

Jurisdictional Boundaries of the Unified Patent Court: An analysis of the Judgment of the Düsseldorf Local Division in case UPC_CFI_355/2023

Límites jurisdiccionales del Tribunal Unificado de Patentes: Un análisis de la sentencia de la División Local de Düsseldorf en el Asunto UPC_CFI_355/2023

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Abstract: This note examines the jurisdictional architecture of the Unified Patent Court (UPC), focusing on the interaction between the Unified Patent Court Agreement (UPCA) and the Brussels I bis Regulation when asserting jurisdiction over European patents. The analysis centers on judgment UPC_CFI_355/2023 rendered by the Düsseldorf Local Division of the UPC, which raises questions about the limits of the UPC's jurisdiction, especially in cases involving infringement of European patents validated in states not party to the UPCA. Moreover, the decision sheds light on the complex issue of validity challenges under Art. 24(4) of the Brussels I bis Regulation in infringement proceedings, especially in view of the recent ruling of the Court of Justice of the European Union (CJEU) in *BSH Hausgeräte*.

Keywords: European patent, patent infringement, Jurisdiction, Unified Patent Court.

Resumen: Esta nota examina la arquitectura jurisdiccional del Tribunal Unificado de Patentes (TUP), centrándose en la interacción entre el Acuerdo del Tribunal Unificado de Patentes (UPCA) y el Reglamento Bruselas I bis al ejercer la jurisdicción sobre patentes europeas. El análisis se centra en la sentencia UPC_CFI_355/2023, dictada por la División Local de Düsseldorf del UPC, que plantea interrogantes sobre los límites de la jurisdicción del UPC, especialmente en casos de infracción de patentes europeas validadas en Estados no parte del UPCA. Además, la decisión arroja luz sobre la compleja cuestión de las impugnaciones de validez en virtud del artículo 24(4) del Reglamento Bruselas I bis en procedimientos de infracción, especialmente a la vista de la reciente sentencia del Tribunal de Justicia de la Unión Europea (TJUE) en *BSH Hausgeräte*.

Palabras clave: Patente europea, infracción de patente, competencia judicial internacional, Tribunal unificado de patente.

Summary: I. Introduction. II. The patent system in Europe. 1. The European Patent Convention and the Unitary Patent Regulation. 2. The Unitary Patent Court Agreement. III. Conflict of laws in the European patent system. 1. Jurisdiction. 2. Applicable law. IV. The judgment of the Unified Patent Court in Case UPC_CFI_355/2023. V. What are the limits of the Unified Patent Court jurisdiction after judgment UPC_CFI_355/2023. 1. The Unified Patent Court as any other court of the Member States. 2. The question of validity within infringement proceedings. VI. Conclusions.

I. Introduction

1. The establishment of the UPC marks a significant evolution in the European patent system. Designed to centralise and streamline litigation over European patents and newly introduced unitary patents, the UPC promises to unify judicial outcomes across the EU. However, the transition from a fragmented to a quasi-unified system has raised complex questions concerning jurisdiction and applicable law, given the existence of different types of patents governed by different legal regimes.

At the heart of this complexity lies the coexistence of traditional European patents, which must be validated in each state and are entirely governed by national laws, and unitary patents, which provide uniform protection across only some EU Member States (MS). The UPCA¹ and Regulation (EU) No. 1257/2012² (Unitary Patent Regulation), together with the Brussels I bis Regulation³, define the jurisdictional reach of the UPC, particularly in relation to unitary patents and “traditional” European patents with effect in UPCA Contracting States. Yet, the situation becomes more intricate when dealing with European patents validated in EU MS or third countries not party to the UPCA, such as Spain and the United Kingdom.

This paper explores the boundaries of the UPC’s jurisdiction by analysing the legal framework provided by the UPCA, the Unitary Patent Regulation, and the Brussels I bis Regulation, including its modification through Regulation (EU) No. 542/2014⁴. A central focus of the analysis is the recent case UPC_CFI_355/2023⁵, in which the Düsseldorf Local Division of the UPC addressed a jurisdictional challenge concerning infringement claims related to a European patent validated in the UK.

The decision provides a rich lens through which to examine the complex interaction between all the legal sources governing European patent litigation, while exposing the practical limitations of asserting jurisdiction over patents validated in states outside the UPCA system. Furthermore, it offers an opportunity to discuss a long-debated issue regarding the application of Art. 24(4) of the Brussels I bis Regulation: the consequence of raising the issue of validity during infringement proceedings concerning registered intellectual property rights (IPR) before a court of a MS other than the one where the IPR is registered. Finally, while not the main focus of this analysis, applicable law will also be addressed to provide a more comprehensive understanding of the European patents’ legal framework.

II. The patent system in Europe

1. The European Patent Convention and the Unitary Patent Regulation

2. The European patent framework consists of two parallel systems. On the one hand, the “traditional” European patent system, created by the European Patent Convention (EPC)⁶, enables an applicant to submit a single application to the European Patent Office (EPO), designating the contracting states of the EPC in which protection is sought. Upon examination, if the application meets the necessary requirements, the EPO grants a European patent. However, this patent must then be validated in each designated contracting state, where it becomes a national patent.

¹ Agreement on a Unified Patent Court, OJ C 175, 20.6.2013, p. 1-40.

² Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, OJ L 361, 31.12.2012, pp. 1-8.

³ 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), OJ L 351, 20.12.2012, p. 1-32.

⁴ 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, OJ L 163, 29.5.2014, p. 1-4.

⁵ UPC, Düsseldorf Local Division, Judgment of 28 January 2025, case *Fujifilm v Kodak* (UPC_CFI_355/2023).

⁶ Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973.

In essence, a single application can lead to the granting of multiple national patents for the same invention⁷. While the procedure for granting the patent is centralised, the resulting European patent is a bundle of national patents, with each EPC contracting state applying its own national law. This system streamlines the patent granting process across participating states but does not eliminate the territorial nature of patents⁸. Consequently, key aspects such as validity, scope of protection, and infringement are governed by the laws of each country where the patent is validated, making the term “European patent” potentially misleading⁹.

3. On the other hand, the European patent with unitary effect (unitary patent) provides a single patent with uniform effect across the EU MS participating in the enhanced cooperation established by the Unitary Patent Regulation¹⁰. This uniform IPR aims to follow the model set by other EU-wide rights such as the EU trade mark¹¹ and the EU design¹². Consequently, the unitary patent ensures consistent protection in all participating MS, without requiring national validation in each country.

However, it should be noted that the unitary patent is not a truly independent unitary IPR. Instead, it allows the applicant of a European patent to opt for “unitary protection” in the MS participating in the enhanced cooperation¹³. This protection is entirely subject to the national laws of those MS¹⁴, as the Unitary Patent Regulation does not contain any substantive provisions. Consequently, it has been argued that the unitary patent system leaves the EU with a more fragmented patent network than before¹⁵.

4. The EPO remains the designated authority for granting these patents, thereby assuming a dual role. It grants European patents under the framework of the EPC -an international treaty that includes both EU and non-EU MS- and it grants unitary patents pursuant to the Unitary Patent Regulation, an EU instrument applicable exclusively to EU MS. The Unitary Patent Regulation does not apply to all EU MS but only to those that have opted into the corresponding enhanced cooperation, which excludes Croatia, Poland, and Spain.

2. The Unitary Patent Court Agreement

5. The creation of a unitary patent right, which coexists with the traditional European patent, was accompanied by the establishment of the UPC. This unified court system, introduced through the

⁷ P. A., DE MIGUEL ASENSIO, «La patente europea con efecto unitario y su régimen jurídico», *Revista de Direito Intelectual*, 1, 2016, pp. 143-167, p. 144.

⁸ For an in-depth analysis of the European Patent Convention see SINGER, M./SINGER, R./STAUDER, D., *Europäisches Patentreibereinkommen*, 4th ed., Köln, Heymann, 2007.

⁹ M., HAEDICKE/H., TIMMANN, (eds.), *Patent Law: A Handbook on European and German Patent Law*, Baden-Baden, Nomos, Oxford, Hart, 2014, p. 951.

¹⁰ This Unitary Patent Regulation is complemented by another instrument which governs the translation arrangements for the unitary patent: Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, OJ L 361, 31.12.2012, pp. 89-92. For a critical analysis of this enhanced cooperation and the CJEU's ruling on its legitimacy, see M., LAMPING, «Enhanced Cooperation in the Area of Unitary Patent Protection - Testing the Boundaries of the Rule of Law», *Max Planck Institute for Intellectual Property and Competition Law Research Paper*, 2015, pp. 1-14.

¹¹ Established by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification), OJ L 154, 16.6.2017, pp. 1-99. Former Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

¹² Established by Regulation (EU) 2024/2822 of the European Parliament and of the Council of 23 October 2024 amending Council Regulation (EC) No 6/2002 on Community designs and repealing Commission Regulation (EC) No 2246/2002, OJ L, 2024/2822, 18.11.2024. Former Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs.

