



Local division Munich  
UPC\_CFI\_2/2023  
UPC\_CFI\_298/2023

**Order**  
**of the Court of First Instance of the Unified Patent Court**  
**issued on 16 July 2025**

**Headnote:**

For an application for compensation (Rule 213.2 of the Rules of Procedure, RoP) court fees must be paid. This is evident from Rules 125, 126 and 132 RoP.

CLAIMANTS

1. **10x Genomics, Inc.**, 6230 Stoneridge Mall Road, 94588-3260 Pleasanton - USA
2. **President and Fellows of Harvard College**, Richard A. and Susan F. Smith Campus Center, Suite 727E, 1350 Massachusetts Avenue, Cambridge, Massachusetts 02138 - USA

represented by: Tilman Müller-Stoy

DEFENDANTS

1. **Bruker Spatial Biology, Inc.**, 530 Fairview Ave N, Seattle, WA 98109, USA
2. **Luxendo GmbH**, Im Breitspiel 2-4, 69126 Heidelberg, Deutschland
3. **Bruker Nederland B.V.**, Elisabethhof 15, 2353 EW Leiderdorp, Niederlande

represented by: Oliver Jan Jüngst

PATENT AT ISSUE

European patent no° EP 4 108 782

PANEL/DIVISION

Panel 1 of the Local Division Munich

DECIDING JUDGES

This decision has been issued by Presiding Judge Dr. Matthias Zigann, the Legally Qualified Judge Tobias Pichlmaier (Judge-Rapporteur), the Legally Qualified Judge András Kupecz and the Technically Qualified Judge Eric Enderlin.

LANGUAGE OF THE PROCEEDINGS

English

SUBJECT MATTER OF THE PROCEEDINGS

Withdrawal (Rule 265 RoP) / Reimbursement of court fees (Rule 370 RoP)

## **SUMMARY OF THE FACTS**

On 1 June 2023, Claimants applied for preliminary measures due to patent infringement (UPC\_CFI\_2/2023).

The main action was filed on 31 August 2023 (UPC\_CFI\_298/2023). The amount in dispute was stated as 10 million €. An advance payment of 76,000 € was paid towards court fees. Defendants filed a counterclaim for revocation on 11 December 2023 (CC\_592964/2023, CC\_593060/2023, CC\_593069/2023). The amount in dispute was stated as 10 million €. An advance payment of 20,000 € was paid towards court fees. The written procedures have not yet been formally closed. A date for the oral hearing has already been set. The parties have filed more than 30 different applications (including Rule 333 RoP and appeal) within the infringement and counterclaim proceedings, which had to be processed by the Court. In this regard, reference is made to the content of the CMS. The Court had to render numerous orders and decisions in this regard, some of which required lengthy explanations.

On 26 February 2024, the CoA revoked the order for preliminary measures rendered by the Local Division Munich on 19 September 2023. The CoA had doubts regarding the validity of the patent at issue.

On 25 February 2025, Defendants filed an application for compensation according to Art. 60 (9), 62 (5) UPCA, Rule 213.2, Rule 354.2 RoP (App\_9111/2025). The amount in dispute on the part of Defendants was stated as 40.000.000,00 €. An advance payment of 253,000 € was made towards court fees.

In the proceedings concerning the validity of the patent at issue before the European Patent Office, the opposition division upheld the patent at issue with decision of 20 March 2025 in a limited version (auxiliary request 2).

In its request of 14 May 2025 (App\_22732/2025) Defendant's representative informed the Court that the parties have reached a settlement. Subsequently, the infringement action, the counterclaim for revocation and the application for compensation were withdrawn.

## **REQUESTS OF THE PARTIES**

### **Claimants request**

1. to allow the withdrawal of the infringement action filed on August 31, 2023 (UPC\_CFI\_298/2023) as well as of the Applications to amend the patent of August 19, 2024 (CC\_593060/2023, CC\_593069/2023, CC\_592964/2023, filed with the reply brief, and revised on April 9, 2025) and to declare the proceedings closed, according to R. 265.1, 2 RoP.
2. to refrain from a cost decision.
3. to order the reimbursement of 60 % of the court fees paid by the Claimants according to R. 370.11 RoP and R. 370.9 (b) (i) RoP.

