Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Reference no:

UPC-COA-130/2026

ORDER

of the Court of Appeal of the Unified Patent Court

issued on 24 November 2026

HEADNOTES

1. A decision of the Court of First Instance which is set aside on appeal is to be regarded as having had no legal effect from the outset and that its setting aside therefore removes the legal basis for any subsequent decision ordering the payment of periodic penalty payments.

2. R. 354.2, third sentence, RoP addresses a situation in which the decision or order remains in existence notwithstanding the subsequent amendment or revocation of the patent. It does not apply where the underlying infringement decision has itself been set aside on appeal with retroactive effect.

KEYWORDS

Rehearing.

APPLICANTS

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RESPONDENT

Fujifilm Corporation, 26-30, Nishiazabu 2- chome, Minato-ku, Tokyo 106-8620, Japan

represented by attorney-at-law Christof Augenstein, Kather Augenstein Rechtsanwälte PartGmbB

PATENT AT ISSUE

EP 3 511 174

DECIDING PANEL

Panel 1c
Klaus Grabinski, presiding judge and president of the Court of Appeal
Paolo Catallozzi, legally qualified judge and judge-rapporteur
Peter Blok, legally qualified judge

LANGUAGE OF THE PROCEEDINGS

English

DECISION UNDER REVIEW

□ Order of the Court of Appeal of the Unified Patent Court dated 14 October 2025.

Number attributed by the Court of Appeal: UPC_CoA_699/2025.

SUMMARY OF FACTS

1. By order of 14 October 2025 the Court of Appeal decided the appeal against the penalty order issued by the Mannheim Local Division on 23 July 2025.

2. On 3 August 2026, the Applicants filed an application for rehearing pursuant to Art. 81 UPCA and R. 245 et seq. RoP requesting that: (a) the order of the Court of Appeal of 14 October 2025 be set aside and the proceedings be reopened for a rehearing and a new decision; (b) the Respondent be ordered to bear the costs of the rehearing proceedings and of the underlying penalty proceedings at both instances; (c) the value in dispute be set at EUR 100,000. In the alternative, the Applicants request the Court to declare that the order of the Court of Appeal of 14 October 2025 has ceased to have any legal effect as a consequence of the setting aside, with retroactive effect, of the first instance decision of 2 April 2025 (UPC_CFI_365/2023) by the Court of Appeal's decision of 2 June 2026 (UPC_CoA_312/2025) and that this declaration shall

also apply to the first-instance penalty order of 23 July 2025 (UPC_CFI_365/2023), in so far as it continues to burden the Applicants.

3. In support of the application, the Applicants submit that the order of 14 October 2025 is affected by a fundamental procedural defect because the decision of 2 June 2026 allegedly removed, with retroactive effect, the legal basis on which the penalty proceedings and the related costs order rested.

4. The Respondent requests that the application for rehearing and the auxiliary request for a declaration that the orders of 23 July 2025 and of 14 October 2025 have ceased to have legal effect be rejected. It submits, in essence, that the Applicants have not identified any fundamental procedural defect in the proceedings leading to the order of 14 October 2025, but rely solely on the subsequent setting aside, by the decision of 2 June 2026, of the first-instance infringement decision. According to the Respondent, that subsequent event is not a ground for rehearing under Art. 81(1) UPCA; nor are the Applicants adversely affected by the order whose rehearing is sought, since the penalty payment of EUR 100,000 was set aside, no payment obligation arises directly from the remaining penalty orders, and the subsequent penalty payment orders have already been set aside. The Respondent further submits that the costs order remains unaffected, that there is no legal basis or legitimate interest for the declaratory relief sought in the alternative, and that the Applicants should bear the costs of the rehearing proceedings.

GROUNDS FOR THE ORDER

Legal framework.

5. Pursuant to Art. 81(1) UPCA, a request for rehearing after a final decision of the Court may exceptionally be granted by the Court of Appeal on the ground of the discovery of a fact of such a nature as to be a decisive factor and which, when the decision was given, was unknown to the party requesting the rehearing, provided that the request is based on an act which has been held, by a final decision of a national court, to constitute a criminal offence, or on the ground of a fundamental procedural defect. Under R. 245.1 RoP, an application for rehearing may be lodged by a party adversely affected by a final decision within the meaning of that provision.

6. A rehearing is not an ordinary appeal, but an extraordinary legal remedy. Only a procedural defect that is so fundamental that it is intolerable for the legal system may justify overriding, in the interest of justice, the principle that proceedings which have led to a final decision should not be reopened. Furthermore, a defect may be regarded as fundamental only if it is established that, without that defect, the same decision would not have been taken. It is for the applicant to establish that those requirements are met (Court of Appeal, decision of 19 June 2025, *Alexion v Amgen*, UPC_CoA_405/2024, paras 11-13; Court of Appeal, decision of 24 February 2026, *Suinno v Microsoft*, UPC_CoA_883/2025 and UPC_CoA_892/2025, para. 13).

