

Cross-border decisions and the UPC

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In September 1948 the French Senator Henry Longchambon proposed to the Council of Europe the creation of a European Patent System. His ideas led to the European Patent Project. The original idea was not only to have a central European grant system (as we know nowadays) but also to have a European enforcement system. However, it proved impossible to reach consensus and it was decided to continue only with what has now become the EPC. So the result was that it became relatively easy to obtain a patent which was valid in (nowadays) 48 countries but enforcement in the territory covered by the EPC requires many parallel proceedings which certainly for smaller companies proves (financially) impossible and easily results in conflicting decisions with respect to the same European Patent despite the fact that on validity and infringement the same provisions of the EPC are applicable.

In my thesis in 1988 I defended the possibility of so called cross-border injunctions especially referring to the Brussels Convention on jurisdiction of 1968² and one year later in 1989 the President of the District Court of the Hague mr. Brinkhof granted, as I believe, the first cross-border injunction with respect to an European Patent³. In the nineties the cross-border injunctions of the Dutch court became an efficient means of enforcement of European Patents. However, in *Roche vs. Primus*⁴ the ECJ held that there was no possibility of irreconcilable judgments if the codefendants (of the Dutch defendant) established in other EU and Lugano countries each infringed only in their own country the same European patent with the same product even if they all belonged to the same concern. The decision of the ECJ was an example of a political decision especially to satisfy the (patent community in the) UK which was unhappy with Dutch courts making decisions for the UK (“cowboy justice”). The ECJ used as argument first of all that there were different defendants which of course was a non-sensical argument as more defendants was (and is) the essence of (then) Art. 6 under 1 of the Brussels Convention (now Art. 8 under 1 of the Brussels Regulation). A further main argument was that different national laws were applicable in the different countries with respect to the European Patent. This was justified by quoting only the first part of Art. 2(2) of the EPC (see consideration 11 of the ECJ judgment) and not the part which states that indeed national law is applicable but “unless this Convention provides otherwise”. So what ECJ stated was simply not true for the infringement question at hand. In all countries the same law was applicable: Art. 69 EPC. What made it worse was that in the report for the hearing this incomplete citation of Art. 2(2) had appeared and that the ECJ during oral argument specifically was pointed to the fact that the citation was incomplete and incorrect as Art. 69 if the EPC applied in all countries.

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2 W.A. Hoyng, *Repareren in het Octrooirecht* (diss. Tilburg), Tilburg: Tilburg University 1988, Chapter 10, and especially footnotes 8-11.

3 President Court the Hague 17 May 1989, ECLI:NL:RBSGR:1989:AM1399, *BIE* 1990/51 (*Langen vs. Stork*).

4 European Court of Justice 13 July 2006, C-539/03, ECLI:EU:C:2006:458, *NJ* 2008/79, ann. P. Vlas, *BIE* 2006/72 (*Roche vs. Primus*).

The decision has been severely criticized and seems after among others *Painer*⁵ not any more good law. In *Solvay vs. Honeywell*⁶ in which case different defendants (among which in this case a Dutch defendant) infringed the same (national) European Patents (among which not the Dutch European Patent⁷) the ECJ accepted the possibility that in provisional or preliminary decisions a court (in this case the Dutch Court) can deal on a provisional basis with the validity of foreign patents. This made it possible for all EU courts to grant preliminary cross-border injunctions against company A established in the country of the court (and codefendants of other countries if in these countries also company A infringes). However, other courts than the Dutch Courts do not grant such injunctions “finding” procedural reasons to abstain. There also have been several examples where Dutch and also UK courts have entertained the possibility to ask for cross-border declarations of non- infringement against a patentee which resides or has a place of business in the country of the court but in practice this is seldom done because one cannot raise invalidity arguments in such proceedings⁸.

The conclusion has to be that there are certainly possibilities in national EU courts and especially the Dutch Court to obtain cross-border relief but that these possibilities are rather limited.

This is now going to change (in part) with the coming into force of the Unified Patent Court Agreement (UPCA) and the Unitary Patent Regulation (which makes it possible to obtain one patent – a UP – for all participating countries contrary to an EP which leads to a bundle of national rights).