### **Defendants request**

- to allow the withdrawal of the application for compensation and declare the proceedings closed (R. 265.2),
- refrain from a cost decision
- reimburse all court fees to the signatory's law firm bank account below:

Bird & Bird LLP  
Deutsche Bank AG  
IBAN: DE71 3007 0024 0106 6398 00  
BIC: DEUTDE33HAN  
Reference: PI damages EP782

### **Defendants further request**

- to allow the withdrawal of the counterclaim for revocation and declare the proceedings closed (R. 265.2)
- refrain from a cost decision
- reimburse any court fees in line with R. 370.9c to the signatory's law firm bank account below:

Bird & Bird LLP  
Deutsche Bank AG  
IBAN: DE71 3007 0024 0106 6398 00  
BIC: DEUTDE33HAN



Reference: Refund EP782-Counterclaim

Both parties asked the Court to refrain from a cost decision with regard to the proceedings concerned.

**Claimants further request**

to rectify the order dated 24 February 2025 (App\_15954/2024) in so far as Respondent 2 in this order is designated as “NanoString Technologies”.

## **REASONS FOR THE ORDER**

### **I. Withdrawal**

1. As long as there is no final decision in an action, a claimant may apply to withdraw his action (Rule 265 RoP). The application for withdrawal is not allowed, if the other party has a legitimate interest in the action being decided by the Court.

The parties have settled. Therefore, there is no legitimate interest in the actions (infringement action and counterclaim for revocation) being decided by the Court. Consequently, the withdrawals are permitted.

2. An application for compensation according to RoP Rule 213.2 is also to be treated as an action within the meaning of Rule 265.1 RoP. There is no apparent reason why the withdrawal of an application under Rule 213 RoP should not be possible.

The withdrawal of the application for compensation was declared before a final decision by the Court was issued. Since the parties have settled, Respondents have no legitimate interest pursuant to Rule 265.1 RoP.

3. The consequence of permitting a withdrawal is, according to Rule 265.2(a) and (b) RoP, to give a decision declaring the proceedings closed and to order the decision to be entered on the register.

### **II. Reimbursement of court fees for the infringement action and the counter-claim for revocation**

With regard to the infringement action and the counterclaim for revocation, only 40% of the court fees paid can be reimbursed.

The following reasons are decisive for this:

The purpose of the graduated scale for the reimbursement of fees in the event of the withdrawal of an action (Rule 370.9 RoP) is to ensure that the efforts already incurred by the Court are adequately remunerated. That means: The later an

action is withdrawn, the higher the estimated efforts incurred by the Court are and, as a result, the lower the refund will be.

This purpose is also subject of Rule 370.9(e) RoP. According to this rule, the court in exceptional cases may deny or decrease the reimbursement payable under Rule 370.9(b) and (c), taking into account in particular the stage of the proceedings.

In the case at hand the parties have conducted the proceedings outstanding intensively. Therefore, until the withdrawal exceptionally high efforts of the Court were caused, far above the average amount of work to be expected at this stage of the proceedings. This easily can be shown by the number of applications filed.

Therefore, the requested reimbursement of 60% had to be rejected pursuant to Rule 370.9 (e) RoP. This rule would not apply if the present case were not covered by it. In view of this, the panel considers it justified to limit the proportional reimbursement of court fees for the infringement action and the counterclaim for revocation to 40 % in each case.

### **III. Reimbursement of court fees for the application for compensation**

With regard to the application for compensation (App\_9111/2025), 60% of the court fees paid will be reimbursed.

1. Pursuant to Rule 370.9(b)(i) RoP in conjunction with Rule 370.11 RoP, 60 % of the court fees paid are to be reimbursed if the action – as in this case – is withdrawn before the closure of the written procedure.
2. Consequently, the court fees paid by Defendants regarding the application for compensation according to RoP Rule 213.2 are subject to a reimbursement according to Rule 370 RoP.

3. Contrary to defendant's view, there is no entitlement to a full refund of the court fee paid by Defendants for the application for compensation (Rule 213.2 RoP).

Defendants justified their request for full reimbursement on the grounds that there is no legal basis for charging a fee in this case. This view is not to be followed.

The payment of these court fees has not been made voluntary or without legal basis. The filing of the application for compensation according to RoP Rule 213.2 is subject to court fees. These fees have been correctly calculated by Defendants in accordance with the value in dispute stated. These fees are not covered by the fees paid by Claimant for the application for preliminary measures.

