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The background of the book cover is a photograph of classical stone columns, likely from a courthouse or government building, with a focus on the fluted shafts and capitals. The image is in a muted, teal-toned color palette.

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DISPUTES ACROSS EUROPE

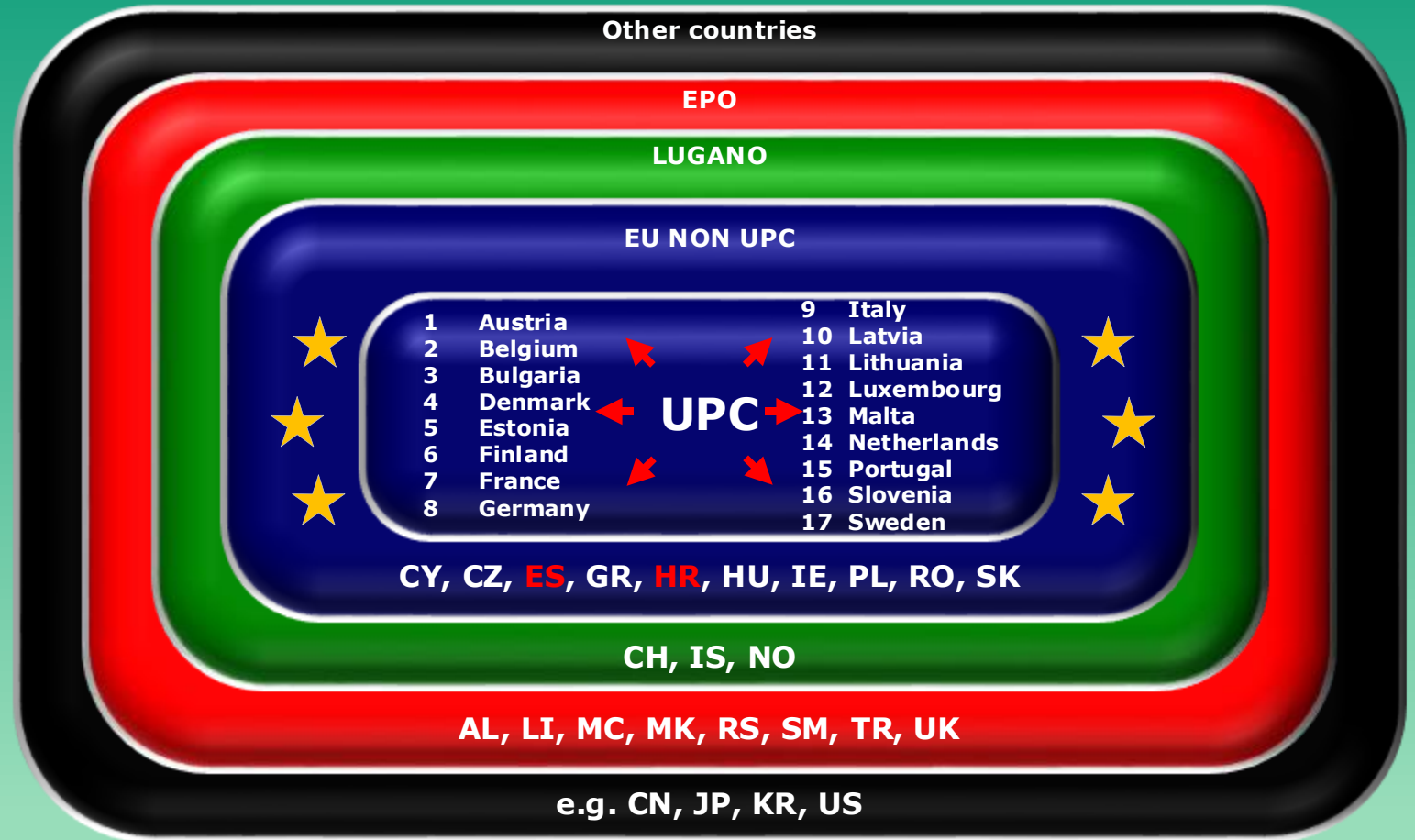
# Extra-Contracting Member State jurisdiction of the UPC

