



UPC Court of Appeal
UPC_CoA_7/2025
APL_322/2025
App_23301/2025

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 23 May 2025
Withdrawal pursuant to R. 265 RoP and
Application for reimbursement of Court fees (R. 370.9 RoP)

APPELLANT (AND CLAIMANT BEFORE THE COURT OF FIRST INSTANCE)

NJOY Netherlands B.V., Amsterdam, The Netherlands
(hereinafter 'NJOY')

represented by: Attorney-at-law Dr Henrik Holzapfel, McDermott Will & Emery, Düsseldorf, Germany, and other representatives from that firm

RESPONDENT (AND DEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

Juul Labs International Inc., San Francisco, USA
(hereinafter 'Juul Labs')

represented by: European Patent Attorney Bernhard Thum, Thum & Partner, Munich, Germany

PATENT AT ISSUE

EP 3 504 991

PANEL AND DECIDING JUDGE

Panel 2

Rian Kalden, presiding judge and legally qualified judge
Ingeborg Simonsson, legally qualified judge and judge-rapporteur
Patricia Rombach, legally qualified judge
Wiem Samoud, technically qualified judge
Andrea Scilletta, technically qualified judge

IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

Central Division Paris, 5 November 2024, ORD_60043/2024, revocation action ACT_571801/2023, UPC_CFI_315/2023

LANGUAGE OF THE PROCEEDINGS

English

REASONS

1. NJOY brought a revocation action against Juul Labs before the Paris Central Division for revocation of the patent at issue.
2. The Paris Central Division dismissed the revocation action and ordered NJOY to bear the costs of the proceedings.
3. NJOY appealed and requested that the decision on the obligation to bear legal costs be set aside and be substituted with an order for NJOY to bear 80 % of the costs of the proceedings, and Juul Labs to bear 20 %. NJOY subsequently amended the second part of its request and asked for an order that NJOY bear 20 % of the costs of the proceedings, while Juul Labs has lost its right to make any claims regarding the remaining 80 % of the costs which otherwise NJOY would have to bear.
4. NJOY has now applied to withdraw the appeal pursuant to R.265 RoP, and requested that the Court of Appeal declares the appeal proceedings closed, that the hearing scheduled for 16 June 2025 is cancelled, and order (should the Court of Appeal deem it necessary) that each party shall bear its own costs in the appeal proceedings. NJOY has in addition applied for reimbursement of court fees pursuant to R.370 RoP.
5. Juul Labs has consented to the withdrawal of the appeal, the cancellation of the oral hearing and that each party bears its own costs in these appeal proceedings.

GROUND

Conditions for permitting withdrawal

6. As long as there is no final decision in an action, a claimant may, pursuant to R. 265.1 RoP, apply to withdraw his action. The application to withdraw shall not be permitted if the other party has a legitimate interest in the action being decided by the Court. R. 265.1 RoP also applies mutatis mutandis to the withdrawal of an appeal.
7. 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 application to withdraw the appeal can be permitted.

Costs

8. R. 265.2 (c) RoP provides that the Court shall issue a cost decision in accordance with Part 1, Chapter 5. NJOY only requests that a cost decision be issued, should the Court of Appeal deem it necessary. Both parties agree that each party shall bear its own costs in these appeal proceedings. The decision shall include an order to this effect.

Reimbursement of Court fees

9. In case of the withdrawal of an action (R. 265 RoP), the party liable for the Court fees will be reimbursed by 60 % in accordance with R. 370.9 (b) (i) RoP if the action is withdrawn before the written proceeding have been concluded. In this case, the Statement of response had already been lodged when the application to withdraw was made. The withdrawal was however made before the closure of the interim procedure (R. 370.9 (b) (ii) RoP). Reimbursement by 40 % is to be ordered in accordance with this provision.

ORDER

The Court of Appeal:

- permits the withdrawal of the appeal and declares the proceedings closed;
- orders that this decision shall be entered on the Register;
- orders that each party shall bear its own costs for the appeal proceedings;
- declares the oral hearing on 16 June 2025 cancelled;
- orders that 40 % of the appeal Court fees be reimbursed to NJOY.

Issued on 23 May 2025

Rian Kalden, presiding judge and legally qualified judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Wiem Samoud, technically qualified judge

Andrea Scilletta, technically qualified judge