As in the meantime the Provisional Application Protocol has been in force since 19 January 2022, it is at the time of this writing to be expected that during the first quarter of 2023 at the latest the Unified Patent Court (UPC) opens its doors. At the time of this writing this means that in that Court Unitary Patents and European Patents (and SPC's) for 17 EU countries can be litigated unless the patentee in accordance with Art. 83 of the UPCA has opted out that European Patent. As to the Unitary Patents the Court has exclusive jurisdiction. With respect to non-opted out European patents they can be also litigated during the transitory period of 7 years in national courts.

The UPC consists of a Court of First Instance and a Court of Appeal. The Court of First Instance consists of Local Divisions: 4 in Germany and one in all other participating countries⁹ except Luxemburg, Malta and Bulgaria (where for the moment no Division is planned) and the Baltic countries and Sweden who will have together one Regional Division. Finally, there will be one Central Division with location (for the moment) in Paris and Munich. At the moment the plan is to divide the (pharma) work of the location London (after Brexit the UK withdrew from the UPCA) between Paris and Munich until there is a decision about a new location.

A decision of a Division will have effect for a UP or EP (and SPC's) for all the participating countries. The following countries have not ratified until now: Greece, Romania, Cyprus (there is

5 ECJ 1 December 2011, C-145/10, ECLI:EU:C:2011:798, NJ 2013/66, ann. T.M. de Boer; IER 2012/16, ann. S.J. Schaafsma (*Painer vs. Standad Verlags. GmbH*).

6 ECJ 18 October 2012, C-616/10, ECLI:EU:C:2012:193, NJ 2013/67, ann. C. Gielen; IER 2012/62, ann. S.J. Schaafsma (*Solvay vs. Honeywell*).

7 as that patent had a different claim.

8 See f.i. *Actavis vs. Eli Lilly*, UK Supreme Court [2017] UKSC48.

9 Germany, France, Finland, Denmark, the Netherlands, Italy, Belgium, Slovenia and Austria.

a plan in these countries to have with Bulgaria a Regional Division), Hungary, the Czech Republic and Slovakia. Poland (which had signed the UPCA), Spain and Croatia have indicated not to join (for the moment).

This is therefore both for the patentee and for third parties who look for invalidity or a declaration of non-infringement a big improvement compared to the present situation where (with the exception of the above described cross-border possibilities) in each country of the EU the patent has to be enforced or revoked. On the other hand, the risk for a patentee is that he loses his EP (UP) patent in all participating countries if a Division finds the patent invalid.

The patentee of an UP patent and a non-opted out EP will have in general a wide choice in which Division he wants to enforce his patent. However, as to the enforcement of an EP patent this cross-border enforcement possibility offered by the UPC Agreement can easily be frustrated by an (invalidity and/or declaration of non-infringement) action in a national court during the transitory period of 7 years (which may be extended to 14 years – see Art. 83 under 5 UPCA –). In a situation where a case is pending in a national court Art. 71c jo. 29-32 of the Brussels Regulation apply. The UPC has then no jurisdiction for such country. Although such a national case would also give the UPC the possibility on the basis of Art. 30 Brussels Regulation to suspend a case which is started (later) in the UPC for the countries where no national proceedings are pending it is hoped that the Court will not do so.

Assuming no such action is pending between the patentee and the defendant, the patentee can sue for infringement in any Local or Regional Division in the territory of which infringement is committed or threatens. This gives, certainly if the infringement threatens or is committed in the whole territory of the UPC, a possibility of forum shopping.

Although it may be expected that Divisions will not operate in very different fashions and will try to apply the law and the Rules of Procedure in as much the same way, there will certainly be differences especially also because the Rules of Proceedings leave a lot of maneuvering space for the Divisions which may lead to certain differences as Divisions come from different national traditions. On the one hand one has for instance the German tradition of bifurcation and emphasis on the written submission and an aversion against the hearing of experts while on the other hand one has for instance the Scandinavian more Anglo-Saxon way of conducting a case. Another example is the German custom that the Presiding Judge at the start of the oral hearing gives a summary of the case and often the preliminary view of the Court. Especially the latter is certainly “not done” in most other jurisdictions. Of course, the Divisions have a multinational composition but in countries with more than 50 cases a year such as Germany, France, the Netherlands and Italy this still means that two out of the three legal judges are from the local country.

