

ORDER
of the Court of Appeal of the Unified Patent Court
issued on 17 August 2026
concerning a request for review pursuant to R. 333 RoP
and an application for re-establishment of rights pursuant to R. 320 RoP

HEADNOTES:

- 1) The infringement action and the counterclaim for revocation are separate actions under the UPCA and Rules of Procedure. Making the counterclaim for revocation conditional upon a finding of infringement is an ‘inter-procedural’ condition.
- 2) Whether a condition is ‘intra-procedural’ in the strict sense or ‘inter-procedural’ is relevant for the question of whether a cross-appeal may be lodged, which is possible if the condition is intra-procedural in the strict sense, or a separate appeal must be lodged, which is the case if the condition is inter-procedural.
- 3) Whether the condition of a finding of infringement must be considered intra-procedural or inter-procedural has no relevance for the question of whether making a counterclaim conditional upon a finding of infringement is permissible. Nothing in the UPCA or Rules of Procedure suggests that this is excluded per se.
- 4) Where a counterclaim for revocation is made conditional upon a finding of infringement, the claims remain unchanged but are limited in terms of need for adjudication. It does not mean that the entire counterclaim for revocation action as such is made conditional upon a finding of infringement in the sense that it would not be pending as long and/or as soon as the condition is not fulfilled. R. 263.3 RoP applies by analogy (see clarification order of 16 July 2026 in UPC-CoA-40/2026).
- 5) Where a counterclaim for revocation is made conditional upon a finding of infringement by ‘the Court’, in the absence of an explicit indication by a party to the contrary (e.g. by explicitly referring to ‘the Court of First Instance’), ‘the Court’ must be understood as to refer to both the Court of First Instance and the Court of Appeal. Consequently, after a finding of non-infringement by the Court of First Instance, the conditional counterclaim is still ‘pending’ for the duration of the appeal period and the decision may be appealed from, after which it becomes pending before the Court of Appeal.
- 6) In R. 242.2(b) RoP the wording ‘failed to decide’ does not (only) refer to an ‘omission attributable to the Court’, but refers to any situation where something relevant for a decision on appeal was not decided upon at first instance, regardless of the reason therefor. There is no indication in R. 242.2(b) RoP and no reason to treat non-decided infringement and invalidity arguments differently.

KEYWORDS:

infringement action and the counterclaim for revocation separate actions; relevance of intra-procedural and inter-procedural condition, application of R. 263.3 by analogy; meaning of ‘the Court’; meaning of ‘failed to decide’ in R. 242.2(b) RoP.

RESPONDENT (DEFENDANT BEFORE THE COURT OF FIRST INSTANCE) IN UPC-CoA-40/2026

APPELLANT (COUNTER-CLAIMANT BEFORE THE COURT OF FIRST INSTANCE) IN UPC-CoA-123/2026

AorticLab, srl, Colletterto Giacosa, TO, Italy

(hereinafter also referred to as “AorticLab”)

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

APPELLANT (CLAIMANT BEFORE THE COURT OF FIRST INSTANCE) IN UPC-CoA-40/2026

RESPONDENT (COUNTER-DEFENDANT BEFORE THE COURT OF FIRST INSTANCE) IN UPC-CoA-123/2026

Emboline Inc., Santa Cruz, CA, United States of America

(hereinafter also referred to as “Emboline”)

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

PATENT AT ISSUE

EP 2 129 425

LANGUAGE OF THE PROCEEDINGS

English

DECIDING JUDGES

Panel 2

Rian Kalden, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Ingeborg Simonsson, legally qualified judge

Renaud Fulconis, technically qualified judge

Max Tilmann, technically qualified judge

IMPUGNED DECISION OF THE COURT OF FIRST INSTANCE

Decision of the Local Division Munich issued on 13 January 2026 in the infringement (UPC-CFI-628/2024) and
counterclaim for revocation proceedings (UPC-CFI-125/2025)

SUMMARY OF FACTS

1. Emboline filed a Statement of claim against AorticLab, alleging that AorticLab infringes the patent at issue.
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).
3. 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.

4. In its decision of 13 January 2026, the LDM held that the patent had not been infringed and that 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 Art. 69(3) UPCA, ordered AorticLab to bear the costs.
5. Emboline filed an appeal against the dismissal of the infringement action.
6. In its clarification order of 16 July 2026 (the 'Clarification order'), the Court of Appeal (presiding judge and judge-rapporteur) considered as follows (para. 3-10):

"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.”

