

EIP

Paris local division revokes DexCom patent

DexCom, Inc. v Abbott Laboratories and nine other Abbott entities (UPC_CFI_230/2023)

Decision of 4 July 2024 (ORD_37297/2024) [1]

The second decision on the merits from the UPC, following just a day after the first, comes from the Paris Local Division, in a case heard in the English language.

DexCom asserted EP3435866, concerning a glucose monitoring system, against Abbott. The patent was asserted in respect of all the states that had ratified the UPC Agreement, with the exception of acts committed by three of the named defendants [2], which were already the subject of infringement proceedings and a revocation action nationally in Germany. (There was also parallel litigation in UK, where the patent was revoked by consent).

Abbott counterclaimed for revocation. DexCom argued that under the lis pendens rules of Art. 31 UPCA, and Art. 71c(2), Art. 30(2) of EU Regulation 1215/2012 ("Brussels I recast"), the UPC should decline jurisdiction with respect to Germany, since there was already a German revocation action pending.

The court considered that since there was not identity of parties between the UPC action and the German actions, there was no mandatory stay as provided by Art 29 of Regulation 1215/2012; the actions were considered to be "related actions" according to Art 30 of Regulation 1215/2012 and so a stay was discretionary. Since the Paris court was in a position to render judgment, and the German revocation action was not scheduled for an oral hearing until 29 January 2025, the court considered that it was not in the interests of the proper administration of justice either to decline jurisdiction in favour of the German national court or to stay proceedings pending the decision of the national court. It therefore decided to maintain jurisdiction to rule on the validity of the entire European

patent, including its German part.

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Turning to the validity of the patent, the court considered that the claimed invention represented an obvious modification of the prior art US 2015/0205947 (D1; Berman) in view of the common general knowledge. A first auxiliary request was considered not to cure the lack of inventive step, and a second auxiliary request was considered to involve added matter.

Having decided that the patent was invalid, the court did not rule on whether it was in fact infringed.

Accordingly, the court ordered that the patent be revoked for all 17 UPC member states, dismissed the infringement action, and ordered DexCom to pay the costs of the proceedings. It did not however allow Abbott's request for an interim award of costs of €100,000.

[1] <https://www.unified-patent-court.org/en/node/900>

[2] Abbott Laboratories, Abbott Diabetes Care Inc. and Abbott GmbH