

Decision
of the Court of Appeal of the Unified Patent Court
issued on 9 January 2026
regarding an application to withdraw the appeal pursuant to R. 265 RoP and
an Application for reimbursement of Court fees (R. 370.9 RoP)

HEADNOTE

According to R. 370.9(b)(iii) RoP as it read until 31 December 2025, 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of the action (R. 265 RoP), the party obliged to pay the Court fees shall receive a refund of 20 % if the action is withdrawn before the closure of the oral procedure. This provision has been deleted following the amendments to R. 370.9 RoP. The entry into force provides that amendments shall enter into force on 1 January 2026. The amendments apply only to those actions and applications filed after 31 December 2025.

KEYWORDS

Court fees, reimbursement

APPELLANT (AND DEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

VMR Products LLC, San Francisco, USA

(hereinafter ‘VMR Products’)

represented by European Patent Attorney Bernhard Thum, Thum & Partner Thum, Mötsch, Weickert, Munich, Germany, and by representatives from Bardehle Pagenberg, Munich, Germany

RESPONDENT (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 & Schulte, Düsseldorf, Germany

PATENT AT ISSUE

EP 3 613 453

PANEL AND DECIDING JUDGES

Panel 2

Rian Kalden, legally qualified judge and presiding 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, 22 January 2025, revocation action, UPC_CFI_310/2023

LANGUAGE OF THE PROCEEDINGS

English

SUMMARY OF FACTS AND PARTIES' REQUESTS

1. NJOY brought an action for revocation of the patent at issue against VMR Products before the Central Division Paris. The Central Division partially revoked the patent at issue with effect for the territories of Austria, Belgium, Denmark, Finland, France, Germany, Italy, Latvia, Luxembourg, Netherlands, Portugal and Sweden, maintaining it in part based on claims 6, 7 and 8 in combination with claim 1 as granted. The parties were ordered to bear their own costs of the proceedings.
2. VMR Products appealed. The parties were summoned to an oral hearing on 9 February 2026. On 11 November 2025 the Boards of Appeal of the EPO revoked the patent.
3. In view of this, NJOY lodged an application pursuant to R. 360 RoP. NJOY requested that the revocation action be disposed of by way of an order, in the alternative, the appeal be disposed of by way of order and, in the further alternative, that the appeal be dismissed. In addition, NJOY requested that VMR Products be ordered to bear the costs of the appeal; in the alternative, to bear the costs of the first instance proceedings and the appeal.
4. In response, VMR Products has lodged an application pursuant to R. 265 RoP. VMR Products requests the Court to permit the withdrawal of its appeal. In the alternative, VMR Products requests the revocation action to be disposed by way of order according to R. 360 RoP. If the withdrawal request is permitted by the Court, Juul Labs requests a partial refund of the appeal fee. Additionally, VMR Products requests that NJOY be ordered to bear the costs of the proceedings. VMR Products sets forth that NJOY initiated the revocation action without any provocation or legitimate cause, well aware of the pending and parallel EPO opposition proceedings.
5. NJOY has replied that it consents to the withdrawal of the appeal. NJOY requests that VMR Products be ordered to bear the costs of the appeal; in the alternative be ordered to bear the costs of the first instance proceedings and the appeal.
6. NJOY has informed that the parties have concluded a settlement regarding the recovery of costs from the first instance proceedings.

