



**Order**  
**of the Court of First Instance of the Unified Patent Court**  
**issued on 21 May 2025**  
**concerning EP 2 352 431 B1**

**HEADNOTES:**

The burden of showing that the enforcement of a cost order is unduly burdensome is on the applicant of an order for security for costs. To this end, the applicant in its application shall not only provide evidence as to the foreign law applicable in the territory where the order shall be enforced, but also its application.

**KEYWORDS:**

Security for costs.

CLAIMANT:

**Hologic, Inc.**, 250 Campus Drive, Marlborough, MA 01752, United States of America, represented by its President & CEO Stephen MacMillan

(hereinafter Hologic or Claimant)

Represented by: Attorney-at-law Dr Thure Schubert, Attorney-at-law Christian-Leopold Zapp, Attorney-at-law Arnold Asmussen, Attorney-at-law Dr Christoph Eisenmann, Vossius & Partner Patentanwälte Rechtsanwälte mbB, Siebertstraße 3, 81675 Munich, Germany

Electronic address for service: vb-hologic-siemens@vossiusbrinkhof.eu

DEFENDANTS:

1. **Siemens Healthineers AG**, Siemensstr. 3, 91301 Forchheim, Germany
2. **Siemens Healthcare GmbH**, Henkestr. 127, 91052 Erlangen, Germany
3. **Siemens Healthineers Nederland B.V.**, Prinses Beatrixlaan 800, 2595 BN Den Haag, The Netherlands
4. **Siemens Healthcare SAS**, 6 rue du Général Audran, 92400 Courbevoie, France

(hereinafter all defendants together Siemens or Defendants)

All Defendants represented by: Attorney-at-law Dr Matthias Meyer, Attorney-at-law Dr Daniel Misch, Patent Attorney Dr Felix Harbsmeier, Patent Attorney Cameron Walker, Bird & Bird LLP, Carl-Theodor-Straße 6, 40213 Düsseldorf, Germany

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PATENT AT ISSUE:

European Patent No. 2 352 431 B1

PANEL/DIVISION:

Panel of the Düsseldorf Local Division

DECIDING JUDGES:

This Order was issued by Presiding Judge Thomas, legally qualified Judge Dr Thom acting as judge-rapporteur and legally qualified Judge Rinkinen.

LANGUAGE OF THE PROCEEDINGS: English

SUBJECT OF THE PROCEEDINGS: Patent infringement action - R. 158 RoP application for security for costs

### PARTIES' REQUESTS

Siemens request that the Court

1. orders Hologic to provide security for the legal costs and expenses of the Defendants which the Claimant may be liable to bear in the present infringement proceedings and in the parallel counterclaim for revocation, namely
  - EUR 600,000 for the infringement proceedings and
  - EUR 600,000 for the counterclaim for revocation,
2. sets the Claimant a deadline of three weeks, to provide the security according to request 1.

Hologic requests that the Court rejects the Defendants' request for security for costs.

### BACKGROUND AND SUMMARY OF FACTS

Hologic has lodged the Statement of Claim in infringement proceedings (UPC\_CFI\_758/2024, ACT\_63758/2024) on 2 December 2024.

Siemens has lodged the Counterclaim for revocation (UPC\_CFI\_259/2025, CC\_14403/2025) on 26 March 2025 and this Request for security for costs (App\_16529/2025) on 4 April 2025.

The value of the proceedings has not been set by the Court but the Claimant has proposed a value of the infringement procedure of EUR 5 million. The Defendants propose that the value of the counterclaim should be at least the same as the infringement action.

Based on the costs ceiling as set by the Administrative Committee (Scale of Ceilings for Recoverable Costs adopted by the Administrative Committee on 24 April 2023) the maximum ceiling for costs in each of these proceedings is EUR 600,000 if the value is set on EUR 5 million.

### SUBMISSIONS OF THE PARTIES

Siemens argues that enforcing a potential cost order against the Claimant would be unduly burdensome for the Defendants as the Claimant has its registered place of business in Massachusetts in the United States of America, which has not ratified any international agreement regarding the recognition of foreign judgments. Enforcing a judgment in Massachusetts would require another court procedure in that state, which would create uncertainty and additional costs.