¹³ M., DESANTES REAL, «Hacia un tribunal unificado y un efecto unitario para las patentes europeas en casi todos los estados miembros de la Unión Europea. Consecuencias de la autoexclusión de España», *Revista Española de Derecho Internacional*, 2013, 65(2), pp. 51-70, pp. 58-59.

¹⁴ And, as it will be seen, to arts. 25-30 of the UCPA.

¹⁵ D., TILT, «The historical contextualisation of the (failed) European Unitary Patent», in M. C., BARUFFI/ M., ORTINO, *Trending topics in international and EU law: legal and economic perspectives*, Napoli, Edizioni Scientifiche Italiane, 2019, pp. 543-557, p. 547.

UPCA, has exclusive jurisdiction over European patents validated by EU MS that are contracting parties to the UPCA, as well as unitary patents with effect in those contracting EU MS participating in the enhanced cooperation established by the Unitary Patent Regulation. Consequently, the European patents validated in non-EU countries and in EU MS not participating to the UPCA should, in principle, fall outside the UPC's jurisdiction.

6. Pursuant to Art. 32 of the UPCA, the following actions can be brought before the UPC: 1) Infringement or threatened infringement, including defences and counterclaims regarding licenses; 2) Declarations of non-infringement; 3) Provisional and protective measures; 4) Revocation and invalidity actions; 5) Counterclaims for revocation and invalidity; 6) Damages related to provisional protection conferred by a published European patent application; 7) Rights based on prior use; 8) Compensation for licenses; 9) Decisions of the European Patent Office under Art. 9 of the Unitary Patent Regulation.

7. It should be noted that the UPCA does not constitute an EU instrument, but rather a classic international convention, similar in nature to the 1968 Brussels Convention¹⁶. Nevertheless, similarly to the Brussels Convention, it has been regarded as a *sui generis* source of EU law¹⁷, due to its close connection with the EU legal framework. An example of this is Art. 21 of the UPCA, which mandates that the UPC cooperate with the CJEU to ensure the correct application and uniform interpretation of EU law, by requesting, where necessary, preliminary rulings, as any other national court¹⁸. It is also specified that the decisions of the CJEU are binding on the UPC.

In this regard, Art. 1 of the UPCA states that the UPC is a court common to the Contracting MS and, as such, is bound by the same obligations under EU law as any national court. This "common court" operates within the judicial system of each Contracting MS as a national court.

However, the UPC essentially falls outside the EU's legal order¹⁹, with the CJEU retaining indirect authority insofar as the UPC applies EU law. As noted earlier, the UPCA is not an EU instrument, meaning its provisions are not subject to the CJEU's jurisdiction. Among these provisions are the only substantive rules on unitary patent protection²⁰, which were originally part of the draft of the Unitary Patent Regulation but later excluded and incorporated into the UPCA. This shift was intended to prevent the CJEU from having jurisdiction over the substantive rules governing the unitary patent²¹.

Accordingly, the current Unitary Patent Regulation merely states that unitary patents provide a uniform scope of protection and limitations against third-party infringement throughout the Contracting MS, entrusting their applicable legislation with the definition of such protection and limitations²².

¹⁶ 1968 Brussels Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, OJ L 299, 31.12.1972, p. 32-42.

¹⁷ This special character of the 1968 Brussels Convention was emphasised by several authors. Among others, see T., BALLARINO, *La convenzione giudiziaria di Bruxelles del 1968 e la riforma del processo civile italiano*, Angeli, Milano, 1985, pp. 51-52; F., POCAR, *La Convenzione di Bruxelles sulla giurisdizione e l'esecuzione delle sentenze*, 3th ed., Giuffrè, Milano, 1995, p. 32.

¹⁸ M. A., GANDÍA SELLENS, «The Viability of the Unitary Patent Package After the UK's Ratification of the Agreement on a Unified Patent Court», *International Review of Intellectual Property and Competition Law*, 2018, 49(2), pp. 136-152, pp. 138-139.

¹⁹ M., MALAGA, «The European Patent with Unitary Effect: Incentive to Dominate? A look From the EU Competition Law Viewpoint», in J., ROSÉN, *European Intellectual Property Law*, Cheltenham, Edward Elgar Publishing, 2016, pp. 137-163, p. 144.

²⁰ Arts. 25-30 of the UPCA.

²¹ P. A., DE MIGUEL ASENSIO, «La patente europea con efecto unitario y su régimen jurídico», *cit.*, p. 158. M., DESANTES REAL, «Hacia un tribunal unificado y un efecto unitario para las patentes europeas en casi todos los estados miembros de la Unión Europea. Consecuencias de la autoexclusión de España», *cit.*, p. 64. However, the author points out that there is a significant link between the functioning of the UPC and EU law, which entails that the CJEU will inevitably be called upon to indirectly interpret the terms of the UPCA. M., HAEDICKE/H., TIMMANN, (eds.), *Patent Law: A Handbook on European and German Patent Law*, *cit.*, p. 955. Also Á., GARCÍA VIDAL, «La Patente Europea con Efecto Unitario (I): Aspectos básicos de la Patente Europea con Efecto Unitario», 2013, p. 4, from <https://ga-p.com/publicaciones/la-patente-europea-con-efecto-unitario-i/>.

²² Art. 5 of Regulation (EU) No 1257/2012.

III. Conflict of laws in the European Patent System

8. The rules governing jurisdiction and applicable law within the European patent system are fragmented across multiple legal instruments. The applicable provisions differ depending on whether the patent in question is a European patent or a unitary patent. This section will first examine the rules on jurisdiction, followed by a discussion of the provisions on applicable law.

1. Jurisdiction

9. Before delving into the rules governing jurisdiction of the UPC, it is important to distinguish between four different categories of patents under the European patent system²³: 1) unitary patents; 2) European patents validated in EU MS participating in the UPCA; 3) European patents validated in EU MS not participating in the UPCA and; 4) European patents validated in non-EU countries that are part of the EPC.

As outlined in the previous section, unitary patents can be granted in MS that are part of both the UPCA and the Unitary Patent Regulation. By contrast, traditional European patents can be granted in any state that is a contracting party to the EPC, including all EU MS and several third countries.

The jurisdiction of the UPC clearly covers unitary patents, as well as European patents validated in EU MS that are also part of the UPCA. Conversely, it is unclear whether the UPC have jurisdiction over European patents validated in EU MS not participating in the UPCA, such as Croatia, Poland, and Spain. Similarly, European patents validated in third countries should, in principle, fall exclusively under the jurisdiction of the respective national courts.

10. The rules of international jurisdiction for patent disputes within the EU are primarily governed by the Brussels I bis Regulation as such disputes are considered “civil and commercial matters” to which the Regulation, with some exceptions, applies. This is further confirmed by Art. 24(4) of the Brussels I bis Regulation, which deals with exclusive jurisdiction over the validity of patents, trade marks, designs, or other similar rights that require deposit or registration.

Hence, as a private international law (PIL) instrument designed to address cross-border litigation between MS, the Brussels I bis Regulation applies to cross-border national patent disputes. However, the unitary patent is not a national patent but rather a *sui generis* title²⁴, with its regulation divided between an EU instrument and an international agreement.

Nevertheless, PIL falls within EU’s exclusive competence²⁵, leaving the UPCA no choice but to refer to the Brussels I bis Regulation for the rules governing international jurisdictions over unitary patent disputes²⁶. Consequently, in accordance with Art. 31 of the UPCA, jurisdiction over these disputes is determined by the Brussels I bis Regulation and, where applicable, the Lugano Convention²⁷. However, once international jurisdiction is established, the provisions governing the internal distribution of cases

²³ For a thorough and critical analysis of the different categories of European patents and their legal regime, see V., DI CATALDO, «Competition (or confusion?) of models and coexistence of rules from different sources in the European patent with unitary effect: Is there a reasonable alternative?», in C., HONORATI (ed.), *Luci e ombre del nuovo sistema UE di tutela brevettuale*, Turin, G. Giappichelli, 2014, pp. 27-47, pp. 30-32.

²⁴ As observed above, it cannot be entirely defined as an EU unitary IPR but rather as a European patent that, upon an explicit additional request, grants uniform protection across the Contracting MS. This request is therefore a prerequisite for the unitary effect, see L., SANDRINI, «La convenzione di Monaco sul brevetto europeo e i suoi rapporti con il “pacchetto brevetti”», in C., HONORATI (ed.), *Luci e ombre del nuovo sistema UE di tutela brevettuale*, cit., pp. 49-72, pp. 55-56.

²⁵ Art. 81 of the Treaty on the Functioning of the European Union, Consolidated version of the Treaty on the Functioning of the European Union, OJ C 326, 26.10.2012, p. 47-390.