7. The Court of Appeal also considered (para. 12) that

“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.”

8. On 24 July 2026, AorticLab filed a Statement of appeal and grounds of appeal against the impugned decision. Simultaneously therewith it filed an application for the re-establishment of rights pursuant to R. 320.2 RoP. AorticLab seeks re-establishment of its right to lodge a Statement of appeal against the impugned decision and to file a Statement of grounds of appeal.

9. Emboline has been given the opportunity to comment on AorticLab’s Application pursuant to Rule 320.2 RoP and on the judge-rapporteur’s proposal that the Statement of response be lodged no later than 24 September 2026.

10. On 29 July 2026 Emboline informed the Court that the proposed deadline of 24 September 2026 for filing a response to Respondent’s appeal on the counterclaim for revocation is acceptable, however, without prejudice to its position that AorticLab’s conditional counterclaim is impermissible under the UPCA, that AorticLab’s Application for re-establishment of rights should be rejected, and that AorticLab’s conditional appeal is inadmissible.

11. On 31 July 2026, Emboline filed an Application for review of the Clarification order.

12. Emboline in its submission requests that panel 2 of the Court of Appeal:

- set aside the Order of 16 July 2026 in its entirety;
- find that a conditional counterclaim for revocation is not permissible under the UPCA and the Rules of Procedure and that the counterclaim for revocation is deemed to be withdrawn;
or, as an alternative, that the unconditional counterclaim lodged on 17 February 2025 remains pending before the LDM, as the LDM has made no decision on the counterclaim;
- in the alternative, if a conditional counterclaim is held to be permissible, find that the conditional counterclaim was late-filed on 2 December 2025;

- in the further alternative, if a conditional counterclaim is held to be permissible and not late-filed, find that the counterclaim for revocation is no longer pending and be deemed "not filed" upon the finding of non-infringement;
- in an even further alternative, if a conditional counterclaim is held to be permissible and not late-filed, and still pending, find that an appeal by AorticLab against a decision on the counterclaim for revocation is not permissible;
 - as there is no decision by the LDM on the counterclaim which can be appealed and
 - as AorticLab is not adversely affected by the decision of the LDM as it ruled exactly as requested by AorticLab who is therefore not wronged and thus not entitled to appeal;
- in a final, further alternative, if an appeal with respect to the counterclaim for revocation is held to be permissible, find that in the event the Court of Appeal will find infringement on appeal, the counterclaim for revocation should be referred back to the court of first instance for decision, rather than decided by the Court of Appeal for the first time;
- decide this Application for review before, or together with, AorticLab's Application for Re-establishment of rights in proceedings UPC-CoA-123/2026;
- order AorticLab to bear the costs of this Application for review, including reimbursement of the fee paid pursuant to R. 333.3 RoP

13. Emboline commented on AorticLab's Application for re-establishment of rights on 6 August 2026 and (among other requests) requested that it be rejected.

14. AorticLab was given the opportunity to comment on Emboline's Application for Review, which it did on 7 August 2026. It requests that the Application and the requests therein be dismissed and that Emboline be ordered to bear the costs.

GROUND

Emboline's request for review pursuant to R. 333 RoP

15. Emboline argues that a conditional counterclaim for revocation is not permissible under the UPCA and the Rules of Procedure. It also argues that under the allegedly (directly or *mutatis mutandis*) applicable R. 265 RoP it should have been heard and that "the counter-defendant may have a legitimate interest that the court decides on the counterclaim, in particular when the arguments of counterclaimant are not persuasive and counter-defendant seeks to obtain a positive decision with respect to the validity of the asserted patent."

16. If this argument must be understood as an allegation that Emboline has been negatively affected by the LDM's acceptance of AorticLab's request to make the counterclaim conditional upon a finding of infringement, Emboline should have appealed from the LDM's decision of 13 January 2026, where the LDM explicitly considered that neither the UPCA nor the Rules of Procedure indicate that making a counterclaim conditional upon a finding of infringement is inadmissible. Emboline has not done so within the applicable time period for an appeal and cannot circumvent this by challenging the Clarification order.