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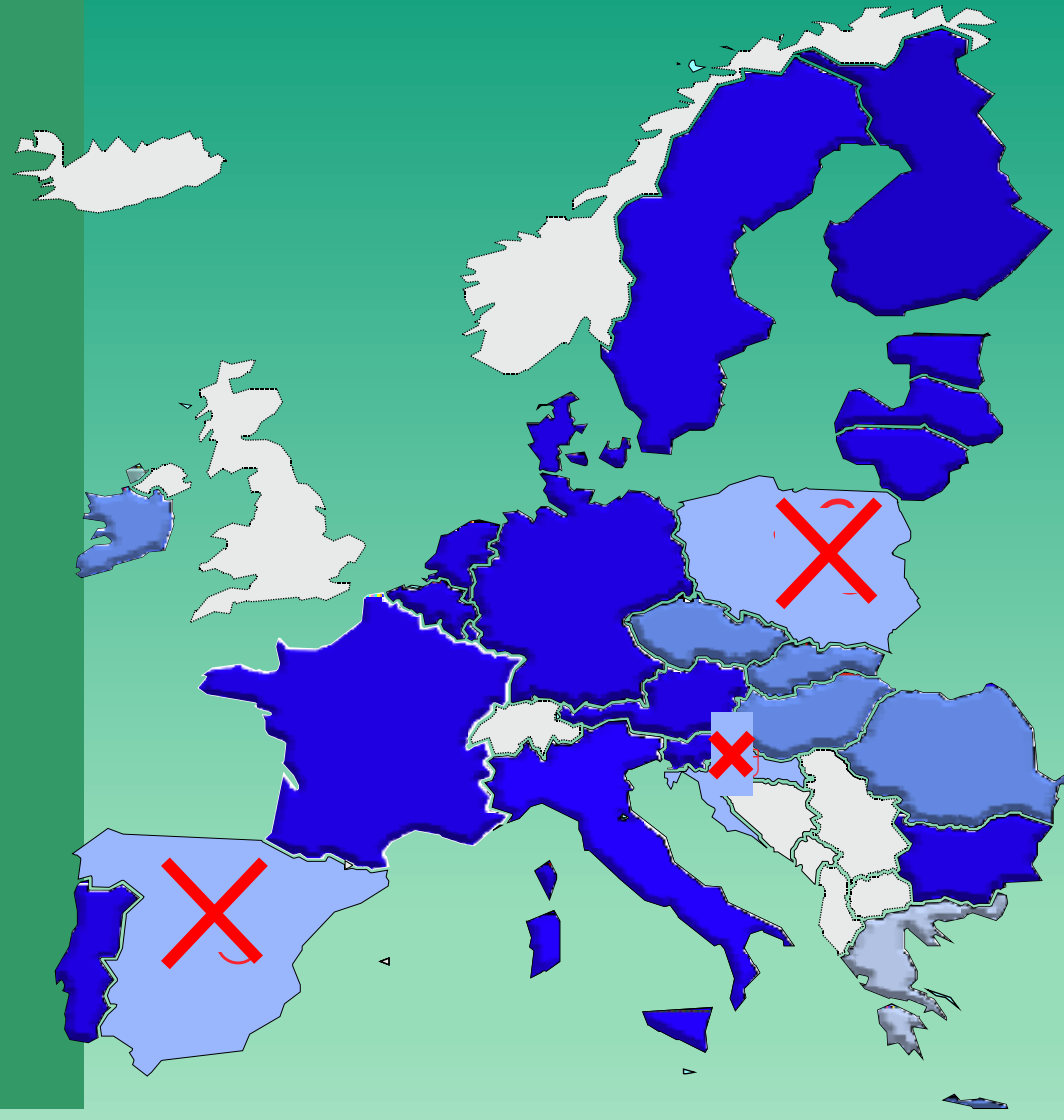
# Agenda

- Introduction
- Wide View
- Narrow View
- Practicalities and Consequences of any overlapping jurisdiction

