

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 16 July 2026
clarification on a conditional counterclaim for revocation

HEADNOTES

- 1) Limiting a counterclaim for revocation by making it conditional upon a finding of infringement is permissible.
- 2) There is a need for clarification on such a conditional counterclaim if and when the infringement claimant appeals from a finding of non-infringement by the Court of First Instance.
- 3) In the event of an appeal by the infringement claimant, the counterclaimant may appeal against the Court of First Instance's decision not to decide on the counterclaim for revocation. Even though upon a finding of non-infringement a decision not to decide on the counterclaim is in accordance with the counterclaimant's request, the (conditional) counterclaimant must nevertheless be considered to have a legitimate interest in an appeal since, if the Court of Appeal were to overturn the Court of First Instance's decision and finds an infringement, the condition would be fulfilled and the decision of the Court of First Instance holding that the condition was not fulfilled must be set aside.
- 4) The counterclaimant may lodge an appeal pursuant to R. 220.1(a) RoP under the condition that the infringement claimant lodges an appeal against the decision in the infringement action. Once an appeal in the infringement action is lodged, the applicable (regular) appeal fee must be paid. If no appeal against the decision in the infringement action is lodged, the condition under which the appeal in the counterclaim for revocation action was lodged is not fulfilled, the appeal is considered to be not lodged and no appeal fees shall be due.
- 5) On appeal, the counterclaim for revocation remains conditional, unless the counterclaimant would request to remove the condition and pursue its claim unconditionally. Such a request will then be subject to leave to change claim pursuant to R. 263 RoP by analogy, and R. 222.2 RoP.
- 6) If the condition to which the counterclaim for revocation action is subjected is fulfilled due to a finding of infringement by the Court of Appeal, the Court of Appeal shall as a rule not refer the counterclaim back to the Court of First Instance, but shall decide on it, in accordance with Art. 75(1) UPCA and R. 242.2(b) RoP, last sentence.

KEYWORDS

Conditional counterclaim for revocation

APPELLANT (AND CLAIMANT AND COUNTERCLAIM-DEFENDANT BEFORE THE COURT OF FIRST INSTANCE)

Emboline, Inc., Santa Cruz, United States

(hereinafter 'Emboline')

represented by Dr. Thure Schubert, attorney at law, and other attorneys at law of the law firms Vossius & Partner Patentanwälte Rechtsanwälte mbB, Munich, Germany and KIPA AB, Helsingborg, Sweden

RESPONDENT (AND DEFENDANT AND COUNTERCLAIMANT BEFORE THE COURT OF FIRST INSTANCE)

AorticLab srl, Samone, Italy

(hereinafter 'AorticLab')

represented by Sabine Agé, attorney at law of Hoyng Rokh Monegier, Paris, France, and other attorneys at law of the law firm André Roland, Lausanne, Switzerland

PATENT AT ISSUE

EP 2 129 425

PANEL AND DECIDING JUDGE

Panel 2

This order was issued by Rian Kalden, presiding judge and judge-rapporteur

IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

Decision of the Local Division Munich issued on 13 January 2026 in the infringement proceedings UPC_CFI_628/2024

POINT AT ISSUE

Clarification of a conditional counterclaim for revocation

LANGUAGE OF THE PROCEEDINGS

English

REASONS

1. In proceedings at first instance, Emboline lodged an infringement action against Aorticlab.
2. AorticLab lodged a counterclaim for revocation and requested that the Local Division Munich (LDM) revoke the patent at issue in its entirety with effect in all the Contracting Member States of the UPC in which the patent has effect (Art. 65(2) UPCA, R. 25 RoP). However, during the oral hearing, Aorticlab declared that it would not pursue its counterclaim as originally filed and instead made the counterclaim dependent on the occurrence of a finding of patent infringement by the Court.
3. In its decision of 13 January 2026, the LDM considered that neither the UPCA or Rules of Procedure indicate that making a counterclaim conditional upon a finding of infringement is inadmissible and furthermore that, since Aorticlab requested this limitation without any further condition, making the counterclaim conditional upon a finding of infringement by the Court constitutes an unconditional limitation of the counterclaim in accordance with R. 263.3 RoP.