17. There is also no reason to set the Clarification order aside, since it rightly concurs with the LDM's finding that a counterclaim may be made conditional upon a finding of infringement.

18. Emboline argues that an intra-procedural condition may only be given within one action and the infringement action and the counterclaim for revocation are separate actions. The Court of Appeal agrees that the infringement action and the counterclaim for revocation are separate actions under the UPCA and Rules of

Procedure. This is, as Emboline rightly notes, for instance clear from the fact that they are separately mentioned in Art. 32(1) UPCA under (a) and (e) respectively, with the revocation action also mentioned as a separate action (under (d)); that the infringement action and counterclaim may be bifurcated (Art. 33(3)(b) UPCA); and that a withdrawal of the infringement action has no effect on the counterclaim (R. 265.2 RoP). The possibility of lodging a separate revocation action does not render the possibility of lodging a counterclaim for revocation unnecessary, since other than in revocation proceedings, the procedural framework in relation to a counterclaim for revocation ensures that it is adjudicated alongside the infringement action.

19. The LDM referred to the condition of a finding of infringement as an *intra-procedural* condition. If the LDM intended to express therewith that it is a condition within the same action, then that would be incorrect, since a finding of infringement is made within the infringement action, which, as said, is an action different from the counterclaim for revocation proceedings. Making the counterclaim for revocation conditional upon a finding of infringement is thus rather an ‘inter-procedural’ condition.
20. Whether a condition is ‘intra-procedural’ in the strict sense or ‘inter-procedural’ is relevant for the question of whether a cross-appeal may be lodged, which is possible if the condition is intra-procedural in the strict sense, or a separate appeal must be lodged, which is the case if the condition is inter-procedural, such as in this case (see also para. 48 below).
21. However, whether the condition of a finding of infringement must be considered intra-procedural or inter-procedural has no relevance for the question of whether making a counterclaim conditional upon a finding of infringement is permissible. Nothing in the UPCA or Rules of Procedure suggests that this is excluded per se. R. 30.1(c) RoP allows an Application to amend the patent containing conditional proposals for amendments of the claim(s). Art. 56(1) UPCA explicitly provides that the Court may make its orders subject to conditions, in accordance with the Rules of Procedure. R. 118.2(a) RoP provides that the Court may render its decision in infringement proceedings under the condition subsequent that the patent is not held invalid by the final decision in revocation proceedings pending before the central division (i.e. a different action) or a final decision of the European Patent Office (i.e. even a different body) or under *any other term or condition*.
22. It is fully in line therewith that a party may also make its counterclaim for revocation conditional upon a finding of infringement. This also follows from the fact that under the UPCA and the Rules of Procedure the subject-matter of a claim or counterclaim is defined by the party bringing it.
23. Pursuant to Art. 43 UPCA, the Court shall actively manage the cases before it, but without impairing the freedom of the parties to determine the subject-matter of their case. In addition, according to Art. 76(1) UPCA, the Court shall decide in accordance with the requests submitted by the parties and shall not award more than is requested. It therefore cannot be regarded as contrary to procedural autonomy of the Court as envisaged by Art. 33(3) UPCA (which concerns the question of which court shall adjudicate the counterclaim) if a party wishes to make its (counter)claim conditional upon a finding of infringement (which concerns the different question of whether the counterclaim needs to be adjudicated at all), as Emboline asserts. Rather, it is a party’s prerogative.
24. It also follows from R. 263.1 RoP that a party may at any stage of the proceedings apply to the Court for leave to change its claim or to amend its case. According to R. 263.3 RoP leave to limit a claim when it is applied for unconditionally *shall* always be granted. Making a claim conditional is a limitation, because it limits the circumstances under which it is required to be adjudicated. Making a claim conditional upon a certain occurrence can be done unconditionally.