# Introduction: the EP-centric world of patents...



UPC's  
gearing up  
period



- 1 Belgium
- 2 Bulgaria
- 3 Denmark
- 4 Germany
- 5 Estonia
- 6 France
- 7 Italy
- 8 Latvia
- 9 Lithuania
- 10 Luxembourg
- 11 Malta
- 12 Netherlands
- 13 Austria
- 14 Portugal
- 15 Slovenia
- 16 Finland
- 17 Sweden

- 1 Czechia
- 2 Ireland
- 3 Greece
- 4 Cyprus
- 5 Hungary
- 6 Romania
- 7 Slovakia

- 1 Spain
- 2 Croatia
- 3 Poland

**17 States (2022) + 7 to follow + 3 not aboard**

# UPC's jurisdiction

- Jurisdiction in relation to Unitary Patents relatively straightforward; they only have effect in CMS
- What, though about European Patents? EPs are granted (and will continue to be granted) in territories wider than CMS and indeed EU / EFTA.
- What is the reach of the new Court's powers:
  - Ratified CMS? Non-ratified CMS? Non-participating EU territories? EFTA countries? All EPC territories?

# UPC's jurisdiction

2 'dimensions' to the analysis:

- Where are the acts of infringement taking place, and does the UPC have the power to rule on such acts of infringement? (subject matter jurisdiction)
- If yes, then if there are multiple potential fora which could rule on the allegations, how to decide which should? (geographical jurisdiction)

# UPC's jurisdiction

Structure of discussion:

- Consider range of cases from more straightforward to more complex:
- UPC CMS – not challenged!
- EU non-CMS (not yet ratified e.g. IE, not intending to take part e.g. ES)
- Lugano Convention (CH, NO, IS)
- Extra EU / EEA (e.g. UK, Turkey)

# UPC's jurisdiction

Not going to discuss application of

- Art.32 (causes of action before the UPC); and
- Art. 33 UPCA (how to decide between UPC internal jurisdictions)



# Wide view on cross-border jurisdiction UPC

- The framework: UPCA & Brussels I bis recast
- XB jurisdiction against CMS defendants
- XB jurisdiction against EU MS non CMS defendants
- XB jurisdiction against non CMS non EU MS defendants

# The legal framework: UPCA

- Art. 1: “A Unified Patent Court for the settlement of disputes relation to European patents and European patents with unitary effect is hereby established.”
- Art. 3: “This Agreement shall apply to any: (a) European patent with unitary effect, (b) SPC, (c) European patent, (d) European patent application”
- “Any European patent” = all national parts of the bundle (EPC MS)

# The legal framework: UPCA (c'd)

- Art. 34: Decisions of the Court shall cover, in the case of a European patent, the territory of those CMS for which the European patent has effect.”
- Purpose: make clear that, unlike UP decisions, EP decisions limited to where the national parts are in force
- Does not restrict competence or jurisdiction (not: “shall *only* cover CMS territory”, or “shall not cover non-CMS territory”)

# The legal framework: UPCA (c'd)

- Art. 24 (Sources of law):
  - (2) “To the extent that the Court shall base its decisions on national law, including where relevant the law of non-contracting States, the applicable law shall be determined: ...
  - (3) The law of non-contracting States shall apply when designated by application of the rules referred to in par. 2, in particular in relation to Art. 25-28, 54, 55, 64, 68 and 72” (= i.a. infringement, indirect infringement, prior use)
- So: UPC can apply non-CMS infringement law of EPs

# The legal framework: international jurisdiction -> Brussels Regulation

- Art. 31 UPCA: The international jurisdiction of the Court shall be established in accordance with Brussels Regulation (1215/2012) + Lugano Convention
- Brussels Regulation amended to that effect, Lugano Convention not...
- Art. 71a BR: UPC is a “court common to several Member States” (‘a common court’), “shall be deemed to be a court of a (EU) MS”

# Brussels Regulation: Art. 71b-1

Art. 71b-1: UPC has jurisdiction when a MS court has jurisdiction under the BR:

- Art. 4 BR: if defendant is domiciled in a UPC CMS
- Art. 7 (2) BR: if defendant infringes in a UPC CMS
- Art. 8 (1) BR: if defendant is one of multiple defendants, including domiciled in a UPC CMS (if claims are closely connected, to avoid risk of irreconcilable judgements)
  - NOTE: these provisions concern defendants domiciled in a EU MS
  - Art. 6 BR: for defendants *not* domiciled in a EU MS, national MS law shall determine jurisdiction (I will come back on that)