7. A rehearing does not provide the parties with a further opportunity to challenge the Court's interpretation of the applicable law or its assessment of the requests, facts and arguments submitted in the original proceedings. A mere disagreement with the reasoning of the Court of Appeal or with the outcome of the case does not constitute a ground for rehearing (Court of Appeal, decision of 24 February 2026, *Suinno v Microsoft*, UPC_CoA_883/2025 and UPC_CoA_892/2025, para. 23).

The main request.

8. The Applicants base their application on Art. 81(1)(b) UPCA, but fail to establish a fundamental procedural defect affecting the proceedings that led to the order whose rehearing is sought. They do not challenge the manner in which those proceedings were conducted, the Court's treatment of their requests, submissions or evidence, or the opportunity afforded to them to be heard. On the contrary, they expressly state that they take no issue with the assessment of the arguments or evidence, or with the legal reasoning underlying that order.

9. The application is based solely on the subsequent setting aside, by the decision of the Court of Appeal of 2 June 2026, of the first-instance decision of 2 April 2025. That circumstance did not exist when the proceedings leading to the order under review were conducted or when that order was issued. It cannot therefore constitute a procedural defect in those proceedings within the meaning of Art. 81(1)(b) UPCA.

10. The retroactive effect of the setting aside does not lead to a different conclusion. The Court of Appeal has held that a decision of the Court of First Instance which is set aside on appeal is to be regarded as having had no legal effect from the outset and that its setting aside therefore removes the legal basis for any subsequent decision ordering the payment of periodic penalty payments (Court of Appeal, order of 10 December 2024, *NanoString v 10x Genomics*, UPC_CoA_470/2023, para. 10; Court of Appeal, order of 3 August 2026, *Kodak v Fujifilm*, UPC_CoA_28/2026, para. 19).

11. That case law concerns the substantive consequences of the setting aside of the underlying decision. It does not establish that the procedure followed in proceedings concluded before the underlying decision was set aside becomes retrospectively defective. The removal, with retroactive effect, of the legal basis for the enforcement of an order must therefore be distinguished from a fundamental procedural defect in the proceedings that led to that order.

12. The Applicants rely on R. 247(d) RoP, but they have not identified any request made in the proceedings leading to the order of 14 October 2025 on which the Court failed to rule. The subsequent setting aside of the first-instance decision cannot be equated with a failure to decide a request that was before the Court. R. 247(d) RoP concerns a defect existing when the decision was given and does not encompass the consequences of an event occurring thereafter.

13. Moreover, the order of 14 October 2025 did not require the Applicants to pay the

penalty payment of EUR 100,000 imposed by the Court of First Instance. On the contrary, it set aside that part of the order under appeal. As regards possible future non-compliance, it maintained the remaining orders in a limited form as penalty orders, while expressly stating that the actual forfeiture of any penalty payment would first have to be determined by the Court of First Instance in separate proceedings under R. 354.4 RoP.

14. After the first-instance infringement decision was set aside, no penalty payment could be imposed on the basis of non-compliance with the orders contained in that decision. The Court of Appeal has already applied that consequence by setting aside the subsequent penalty payment orders and ordering the repayment of the penalty payments made (Court of Appeal, order of 3 August 2026, *Kodak v Fujifilm*, UPC_CoA_28/2026, paras 19, 26 and 29).

15. The costs order contained in the order of 14 October 2025 does not justify a different conclusion. The appeal in the penalty proceedings was successful only in part: the order requiring payment of EUR 100,000 was set aside, and the further orders were set aside in so far as they required immediate payment, but were maintained in a limited form as penalty orders for possible future non-compliance. In view of that partial success, the Court ordered, pursuant to Art. 69(2) UPCA, that each party bear its own costs at first instance and on appeal.

16. The subsequent setting aside of the infringement decision does not retrospectively alter the outcome of the penalty proceedings on the issues which were before the Court at that time. In particular, the allocation of costs was not based on a determination, in those proceedings, of whether the patent had been infringed. It reflected the parties' respective success concerning the interpretation and application of R. 354.3 and R. 354.4 RoP and the legality of the orders made by the Court of First Instance. The removal of the substantive basis for enforcement does not therefore constitute a defect in the costs decision capable of justifying a rehearing under Art. 81(1)(b) UPCA.

17. This does not prejudge whether costs incurred by the Applicants in connection with the enforcement of the first-instance infringement decision constitute recoverable injury under the compensation order contained in the decision of 2 June 2026. That question, including the relevance, if any, of the costs order of 14 October 2025, falls to be determined in the proceedings under R. 125 RoP concerning the amount of compensation.