25. The underlying rationale of this Rule is that a party is free to narrow the scope of its own claim, because it does not worsen the procedural position of the other party if the claimant seeks less relief than previously requested and thus cannot prejudice it. The question of whether the claimant would need to limit its claim is not relevant. A limitation does not require any justification.
26. The same rationale applies where a counterclaim for revocation is made conditional upon a finding of infringement. It narrows the circumstances in which the Court is asked to adjudicate on the requests of that action. Making a counterclaim conditional upon a finding of infringement therefore does not adversely affect the other party's procedural position. It follows that the counterclaimant does not require a justification for doing so, as Emboline seems to suggest (para. 16 Application for review).
27. Where a counterclaim for revocation is made conditional upon a finding of infringement, the claims remain unchanged but are limited in terms of need for adjudication. It does not mean that the entire counterclaim for revocation action as such is made conditional upon a finding of infringement in the sense that it would not be pending as long and/or as soon as the condition is not fulfilled. R. 263.3 RoP applies by analogy (see clarification order of 16 July 2026 in UPC-CoA-40/2026).
28. To the extent that R. 263.3 RoP does not apply directly, there is room for the application of R. 263.3 RoP by analogy. There is a clear unintended legislative gap in the UPCA and Rules of Procedure. The fact that the UPCA recognizes the prerogative of the parties to determine the subject-matter of their case and recognizes conditional decisions shows that the absence of provisions on conditional counterclaims is not a deliberate choice, but rather an oversight. Application of R. 263.3 RoP by analogy is also justified, since the rationale underlying R. 263.3 RoP applies equally to a limitation of a claim in the strict sense and to making it conditional upon the outcome of other proceedings in the sense that it limits the circumstances under which it must be tried. In addition, in both situations the position of the other party is not adversely affected.
29. Emboline's argument that it should rather be R. 265 RoP (request for withdrawal of an action) that should apply by analogy to a request to make a counterclaim conditional must thus be dismissed. A request for withdrawal leads to the action ceasing to exist immediately after it has been allowed, which is obviously not the counterclaimant's intention, which clearly is that its action is still adjudicated (only) under certain circumstances.
30. Emboline has advanced in that respect (para. 23 Application for review) that "[a]ccording to R. 265.1 RoP, the court needs to decide about the withdrawal of the claim after hearing the other party and shall not be permitted if the other party has a legitimate interest in the action being decided by the court. In this context, the counter-defendant may have a legitimate interest that the court decides on the counterclaim, in particular when the arguments of counterclaimant are not persuasive and counter-defendant seeks to obtain a positive decision with respect to the validity of the asserted patent". If Emboline meant to argue it should have been heard, it should have appealed from the LDM's decision if it was negatively affected. It is unclear whether Emboline meant to argue that it had an interest to be heard. The Court of Appeal anyway notes that Aorticlab's declaration that it would not pursue its counterclaim as originally filed and instead made it dependent on the Court's finding of patent infringement, was made during the oral hearing (impugned decision at para. 61). This would have enabled Emboline to object right away, if it had identified an interest in doing so. Moreover, and as mentioned above, a limitation by making a counterclaim conditional cannot be considered to adversely affect the counter-defendant. In addition, the interest mentioned by Emboline is not a 'legitimate' interest. The UPCA and Rules of Procedure do not provide for the possibility that the patentee obtains a positive

decision with respect to the validity of the asserted patent. While a party may request a declaration of non-infringement, the possibility of a declaration of validity by the Court is not foreseen in the UPCA.