# Brussels Regulation: Art. 71b-2

Art. 71b-2: If defendant is not domiciled in a EU MS, the jurisdiction rules of the BR “shall apply as appropriate regardless of the defendant’s domicile”

- Art. 7 (infringement in UPC territory) + Art. 8 (co-defendant with a EU MS defendant) also apply to non-EU MS defendants

Art. 71b-2, second paragraph: Application may be made to UPC for Pls and protective measures, “even if the courts of a *third State* have jurisdiction as to the substance of the matter”

- NOTE: broader scope than Art. 35, which is limited to “even if the courts of *another MS* have jurisdiction”. Art. 71b-2 also covers e.g. UK, CH, TK

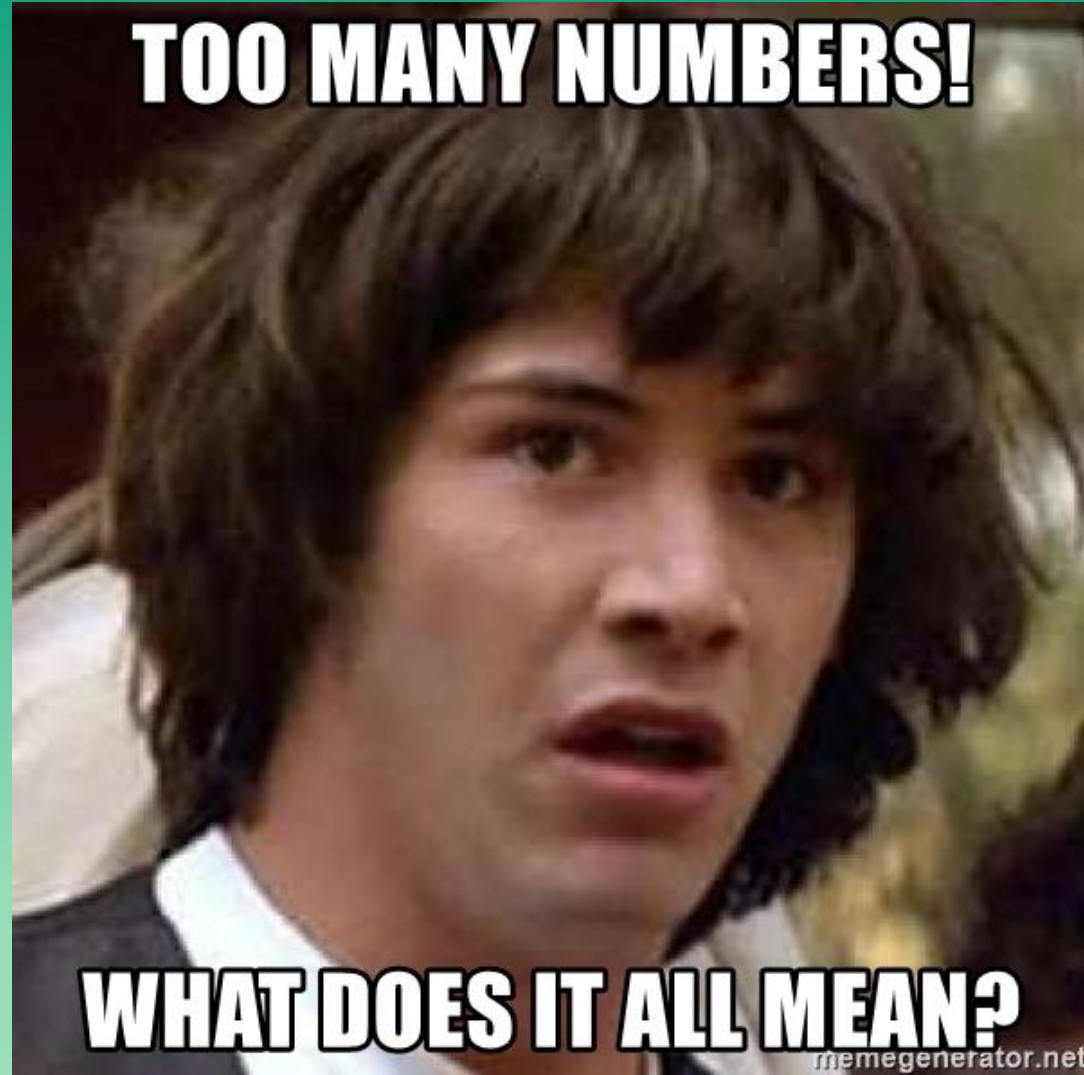
# Brussels Regulation: Art. 71b-3

Art. 71b-3: If art. 71b-2 applies (jurisdiction against non-EU MS defendant), and there is damage in the EU territory, the UPC may also exercise jurisdiction in relation to damage outside the EU territory

- Second paragraph: this XB damage jurisdiction only applies if defendant has property in a EU MS
  - (Strange limitation: why can't the UPC order compensation for all damages arising from EP infringement, regardless where damage occurs? E.g. manufacture in EU, sales outside EU)



**TOO MANY NUMBERS!**



**WHAT DOES IT ALL MEAN?**

# 1. Against EU MS UPC MS defendant:

I.e. defendant domiciled in one of the 17 CMS (e.g. Dutch defendant):

- UPC has Art. 4 jurisdiction (jo. 71b-1)
- This jurisdiction is not territorially limited (case law in i.a. NL, FR, literature): 'home court' has jurisdiction over its own people for any acts committed anywhere in the world, falling within the scope of the UPC (including UP, SPC and EP infringements): UPC can deal with EP infringement of Dutch defendant in ES, UK, CH, TK
- Foreseen in art. 24 UPCA: apply third State law
- If invalidity defence raised: UPC can deal with that for UPC territory. For non-CMS territory provisional injunction possible: Art. 35 (ES), Art. 71b-2 (UK, CH, TK), CJEU Solvay/Honeywell

## Support: i.a. prof. Ansgar Ohly

*"The jurisdiction of European courts in patent disputes"*  