Hologic argues that mere foreign domicile does not warrant such an order but a demonstrable risk of non-enforceability of costs and/or concrete indications of financial instability are required. It is commonplace and day-to-day practise in the United States of America to enforce foreign judgments. Claimant disputes that the judicial recognition procedure of UPC judgments in Massachusetts, or Delaware which is the state of incorporation of the Claimant, is uncertain and entails significant costs. Claimant is solvent Nasdaq traded S&P 500 company. Furthermore Claimant holds significant assets within European Union and has number of European subsidiaries.

In addition the Claimant argues that request for security as counterclaimant is inadmissible as such security can be ordered only based on the request of a defendant.

Furthermore the Claimant argues that should the security be ordered it should be maximum of EUR 200,000 and only for the infringement procedure.

#### GROUND OF THE ORDER

Based on Article 69(4) of the Agreement on a Unified Patent Court (UPCA), at the request of the defendant, the Court may order the applicant to provide adequate security for the legal costs and other expenses incurred by the defendant which the applicant may be liable to bear, in particular in the cases referred to in Articles 59 to 62 UPCA.

According to R. 158.1 of the Rules of Procedure of the UPC (RoP), at any time during proceedings, following a reasoned request by one party, the Court may order the other party to provide, within a specified time period, adequate security for the legal costs and other expenses incurred and/or to be incurred by the requesting party, which the other party may be liable to bear. Where the Court decides to order such security, it shall decide whether it is appropriate to order the security by deposit or bank guarantee.

The Claimant has argued that the application is inadmissible concerning the counterclaim for revocation because a security can be ordered only based on a request of a defendant. This LD has already in its order 3 December 2024 (UPC\_CFI\_140/2024, App\_48598/2024), and the case law referred to in the order answered the Claimants inadmissibility arguments. Based on the grounds presented already in the aforementioned order, it is clear that also the claimant, under R. 158.1 RoP, is permitted to submit a request for security for costs, as this rule does not restrict such actions to a defendant only. Hence, the Claimant's argument regarding the inadmissibility of the application must be rejected as such.

The Defendants base their application merely to the argument that it would be unduly burdensome for them to enforce a cost decision against the Claimant as the Claimant has its registered place of business in Massachusetts, United States of America.

The Court of Appeal of the UPC (CoA) has on its order 29 November 2024 (UPC\_CoA\_548/2024, APL\_52969/2024) ruled that, when deciding on a request for security for costs, it is not required that it is proven that enforcement is impossible. It is sufficient for a defendant to establish that enforcement of a cost order is unduly burdensome. The burden of showing this is on the applicant of an order for security for costs. To this end, the applicant shall not only provide evidence as to the foreign law applicable in the territory where the order shall be enforced, but also its application.

The Defendants have not provided evidence of the applicable foreign law, just an argument about such, nor have they provided evidence about the application of such law. The Claimant argues that the enforcement of UPC orders and decisions is not unduly burdensome in the United States of America.

The Court finds already based solely on the above that the Defendants have not provided sufficient evidence for the application for security for costs to be accepted. Furthermore, the Court notes that, according to the UPC case law, US courts routinely recognise and enforce judgments of foreign courts (Local Division Munich, 23 April 2024, UPC\_CFI\_514/2023, ORD\_12227/2024). This

notion of the LD Munich was not considered otherwise by the CoA on its order 17 September 2024 (e.g. UPC\_CoA\_218/2024, APL\_25922/2024) even though the order of the Munich LD was set aside for other reasons.

Therefore, the Court does not need to decide whether the security calculation is based on the correct figures, especially on two ceilings which is rather doubtful.

ORDER:

The request for security for costs is dismissed.

Issued in Düsseldorf on 21 May 2025

NAME AND SIGNATURE

|                                  |  |
|----------------------------------|--|
| Presiding Judge Thomas           |  |
| Legally qualified Judge Dr Thom  |  |
| Legally qualified Judge Rinkinen |  |

DETAILS OF THE ORDER:

App\_16529/2025 under main file reference ACT\_63758/2024 and CC\_14403/2025

UPC number: UPC\_CFI\_758/2024 and UPC\_CFI\_259/2025

Type of procedure: Infringement action and Counterclaim for revocation