31. Consequently, since AorticLab's request to make the counterclaim conditional cannot be considered as a withdrawal and refiling of a new action at the oral hearing, leading to it being late filed, it is not inadmissible, as Emboline contends (para. 55 et seq. Application for review).
32. Contrary to Emboline's argument, the non-fulfilment of the condition does not lead to the action ceasing to exist, being considered not-filed or being withdrawn. As considered above, since it is not the action itself, but rather the claims that are limited by the condition, the only consequence of non-fulfilment of the condition is that there is no need for the Court to decide on the substance of the counterclaim. It also does not lead to a situation where there is no decision at all. Indeed, the Court still needs to decide the action, i.e. declare that the condition is not fulfilled and issue a cost decision, as the LDM rightly did (in Emboline's favour). Where the LDM stated that 'no decision had to be made upon the counterclaim', this is to be understood in the sense that the Court did not have to adjudicate the counterclaim in substance, since the LDM clearly rendered a decision.
33. The fact that a cost decision is rendered does not indicate that the LDM 'disposed' of the action, rather it decided pursuant to Art. 69 UPCA who shall have to bear the costs of the action, which – as in any action decided upon by the Court of First Instance – may be reversed by the Court of Appeal pursuant to R. 242.1 RoP.
34. In addition, where a counterclaim for revocation is made conditional upon a finding of infringement by 'the Court', in the absence of an explicit indication by a party to the contrary (e.g. by explicitly referring to 'the Court of First Instance'), 'the Court' must be understood as to refer to both the Court of First Instance and the Court of Appeal. According to Art. 2 UPCA, 'the Court' means the Unified Patent Court created by the Agreement and according to Art. 6 UPCA the Court shall comprise a Court of First Instance and a Court of Appeal. The condition of a finding of infringement by 'the Court', must thus be understood to mean a *final* finding of infringement, i.e. in case the infringement claimant appeals from a finding of non-infringement by the Court of First Instance, a finding of infringement by the Court of Appeal.
35. Consequently, after a finding of non-infringement by the Court of First Instance, the conditional counterclaim is still 'pending' for the duration of the appeal period and the decision may be appealed from, after which it becomes pending before the Court of Appeal.
36. As already stated in the Clarification order, and not disputed by Emboline, the counterclaimant's interest in bringing its conditional counterclaim before the Court of Appeal lies in the circumstance that the Court of First Instance's finding that the condition was not fulfilled is (retrospectively) wrong, if the infringement claimant appeals from the finding of non-infringement and the Court of Appeal finds that the patent is infringed. In addition, if the Court of Appeal finds the patent to be invalid, so is the cost decision. The counterclaimant thus has a clear interest that the counterclaim is adjudicated on appeal as soon as the condition becomes fulfilled. The possibility of filing a separate revocation action at that time does not take away the interest in having its counterclaim adjudicated at the same time. Lodging a separate revocation action would, to the contrary, lead to a considerable time lag between the (final) decision finding an infringement and the decision in the revocation action.

37. As already explained above, under the UPCA it is the prerogative of a party to determine the subject-matter of its case. There is nothing in the UPCA or the Rules of Procedure that would prevent a party from filing an appeal in the counterclaim for revocation under the condition that an appeal will be lodged in the infringement action. The Clarification order therefore did not create an entirely new procedural instrument, as Emboline asserts (para. 25 Application for review), but rather pointed to an already existing possibility under the UPCA and Rules of Procedure. Also, since there is a decision (to the effect that the condition is not fulfilled and a cost decision) it is not a new type of appeal against a non-decision, as Emboline also argues (para. 43 Application for review).
38. Emboline also without success argues that the Court of Appeal cannot decide on the counterclaim for revocation once the condition of a finding of infringement has been fulfilled, but should refer it back to the Court of First Instance. R. 242.2(b) RoP provides that "It shall not normally be an exceptional circumstance justifying a referral back that the Court of First Instance failed to decide an issue which it is necessary for the Court of Appeal to decide on appeal." The wording 'failed to decide' does not (only) refer to an 'omission attributable to the Court', but refers to any situation where something relevant for a decision on appeal was not decided upon at first instance, regardless of the reason therefor.
39. The Court of First Instance is not obliged to decide on any and all arguments brought forward by the parties, but only insofar as relevant to decide on the requests. If the patent is held to be invalid in the counterclaim for revocation, there is no need to decide in substance on whether an embodiment falls within the scope of a claim and would thus infringe a patent, since an invalid patent cannot be infringed. Equally, if a patent is held to be invalid due to added matter, there is no need for the Court to decide whether it would also be invalid for lack of novelty or inventive step. If, on appeal, the Court of Appeal decides differently, e.g. in the given examples holds the patent to be valid or not to contain added matter, then the other arguments – in the examples: infringement and further invalidity arguments – need to be considered in order to decide on the requests. These are issues that the Court of First Instance 'failed to decide' in the sense of R. 242.2(b) RoP. Nothing else follows from the Court of Appeal's decision in *Rematec v Europe Forestry* (UPC_CoA_302/2025 and UPC_CoA_305/2025, of 17 February 2026) that Emboline referred to. There is also no indication in R. 242.2(b) RoP and no reason to treat non-decided infringement and invalidity arguments differently in this respect, as also follows from case law of this Court (e.g. *Abbott v Sibio*, UPC-CoA-382/2024 of 14 February 2025).
40. There is no indication in R. 242.2(b) RoP and also no justification to treat a situation where at first instance some issues were left undecided because a condition was held to be not fulfilled and on appeal it is held to be fulfilled, differently. For the Court of First Instance there was no need to consider the invalidity arguments, while it would need to be decided once the Court of Appeal finds an infringement. Contrary to Emboline's argument, where the conditional counterclaim is not stayed awaiting the decision in the infringement action (such as in the present proceedings) the submissions in relation to the conditional counterclaim must be fully developed, because the parties do not know in advance whether the condition will be fulfilled or not, since that depends on the Court's decision in the infringement action.
41. There is also no justification for a referral back to the First Instance because "it deprives the patent holder of the right to have validity assessed by a panel including a technically qualified judge selected for the specific field of technology", as Emboline asserts (para. 36 Application for review) since the case will be decided on appeal by a panel with two technically qualified judges selected for the specific field of technology. Contrary to Emboline's assertion, there is also no 'fundamental' right to have all issues decided in two instances. This