Before the entry into force of the UPCA meetings are foreseen between all the judges to try to avoid as much as possible serious differences between Divisions. Of course, expertise and speed will certainly be a consideration when one chooses its forum. The Netherlands has an attitude to get on with the case and to not let all kind of formal objections and procedural maneuvering get in the way. That is different in the tradition of Italy and France where procedural maneuvering is often causing delays and national patent courts have never been able to decide patent cases within a year. Of course, the quality of the national judgments in the past and also the attitude towards patents (how strict is the court on inventive step, how liberal as to the doctrine of equivalence)

may all be considerations. Last but not least, linguistic considerations may play a role. Although all Divisions accept at least English as a second language that certainly does not mean that the linguistic capabilities will be the same for all Divisions. In that sense the Dutch Division can be a good choice. In the Netherlands the judges have not only always accepted all English language documents without translation but frequently speak English in court for instance when non-Dutch speaking experts or witnesses are being heard. It is clear that such linguistic capabilities are very important for a successful hearing.

Apart from the place of (threatened) infringement the place where the defendant has its residence will give the Division jurisdiction. If the defendant has no residence then the (principal) place of business is sufficient to create jurisdiction. This is especially important if one wants to sue multiple defendants such as all the local distributors who may only sell in their own territory. As long as there is a commercial relationship with the defendant (f.i. the supplier of the local distributors) one can sue these defendants in the same Division¹⁰.

It is also important to realize that each party has always the right to ask the President of the Court in First Instance to appoint a fourth technical judge. If a counterclaim for invalidity is filed and the Division decides to deal with that claim itself (and not refer it to the Central Division) such fourth technical judge is compulsory. Apart from a possible choice between a Local or Regional Division the patentee may also chose to bring his case in the Central Division because this Division is competent for infringements in countries which do not have a Local Division. This would avoid the risk of bifurcation which (in theory) exist in a Local or Regional Division which can send the invalidity case to the Central Division and suspend the infringement case. However, certainly outside Germany (with its bifurcation tradition) this seems not very likely as it causes (certainly in the case of suspension of the infringement case) delay which is not in the spirit of the UPC. However, one can imagine this tool being used in cases where the invalidity arguments are clearly without merit. In such situation the Divisions can speed things up by referring the invalidity case to the Central Division and continuing with the infringement case.

These forum shop possibilities do not exist for third parties who want to invalidate the patent and/or ask for a declaration of non-infringement. These actions have to be brought before the Central Division except if already an infringement action between the same parties is pending then these actions can also be brought before the same Local or Regional Division where such case is pending. In case an action for revocation is first filed and thereafter the infringement action then the Local or Regional Division where the infringement action is filed can decide to deal with the whole case or leave the revocation case in the Central Division and continue with the infringement case or suspend that case or with the agreement of the parties send also the infringement case to the Central Division. With respect to an action for a declaration of non-infringement filed in the Central Division the patentee can, within three months after the filing in the Central Division, file an infringement case in a competent Local or Regional Division and the case in the Central Division will then be suspended. The patentee can also chose to file in the Central Division a cross complaint for infringement.

The conclusion is that the UPC system is as far as jurisdiction concerned very patentee friendly. It is the patentee who decides where the litigation takes place even in cases in which third parties,——

¹⁰ See hereafter with respect to distribution in EU countries outside the UPC area.

such as a generic, take the initiative. This is only different if a third party (such as a generic) decides to first clear the way and not to (threaten to) infringe as long as the invalidity case has not been decided by the Central Division. Moreover, the patentee can avoid for future patents to be sued in undesirable national courts of the UPC states by asking for a Unitary Patent. The downside is only that if his UP is invalidated that means that he loses his patent for the whole of the UPC¹¹. However, one may expect that the UPC will not be stricter on invalidity than the Boards of Appeal of the European Patent Office where in opposition a patent can be lost for the whole of the EPC. If the UPC on validity would be stricter than the EPO or national courts, it will be clear that the UPC will not become a success!

Although decisions in the UPC are “cross-border” it is clear that the UPC has not yet achieved the original idea of a truly European Patent Jurisdiction. That was the original plan of the founding fathers of the EPC and even the idea of a Community Patent as laid down in the Community Patent Convention has not been achieved as Spain, Poland and Croatia do not participate in the UPC while EPLA (European Patent Litigation Agreement) with even broader geographic coverage was torpedoed by the European Commission¹² and the original geographically broader UPC by the ECJ (although opinions as to the true effect of the ECJ’s opinions on this differ)¹³.