²⁶ M., DESANTES REAL, «Hacia un tribunal unificado y un efecto unitario para las patentes europeas en casi todos los estados miembros de la Unión Europea. Consecuencias de la autoexclusión de España», cit., p. 64.

²⁷ Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, OJ L 339, 21.12.2007, p. 3-41.

under Art. 33 of the UPCA come into play. The UPCA explicitly distinguishes these provisions from international jurisdiction rules by using the term “competence” in the article’s title²⁸.

11. With regard to traditional European patents, they are essentially bundles of national patents, meaning their legal regime is not different from that of patents registered directly with national Intellectual Property Offices. As such, European patents validated in MS participating in the UPCA and those validated in MS outside the Agreement are both governed by the Brussels I bis Regulation.

The key difference lies in the specific competent court: for patents validated in UPCA Contracting MS, the competent courts are part of the UPC system²⁹, meaning that they are subject to the rules concerning allocation of cases among the UPC’s divisions mentioned above. Consequently, a specific case may be assigned to a court in a different MS than the one that would have jurisdiction under a strict application of the Brussels I bis Regulation³⁰. For patents validated in MS not party to the UPCA, the Brussels I bis Regulation will apply in full, along with their domestic rules on territorial and subject matter jurisdiction.

It should be pointed out, however, that Art. 83 of the UPCA establishes a transitional regime, under which, for a period of seven years following the Agreement’s entry into force, legal actions related to European patents validated in UPCA Contracting MS can still be brought before national courts. Furthermore, European patent owners and applicants who filed for a European patent before the end of the transitional period, can permanently opt out from the exclusive jurisdiction of the UPC. As a result, these patents, although validated in MS that are part of the UPCA, are governed by the territorial and subject matter rules on jurisdictions of the state in which they have been validated, while remaining subject to the rules on international jurisdiction provided by the Brussels I bis Regulation.

Finally, disputes concerning European patents validated in third countries which are part of the EPC fall outside the scope of the Brussels I bis Regulation. Instead, jurisdiction over these disputes is determined by the national PIL rules and domestic rules on territorial and subject matter jurisdiction of the respective non-EU countries.

12. To ensure the combined and coherent application of the Brussels I bis Regulation and the specific rules contained in the UPCA³¹, on 15 of May 2014 Regulation (EU) No. 542/2014 was adopted. As outlined in the explanatory memorandum of the Commission’s proposal, this regulation serves several objectives. First, it clarifies that the UPC³² qualifies as “court” within the meaning of the Brussels I bis Regulation. In this regard, Art. 71a of Regulation (EU) No. 542/2014 defines the UPC as a “common court”, in line with Art. 1 of the UPCA, and thus equivalent to any other court of the MS when exercising jurisdiction over matters within the scope of the Brussels I bis Regulation.

This clarification was deemed necessary due to the UPC’s specific structure and internal rules for allocating proceedings among its divisions. As noted earlier, these rules may lead to an action being brought before a court other than the one that would typically have jurisdiction under the Brussels I bis Regulation³³. Qualifying the UPC as a common court ensures that Art. 71 of the Brussels I bis Regulation³⁴ does not prevent the application of these rules on the division of competence.

²⁸ P. L. C., TORREMANS, «An International Perspective II: A View from Private International Law», in J., PILA, C., WADLOW, *The Unitary EU Patent System*, Oxford, Hart, 2015, pp. 161-178, p. 163.

²⁹ Although they remain integrated into the national judicial system of the MS.

³⁰ P. A., DE MIGUEL ASENSIO, «Tribunal Unificado de Patentes: competencia judicial y reconocimiento de resoluciones», *Anuario español de Derecho internacional privado*, 2013, 13, pp. 73-99, p. 78.

³¹ Explanatory Memorandum of the Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL amending Regulation (EU) No 1215/2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters /* COM/2013/0554 final - 2013/0268 (COD) */.

³² Along with the Benelux Court of Justice.

³³ In this regard, coordination between Art. 33 of the UPCA and the Brussels I bis Regulation may prove challenging, see M., DESANTES REAL, «Le “paquet européen des brevets”, paradigme du chemin à rebours : de la logique institutionnelle à la logique intergouvernementale», *Cahiers de droit européen*, 2013, 49(3), pp. 577-670, p. 663.

³⁴ According to Art. 71 of the Brussels I bis Regulation, the Regulation takes precedence over any international agreements concluded after its adoption.

Similarly, Art. 71b(1) of Regulation (EU) No. 542/2014 confirms that, for EU-domiciled defendants, the same jurisdictional rules apply to the UPC as to any other national court. While this provision may be redundant in light of Article 71a, it reflects the Commission's commitment to ensuring transparency in the coordination between the Brussels I bis Regulation and the UPCA³⁵. In essence, the above provisions ensure that, where the Brussels I bis Regulation grants jurisdiction to the courts of a MS that is part of the UPCA, and the subject matter of the case falls within the scope of the Agreement, jurisdiction is transferred from the national court to the UPC³⁶.

13. Secondly, Arts. 71b(2) and (3) establish uniform rules for defendants domiciled in third states where the Brussels I bis Regulation, according to its Art. 6, defers to national law³⁷. Specifically, under Art. 71b(2), where the defendant is not domiciled in a MS and the Regulation does not grant jurisdiction over them based on another ground for jurisdiction³⁸, the provisions on special jurisdiction of Arts. 7 and 8 of the Brussels I bis Regulation will apply as if the defendant were domiciled in a MS³⁹. This is a logical approach, given that patent protection cannot depend on the defendant's domicile⁴⁰. The UPC may also grant provisional or protective measures, even if a third-state court has jurisdiction over the substance of the matter. Contrary to Art. 35 of the Brussels I bis Regulation⁴¹, provisional measures will be granted in accordance with the rules of procedure of the UPC⁴².

Moreover, Art. 71b(3) extends the UPC's jurisdiction over non-EU domiciled defendants in infringement disputes causing damage outside the EU, provided the UPC has jurisdiction under Chapter II⁴³ of the Brussels I bis Regulation and that part of the damage occurs within the EU. In addition, it is necessary that the defendant owns property in a MS party to the UPCA and that the dispute has a sufficient connection with that MS. An example of relevant factors that may indicate such a connection is provided in Recital 7 of Regulation (EU) No. 542/2014, which mentions the claimant's domicile or the availability of evidence in that MS. The same Recital also specifies that, when determining its jurisdiction, the UPC should consider the value of the property, which must be sufficient to enforce the judgment.

14. Thirdly, Art. 71c specifies that the rules on *lis pendens* and related actions provided in Arts. 29-32 will apply between the UPC and the courts of the MS not party to the UPCA, as well as between the UPCA and the courts of MS party to the UPCA during the transitional period referred to in Art. 83 of the UPCA.

15. Finally, Art. 71d, addresses the recognition and enforcement of judgments. It stipulates, on the one hand, that judgments of the UPC must be recognised and enforced in MS not party to the UPCA. This means that even judgments based on special jurisdiction rules for non-EU domiciled defendants must be recognised in non-Contracting MS⁴⁴. On the other hand, it states that judgments from the courts of MS not party to the UPCA must be recognised and enforced in MS that are parties to the Agreement.

³⁵ M. C. A., KANT, *Cross-Border Patent Infringement Litigation within the European Union*, Groningen, Ulrik Huber Institute for Private International Law, 2015, p. 528.

³⁶ P. L. C., TORREMANS, «An International Perspective II: A View from Private International Law», *cit.*, p. 167.

³⁷ A domicile in an EU MS is a prerequisite for the general rules of the Brussels I bis Regulation to apply. According to Art. 6 of the Regulation, defendants domiciled outside the EU are subject to the national PIL rules of the court hearing the case.

³⁸ Such as validity (Art. 22(4)) or prorogation of jurisdiction (Art. 25), which do not require the defendant to be domiciled in the EU.

³⁹ P. A., DE MIGUEL ASENSIO, «The Unified Patent Court Agreement and the Amendment to the Brussels I Regulation (Recast)», in C., HONORATI (ed.), *Luci e ombre del nuovo sistema UE di tutela brevettuale*, *cit.*, pp. 153-169, pp. 158-159.

⁴⁰ P., MANKOWSKI, «Die neuen Regeln über gemeinsame Gerichte in Artt. 71a-71d Brüssel Ia-VO» *GPR: Zeitschrift für das Privatrecht der Europäischen Union*, 2014, 11(6), pp. 330-342, p. 336.

⁴¹ Which establishes that national courts may grant provisional measures according to their own national rules of procedure.

⁴² M. C. A., KANT, *Cross-Border Patent Infringement Litigation within the European Union*, *cit.*, p. 533.

⁴³ For instance, under the *forum delicti commissi* rule of Art. 7(2) of the Brussels I bis Regulation.