(2022):

- "The jurisdiction under Art. 4(1) BR is general. The courts in the defendant's country of domicile can hear and determine disputes concerning patent infringement in all countries..."
- "(t)he UPC would also have jurisdiction over infringements of European patents in non-UPCA contracting member states which are contracting states to the EPC (...), for example Spain, Switzerland or Turkey, as European patents validated for these states can be infringed there. The UPC could also award damages accordingly."

# More support: Judge Grabinski

## Example 1 – single defendant:

Infringement of a EP in DE, FR and ES; **defendant has its seat in a Member State (e.g. DE).**

- **General jurisdiction** (seat of defendant, Art. 4 Brussels Ia Reg.)
  - National Court:
    - DE courts yes on **infringements** of the EP in DE, FR, ES, but only on the **validity** of the **DE** part of the EP, not on the validity of the FR and ES part of the EP (CJEU in Gat v LUK)
  - UPC (seat of defendant, Art. 71 b (1), 4 Brussels Ia Reg.)
    - UPC yes on **infringements** of the EP in DE, FR, ES and also on the **validity** of the **DE and FR** part of the EP (**one stop only**), however not on the validity of the ES part of the EP.

## 2. Against EU MS non UPC MS defendant:

E.g. Spanish defendant:

- UPC is not 'home court': no XB Art. 4 jurisdiction
- If Spanish defendant infringes in UPC territory: Art. 7(2) BR (jo. 71b-1): UPC has jurisdiction. According to established case law not XB (so: not also for Spain)
- If Spanish defendant infringes together with Dutch defendant: Art. 8(1) BR (jo. 71b-1). In that case, the UPC has Art. 4 XB jurisdiction over the Dutch defendant, incl. Spanish territory. Then also Art. 8 XB jurisdiction over Spanish co-defendant: claims closely connected, avoid irreconcilable decisions
- Here too: if invalidity defence raised: provisional injunction for Spain: Art. 35, CJEU Solvay/Honeywell

### 3. Against non EU MS non UPC MS defendant:

E.g. UK, CH or TK defendant (PV: 'aliens'):