The legal basis for these fees are Rules 370.2(e), 132 ("Fee for the Application for the determination of damages") RoP. The expression "damages" used in Rule 132 RoP (Chapter 4: Procedure for the determination of damages and compensation) shall be deemed to include compensation according to Rule 213.2 RoP. This is explicitly stated in Rule 125 RoP (sentences 2 and 3).

Defendants are reminded that the UPC is not based on the principle of free proceedings, but on the idea that the party who initiates proceedings and thus an activity of the Court by filing a statement of claim or an application must pay fees. Article 70 UPCA generally provides that the parties to the proceedings shall pay court fees for legal proceedings. The determination of compensation according to Rule 213.2 RoP may be the subject of separate proceedings (Rule 125 RoP). Article 36(3) UPCA ensures that the parties have to contribute for the costs incurred by the Court (LD Munich, UPC\_CFI\_487/2023, ACT\_595922/2023, ORD\_23222/2025). It cannot be inferred from Article 36(2) or (3) UPCA that certain types of actions or applications are to be exempted from the general obligation to pay fees.

## ORDER

1. The withdrawal of
  - the infringement action filed on 31 August 2023 (UPC\_CFI\_298/2023),
  - the counterclaim for revocation filed on 11 December 2023,
  - the application to amend the patent filed on 19 August 2024 (CC\_593060/2023, CC\_593069/2023, CC\_592964/2023) and
  - the application for compensation (App\_9111/2025)is permitted.
2. The proceedings mentioned in No. 1. and their respective workflows still open are declared closed. Any remaining deadlines and dates in the above mentioned proceedings are cancelled.
3. This decision is to be entered on the register.
4. It is declared that there is no need for a cost decision.
5. The amount in dispute for the infringement action and the counterclaim for revocation is set at a total of 20.000.000,00 €. The amount in dispute for the application for compensation was stated as 40.000.000,00 €.
6. Claimants are to be reimbursed 40 % of the court fees of the infringement action (UPC\_CFI\_298/2023) paid by them, and thus an amount of € 30.400,00. The further application is rejected.
7. Defendants are to be reimbursed 40 % of the court fees of the counterclaim for revocation paid by them, and thus an amount of € 8.000,00 to the signatory's law firm bank account below:

Bird & Bird LLP  
Deutsche Bank AG  
IBAN: DE71 3007 0024 0106 6398 00  
BIC: DEUTDE33HAN  
Reference: Refund EP782-Counterclaim

8. Defendants are to be reimbursed 60 % of the court fees of the application for compensation (App\_9111/2025) paid by them, and thus an amount of € 151.800,00 to the signatory's law firm bank account below:

Bird & Bird LLP  
Deutsche Bank AG  
IBAN: DE71 3007 0024 0106 6398 00  
BIC: DEUTDE33HAN  
Reference: PI damages EP782

The further application is rejected.

9. The order dated 24 February 2025 (App\_15954/2024) is rectified in so far as Respondent 2 (President and Fellows of Harvard College, Suite 727E, 1350 Massachusetts Avenue, Massachusetts 02138, USA) in this order by clerical mistake is designated as "NanoString Technologies Inc., 530 Fairview Ave N – 98109 – Seattle (WA) – USA".

Dr. Zigann Presiding Judge	Matthias ZIGANN <small>Digital unterschrieben von Matthias ZIGANN Datum: 2025.07.15 11:11:14 +02'00'</small>
Pichlmaier Legally Qualified Judge Judge-Rapporteur	Tobias Günther Pichlmaier <small>Digital unterschrieben von Tobias Günther Pichlmaier Datum: 2025.07.15 08:30:10 +02'00'</small>
Kupecz Legally Qualified Judge	András Ferenc Kupecz <small>Digital unterschrieben von András Ferenc Kupecz Datum: 2025.07.15 08:58:16 +02'00'</small>
Enderlin Technically Qualified Judge	Eric ENDERLIN <small>Signature numérique de Eric ENDERLIN Date : 2025.07.15 10:32:27 +02'00'</small>

## INSTRUCTION FOR THE REGISTRY

The Registrar is instructed to make payments according to this order to Defendants and Claimants.