directly follows from Art. 75(1) UPCA and R. 242.2(b) RoP.

42. Contrary to Emboline's arguments, Art. 75 UPCA does not presuppose an earlier decision by the Court of First Instance on all arguments. It presupposes a decision in the action which may be revoked and provides that a new decision is then rendered by the Court of Appeal. That new decision may rest on other arguments, not previously decided upon by the Court of First Instance, as follows from R. 242.2(b) RoP. As already said, also in case of a conditional counterclaim where the condition is not fulfilled, there still is an action and a decision in that action, notably stating that the condition is not fulfilled and a cost decision.

43. Given that the UPCA and the Rules of Procedure allow a party to make its revocation action conditional upon a finding on infringement, either upon filing or by later limitation, as considered above, where any issues have not been decided at first instance, the non-fulfilment of a condition is not 'an exceptional circumstance' as meant in R. 242.2(b) RoP that would necessitate a referral back to the Court of First Instance to have the issues decided. Quite to the contrary, it would be contrary to the purpose of the possibility to file a counterclaim in addition to the possibility of filing a revocation action. Where a counterclaim is filed, the Rules of Procedure provide for a mechanism that these actions proceed in parallel leading to a decision at the same time. If the counterclaim had to be referred back to the Court of First Instance upon fulfilment of the condition, i.e. a final finding of infringement which may already be enforced, the counterclaim proceedings would considerably lag behind and unduly disadvantage the counterclaimant.

44. None of Emboline's objections against the Clarification order succeed, and the requested review and requests therein shall therefore be rejected.

AorticLab's Application for Re-establishment of rights

45. In view of what has been considered above in relation to Emboline's rejected Application for review, AorticLab's Application to re-establish its right to lodge a Statement of appeal against the impugned decision and to file a Statement of grounds of appeal must be granted.

46. The possibility of making a counterclaim for revocation conditional upon a finding of infringement – which the LDM allowed – is not expressly addressed in either the UPCA or the Rules of Procedure. There was therefore 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, as is the case in the appeal proceedings UPC-CoA-40/2026.

47. The Court of Appeal provided this clarification in its order of 16 July 2026, therefore after the time period of 2 months of service of the impugned decision within which pursuant to R. 224.1(a) RoP an appeal against the impugned decision should have been lodged, and after the time period of 4 months of service of the impugned decision within which pursuant to R. 224.2(a) RoP a Statement of grounds of appeal should have been lodged.

48. In view of the case law of the Court of Appeal on the required interest in an appeal in accordance with R. 220.1 RoP, which states that an appeal may be brought by a party "adversely affected" (orders of 17 April 2026 in UPC-CoA-901/2025, *Abbott v Sinocare* and of 2 July 2026 in UPC-CoA-19/2026, *Guardant Health v Sophia Genetics*), it was not obvious that a conditional counterclaimant would have a sufficient interest in an appeal where the Court of First Instance, in accordance with such counterclaimant's request, did not decide on the counterclaim for lack of fulfilment of the condition and ordered the counterclaimant to bear the costs as having been unnecessarily made.

