

Kluwer Patent Blog

Abbott Diabetes Care Inc. v Sibio Technology Limited – an update

Gregory Bacon, Aida Tohala (Bristows) · Friday, August 23rd, 2024

Background

In June 2024, we [reported](#) that in an application for provisional measures brought by Abbott Diabetes Care against Sibio Technology, The Hague Local Division (“LD”) determined, *inter alia*, that it had competence for Ireland, in the sense that it could grant a PI extending to Ireland under European patent validated in that country. In Abbott’s application, it had stated: “*The Patent is valid and in force in the Contracting Member States of Germany, France, The Netherlands and also Ireland. It is also in force in the UK.*” The order Abbott sought included a request for provisional measures “*for the Contracting Member States in which the patent is in force*”. The Hague LD determined that when read together, the application and order sought indicated that Abbott was seeking the order to cover Ireland which was a Contracting Member State of the UPCA since it had signed the agreement (albeit not yet ratified it). The Court concluded it did have competence over Ireland in view of Art. 31 of the UPCA and certain provisions of the Brussels Regulation (recast), and the fact that Sibio had not challenged the competence of the UPC to grant relief covering Ireland.^[1] An order was granted accordingly. This point of the judgment has now been assessed by the Court of Appeal. In a [decision](#) issued on 19 August 2024, the Court of Appeal has clarified that this finding was “*manifestly erroneous*”.

Court of Appeal weighs in

Although Sibio had not contested the UPC’s competence over Ireland at the first instance stage, it did take issue with this when appealing against the order granted. In the grounds of appeal, Sibio requested that the appeal have suspensive effect pending determination of their appeal against grant of the PI, or alternatively, that it have suspensive effect to the extent that the order extended to Ireland. The Court of Appeal thus had to decide whether the circumstances justified an exception to the default principle that an appeal has no such suspensive effect.

The Court of Appeal held that the first instance court’s reasoning based on Ireland’s signing of the UPCA was clearly wrong as only countries which have both signed and ratified the UPCA are Contracting Member States thereof. Ireland therefore cannot be considered to have been covered by Abbott’s stated request for provisional measures. As such, The Hague LD’s order contravened Art 76 UPCA by awarding more than was requested. Sibio’s failure to challenge the court’s competence on this point was not held against it as the Court of Appeal noted that Sibio did not have to expect The Hague LD’s mistaken interpretation of Abbott’s claim as it did. Therefore, the

Court of Appeal granted the request for suspensive effect only insofar as the order applied to Ireland.

An alternative argument?

What the Court of Appeal's decision does not address (and therefore appears to remain fair game for parties to argue in future cases) is whether the UPC has jurisdiction over countries which are parties to the Brussels Regulation (recast), which would include Ireland, based on the provisions thereof, so long as the requested relief is properly framed to extend to those countries. Indeed, this would be a fair alternative reading of The Hague LD's first instance reasoning, at least in relation to provisional measures.

Potentially, this argument was not advanced by Abbott in its Statement of Response, or opposed by Sibio in its Statement of Appeal, given the absence of a discussion of this in the Court of Appeal's judgment. The case is an example of where the lack of transparency as to parties' filings presents difficulties for third parties wishing to fully understand the nuances of published decisions. Without having access to the arguments presented to the court, third parties are fully reliant on the deciding court comprehensively summarising the arguments in the published decision in order to fully appreciate what was considered and decided. As such, if anything is left out, the public are only actually getting an incomplete view of the decision being made, which in this case was on a limited pleading point. That is not to say that is what happened here – but then again, it is anyone's guess other than for those who were party to the proceedings in question.

The decision also suggests that certain provisions of the UPCA that refer to Contracting States, including Art. 33(1) on claims against defendants outside the territory of the Contracting Member States, Art. 36 on financial contributions from the Contracting Member States, Art. 48(1) on Authorised Representatives, Art. 65 on revocation of patents, and Art. 83 on enforcement in Contracting Member States, will not in the future be interpreted to extend to countries such as Ireland that have signed but not yet ratified the Agreement.

How to claim suspensive effect on appeal

Finally, the Court of Appeal has also helpfully clarified that a request for suspensive effect does not need to be lodged in a separate application from the appeal in order to be admissible. However, the Court added that a separate application would be advisable if a decision on the point was urgent, but is not necessary as it is clear from the wording in R.223 RoP that such an approach “*may*” be followed.

[1] Articles 26, 35 and 71, 71a and 71b Brussels Regulation 1215/2012 as amended by EU Regulation 542/2014

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).

Kluwer IP Law

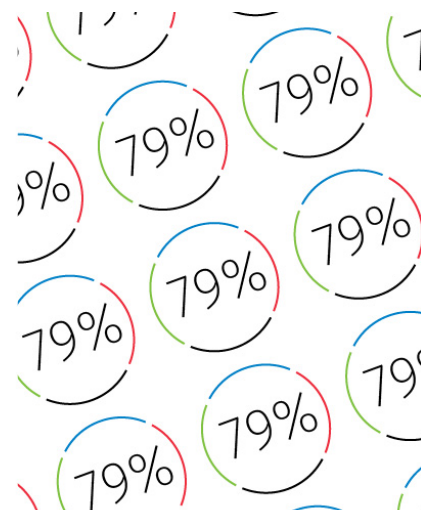
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Friday, August 23rd, 2024 at 10:56 am and is filed under [Case Law](#), [Litigation](#), [UPC](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.