⁴⁴ P. A., DE MIGUEL ASENSIO, «The Unified Patent Court Agreement and the Amendment to the Brussels I Regulation (Recast)», *cit.*, pp. 167-168.

2. Applicable law

16. The applicable law in the European patent system primarily depends on the type of patent at issue and its corresponding legal regime. Based on the different categories of patents outlined in the Jurisdiction section, three legal regimes can be identified: 1) the regime governing unitary patents; 2) the regime applicable to European patents validated in UPCA Contracting MS and 3) the regime for European patents validated in MS not party to the UPCA, as well as in third countries that are party to the EPC.

The first two categories of patents fall under the hierarchy of legal sources set out in Art. 24(1) of the UPCA. Accordingly, the UPC must base its decision on a) EU law⁴⁵, including the Unitary Patent Regulation; b) the UPCA itself; c) the EPC; d) international agreements binding on UPCA Contracting MS; and e) national law. However, only the unitary patent is subject to the Unitary Patent Regulation. By contrast, European patents validated in MS not party to the UPCA, or in third countries that are parties to the EPC, are governed by the EPC and the national law of the state in which they have been validated.

17. As previously noted, identifying the applicable law depends on the specific category of patent and may entail engaging with all or some of the legal sources listed above. In the case of unitary patents, the analysis is particularly intricate. The key EU instrument intended to establish the core legal framework of the unitary patent, namely the Unitary Patent Regulation, does not provide for substantive provisions on patent protection⁴⁶. Instead, its Art. 5(1) merely emphasises the uniform nature of the protection and limitations of the unitary patent. However, the Regulation does provide conflict-of-law rules intended to identify the applicable substantive provisions governing both the property regime and patent infringement.

Specifically, Art. 7 of the Regulation sets out the criteria for determining the law applicable to a unitary patent as an object of property. This law will be the law of the Contracting MS in which the applicant had their residence, main place of business, or, if neither applies, any other place of business at the time of filing the application (Art. 7(1)). If no applicant has a connection to a Contracting MS, the law of the Contracting MS where the EPO has its headquarters, namely Germany, will apply (Art. 7(3)).

Similarly, Art. 5(3) of the Regulation deals with the conflict-of-law rules related to unitary patent infringement, establishing that the applicable law for infringement will be the law applied to unitary patents in the Contracting MS whose national law governs that patent as an object of property.

While the property regime of the unitary patent mirrors that of a national patent -meaning that the substantive provisions governing the property of national patents will apply directly⁴⁷- the determination of the law applicable to infringement requires a broader interpretation. Art. 5(3)⁴⁸ implies that all legal sources applicable to unitary patents in the relevant MS⁴⁹ come into play. These include the Unitary Patent Regulation itself, the UPCA, the EPC, relevant international agreements, and national law. This is consistent with the framework set forth in Art. 24(1) of the UPCA.

Nevertheless, the UPC will primarily rely on the UPCA and the national laws of the Contracting MS, as the other sources lack substantive provisions⁵⁰. The UPCA provides several substantive rules related to the *ius prohibendi* of the patent holder and its limitations (Arts. 25-27 of the UPCA), which

⁴⁵ The primacy of EU law within the hierarchy of sources is confirmed in Art. 20 of the UPCA.

⁴⁶ The lack of substantive rules in the Unitary Patent Regulation was contested by Spain in its action for annulment brought before the CJEU on March, 22 of 2013. The CJEU confirmed the validity of Regulation (EU) No 1257/2012. See CJEU, Judgment of 5 May 2015, case *Spain v Parliament and Council* (C-146/13), ECLI:EU:C:2015:298.

⁴⁷ For a critical analysis of Art. 7 of Regulation (EU) No 1257/2012 and its implications on the “right to patent”, see B., CALABRESE, «European patent with unitary effect but with variable law: regulating the right to patent for transnational inventions», *Revista Lex Mercatoria*, 2018, 8(1), pp. 29-37.

⁴⁸ Which refers to “the law applied to European patents with unitary effect in the participating Member State whose national law is applicable to the European patent with unitary effect as an object of property”.

⁴⁹ P. A., DE MIGUEL ASENSIO, «La patente europea con efecto unitario y su régimen jurídico», *cit.*, pp. 162-163.

⁵⁰ The EPC has limited relevance in this context. Art. 2 of the EPC, which refers to the substantive national law of the state in which the European patent has been validated, does not apply to unitary patents. Similarly, Art. 64 of the EPC, which defers infringement matters to national law, leads to the same outcome as the UPCA, since this reference includes national PIL rules, rules to which the UPCA also refers.

essentially define what constitutes an infringement of a unitary patent. However, issues such as the basis and extent of liability, remedies and damages will be dealt with by national law.

In this regard, Art. 24(2) of the UPCA provides that, to the extent that the UPC must apply national law, -including that of non-Contracting States- the applicable law will be determined as follows: a) primarily, in accordance with EU PIL rules; b) in the absence of relevant EU provisions, by reference to international PIL rules; and c) where neither EU nor international rules apply, based on the national PIL rules as determined by the UPC.

Given that the applicable national law must be determined primarily by applying the relevant provisions of EU PIL, in matters of infringement of a unitary IPR⁵¹ this should imply the application of Art. 8(2) of the Rome II Regulation⁵². Admittedly, Art. 27 of the Rome II Regulation specifies that the Regulation does not affect other EU instruments containing conflict-of-law rules for specific matters⁵³.

However, while Art. 24(2) of the UPCA may be understood as referring primarily to Art. 5(3) of the Unitary Patent Regulation, the latter in turn refers to the law applicable to unitary patents in the Contracting MS. This encompasses not only the substantive provisions of the UPCA but also the relevant national law. As confirmed by Recital 9 of the Unitary Patent Regulation⁵⁴, this reference to national law includes its PIL rules, thereby reaffirming the applicability of the Rome II Regulation⁵⁵.

18. According to Arts. 5(1) and (2) of the Unitary Patent Regulation, once the relevant national law is determined, it will confer protection on the unitary patent throughout the EU. This results in an extraterritorial extension of national patent law by virtue of EU law⁵⁶, as each unitary patent will be governed by a single national law across the territories of the Contracting MS⁵⁷. However, this also means that different unitary patents will be subject to different national laws. This system has been widely criticised as it fails to achieve true uniformity, resulting in the fragmented application of multiple national laws⁵⁸.

19. With respect to European patents validated in Contracting States of the UPCA, it has been shown that they are subject to the same sources of law as unitary patents, the sole distinction being that they do not fall within the scope of the Unitary Patent Regulation. Hence, these patents are governed first by Arts. 25-27 of the UPCA⁵⁹, which define the scope of protection.

⁵¹ Although, as pointed out earlier, the unitary nature of the unitary patent remains a subject of considerable debate.

⁵² Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II), OJ L 199, 31.7.2007, pp. 40-49. Art. 8(2) of the Rome II Regulation provides that the applicable law to non-contractual obligations resulting from an infringement of a unitary IPR is the law of the country in which the infringement is committed.

⁵³ P. A., DE MIGUEL ASENSIO, «La patente europea con efecto unitario y su régimen jurídico», *cit.*, pp. 163-164

⁵⁴ Recital 9 states “The European patent with unitary effect should confer on its proprietor the right to prevent any third party from committing acts against which the patent provides protection. This should be ensured through the establishment of a Unified Patent Court. In matters not covered by this Regulation or by Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of unitary patent protection with regard to the applicable translation arrangements, the provisions of the EPC, the Agreement on a Unified Patent Court, including its provisions defining the scope of that right and its limitations, and national law, including rules of private international law, should apply”.

⁵⁵ With all the practical consequences that this may entail. In fact, Article 8(2) leads to the so-called “mosaic principle”, meaning the application of as many laws as MS in which the infringement occurs. This contrasts with the uniform protection that, as will be discussed shortly, Arts. 5(1) and 5(2) of the Unitary Patent Regulation confer on the unitary patent.

⁵⁶ H., ULLRICH, «Select from within the system: The European patent with unitary effect», *Max Planck Institute for Intellectual Property and Competition Law Research Paper*, 2012, 11, pp. 1-47, p. 32.

⁵⁷ As noted above, while this is certainly the case for the legal regime of ownership, it is hard to conceive in disputes involving multistate infringement under Art. 8(2) of the Rome II Regulation.

⁵⁸ R. M., HILTY/T., JAEGER/M., LAMPING/H., ULLRICH, «The Unitary Patent Package: twelve reasons for concern», *Max Planck Institute for Intellectual Property and Competition Law Research Paper*, 2012, 12, pp. 1-11, p. 2.