- Here too: If alien defendant infringes in UPC territory: Art. 7(2) BR (jo. 71b-2): UPC has jurisdiction, but not XB
- But: if alien defendant infringes together with Dutch defendant: Art. 8(1) BR (jo. 71b-2). UPC has Art. 4 XB jurisdiction over Dutch defendant. Then also Art. 8 XB jurisdiction over alien co-defendant. This includes Spain, but also UK, CH, TK: for these alien countries too, the claims are closely connected, and there would be a risk of irreconcilable decisions
- Here too: if invalidity defence raised: provisional injunction still possible: Art. 71b-2, CJEU Solvay/Honeywell

# Widest view: national route via Art 6 BR still possible?

- Art. 6 BR relates to jurisdiction against a defendant which is not domiciled in a MS. In that case, par. 1 allows that the jurisdiction of the courts of each MS shall be determined by the law of that MS. On this basis, e.g. French and Dutch courts accept jurisdiction against non-EU MS defendants based on national rules (similar to the BR rules), which can be XB.
- Par. 2 says: Against such a (alien) defendant, “any person domiciled in a MS may ... avail himself in that MS of the rules of jurisdiction there in force”
- If e.g. a FR or NL court would accept jurisdiction against an alien for EP infringement based on Art. 6 BR and national law, so can the UPC under Art. 71b-1 (same jurisdiction as MS courts rule)

# Narrow views on cross-border jurisdiction

1. UPC limited to UPC territory?
2. Lugano Convention applicable?
3. No "national route" based on Art. 71 b II
4. Limited "long-arm jurisdiction"
5. Cross-border PIs
6. Summary of cross-border scope



# 1- Limited competence of the UPC

- Art. 34 UPCA: Territorial scope limited to CMS
- Art. 31 UPCA referring to Brussels Regulation
- Art. 71a BR: jurisdiction of UPC only pursuant to the UPCA?

*"pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of this Regulation."*

- Art. 24 UPCA: Applicability of non-CMS law does not mean that scope of e.g. injunction would cover non-CMS territory

## 2 – Brussels Regulation / Lugano Convention

If we accept extra-territorial competence of UPC:

- Brussels Regulation:
  - amended to include UPC as common court
  - acceptance by all EU member states re reciprocal transfer of jurisdiction
    - also ES court could issue XB injunction re UPC territory
- Lugano Convention:
  - not amended. Is the UPC a national court under the LC? Art. 2: "the courts of a State"

### 3 - No "national route" via Art. 6 BR

#### Article 71b

*"The jurisdiction of a common court shall be determined as follows:*

*(1) a common court shall have jurisdiction where, **under this 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;*

>> UPC only steps into jurisdiction of MS according to this Regulation, not according to national law

# 3 - No "national route" via Art. 6 BR

## Article 71b

*(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**. ...*

- only applicable in view of jurisdiction conferred by this Regulation
- Chapter II only applicable as appropriate
- Exception to Art. 71b (1): No reference to national jurisdiction possible
- National route would contradict harmonization through UPC

# 3 - No "national route" via Art. 6 BR

## Regulation 542/2014 changing BR Consideration (6)

- (6) As courts common to several Member States, the Unified Patent Court and the Benelux Court of Justice cannot, unlike a court of one Member State, exercise jurisdiction on the basis of national law with respect to defendants not domiciled in a Member State. To allow those two Courts to exercise jurisdiction with respect to such defendants, the rules of Regulation (EU) No 1215/2012 should therefore, with regard to matters falling within the jurisdiction of, respectively, the Unified Patent Court and the Benelux Court of Justice, also apply to defendants domiciled in third States. The existing rules of jurisdiction of Regulation (EU) No 1215/2012 ensure a close connection between proceedings to which that Regulation applies and the territory of the Member States. It is therefore appropriate to extend those rules to proceedings against all defendants regardless of their domicile. When applying the rules of jurisdiction of Regulation (EU) No 1215/2012, the Unified Patent Court and the Benelux Court of Justice (hereinafter individually referred to as a 'common court') should apply only those rules which are appropriate for the subject-matter for which jurisdiction has been conferred on them.