While EU countries like Spain, Croatia and Poland for different reasons do not want to join a country as Switzerland, which would gladly have participated, has been kicked out because the UPC is (for the moment) only open for EU countries. If we realize that European Patents are granted nowadays for 38 countries, one can imagine that the UPC is a big step forward for an efficient enforcement of European Patents but that certainly a lot remains to be desired. It is therefore interesting to see if the Unified Patent Court just like the national courts has also true cross border powers. Can it also deal with infringements of European Patents in other countries than UPC countries?

In this respect it is good to realize that what has been described until now hereabove as to jurisdiction is based on Art. 33 UPCA which deals with the internal jurisdiction between the Divisions of the Court. Art. 31 UPCA states that the international jurisdiction of the Court is established in accordance with the Brussels Regulation and the Lugano Treaty.

The fourth “whereas” of Regulation (EU) No. 542/2014 which introduced articles 71a-d of the Brussels Regulation¹⁴ reads as follows:

“The Unified Patent Court and the Benelux Court of Justice should be deemed to be a court within the meaning of Regulation (EU) 2015/2012 in order to ensure legal certainty and predictability for defendants who could be sued in those courts at a location in a Member State other than the one designated by the rules or Regulation (EU) no 2015/2012”.

11 However, this effect can be mitigated by filing national patents. In for instance Germany and France such national patents can exist alongside EP or UP patents.

12 See for its history Wikipedia “European Patent Litigation Agreement”.

13 Opinion of the Court of 8 March 2011, C-1/09, ECLI:EU:C:2011:123 and the ECJ decisions in the challenges by Spain: ECJ 5 May 2015, C-146/13, ECLI:EU:C:2015:298, NJ 2016/192 (*Spain vs. European Parliament and Council of the European Union*) and ECJ 5 May 2015, C-147/13, ECLI:EU:C:2015:299, NJ 2016/193 (*Spain vs. Council of the European Union*).

14 Confusingly these articles are in the Dutch text given the numbering 71bis tot quinquies!

The fact that the UPC has to be considered as a national court of a Member State as stated in this “whereas” follows from the new Article 71a of the Brussels Regulation which together with Art. 71b-d were especially introduced in the Regulation in order to provide for the coming into force of the UPCA.

As it was realized that the Brussels Regulation had not been written with respect to a court whose jurisdiction covered more than one country the UPC Agreement specifically stated (in art. 89 under 1 UPCA) that it would not enter into force before the Regulation would have been amended.

Art. 71a under 1 reads as follows:

(1) For the purposes of this Regulation a court common to several Member States as specified in paragraph 2 (“a common court”) shall be deemed to be a court of a Member State when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of this Regulation.

In par 2 of Art. 71 sub a the UPC and the Benelux Court are said to be “common courts”.

This therefore makes in my view clear that for UPC matters the UPC area is considered as one country with one court. In fact, this also follows from the fact that with respect to non EU defendants for the UPC (and the Benelux Court) one special jurisdiction rule has been created. The Regulation refers for these defendants in art. 6 under 1 for the question whether a national court has jurisdiction to the national law of the EU country where the non-EU defendant is sued. For the UPC Territory there is no such national law. So that “national” law (for the UPC Territory) had to be created and that is exactly what the amended Regulation does in Art. 71b under 2 which reads:

(2) where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, Chapter II shall apply as appropriate regardless of the defendant’s domicile.

Applications may be made to a common court for provisional, including protective, measures even if the court of a third State has jurisdiction as to the substance of the matter.

So the conclusion has to be that with respect to jurisdiction there is no difference between EU residents or non EU residents and that the UPC court is a court for the UPC Territory just like a national court is for an EU country;

It has been argued that certain provisions of Art. 33 (the internal division of jurisdiction between the Divisions) are not in accordance with the Brussels Regulation. As an example, for instance, one can think of a Dutch company infringing in Luxemburg an EP. Under the Brussels Regulation that Dutch company can only be sued in the Netherlands (Art. 4) or in Luxemburg (Art. 7 under 2) and not as Art. 33 UPCA states in the Central Court in Paris or depending on the technical content of the patent Munich (because of the fact that Luxemburg has no Local Division). However, that criticism is in my view based on not accepting that the UPC territory for the purposes of EP and UP patents has in fact to be seen as one country of the EU. Within that one country one is free to regulate which courts hear which patent cases or better which chambers (Divisions) of the one court (the UPC) hear which cases.