⁵⁹ Admittedly, Article 24(1) designates EU law as the primary source, which naturally excludes the Unitary Patent Regulation. Given that EU law lacks substantive rules concerning European patents, this reference may be understood as pointing directly to the EU rules on PIL, which in turn defer to national law. However, Arts. 25-27 of the UPCA, when defining the scope of protection, refer generally to “patents” without distinguishing between unitary and European patents. It must therefore be understood that these provisions apply to both. That said, this is a complex issue that falls outside the scope of the present paper.

Second, they are subject to the EPC⁶⁰, which refers to the national law of the state in which the patent has been validated. On the one hand, Art. 2 of the EPC grants European patents the same treatment as national patents, thereby implying the direct application of substantive national law⁶¹. On the other hand, for infringement matters, the reference in Art. 64 of the EPC to national law includes national PIL rules⁶². However, pursuant to Art. 24(2) of the UPCA, when the UPC bases its decision on national law, this law must first be determined through the relevant rules of EU PIL. As a result, in infringement matters, Art. 8(1) of the Rome II Regulation will apply⁶³ to all issues not expressly covered by the UPCA itself⁶⁴.

20. For the European patents with effect in MS which are not Contracting States under the UPCA, as well as those with effect in third states participating in the EPC, the determination of the applicable law is more straightforward. In both cases, the EPC applies, referring to the law of the state in which the European patent has effect. As with European patents validated in UPCA Contracting States, the substantive provisions of the applicable national law will govern directly the European patent as if it were a national patent.

With regard to infringement matters, the European patents validated in non-Contracting MS will be governed by the law determined under Art. 8(1) of the Rome II Regulation⁶⁵. However, the application of the Rome II Regulation in this case is triggered not by Art. 24(2) of the UPCA -which does not apply in this context- but directly by Art. 64 of the EPC. For European patents validated in third states, Art. 64 of the EPC applies, leading to the application of the PIL rules of those states.

21. Lastly, it is worth noting that, in contrast to the approach taken with the substantive law of the unitary patent, the UPC Statute⁶⁶, together with its Rules of Procedure⁶⁷, establishes a genuine EU Code of Civil Procedure specifically applicable to unitary and European patents in force in the Contracting States of the UPCA⁶⁸. This Code sets out detailed rules on legal capacity, party representation, evidence, written and oral proceedings, provisional measures, injunctions, appeals, and other procedural matters.

IV. The judgment of the Unified Patent Court in Case UPC_CFI_355/2023

22. In light of the intricate legal framework outlined above, the extent of the UPC's jurisdiction remains somewhat ambiguous. Admittedly, disputes concerning unitary patent should not present any difficulties, as all MS in which unitary patents are protected are indisputably subject to the UPC's jurisdiction. However, litigation involving traditional European patents may prove more complex, as a European patent can designate both UPCA Contracting and non-Contracting States⁶⁹.

⁶⁰ Which could not apply to unitary patents given the primacy of the Unitary Patent Regulation.

⁶¹ National law will thus govern matters such as validity and ownership.

⁶² Art. 64 of the EPC states that "any infringement of a European patent will be dealt shall by national law". This provision should be understood as also encompassing national PIL rules, in contrast to Art. 2 of the EPC, which provides that European patents are to be treated in the same manner as national patents.

⁶³ Admittedly, the application of Art. 24(2) of the UPCA leads to the same outcome as applying Art. 64 of the EPC, namely, the application of the Rome II Regulation.

⁶⁴ Art. 8(1) of the Rome II Regulation states that the applicable law to non-contractual obligations resulting from an infringement of an IPR is the law of the country for which protection is sought. This provision codifies the *lex loci protectionis* principle, ultimately leading to the application of the same law that would be determined under Art. 2 of the ECP.

⁶⁵ Art. 8 of the Rome II Regulation is thoroughly examined by G., PALAO MORENO, in G., PALAO MORENO «La protección de los derechos de propiedad intelectual en Europa: el artículo 8 del Reglamento Roma II», *Revista Jurídica del Deporte y Espectáculo*, 2008, pp. 557-571.

⁶⁶ Annex I of the UPCA.

⁶⁷ Rules of Procedure of the Unified Patent Court, as adopted by decision of the Administrative Committee on 8 July 2022.

⁶⁸ M., DESANTES REAL, «Hacia un tribunal unificado y un efecto unitario para las patentes europeas en casi todos los estados miembros de la Unión Europea. Consecuencias de la autoexclusión de España», *cit.*, p. 65.

⁶⁹ EU MS as well as third countries.

This is evidenced by the recent judgment of the Düsseldorf Local Division of the UPC (the Court) in case UPC_CFI_355/2023, concerning a European patent owned by Fujifilm. Fujifilm initiated an infringement action against several Kodak subsidiaries regarding alleged infringing activities in both Germany and the UK. The defendants, on the one hand, filed a counterclaim for revocation of the German part of the European patent. On the other hand, they challenged the Court's jurisdiction over the infringement claims related to the UK part of the patent. This latter defence will be the focus of this analysis.

23. Specifically, the defendants maintained that the Court's jurisdiction covers solely the alleged infringement in Germany and does not encompass the UK. Among several arguments, the defendants argued that under Art. 34 of the UPCA, the UPC can only assert jurisdiction over UPCA Contracting MS. Pursuant to Art. 34, in disputes involving European patents, the decision of the UPC will cover the territory of those Contracting MS in which the patent has been validated. Given that the UK is not a party to the UPCA, the territorial scope of a UPC decision cannot extend to the UK.

Moreover, the defendants call into play Art. 71a⁷⁰ of Regulation (EU) No 542/2014, according to which the UPC has jurisdiction only "pursuant to the instrument establishing it". Similarly, under Art. 71b, the jurisdiction of the UPC is limited to matters "governed by that instrument"⁷¹. Finally, pursuant to Art. 24(4) of the ⁷², the Court lacks the authority to revoke the UK part of the European patent. Moreover, this provision precludes the claimant from bringing an infringement action over this patent, as the UK's national courts have exclusive jurisdiction.

24. Conversely, the claimant argued that the Court's jurisdiction over infringement extends to both Germany and the UK. It was argued, among other things, that Art. 34 of the UPCA should be interpreted alongside Art. 3(2) of the Unitary Patent Regulation. The latter stipulates that the unitary patent ensures uniform protection and has the same effect across all Contracting MS. By contrast, European patents lack unitary effect, which is why Art. 34 guarantees that the UPC's decisions also apply uniformly to these patents in all Contracting MS.

Art. 34 of the UPCA, therefore, does not address international jurisdiction. Instead, this falls under Art. 31 of the UPCA, which, in turn, refers to the Brussels I bis Regulation. Accordingly, the Court has jurisdiction pursuant to Art. 4 of the Brussels I bis Regulation, as all the defendants are domiciled in Germany.

Furthermore, according to the claimant, there is more evidence indicating that the UPC's jurisdiction extends to non-Contracting MS. For instance, Art. 71b of Regulation (EU) No. 542/2014 concerning the disputes involving defendants not domiciled in the EU⁷³ and Art. 24(2) of the UPCA regarding the sources of law to which the UPC can resort, which include the law of the non-Contracting MS.

Lastly, with respect to Art. 24(4) of the Brussels I bis Regulation, which the defendant invoked to limit the Court's jurisdiction, the claimant maintained, first, that this provision -which enshrines the CJEU's ruling in *GAT v LUK*⁷⁴- does not automatically imply that exclusive jurisdiction on validity also extends to infringement. Secondly, regarding validity itself, Art. 24(4) grants exclusive jurisdiction only to courts of EU MS, meaning that UK's courts do not have such jurisdiction, at least not under Art. 24(4).

⁷⁰ Art. 71a(1) states the following: "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".

⁷¹ Art. 71b 1) states the following: "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".

⁷² Art. 24(4) of the Brussels I bis Regulation establishes that, in matters concerning the validity of patents and, more broadly, registered IPRs, exclusive jurisdiction lies with the courts of the MS where the rights are deposited or registered.

⁷³ This, however, hardly demonstrates that the UPC's decisions can extend to states not party to the UPCA. Admittedly, as previously noticed in the analysis of Regulation (EU) No. 542/2014, Art. 71b(2) is intended to ensure that provisions such as Art. 7(2) of the Brussels I bis Regulation apply irrespective of the domicile of the defendant. In this regard, it may be argued that the objective of Art. 71b(2) is to confer jurisdiction on the UPC over non-EU domiciled defendants, provided they are sued, for instance, for infringing a European patent in an UPCA Contracting State.

⁷⁴ CJEU, Judgment of 13 July 2006, case *GAT* (C-4/03), ECLI:EU:C:2006:457.

25. The Court rejected the preliminary objection, as, on the one hand, the action for revocation concerned only the patent's validity within a Contracting MS, namely Germany. Consequently, the Court was not required to decide on its jurisdiction to revoke patents registered in third states, such as the UK⁷⁵.

