UPC v. NATIONAL COURTS DURING THE TRANSITIONAL PERIOD: WHAT TO EXPECT IN TERMS OF JURISDICTION AND LIS PENDENS?

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BACKGROUND: PARALLEL JURISDICTION
No parallel jurisdiction for other proceedings mentioned in Art 32 UPCA? For example...

- Declaration for non-infringement, Art. 32(1)(b) UPCA
- Provisional and protective measures and injunctions, Art. 32(1)(c) UPCA
- Counterclaims for revocation of EO / declaration of invalidity of SPC, Art. 32(1)(e) UPCA
- Damages or compensation, Art. 32(1)(f) UPCA

Wording refers to:

- action for infringement (cf. Art. 32(1)(a) UPCA)
- revocation of an EP / declaration of invalidity of a SPC (cf. Art. 32(1)(d) UPCA)
KEY LEGAL PROVISIONS
Art. 31 UPCA refers to Brussels I-Regulation

Art. 71c Brussels I-Regulation: Art. 29 to 32 shall apply...
(1): where proceedings are brought before the UPC and a Court of a non-UPCA Member State (e.g. a Spanish or Polish Court)
(2): where proceedings are brought before the UPC and a Court of a UPCA-member-state during the transnational period (e.g. a, French, Italian or German Court)

Art. 71b Brussels I-Regulation: When defendant is not domiciled in a MS (e.g. UK)
(2): Chap. II (incl. Art. 29 to 32) shall apply / UPC has jurisdiction for preliminary proceedings even if court of foreign state has jurisdiction for action on the merits
OVERVIEW OF ART. 29–32 BRUSSELS I-REGULATION

▷ Art. 29: Jurisdiction in case of proceedings involving the same cause of action between the same parties

▷ Art. 30: Jurisdiction in case of related actions

▷ Art. 31: Jurisdiction of the court first seized in cases of exclusive jurisdiction / Handling of agreements on jurisdiction

▷ Art. 32: Definition of the instant at which a court shall be deemed to be seized
MEANING OF "... SAME CAUSE OF ACTION..."

ECJ applies a very broad interpretation of Art. 29 ("Core-Theory")

- if both proceedings concern the same legal consequences arising from the same set of facts.
- Broader understanding than in most EU member states!

EXAMPLE

ECJ, C-144/86: Action for payment based on a contract and action for a declaration of invalidity of the contract concern the same cause of action.

ECJ, C-406/92: Action for a declaration of non-liability and an action directed to damages concern the same cause of action.
ART. 35 BRUSSELS I REGULATION IS NOT MENTIONED!

- Art. 71c does not refer to Art. 35 – thus not applicable?

- This would mean:
  - No deviating regime for preliminary measures
  - The court first seized shall then also have exclusive jurisdiction for preliminary measures

**EXAMPLE**

An action for non-infringement before a CMS-Court would block preliminary injunction proceedings before the UPC?
SCENARIOS
Key info to keep in mind

In these situations:

• EP is not opted out
• we are only looking at the time during transitional period for UPC-MS and UK
Before a national court
Infringement action of a national designation of EP

Before the UPC
• Infringement action of all parts of EP
• DNI claim
• Revocation claim of EP

SCENARIO 1
CARVE OUT
SURVEY
Before a national court

DNI claim targeting several UPC-CMS

Before the UPC

Infringement action of all designated parts of EP

SCENARIO 2
SCENARIO 3

Before a national court
Infringement action based upon a domestic patent (with corresponding EP)

Before the UPC
Infringement action of all designated parts of EP
SCENARIO 4

Before the UPC
DNI claim for EP

Before a national court
Infringement action based upon national designation of EP
SCENARIO 5

Before the UPC
Revocation action for all designations of EP

Before a national court
Infringement action based upon national designation of EP
SCENARIO 6

Before the UPC
Infringement action for all designations of EP

Before a national court
Revocation action targeting national designation of EP
THANK YOU!

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