Art. 71b under 1 states further that a common court (such as the UPC) shall have jurisdiction where, under the Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument.

So we have to find out what are the matters governed by the UPCA. The UPCA itself makes that clear in Art. 3. Art. 3 sub c of the UPCA mentions “European Patent”. It is not restricted to European Patents granted for the territory of the UPC. In other words, the UPC can also deal with European Patents granted for countries outside the UPC territory if the courts of a Member State have jurisdiction with respect to such patents. This should mean that the UPC (on the basis of Art. 4 Brussels Regulation) would have for instance jurisdiction against a company established in the UPC territory with respect to infringement of European Patents outside the UPC Territory and more specifically the Local (or Regional) Division of the country where the infringer is established and if there is no such Local (or Regional Division) the Central Division¹⁵.

Following the caselaw of the Court of Justice in *Solvay vs. Honeywell* this would also mean that the UPC court would also have jurisdiction against codefendants located outside the UPC area if the principal defendant infringes the same patent with the same product as these codefendants. If the codefendant is established in an EU country this follows directly from Art. 8 under 1 and if located outside the EU from Art. 71b under 2 jo. Art. 8 under 1.

I believe that the stricter rule with respect to codefendants of Art. 33 under 1 sub b UPCA would only be applicable with respect to defendants located within the UPC territory and that Art. 8 under 1 of the Brussels Regulation applies to codefendants located outside that territory which means that the UPC Court would be competent against such defendants even if there is no commercial link as long as the conditions of Art. 8 under 1 are fulfilled. I come to this conclusion as the international jurisdiction according to Art. 31 UPCA is determined by the Brussels (and Lugano) Convention. However, if the UPC for UPC matters has to be seen as one territory, as I believe, the jurisdiction with respect to codefendants located within the territory of the UPC seems a local matter governed by Art. 33 lid 1 sub b UPCA.

It will be clear that just like a national EU court the UPC cannot give a (final) judgment with respect to the validity of the EP for f.i. Spain or Turkey but if the patentee would ask in the same case for a provisional injunction I do not see why such injunction would not be granted if f.i. the EP patent has already been found valid for the UPC. The UPC Agreement gives that possibility (Art. 62) and also the Rules of Proceedings seem not to prevent this.

It is true that the Rules of Proceedings do as such not provide expressly for a (conditional) application for provisional measures together with the statement of claim in main proceedings. Rule 206 considers provisional measures before or after main proceedings. However, the Rules in Article 118 under 2 under a explicitly provide in main proceedings for a conditional judgement. In other words the judgement will become null and void if f.i. the patent is invalidated. This in my view is basically the same as a provisional decision. It seems in general always prudent in main proceedings to ask for such (provisional) measures for the situation in which the court after the

¹⁵ Apart from the UPC also the national court of the country of residence of the alleged infringer would also have jurisdiction based on Art. 4 Brussels Regulation.

oral procedure cannot immediately give a final judgment because f.i. it considers further evidence is necessary on the one hand but on the other hand the conditions for provisional measures are fulfilled¹⁶. Finally, it would always be possible to ask for such provisional measures after the main proceedings f.i. after the Court would have suspended the main proceedings with respect to other than UPC countries because it cannot rule about the validity. However, that would result in a loss of time and would be very unpractical as the whole proceedings have to be repeated while in the main proceedings the Court has already dealt with the infringement and invalidity of the same patent for the UPC. However, the latter could be avoided by asking the Court to grant an ex parte preliminary injunction as infringement and validity (for the UPC countries) has already been established.