On the other hand, the Court maintained that it has jurisdiction over an infringement action concerning a European patent validated in the UK. Specifically, the Court agreed with the claimant that Art. 34 of the UPCA, invoked by the defendant to challenge the Court's jurisdiction, does not govern the jurisdiction of the UPC but rather the territorial scope of its decisions within the Contracting MS⁷⁶. This provision does not preclude those decisions from producing effects beyond their territory⁷⁷.

Jurisdiction of the UPC is, by contrast, governed by the Brussels I bis Regulation, as explicitly referenced in Art. 31 of the UPCA. As a consequence, given that all the defendants are domiciled in Germany, the Court has jurisdiction under Art. 4 of the Brussels I bis Regulation. According to the Court, this Regulation is not intended to apply exclusively to disputes concerning EU MS⁷⁸. As emphasised by the CJEU⁷⁹, the Brussels I bis Regulation may also apply in cases connected to third states⁸⁰. The Court also cited Advocate General's opinion in *BSH Hausgeräte*⁸¹, which deemed the ground for jurisdiction of Art. 4(1) Brussels I bis Regulation as "universal".

26. With respect to Arts. 71a and 71b of Regulation (EU) No. 542/2014, the Court held that these provisions do not limit the UPC's jurisdiction to patent infringement within Contracting MS. On the contrary, they clarify that all grounds of jurisdiction of the Brussels I bis Regulation applicable to national courts, along with the relevant CJEU's case law, also apply to the UPC⁸². As previously noted, Art. 4 of the Brussels I bis Regulation allows national courts to hear disputes involving third states, provided the defendant is domiciled in a MS. As a result, also the UPC can hear these disputes.

Moreover, the wording "matter governed by that instrument" of Art. 71b must not be interpreted as limiting the UPC's jurisdiction. Instead, it serves to define the specific subject matter -namely, disputes concerning European patents- for which jurisdiction is transferred from national courts to the UPC under the UPCA⁸³.

27. Another argument raised against the Court's jurisdiction over the infringement of the UK part of the European patent relied on Art. 24(4) of the Brussels I bis Regulation, which grants exclusive jurisdiction over validity matters to the courts of the MS in which the patent is registered. It was contended that this exclusive jurisdiction would prevent the Court from asserting jurisdiction over infringement claims concerning a European patent validated in the UK whose validity is challenged.

In line with the claimant's arguments, the Court held that when the defendant challenges validity within infringement proceedings, this does not automatically divest MS' courts of their jurisdiction over the infringement action. Accordingly, the Court remains competent to hear the case pursuant to Art. 4 of the Brussels I bis Regulation.

⁷⁵ UPC_CFI_355/2023, *cit.*, p. 21.

⁷⁶ The Court argued that "European patents are not necessarily in force in all Contracting Member States, so that Art. 34 UPCA can also be understood to clarify that, in the case of a European patent, decisions of the UPC normally cover the entire territory of the UPC, only with the exception of the territories of those Contracting Member States where that European patent is not or is no longer in force".

⁷⁷ UPC_CFI_355/2023, *cit.*, p. 23.

⁷⁸ UPC_CFI_355/2023, *cit.*, p. 22.

⁷⁹ CJEU, Judgment of 1 March 2005, case *Owusu* (C-281/02), ECLI:EU:C:2005:120, paragraphs 30-35.

⁸⁰ Specifically, the CJEU maintained that the former Art. 2 of the Brussels Convention "applies to circumstances such as those in the main proceedings, involving relationships between the courts of a single Contracting State and those of a non-Contracting State rather than relationships between the courts of a number of Contracting States".

⁸¹ AG, Opinion of 22 February 2024, case *BSH Hausgeräte* (C-339/22), ECLI:EU:C:2024:159, paragraph 30.

⁸² UPC_CFI_355/2023, *cit.*, p. 22.

⁸³ *Ibidem*.

The Court did not address the claimant's additional argument that Art. 24(4) of the Brussels Ibis Regulation confers exclusive jurisdiction only on courts of EU MS⁸⁴, and that, consequently, UK courts no longer benefit from such exclusive jurisdiction under that provision.

In any event, the key point, as acknowledged by the Court at the outset of its reasoning, is that the defendant did not raise any exception or counterclaim regarding the validity of the patent in the UK. Hence, the Court could have reasonably adopted a response similar to that given in relation to the defendant's objection regarding its authority to revoke the UK part of the European patent.

28. Ultimately, the Court maintained that, based on the aforementioned grounds, it had jurisdiction over the infringement of the UK part of the European patent. However, it rejected the claimant's arguments relying on Art. 24(2) of the UPCA, finding it irrelevant for establishing jurisdiction. Admittedly, while Art. 24(2) allows the UPC to apply the law of non-Contracting States, the Court stressed that jurisdiction must be distinguished from the question of applicable law. Similarly, the Court did not consider the claimant's reasoning based on Articles 71b(2) and (3), as these provisions apply to situations where the defendant is domiciled outside the EU, a matter entirely unrelated to the case at issue.

29. It should be pointed out that the Court, while acknowledging its jurisdiction, ultimately dismissed the infringement action in both Germany and the UK. The Court ruled in favour of the counterclaim for revocation of the patent in Germany. On that basis, and in the absence of any argument demonstrating that the UK patent would have withstood a validity challenge in the UK, the Court assumed that the grounds for invalidity set out in relation to the German part of the European patent also apply to the UK part of that patent⁸⁵.

V. What are the limits of the Unified Patent Court jurisdiction after Judgment UPC_CFI_355/2023?

30. From the decision and the parties' submissions, as previously analysed, two main issues emerge that warrant further discussion: 1) The scope of the UPC's jurisdiction in relation to infringement of European patents validated in non UPCA Contracting States; and 2) The interplay between infringement and validity proceedings under the Brussels I bis Regulation.

Although the Düsseldorf Local Division of the UPC did not address the second issue directly, the dismissal of the infringement action concerning the UK patent -based on the invalidity of the corresponding German patent- offers interesting insights for analysis. This becomes even more compelling in light of the recent CJEU decision in *BSH Hausgeräte*⁸⁶, in which the CJEU acknowledged that, under certain circumstances, a court of a MS hearing a patent infringement claim may assess the validity of the patent where invalidity is raised as a defence.

1. The Unified Patent Court as any other court of the Member States

31. As observed in the previous section, the Court held that Art. 34 of the UPCA does not govern the UPC's jurisdiction, but rather concerns the effects of its decisions over European patents within those Contracting MS in which the patents have been validated. As its title suggests, this provision addresses the territorial scope of UPC decisions.

Jurisdiction is instead addressed in Art. 31 of the UPC, which refers to the Brussels Ibis Regulation. Pursuant to Arts. 71a and 71b(1) of Regulation (EU) No. 542/2014, the Brussels I bis Regulation

⁸⁴ In this regard, the first sentence of Art. 24 states "The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties".

⁸⁵ The Court maintained that "it would have been up to the Claimant to comment specifically on the differences between the Contracting Member States and the UK and to explain why these (possibly) lead to a different assessment of the validity of the UK part of the patent in suit".

⁸⁶ CJEU, Judgment of 25 of February 2025, case *BSH Hausgeräte* (C-339/22), ECLI:EU:C:2025:108.

applies in full to the UPC. In essence, this means that where a national court would have jurisdiction under the Brussels I bis Regulation, the UPC also has jurisdiction, in respect of the matters falling within the scope of the UPCA, namely, unitary patents and European patents.

To fully understand the role of Arts. 71a and 71b(1) it is important to recall that jurisdiction over European patents validated in EU MS traditionally lay with national courts. This jurisdiction was exercised in the same manner as for purely national patents, *i.e.*, patents not originating from a European patent application. Despite the difference in the granting process, both are, in legal effect, national patents. The key difference introduced by the UPCA is that national patents resulting from a European patent application now fall under the jurisdiction of the UPC.

32. According to the CJEU's case-law on the Brussels I bis Regulation, MS' courts have jurisdiction over disputes which, because of their subject matter or the claimant's domicile, involve third states⁸⁷. Notably, Art. 4 of the Brussels I bis Regulation has a "universal character", as affirmed by Advocate General Emiliou⁸⁸ and confirmed by the CJEU's reasoning in *BSH Hausgeräte*⁸⁹. In particular, the CJEU stated that cases where the defendant is domiciled in a MS and the subject matter of the proceedings, such as a patent, is located in a third state, fall within the scope of the Brussels I bis Regulation⁹⁰.

In the context of cross-border European patent infringement disputes, this implies that, prior to the establishment of the UPC, a court in a MS where a defendant was domiciled could hear infringement actions relating to European patents validated both within and outside the EU⁹¹.