REASONS

Conditions for permitting the withdrawal

7. As long as there is no final decision in an action, a claimant may apply to withdraw his action. The Court shall decide the application after hearing the other party. 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).
8. This applies also to withdrawals of appeals (CoA, order of 5 July 2024, CoA_234/2024, *10x Genomics vs Curio Bioscience*, para 9).
9. The application to withdraw the appeal is admissible since there is no final decision in the action in view of the pending appeal, and the Court of Appeal is responsible for deciding on the permissibility of the application for withdrawal (CoA, 15 January 2025, UPC_CoA_637/2024, UPC_CoA_638/2024, UPC_CoA_639/2024, *Avago vs Tesla* and CoA, 15 January 2025, UPC_CoA_629/2024, UPC_CoA_631/2024, and UPC_CoA_632/2024, *Avago Technologies International Sales vs Tesla Germany and Tesla Manufacturing Brandenburg*).
10. In view of NJOYs' consent, it 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.
11. Since the Boards of Appeal of the EPO has revoked the patent, the operative part of the impugned decision where the Central Division partially revoked the patent at issue with effect for the territories of Austria, Belgium, Denmark, Finland, France, Germany, Italy, Latvia, Luxembourg, Netherlands, Portugal and Sweden, maintaining it in part based on claims 6, 7 and 8 in combination with claim 1 as granted, has become ineffective.

Reimbursement of Court fees

12. According to R. 370.9(b)(iii) RoP as it read until 31 December 2025, 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 20 % if the action is withdrawn before the closure of the oral procedure. This provision has been deleted following the amendments to R. 370.9 RoP. The entry into force provides that amendments shall enter into force on 1 January 2026. The amendments apply only to those actions and applications filed after 31 December 2025 (see page 4 of the AdminComm Amendment of the table of court fees and other related changes to the Rules of Procedure and Guidelines). In this case, the application was filed before this date, which makes the previous rule applicable. Reimbursement is to be ordered in accordance with this provision.

Cost decision

13. VMR Products' request that NJOY shall be ordered to bear the costs of the appeal proceedings is unsuccessful.
14. According to VMR Products, NJOY started a revocation action which was without merit from the beginning, but also objectively unnecessary. Juul Labs never made any infringement allegations against

NJOY, and NJOY could have awaited the outcome of the pending EPO opposition proceedings and, in the event that an infringement action was brought, joined those EPO opposition proceedings accordingly. Those proceedings were already in an advanced stage at the time NJOY lodged its revocation action on 14 September 2023. NJOY was fully able to monitor those proceedings through the EPO's online file inspection system, and based its revocation action on the same grounds that, according to the preliminary opinion, would either a) lead to a retroactive revocation of the patent in suit or b) render its own attacks baseless.

15. This line of argument fails. As a general rule, in case of a withdrawal of an appeal, the appellant shall be considered to be the unsuccessful party who shall bear the costs (as referred to in R.151(d) RoP) incurred in relation to the appeal proceedings (*10x Genomics vs Curio Bioscience*, para 13).
16. An exception to the general rule of Art. 69 (1) UPCA that the unsuccessful party must bear the reasonable and proportionate legal costs and other expenses incurred by the successful party may apply if a claimant files a revocation action without the patent holder having given rise to the action and the patent holder surrenders the patent immediately at the beginning of the proceedings. For this rule to apply, it is generally necessary that within the time limit for filing a defence to revocation the patent holder not only surrenders the patent but within the same time period also files a request for revocation of the patent pursuant to Art. 105a EPC with the European Patent Office and pays the required fee within that time period (CoA, order of 26 March 2025, *Stäubli Tec vs Respondents*, UPC_CoA-290/2024).
17. This exception does not apply. VMR Products defended its patent in the first instance proceedings. There is furthermore no reason to extend the case-law to a situation such as the present one.
18. VMR Products, being the unsuccessful party, shall be ordered to bear the costs for the appeal proceedings.

DECISION

- I. The Court of Appeal permits the withdrawal of the appeal 257/2025 and declares the proceedings closed.
- II. VMR Products is ordered to bear the reasonable and proportionate legal costs and other expenses incurred by NJOY for the appeal proceedings.
- III. The Court of Appeal orders that 20 % of the appeal Court fees be refunded to VMR Products.

Issued on 9 January 2026

Rian Kalden, legally qualified judge and presiding judge

Ingeborg Simonsson, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Wiem Samoud, technically qualified judge

Andrea Scilletta, technically qualified judge