# 3 - No "national route" via Art. 6 BR

## Implications of Art. 71b (2) on Chapter 2

- Art. 4: no domicile in MS
- Art. 5: no domicile in MS
- Art. 6: reference to national law on domicile-related jurisdiction **excluded**
- Art. 7 II: place of infringement applies regardless of domicile
- Art. 8 I: close connection applies regardless of domicile

## 4 - Limited "long-arm jurisdiction"

- Non-EU defendant, Art. 71b III BR
- Restrictive conditions:
  - UPC competent re infringement of EP
    - e.g. in view of Art. 7 II BR
  - Infringement has caused damages within EU
  - Defendant has (substantial) property in UPC
  - Sufficient connection with UPC
  - Jurisdiction also for damages outside EU caused by such infringement (i.e. the infringement in UPC?)
- Does it really add anything?

# 5 - Cross-border PIs

- Re infringement within EU (Art. 35 BR) and – if applicable – Lugano (Art. 31 LC)
  - Regardless of validity issues
    - CJEU Solvay v Honeywell
- Re infringement outside EU: Art. 71b II 2 BR
  - non-EU defendant
  - BUT: enforcement? comity? territoriality? requirement of a bond?



# 6 – Territorial scope of injunction

- if XB by UPC is accepted –

- **UPC defendant**
  - UPC territory (+)
  - EU non UPC:
    - (+) for main actions (unless validity attack)
    - (+) for PIs
  - Lugano:
    - (-) if LC not applicable
    - (+) if LC applicable, then according to Art. 2 LC (and provided no validity attack) and PIs according to Art. 31 LC
  - EPC but non EU non Lugano
    - (-) for main actions
    - (-) for PIs, Art. 71bII2 BR only applicable to non EU defendants

# 6 – Territorial scope of injunction

- if XB by UPC is accepted –

- **EU non UPC defendant**
  - UPC territory (+)
  - EU non UPC:
    - (-) for main actions, only via Art. 8 BR
    - (+) for PIs
  - Lugano:
    - (-) if LC not applicable
    - (+) if LC applicable, but only via Art. 6 LC (and no invalidity claim) or for PIs
  - EPC but non EU non Lugano
    - (-) for main actions, no legal basis
    - (-) for PIs, Art. 71bII2 BR only applicable to non EU defendants

# 6 – Territorial scope of injunction

- if XB by UPC is accepted –

- **LC (non UPC, non EU) defendant:**
  - UPC territory (+)
  - EU non UPC:
    - (-) for main actions, only via Art. 8 BR
    - (+) for Pls
  - Lugano:
    - (-) if LC not applicable
    - (+) if LC applicable, but only via Art. 6 LC or for Pls
  - EPC but non EU non Lugano
    - (-) supremacy of LC, Art. 71bII not applicable

# 6 – Territorial scope of injunction

- if XB by UPC is accepted –

- **EPC (non UPC, non EU, non LC) defendant:**
  - UPC territory (+)
  - EU non UPC:
    - (-) for main actions, only via Art. 8 BR
    - (+) for Pls
  - Lugano:
    - (-) LC not applicable
    - (?) for Pls, restrictive application of Art. 71bII2 BR
  - EPC but non EU non Lugano
    - (-) for main actions, no legal basis
    - (?) for Pls, restrictive application of Art. 71bII2 BR

# Consequences and Practicalities

- Jurisdiction disputes within UPC: Rule 19 Preliminary Objections
- Validity
- Role of overlapped courts – anti-suit / anti-enforcement?
- Enforcement
- Role of international comity
- Political consequences?

Thank you

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# Backup Slides

Extracts of:

- UPC Agreement
- Rules of Procedures
- Brussels Regulation

# UPC Agreement

## Article 31. International jurisdiction

*"The international jurisdiction of the Court shall be established in accordance with Regulation (EU) No 1215/2012 or, where applicable, on the basis of the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Lugano Convention)."*



# UPC Agreement

## Article 34. Territorial scope of decisions

*"Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member States for which the European patent has effect."*

# Rules of Procedure

## Rule 19 – Preliminary objection

*"1. Within one month of service of the Statement of claim, the defendant may lodge a Preliminary objection concerning:*