While European patents are now subject to the UPC's jurisdiction, the application of the Brussels I bis Regulation -and its interpretation developed by the CJEU- remains unchanged. Accordingly, when a defendant is sued before the UPC in the Contracting MS where they are domiciled⁹², Art. 4 applies just as it would if the proceedings were before a national court. Consequently, the UPC, like any other national court, has jurisdiction to hear infringement actions concerning European patents validated both within and outside the territory of the Contracting MS.

Art. 24(2) of the UPCA appears to take the above for granted, as it allows the UPC to base its decision on the law of non-Contracting states. The claimant attempted to invoke this provision to support its argument on jurisdiction. The Court, correctly, rejected this reasoning, noting that Art. 24(2) of the UPCA clearly concerns the determination of the applicable law and cannot serve as a basis for establishing jurisdiction. However, in cases where the jurisdictional framework leaves room for interpretation, rules on applicable law may serve as an interpretative instrument to clarify jurisdictional issues. While rules on applicable law cannot themselves establish grounds for jurisdiction, in some instances they presuppose them⁹³.

33. Regardless, although the Court held that the UPC may assert jurisdiction solely on the basis of the defendant's domicile being in a Contracting MS, it is a different matter whether a decision concerning an infringement committed in a third country -such as the UK- will ultimately be recognised and enforced there.

⁸⁷ CJEU, case *Owusu* (C-281/02), *cit.*, paragraphs 30-31; CJEU, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraph 70.

⁸⁸ AG, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraph 30.

⁸⁹ CJEU, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraphs 59-61 and 70.

⁹⁰ *Ibidem*, paragraphs 59-60.

⁹¹ For an analysis on the extent of the jurisdiction of the court of the defendant's domicile, see M., FRANZOSI, «GAT and Roche - idola fori, teatri, specus: Regulation 864/2007 makes cross-border patent litigation possible», *Journal of Intellectual Property Law & Practice*, 2009, 4(4), pp. 247-251. The author argues that there are no explicit limitations in the Brussels I bis Regulation that prevent MS courts from ruling on the infringement of IPRs granted in third countries, p. 249.

⁹² Or before the court that would be competent as a result of the combination of the Brussels I bis Regulation with the rules on allocation of cases under the UPCA. While this court may not be located in the MS where the defendant is domiciled, for the purposes of the Brussels I bis Regulation it is considered equivalent to the court of the defendant's domicile.

⁹³ See M., FRANZOSI, «GAT and Roche - idola fori, teatri, specus: Regulation 864/2007 makes cross-border patent litigation possible», *cit.*, p. 248. The author argues that the fact that the Brussels I bis Regulation allows cross-border jurisdiction over infringement of IPRs can be inferred by the Rome II Regulation.

A claimant may, for instance, seek damages in Germany for infringement that occurred in the UK. However, there is no guarantee that an injunction ordering the cessation of infringing activities or the destruction of infringing goods will be enforceable in the UK. Since the UK is no longer an EU MS, it is not bound by the Brussels I bis Regulation in relation to proceedings initiated after the end of the transitional period provided for in the UK-EU Withdrawal Agreement.

34. While in third countries the far-reaching jurisdiction of the UPC may be considered controversial, the same cannot be said of states that, although not parties to the UPCA, are members of the EU -such as Croatia, Poland, and Spain. As EU MS, they are bound by the Brussels I bis Regulation, which constitutes secondary EU law. If the UPC can rule on the infringement of European patents validated in third countries by virtue of the universal character of Art. 4 of the Brussels I bis Regulation -despite the Regulation not being directly applicable to those states- then *a fortiori*, the Regulation should apply within the EU, including in MS that are not parties to the UPCA.

As pointed out above, if a national court of a MS could previously hear a case involving the infringement of a European patent with effect in, for example, Spain, then the UPC may now also exercise that jurisdiction under the Brussels I bis Regulation, as amended by Regulation (EU) No. 542/2014.

35. Similarly, MS that are not party to the UPCA may be affected by this instrument in other manners. For instance, defendants domiciled in Spain may be sued before a division of the UPC located in a MS different than the one that would ordinarily have jurisdiction according to the standard conflict-of-law rules of the Brussels I bis Regulation⁹⁴.

Notably, the combined application of Art. 7(2) of the latter with Art. 33(1)(a) of the UPCA -which is made possible by Regulation (EU) No. 542/2014- confers jurisdiction on the local division of the Contracting MS where the infringement occurs or on the regional division in which that MS participates. As a result, a court in a different MS from the one where the infringement truly takes place may nonetheless be competent to hear the case, thereby deviating from the jurisdictional outcome that would arise under Art. 7(2) of the Brussels I bis Regulation alone.

36. Ultimately, it may be argued that it seems unjustified that an international agreement, to which a MS like Spain is not a party, influences the operation of an EU instrument to which that state, as an EU MS, is subject. However, the jurisdictional and competence provisions contained in the UPCA should be regarded as having the same effect as EU law itself for all MS, as they are incorporated into the EU legal framework through Regulation (EU) No. 542/2014.

To further reinforce this, and to ensure that the deviation in the jurisdictional rules remains practically effective in non-Contracting MS, Art. 71d of Regulation (EU) No. 542/2014 clarifies that the recognition and enforcement rules of the Brussels I bis Regulation apply to UPC judgments as well⁹⁵. This aims at guaranteeing that these jurisdiction rules result in judgments that are recognisable and enforceable throughout the EU. Admittedly, this specification may not have even been necessary, since, as mentioned earlier, the UPC is treated as a national court of a MS, and therefore its judgments must be recognised and enforced in all MS.

37. It is worth pointing out that it remains unclear whether the opt-out mechanism provided for in Art. 83 of the UPCA implies concurrent jurisdiction between national courts and the UPC over a specific European patent, or whether opting out instead confers exclusive jurisdiction on the national courts. Should the latter be the case, it seems paradoxical that a proprietor of a European patent validated in a UPCA Contracting State can avoid the UPC's jurisdiction by opting to grant such jurisdiction to the

⁹⁴ M., DESANTES REAL, «Hacia un tribunal unificado y un efecto unitario para las patentes europeas en casi todos los estados miembros de la Unión Europea. Consecuencias de la autoexclusión de España», *cit.*, p. 68.

⁹⁵ Admittedly, Art. 71d establishes that the Brussels I bis Regulation will apply to judgments given by the UPC which are to be recognised and enforced in a MS not party to the UPCA as well as judgments given by the courts of a MS not party to the UPCA which are to be recognised and enforced in a MS party to the Agreement.

national courts of the Contracting State, while European patents having effect in states that are not, or are no longer, party to the Agreement remains subject to the UPC jurisdiction. It is true that, in the absence of an opt-out, where an infringement action is brought before national courts, those courts must decline jurisdiction in favor of the UPC, while courts in non-Contracting states like the UK and Spain are under no such obligation⁹⁶.

However, this discrepancy is particularly striking in scenarios where an infringement action concerning a European patent is brought before the UPC. In such cases, the UPC is required to decline jurisdiction if the proprietor of a European patent has opted out. However, the UPC is not required to decline jurisdiction over European patents with effect in non-Contracting states.

38. Be that as it may, with regard to MS not party to the UPCA, it has already been shown that the interplay between the Brussels I bis Regulation -as amended by Regulation (EU) No. 542/2014- and the UPCA binds them to the jurisdiction of the UPC. By contrast, the jurisdictional basis arising from the combination of these instruments may, from the perspective of third states not party to the Agreement, be legitimately viewed as an exorbitant ground of jurisdiction.

39. In this context, it should be noted that, unlike unitary patents, European patents do not automatically fall within the subject matter jurisdiction of the UPC, at least not when validated in non-Contracting states of the UPCA.

It is important to emphasise that subject matter jurisdiction can derive from the same source of law that governs the subject matter, or from different, yet coordinated, legal sources⁹⁷. For instance, a court in a given state may have jurisdiction over a specific subject matter by virtue of national law. Similarly, a national court may assert jurisdiction over a matter governed by an international or EU instrument⁹⁸.

Regarding unitary patents, they fall within the subject matter jurisdiction of the UPC due to the combined application of the Unitary Patent Regulation and the UPCA. The situation is different for European patents, where a distinction must be made between Contracting and non-Contracting States of the UPCA. In both cases, the governing legal sources for European patents are the EPC and the national law of the respective states. The EPC governs the granting process, while all other aspects -since a European patent is, in essence, a national patent- are handled by national law, including the determination of jurisdiction⁹⁹. Consequently, national law assigns subject matter jurisdiction to the national courts.

However, while the national law of the Contracting States may not directly grant jurisdiction to the UPC, by ratifying the UPCA, these states effectively transfer subject matter jurisdiction over European patents validated within their territories from the national courts to the UPC. In other words, the UPC acquires a territorially limited subject matter jurisdiction over European patents. National courts, meanwhile, retain subject matter jurisdiction over purely national patents, *i.e.*, those not originating from a European patent application.