18. The retroactive removal of the legal basis for the penalty orders does not require the reopening of the proceedings concluded by the order of 14 October 2025. Since the Applicants have not established a fundamental procedural defect within the meaning of Art. 81(1)(b) UPCA, the application for rehearing must be rejected.

Auxiliary request for a declaration.

19. In the alternative, the Applicants request a declaration that the order of 14 October

2025 and the first-instance penalty order of 23 July 2025 have ceased to have legal effect, in so far as those orders continue to burden them. They rely, by analogy, on R. 354.2, third sentence, RoP and, in the further alternative, on R. 9.1 RoP.

20. That request cannot be granted. R. 354.2, third sentence, RoP concerns the enforceability of a decision or order following the amendment or revocation of the patent after the conclusion of the action. It does not provide a legal basis for a declaration concerning the effects of a decision or an order following the setting aside of an underlying decision in separate appeal proceedings.

21. Nor is there a basis for applying that provision by analogy. R. 354.2, third sentence, RoP addresses a situation in which the decision or order remains in existence notwithstanding the subsequent amendment or revocation of the patent and therefore requires a separate order terminating its enforceability. That is not the situation in the present case. The underlying infringement decision was itself set aside on appeal with retroactive effect. As a result, it must be regarded as having had no legal effect from the outset, and the legal basis for any subsequent ruling requiring the payment of a penalty was thereby removed. No further declaration is required to bring about that legal consequence.

22. R. 9.1 RoP does not provide such a legal basis either. That provision empowers the Court to make procedural orders concerning the conduct of proceedings. It does not empower the Court to issue the substantive declaration sought by the Applicants concerning the continued legal effect of final decisions or orders.

23. Nor is the declaration sought necessary to protect the Applicants against future penalty payments. A penalty order does not, in itself, give rise to an obligation to pay. Any such obligation would require a prior order under R. 354.4 RoP (Court of Appeal, order under review, para. 55). In any proceedings brought under that provision, the Applicants could rely on the setting aside, with retroactive effect, of the underlying infringement decision, which removed the legal basis for any order requiring the payment of a penalty. The possibility of hypothetical future proceedings does not therefore establish a present need for the declaration sought.

24. The Applicants' intention to rely on the requested declaration as evidence in the compensation proceedings does not alter that conclusion. No such declaration is required, since the legal consequences on which the Applicants seek to rely already follow from the retroactive effect of the decision of 2 June 2026 and may be invoked directly in those proceedings.

25. The auxiliary request must therefore also be rejected.

Costs.

26. Pursuant to Art. 69(1) UPCA, the unsuccessful party must, as a general rule, bear the reasonable and proportionate legal costs and other expenses incurred by the successful party, unless equity requires otherwise. That principle also applies in

rehearing proceedings (Court of Appeal, decision of 19 June 2025, *Alexion v Amgen*, UPC_CoA_405/2024, para. 29).

27. The Applicants submit that the Respondent should bear the costs of these proceedings even if the application were rejected, because the Respondent enforced the non-final first-instance infringement decision at its own risk and the present proceedings arise from that enforcement.

28. That submission cannot be accepted. The present rehearing proceedings were initiated by the Applicants after the conclusion of the penalty proceedings and concern whether the requirements of Art. 81(1) UPCA are met. Whether any costs incurred in connection with the enforcement of the first-instance infringement decision are recoverable as injury caused by that enforcement is a separate question to be determined in the proceedings under R. 125 RoP.

29. Since the Applicants are unsuccessful in respect of both the application for rehearing and the auxiliary request, and there are no circumstances justifying a different costs order on grounds of equity, they must bear the costs of the present proceedings.

Value of the rehearing proceedings.

30. The Applicants request that the value in dispute of the rehearing proceedings be set at EUR 100,000.

31. The value in dispute must reflect the objective economic interest pursued by the Applicants in the application for rehearing. Since the application concerns the order relating to a penalty payment of EUR 100,000 and the legal consequences arising from that order, the value in dispute of the rehearing proceedings is set at EUR 100,000.

DECISION

The Court of Appeal:

i) rejects the application for rehearing as not allowable;

ii) rejects the auxiliary request for a declaration that the order of the Court of Appeal of 14 October 2025 and the order of the Mannheim Local Division of 23 July 2025 have ceased to have legal effect;

iii) orders the Applicants to bear the costs of the rehearing proceedings;

iv) sets the value in dispute of the rehearing proceedings at EUR 100,000.

Issued on 24 November 2026.

KLAUS STEFAN MARTIN Grabinski

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Klaus Grabinski, presiding judge and president of the Court of Appeal

Paolo Catallozzi

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