4. Since the LDM held that the patent had not been infringed, the condition for deciding the counterclaim was not fulfilled. Consequently, the LDM did not decide on the counterclaim, held that the costs incurred in relation to the counterclaim are to be considered unnecessary and, pursuant to Article 69 (3) UPCA, ordered AorticLab to bear the costs.
5. The Court of Appeal agrees with the LDM that limiting a counterclaim for revocation by making it conditional upon a finding of infringement is permissible. Even if R. 263.3 RoP is not directly applicable since it is not the claim(s) but rather the entire action that is limited by making it conditional, the balance of interests under R. 263.3 corresponds to that in the case of making a counterclaim for revocation conditional. Failing a Rule covering such a situation, R. 263.3 RoP shall apply by analogy. Thus, if the counterclaimant unconditionally requests that its claim is made conditional upon a finding of infringement, pursuant to R. 263.3 RoP by analogy, such request shall be granted.
6. Since the possibility of making a counterclaim for revocation conditional upon a finding of infringement is not expressly addressed in either the UPCA or the Rules of Procedure, there is a need for clarification on such a conditional counterclaim if and when the original infringement claimant appeals from a finding of non-infringement by the Court of First Instance.
7. In the event of an appeal by the infringement claimant (here Emboline), the counterclaimant (here Aorticlab) may appeal against the Court of First Instance's decision not to decide on the counterclaim for revocation. Even though upon a finding of non-infringement a decision not to decide on the counterclaim is in accordance with the counterclaimant's request, the (conditional) counterclaimant must nevertheless be considered to have a legitimate interest in an appeal since, if the Court of Appeal were to overturn the Court of First Instance's decision and finds an infringement, the condition would be fulfilled and the decision of the Court of First Instance holding that the condition was not fulfilled must be set aside.
8. The counterclaimant may lodge an appeal pursuant to R. 220.1(a) RoP under the condition that the infringement claimant lodges an appeal against the decision in the infringement action. Once an appeal in the infringement action is lodged, the condition is fulfilled and the applicable (regular) appeal fee must be paid. If no appeal against the decision in the infringement action is lodged within the time period indicated in R. 224 RoP, then the condition under which the appeal in the counterclaim for revocation action was lodged is not fulfilled, the appeal is considered to be not lodged and no appeal fees shall be due.
9. On appeal, the counterclaim for revocation remains conditional, unless the counterclaimant would request to remove the condition and pursue its claim unconditionally. Such a request will then be subject to leave to change claim pursuant to R. 263 RoP by analogy, and R. 222.2 RoP.
10. If the condition to which the counterclaim for revocation action is subjected is fulfilled due to a finding of infringement by the Court of Appeal, the Court of Appeal shall as a rule not refer the counterclaim back to the Court of First Instance, but shall decide on it, in accordance with Art. 75(1) UPCA and R. 242.2(b) RoP, last sentence.
11. Aorticlab has not appealed against the decision of the Court of First Instance of 13 January 2026 to not decide on the counterclaim for revocation. The time period for lodging an appeal under R. 224.1(a) RoP has lapsed.
12. Since the possibility of making a counterclaim for revocation conditional upon a finding of infringement is not expressly addressed in either the UPCA or the Rules of Procedure, and it has only been clarified in this order how the counterclaimant should proceed upon a finding of non-infringement by the Court of First Instance, Aorticlab may wish to request re-establishment of rights pursuant to R. 320 RoP.

Issued on 16 July 2026

Rian Kalden, presiding judge and judge-rapporteur

Case management decisions or orders made by the judge-rapporteur shall be reviewed by the panel, on a reasoned Application by a party (R. 333.1 RoP).