*(a) **the jurisdiction and competence of the Court**, including any objection that an opt-out pursuant to Rule 5 applies to the patent that is the subject of the proceedings;*

*(b) the competence of the division indicated by the claimant [Rule 13.1(i)];*

*(c) the language of the Statement of claim [Rule 14]."*

# Brussels Regulation

- REGULATION (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast)

## Amended by

- REGULATION (EU) No 542/2014 of the European Parliament and of the Council of 15 May 2014 amending Regulation (EU) No 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice

# Principle: EU-based defendant shall be sued in the courts of his domicile

## Article 4

*"1. Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.*

*2. Persons who are not nationals of the Member State in which they are domiciled shall be governed by the rules of jurisdiction applicable to nationals of that Member State."*

# Exceptions to the defendant's domicile principle

## Article 5

*"1. Persons domiciled in a Member State may be sued in the courts of another Member State only by virtue of the rules set out in Sections 2 to 7 of this Chapter."*

# Reference to national law

## Article 6

*"1. If the defendant is not domiciled in a Member State, the jurisdiction of the courts of each Member State shall, subject to Article 18(1), Article 21(2) and Articles 24 and 25, be determined by the law of that Member State.*

*2. As against such a defendant, any person domiciled in a Member State may, whatever his nationality, avail himself in that Member State of the rules of jurisdiction there in force, and in particular those of which the Member States are to notify the Commission pursuant to point (a) of Article 76(1), in the same way as nationals of that Member State."*

# Special jurisdiction re torts

## Article 7

*"A person domiciled in a Member State may be sued in another Member State:*

*...*

*(2) in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur;"*

# Exclusive jurisdiction re validity

## Article 24

*"The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties:*

*...*

*(4) in **proceedings concerned with the registration or validity of patents, trademarks, designs, or other similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defence, the courts of the Member State in which the deposit or registration has been applied for**, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place.*

*Without prejudice to the jurisdiction of the European Patent Office under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, **the courts of each Member State shall have exclusive jurisdiction in proceedings concerned with the registration or validity of any European patent granted for that Member State;**"*



# Lis alibi pendens

## Article 29

*"1. Without prejudice to Article 31(2), where proceedings involving the same cause of action and between the same parties are brought in the courts of different Member States, any court other than the court first seised shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seised is established.*

*2. In cases referred to in paragraph 1, upon request by a court seised of the dispute, any other court seised shall without delay inform the former court of the date when it was seised in accordance with Article 32.*

*3. Where the jurisdiction of the court first seised is established, any court other than the court first seised shall decline jurisdiction in favour of that court."*

# Related actions

## Article 30

*"1. Where related actions are pending in the courts of different Member States, any court other than the court first seised may stay its proceedings.*

*2. Where the action in the court first seised is pending at first instance, any other court may also, on the application of one of the parties, decline jurisdiction if the court first seised has jurisdiction over the actions in question and its law permits the consolidation thereof.*

*3. For the purposes of this Article, actions are deemed to be related where they are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings"*

# Provisional measures

## Article 35

*"Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that Member State, even if the courts of another Member State have jurisdiction as to the substance of the matter."*

# UPC as common court

## Article 71b

- 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.*
- 2. For the purposes of this Regulation, each of the following courts shall be a common court:*
  - (a) the Unified Patent Court established by the Agreement on a Unified Patent Court signed on 19 February 2013 (th "UPC Agreement") and*

*...*

# Principles and provisional measures

## Article 71a

*"The jurisdiction of a common court shall be determined as follows:*

*(1) a common court shall have jurisdiction where, under this 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;*

*(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.*

*Application may be made to a common court for provisional, including protective, measures even if the courts of a third State have jurisdiction as to the substance of the matter;*

*...*

# Long-arm jurisdiction

## Article 71b

"...

*(3) where a common court has jurisdiction over a defendant under point 2 in a dispute relating to an infringement of a European patent giving rise to damage within the Union, that court may also exercise jurisdiction in relation to damage arising outside the Union from such an infringement.*

*Such jurisdiction may only be established if property belonging to the defendant is located in any Member State party to the instrument establishing the common court and the dispute has a sufficient connection with any such Member State."*