It is clear that if you accept that the UPC court has also jurisdiction with respect to European Patents granted for non UPC countries as defended hereabove that that also means that a third party can also ask the UPC to give a declaration of non-infringement with respect to a European patent which is (also) granted for non UPC countries owned by a patentee who is established in a UPC territory. The UPCA determines the Central Division as within the UPC the competent Division of the Court for such actions and determines also that the patentee can start infringement proceedings within three months in a Local or Regional Division which according to Art. 33 UPCA would have jurisdiction. So it seems applying this mutatis mutandis with respect to a non UPC European Patent that this means that if the patentee starts infringement proceedings in the countries for which the non UPC European patents are granted the Central Division will have to suspend the case which therefore would make it impossible to obtain such cross-border declaration of non-infringement. This is basically in line with the (patentee friendly) UPC: a third party cannot determine where the infringement question is determined. However, if a third party would file such a cross-border case in the Central Division and therefore himself seeks the UPC court to determine the infringement question for non UPC countries the patentee may decide to file a cross complaint for infringement (Art. 8 under 3 Brussels Regulation). Alternatively, if the demand for a declaration of non-infringement would include UPC countries, the infringement case also with respect to the infringement in non UPC countries can possibly be brought for the local or Regional Division competent to hear the infringement of the UPC patents arguing that by filing its declaration for non-infringement case in the Central Division the third party consented in the jurisdiction of the UPC. It should be noted that if the third party would not at all infringe, I do not think that a successful action for infringement could be started because of lack of interest¹⁷. In that case it seems therefore difficult for the patentee to avoid a decision of the Central Division of the UPC.

With respect to provisional measures, it seems (also) very clear that the UPC can grant cross border injunctions. This follows from Art. 7b under 2. It reads, as we have seen, as follows “*Application may be made to a common court for provisional including protective measures even if the court of a third State have jurisdiction as to the substance of the matter*”. The case law of the Court of Justice (see f.i. *Van Uden, Court of Justice C-391/95*) requires a close connection to the Court which grants such measures but accepts that the court gives also a provisional view on

16 This seems also be the best solution in case of bifurcation and the decision of the court to continue with the infringement case. The Court can give a provisional/conditional injunction in case of infringement which becomes final decision after the invalidity case has been resolved in the Central Division and the patent is maintained. In all other scenario's the injunction would cease having effect and it would be most efficient if the Central Division would deal with the consequences.

17 This would of course have to be decided by the non UPC country in which the patentee would file an infringement action in order to try to avoid a decision of the Central Division.

validity. This means that if an infringer is located in the territory of the UPC the Division of his residence (the close connection) (which as we have seen may in cases, where the country of his residence has not a Local Division, be the Central Division) can grant preliminary injunctions for the UPC and other countries for which the EP is granted. As stated above *Solvey vs Honeywell* means that also codefendants can be sued which infringe the same patent in the same territory assuming the conditions of Art. 33 sub b UPCA (for a UPC territory codefendant) or Art. 8 under 1 Brussels Regulation (for other defendants¹⁸) are fulfilled.

Art. 71b under 3 of the Brussels Regulation gives also a special jurisdiction over a defendant who is not domiciled in the EU in specific situations. It reads as follows:

“Where a common court has jurisdiction over a defendant under point 2 in a dispute relating to infringement of a European Patent giving rise to damage within the Union, that court may also exercise jurisdiction in relation to damages arising outside the Union from such infringement. Such jurisdiction may only be established if property belonging to defendant is located in any Member State party to the instrument establishing the common court and the dispute has sufficient connection with any such Member State.”

The article relates to defendants for which under the normal rules of the Brussels Convention no jurisdiction can be found but for which jurisdiction exists because of Art. 71b under 2 which states that with respect to such defendants one can also apply Chapter 2 of the Brussels Regulation. We have already seen that Art. 71 under 2 means that such non-EU defendant can be sued as codefendant in the UPC for infringements outside the UPC on the basis of Art. 8 under 1. However, this article 71b under 3 gives an extra possibility in case the conditions of the article are fulfilled¹⁹.

Again, as already stated above under the Brussels Regulation normally the question of jurisdiction with respect to a non-EU defendant would be decided according to the national law of the court where the case is brought. In the Netherlands a non-EU defendant can only be sued for infringement outside the Netherlands as a codefendant or if he has assets in the Netherlands. The fact that one can obtain a conservatory seizure of certain assets of such non-EU defendant as security for damages caused by infringement by this non EU defendant elsewhere would as such not give jurisdiction with respect to that infringement except in the situation in which Art. 767 Code of (Dutch) Civil Procedure is applicable which is the case if no decision can be obtained abroad which can be executed in the Netherlands.