49. That is particularly so, since the LDM referred to the condition of a finding of infringement as an intra-procedural condition, which led AorticLab to believe that it would be allowed to cross-appeal together with its Statement of response, as it indeed brought forward. Given that the infringement proceedings and counterclaim for revocation proceedings are distinct proceedings, which need to be appealed separately, that is however not possible. A cross-appeal can only be lodged in the same (appeal) proceedings. Thus, in an appeal against a decision in an infringement action, a cross-appeal cannot attack a decision in the counterclaim for revocation action. That also applies if the decisions are contained in one and the same document which is called 'Decision' (in singular).
50. AorticLab could thus reasonably trust that the Court would not allow a request by a counterclaimant to make its claim conditional upon a finding of infringement, without there being a possibility that the counterclaimant pursue its conditional counterclaim upon a finding of infringement on appeal. Considering the above-mentioned case law, which AorticLab could reasonably interpret such that it failed the required interest in bringing an appeal from the outset, and the indication of the condition as 'intra-procedural', AorticLab could reasonably assume that it would at any rate still be allowed to pursue its counterclaim as part of its Statement of response or as part of a cross-appeal to be filed together with its Statement of response pursuant to R. 237 RoP.
51. The requirement for re-establishment of rights pursuant to R. 320 RoP, that AorticLab failed to observe the time-limit for lodging an appeal pursuant to R. 224.1(a) RoP despite all due care having been taken by it for a cause which was outside its control, has thus been fulfilled. The non-observance of the time limit has furthermore had the direct consequence that an appeal became inadmissible, since pursuant to R. 9.4 RoP the time-limit of R. 224.1 RoP shall not be extended.
52. The Application has been filed and the fee due has been paid within one month of the removal of the cause for non-observance of the time limit as required by R. 320.2 RoP, i.e. within one month after the Clarification order was issued. In compliance with R. 320.4 RoP the Statements of appeal and grounds of appeal have been lodged within the same time limit.
53. Emboline has not raised any other arguments against AorticLab's Application than those brought forward in its Application for review. As considered above, these are all unfounded and must be dismissed.
54. Emboline's reservation of right to submit further observations on AorticLab's Application for Re-establishment of rights and the request to be informed before the expiry of AorticLab's deadline of 16 August 2026 for further substantiating its application, has no basis in the Rules of Procedure. The time limit of R. 320 RoP within which an Application of Re-establishment of rights is to be filed is exactly that: a time *limit*. There is no automatic right for further substantiation of an Application once it has been filed but the time-period of R. 320.2 RoP has not yet expired, as Emboline suggests. AorticLab also did not request to complete or supplement its Application at a later stage and nothing in AorticLab's Application suggests it was not in its final form. Also, the order allowing Emboline to comment on the Application set a time limit for it to do so, and there was no indication that Emboline was entitled to further comment thereafter. That was apparently also not how Emboline has understood the order, as it explicitly requested an extension of the deadline (which the Court has granted, albeit not as long as Emboline had requested), which would not have been necessary if Emboline would have had the right to further supplement its submission at a later stage. Finally, there is anyway no situation where there would be a need to hear Emboline on the Application 'as finally constituted' as AorticLab did in fact not supplement its Application.

55.The fact that Emboline has not made any comments on whether the requirements of R. 320 RoP are satisfied at the stage of filing their comments to AorticLab’s Application despite having been given the opportunity to do so pursuant to R. 320.6 RoP is its own choice and not reason to give it another opportunity to comment on the Application.

56.In view of the fact that in its Statement of appeal and grounds of appeal, AorticLab refers to its first-instance pleadings setting out the grounds for revocation and supporting exhibits, because the impugned decision did not rule on the counterclaim for revocation, the judge-rapporteur considers a time period for lodging the Statement of response of two months after AorticLab’s statement was lodged sufficient. In accordance with R. 9.3(b) RoP the Court of Appeal therefore shortens the time period for filing the Statement of response to two months, so that it shall be lodged ultimately on 24 September 2026. Emboline has expressed its agreement therewith.

57.This order does not close an action, so there is no need for a cost decision at this stage.

ORDER

The Court of Appeal:

- I. rejects the requested review of the Clarification order and dismisses the requests contained therein;
- II. re-establishes AorticLab’s right to lodge a Statement of appeal against the impugned decision and to lodge a Statement of grounds of appeal;
- III. declares the Statement of appeal and grounds of appeal filed on 24 July 2026 to be admissible;
- IV. sets the time period for lodging the Statement of response at 2 months after filing the Statement of appeal and grounds of appeal.

Issued on 17 August 2026

Rian Kalden, legally qualified judge and judge-rapporteur

Patricia Rombach, legally qualified judge

Ingeborg Simonsson, legally qualified judge

Renaud Fulconis, technically qualified judge

Max Tilmann, technically qualified judge