und Rechtsanwälte PartGmbB

RESPONDENTS:

Tandem Diabetes Care, Inc. - 12400 High Bluff Drive, CA 92130, San Diego, United States of America

Tandem Diabetes Care Europe B.V. - Boulevard 359, WTC Schiphol Airport, D-Tower 11th floor, 1118 BJ, Schiphol, Kingdom of the Netherlands

both represented by Charlotte Garnitsch, Wim Maas and Pauline Springorum, Taylor Wessing N.V., Alexander Rubusch, Taylor Wessing Partnerschaftsgesellschaft mbB, and George Seezink, AOMB

PATENT AT ISSUE:

European patent n° EP 2 196 231 B1

PANEL:

Panel 2:

Paolo Catallozzi	Presiding judge and judge-rapporteur
Tatyana Zhilova	Legally qualified judge
Giorgio Checcacci	Technically qualified judge

DECIDING JUDGE:

This order is issued by the Presiding judge and judge-rapporteur Paolo Catallozzi

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 20 January 2025, the applicant filed an application for a cost decision regarding the revocation action registered as No. ACT_589997/2023 UPC_CFI_454/2023, requesting the Court to order the respondents to pay the costs, in the amount of EUR 112,300.00, to the applicant. The applicant argues that it sustained costs for the proceedings in the total amount EUR 211,441.40 (EUR 203,818.02 for representation, EUR 7,323.38 for travel and EUR 300.00 for Court fees), but that its request for cost of representation is limited to EUR 112,000.00 as this amount is the ceiling for reimbursable costs set by the relevant provisions.

2. With their submission of 21 March 2025, the respondents pointed out that there is an inconsistency between the amount requested on page 2 of the application, namely EUR 112.300,00, and the amount requested on page 14 of the application, namely EUR 120.300,00. Furthermore, they object to the travel expenses concerning the applicant's four in-house participants to the oral hearing. Finally, they requested to stay the proceedings pending an appeal against the decision on the merit.

GROUNDS FOR THE ORDER

3. The request for the suspension of the proceedings advanced by the respondents, due to the pending appeal against the decision on the merits and the risk, in the event of the appeal being upheld and the ruling concerning the party obligated to pay the costs of the proceedings being overturned, of further and unnecessary activities for the restitution of sums paid in that regard, must be examined preliminarily for reasons of logical and legal order.

4. In this regard, it must be borne in mind that Rule 295 (m) of the Rules of Procedure allow the Court to stay proceedings "in any other case where the proper administration of justice so requires". This Rule vests in the Court a discretionary power to stay proceedings, which must be exercised in accordance with the fundamental right to an effective legal remedy within a reasonable time as well as the principles of proportionality, flexibility, fairness and equity (point 2 of the Preamble of the 'RoP').

5. That being stated, the Court observes that the mere circumstance of a pending appeal against the decision on the merits does not constitute a sufficient reason to order the stay of the

proceedings for cost decision. A different conclusion would imply that the unsuccessful party could unduly obtain a deferral of the order to pay costs simply by lodging an appeal against the decision on the merits, and this does not appear reasonable, leading to an unjustified sacrifice of the successful party's right to a prompt settlement of costs.

6. Furthermore, the Court observes that the defendants do not allege any risk pertaining to the applicant's inability to repay the sums received as costs of the proceedings in the event of a reversal by the Court of Appeal of the ruling issued on this point by the Court of First Instance.

7. The defendants highlight that a decision on costs could be overturned by the potential upholding of the appeal on the decision on the merits and that would result in a useless and possibly wrong bank transaction and in extra unnecessary proceedings and Court expenses. This circumstance, in the Court's view, does not constitute a fact capable of imposing a different assessment of the request for stay, given that the restitution of the sums paid does not entail particularly burdensome activities, especially for the recipient of the reimbursement who is only required to communicate the bank account details, nor, in any case, does it interfere with the administration of justice.

8. It follows that the respondents' request for stay must be dismissed.

9. Regarding the costs for which the applicant seeks compensation, the application is indeed not entirely clear, given that in the introduction of the application, on page 2, these costs are indicated as EUR 112,000,00 and in the final conclusions thereof, on page 14, these costs are indicated as EUR 120,300.00. This Court holds that, upon an overall reading of the document, the request should be understood as meaning that the request for representation costs is limited to EUR 112,000,00, even though the costs incurred in that regard are significantly higher than that sum, given the ceiling of that amount for cases, such as the one under consideration, with a value of up to EUR 1,000,000.00. The application further includes a request for reimbursement of travel expenses incurred in relation to the final hearing, including those relating to four in-house companies' representatives who participated in that hearing, for a total of EUR 7,323.38, and the costs for the court fee paid in relation to a request for review by the panel of an order of the judge-rapporteur, for a total of EUR 300.00.

10. As for the costs for representation, these are compliant with the ceiling provided for cases – such as the one under consideration – having a value of EUR 1,000,000, as per the decision of the Administrative Committee of 24 April 2023, which applies solely to expenses for such costs. These costs are well-documented and appear necessary and not disproportionate in relation to the activity undertaken. The Court observes that no objection regarding their quantum has been raised by the defendant.

11. As for the travel expenses for attending the oral hearing, the respondents contest those relating to the party, highlighting their excessive number (four) and the possibility for them to participate remotely. In this regard, the Court considers that the travel expenses incurred by the legal representatives, well-documented and not contested by the respondents either as to the principle or the quantum, amounting to EUR 3,488.36, should be fully acknowledged. The travel expenses of the party, however, in light of the procedural evidence and according to the Court's discretionary assessment, can be deemed necessary only with reference to two in-house company's representatives, specifically, [redacted]

[redacted] and [redacted] amounting to EUR 922.13 and EUR 1,031.13 respectively. Therefore, the total amount of travel expenses which must be compensated amount to 5,441.62.

12. Finally, the cost for the Court fee of EUR 300.00, not contested by the respondents, must also be acknowledged, having regard to its evident connection with the proceedings and the fact that it relates to a request not entirely dismissed by the Court.

13. From the foregoing, it follows that the costs incurred by the applicant must be determined, for the purpose of the current proceedings, in EUR 117,741.62.

ORDER

The Court,

i) **determines the costs incurred by Roche Diabetes Care GmbH in the proceedings UPC_CFI_454/2023 in EUR 117,741.62**;

ii) **orders Tandem Diabetes Care, Inc. and Tandem Diabetes Care Europe B.V to pay jointly and severally these costs within three weeks from the date of service of the present decision**.

Issued on 29 April 2025.

The Presiding judge and judge-rapporteur

Paolo Catallozzi

Paolo Catallozzi Firmato digitalmente da Paolo Catallozzi
Data: 2025.04.29 12:39:02 +02'00'

ORDER DETAILS

Order no. ORD_11186/2025 in ACTION NUMBER: ACT_589997/2023
UPC number: UPC_CFI_11/2025
Action type: Revocation Action
Related proceeding no. Not provided Not provided
Not provided Not provided