The special provision of the UPC in Art. 71b (3) seems in many aspects even more limited in application because there must be damage (say: infringement) in the EU and the UPC must have jurisdiction which in general will only be the case if there is infringement in the UPC territory. If all that is the case, then the UPC court may also exercise jurisdiction with respect to damages caused by infringement outside the EU but only if there are assets of the infringer in a Member State of the UPC and there is sufficient connection with that Member State (meaning for instance that also in that State there is infringement?). The article is not applicable with respect to

¹⁸ for defendants residing in a Lugano country (Iceland, Norway or Switzerland) this would be on the basis of Art.6 under 1 of the Lugano Convention.

¹⁹ The question arises what happens as to defendants having their residence in a Lugano country. It seems to follow from Art. 64(2) of the Lugano Convention that it would be contrary the Lugano Convention for the UPC to accept jurisdiction on this basis as there is no basis for such jurisdiction in the Lugano Convention.

defendants in EU Member States which are not a member of the UPC as that would conflict with the Brussels Regulation. Such infringer has in principle to be sued in his residence country. However, as seen above, such EU defendant from outside the UPC (like a non-EU defendant) can under certain circumstances be sued as codefendant in the UPC Court. For instance, if a company established in a UPC country exports to Spain. He can together with his Spanish distributor be sued in the UPC for the infringements in Spain.

A final remark about the reverse side of all this. First of all, the possibilities of the courts in EU countries which have not (yet) joined the UPC Agreement. These are the same as presently existing (see above in the introduction). In practice it depends on the local procedural rules (and the way they are applied by the court) whether these rules provide the possibility of provisional measures/preliminary injunctions in cross-border cases like nowadays in the Dutch courts. In other words in principle a Spanish court could grant a preliminary injunction against a Spanish company not to infringe an EP patent for all the countries where this patent is in force (including the UPC countries) and if the same national EP patent is infringed with the same products by other EU entities the preliminary injunction could in the same proceedings also be pronounced against such companies if the conditions of Art. 8 under 1 of the Brussels Regulation are fulfilled.

This is the same for a Unitary Patent. If a Unitary Patent is infringed by a Spanish company the Spanish Court can also pronounce provisional measures but as with respect to non-Spanish European Patents, it can only deal with validity on a provisional basis as with respect to the validity only the (Central Division of the) UPC is competent.

As to countries outside the EU (and the Lugano countries) such as the UK it will be the national law of the UK which decides the jurisdiction with respect to foreign patents. Does the UK law give jurisdiction to the UK courts f.i. with respect to the infringement by a UK company of EU/Unitary Patents outside the UK²⁰? Can a company obtain an antisuit injunction from a UK court against a patentee which seeks in the UPC an injunction also for an U.K. European Patent?²¹ Such antisuit injunctions are not possible between EU and Lugano countries, but the UK is not a member of the EU and not a member of Lugano. The same can be true of course the other way around if the UK court threatens to deal with f.i. a cross-border declaration of non-infringement of an UP or EP. Apart from the question what the value of such decision is if not accompanied with an injunction not to enforce such patents the question arises if the UPC would be willing to grant an antisuit injunction.

In conclusion it may be expected that in the coming years interesting cases with respect to jurisdictional questions arise. Constant is not only a true expert on patent law, but he has always combined this with excellence in the field of procedural law. A brilliant lawyer, an excellent judge and a first-class professor in procedural law but equally important: a pleasant human being with whom it was good to play soccer in the Westbroek park and work as a colleague during our time at De Brauw. He would be most qualified to solve the different jurisdictional questions which will come to us in the future!

20 Under the Brussels Regulation the UK Courts held that if invalidity was raised as a defense they had no jurisdiction (Coins Control).

21 In March 2022 the UK court granted an ex parte anti antisuit injunction against Boston Scientific until the hearing of a request for an antisuit injunction by Cook for forbidding Boston Scientific to ask for an injunction under the UK EP against Cook UK in the court of the Hague in the Netherlands. After the grant of the anti-antisuit injunction Boston Scientific decided not to pursue the case in the Netherlands based on the UK patent.