Conversely, European patents validated in non-Contracting states, whether EU Member States or third states, do not fall within the subject matter jurisdiction of the UPC. As mentioned above, the EPC defers this issue to the national law of each state, which assigns subject matter jurisdiction to the national courts. However, unlike in the case of Contracting States, there is no international agreement that deprives the national courts of their jurisdiction. As a result, subject matter jurisdiction over all national patents -whether originating from national or European applications- remains with the national courts.

⁹⁶ The UK being neither an EU MS nor a UPCA Contracting state. Spanish courts, on the other hand, are not required to decline jurisdiction pursuant to the Brussels I bis Regulation itself. This is precisely why Art. 71d, as pointed out earlier, also ensures that judgments concerning European patents delivered by courts in MS not party to the UPCA are recognised and enforced in UPCA Contracting MS.

⁹⁷ By source of law or legal sources is meant the legal framework -national, EU, or international- from which legal instruments originate.

⁹⁸ For instance, the EU trade mark courts are national courts with jurisdiction over EU trade mark disputes.

⁹⁹ The EPC itself leaves the determination of jurisdiction to the national law of each state. See the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent (Protocol on Recognition), annexed to the EPC and Art. 64 of the EPC, which states that any infringement of a European patent will be dealt with by national law.

Non-Contracting MS, therefore, are subject to the UPC's jurisdiction not on the basis of its subject matter jurisdiction but, as previously noted, solely by virtue of the operation of the Brussels I bis Regulation and its rules on international jurisdiction. In this respect, it is important to point out that, similarly to the UPC, national courts hearing infringement actions concerning patents registered in other states under Art. 4 of the Brussels I bis Regulation do not possess subject matter jurisdiction either. Nevertheless, they are competent to hear such cases based on the same international jurisdiction rules set out in the Brussels I bis Regulation.

In light of the above, it is difficult to imagine that courts in third states -which have neither transferred subject matter jurisdiction to the UPC, nor are bound by the international jurisdiction rules of the Brussels I bis Regulation- would recognise the UPC's jurisdiction over European patents validated in their territories.

Ultimately, although the UPC may assert jurisdiction over alleged infringements of such patents, the prospects for actual enforcement are minimal. It may be argued, however, that repeated damages claims relating to a third-state patent, brought before a court in a Contracting MS where the defendant is domiciled, could pressure the defendant into voluntarily withdrawing the patent in the third state.

2. The question of validity within infringement proceedings

40. As observed earlier, the defendants filed a counterclaim for revocation of the European patent in Germany and the Court ultimately found the patent to be invalid. They also pointed out that the UPC lacks jurisdiction over the validity of the UK part of the European patent. While acknowledging this, the Court held that, in accordance with the CJEU's case-law, raising the issue of validity does not entail a loss of jurisdiction over the infringement claim¹⁰⁰.

However, the infringement claim was dismissed based on the finding that the German part of the European patent was invalid. The Court reasoned that, absent compelling arguments supporting the validity of the UK part of the patent, it should be presumed to be no more valid than the German part.

This conclusion is particularly significant, as the Court has, in effect, indirectly ruled on the validity of the UK patent *inter partes*. In this regard, the exclusive jurisdiction rule enshrined in Art. 24(4) of the Brussels I bis Regulation -which codifies the CJEU's interpretation in *GAT v. LUK*- provides that only the courts of the MS where an IPR is registered have jurisdiction to rule on its validity, irrespective of whether the issue is raised by way of action or as a defence. This implies that courts hearing infringement actions cannot rule on validity, even if the issue is raised as a defence and the resulting decision would have effect only between the parties.

In the case at hand, however, an *inter partes* ruling on validity was permissible under Art. 24(4) itself, which confers exclusive jurisdiction only on the courts of EU MS. As a third state, the UK is no longer subject to the jurisdictional regime set out in Art. 24(4)¹⁰¹. This position was acknowledged by the CJEU¹⁰², which seems to take a contrasting approach compared to the Court's interpretation of Art. 4 of the Brussels I bis Regulation. In *BSH Hausgeräte*, the CJEU -aligning with Advocate General Emiliou's opinion¹⁰³- emphasised that the Brussels I bis Regulation establishes a jurisdictional system internal to the EU¹⁰⁴.

41. In any event, based on the wording of Art. 24(4) and the recent CJEU's case law¹⁰⁵, the conclusion is that courts of MS hearing infringement actions concerning patents registered in third states

¹⁰⁰ A clarification that, as noted above, was not necessary as to the outcome of the case, since the defendant did not challenge the validity of the UK part of the European patent.

¹⁰¹ In *Irnova* the CJEU confirmed that Art. 24(4) of the Brussels I bis Regulation is not applicable in relation to patents granted in third states. CJEU, Judgment of 8 September 2022, case *IRnova* (C-399/21), ECLI:EU:C:2022:648, paragraph 35.

¹⁰² CJEU, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraphs 53-76.

¹⁰³ AG, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraph 23.

¹⁰⁴ CJEU, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraph 55.

¹⁰⁵ CJEU, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraph 76.

may rule on validity with *inter partes* effect where the issue is raised as a defence¹⁰⁶. By contrast, where the challenged patent is registered in another MS, the court seised of the infringement action cannot rule on validity¹⁰⁷.

However, in denying the court hearing the infringement action jurisdiction over the validity defence, the CJEU clarified an issue left unresolved since the *GAT* judgment: whether a challenge to validity deprives the court of jurisdiction over the infringement claim. The CJEU held that raising the issue of validity in infringement proceedings does not divest the court of its jurisdiction to hear the infringement action. Instead, the court may decide to stay the proceedings where “there is a reasonable, non-negligible possibility of that patent being declared invalid by the court of that other Member State”¹⁰⁸.

42. At any rate, it is still striking that courts of MS may rule on the validity of patents -or more broadly, registered IPRs- with effects limited to the parties only when the right in question is granted in a third state. In contrast, for IPRs granted in other MS, the only available mechanism for a preliminary assessment of validity is to stay the proceedings. The resulting possibility of fragmented litigation risks undermining the effectiveness of cross-border relief in relation to IPRs registered across several MS¹⁰⁹.

This is, regrettably, the legacy of the *GAT* judgment, a precedent that has since been codified in Art. 24(4) of the Brussels I bis Regulation, and that fails to account for the significance of the defendant’s forum within the structure of the Regulation¹¹⁰. According to settled CJEU case law, exclusive jurisdiction rules must be interpreted restrictively, as exceptions to the general rule¹¹¹. Accordingly, the application of Article 24(4) should be limited to cases where the decision may produce *erga omnes* effects and thereby jeopardise the validity of the IPR at stake¹¹². In other words, where validity is raised by way of an action or counterclaim before a court seised under Art. 4 of the Brussels I bis Regulation, or under any jurisdictional ground other than that provided for in Art. 24(4).

VI. Conclusions

43. The European patent system is governed by a unique legal framework combining national, international, and EU legal instruments. The coexistence of unitary patents and European patents -validated across both Contracting and non-Contracting States- together with the plurality of legal sources governing jurisdiction and applicable law, results in a complex and often fragmented judicial landscape. A central aspect of this complexity lies in the challenge of integrating non-Contracting MS and third countries into a coherent litigation framework. It is within this multifaceted legal environment that the UPC_CFI_355/2023 judgment must be understood.

This judgment offers a compelling case study on the complexities of UPC jurisdiction in an increasingly pluralistic European patent landscape. The decision confirms that the UPC has the authority to hear infringement cases involving European patents validated in third states -such as the UK- provided the defendants are domiciled in a Contracting MS.

¹⁰⁶ It may be wondered what the outcome would be where validity is challenged by way of counterclaim or through separate proceedings initiated before the court of the third state in which the patent is registered. In such cases, the national court should still be permitted to continue hearing the infringement action, either by rejecting the counterclaim for lack of subject-matter jurisdiction, or by continuing the infringement proceedings where the separate invalidity action was brought after the infringement proceedings were already pending. In the opposite case, that is, where an action on validity is brought before the court of a third state prior to a court of a MS being seised with an infringement action, the latter court may stay its proceedings pursuant to Art. 33 of the Brussels I bis Regulation.

¹⁰⁷ CJEU, case *BSH Hausgeräte* (C-339/22), *cit.*, paragraphs 35-37.

¹⁰⁸ *Ibidem*, paragraphs 50-51.

¹⁰⁹ P. A., DE MIGUEL ASENSIO, *Conflict of Laws and the Internet* (2nd ed.), Cheltenham, Edward Elgar Publishing, 2024, p. 314.

¹¹⁰ A., KUR, «A Farewell to Cross-Border Injunctions? The ECJ Decisions *GAT v. LuK* and *Roche Nederland v. Primus* and *Goldenberg*», *International Review of Intellectual Property and Competition Law*, 2006, 37(7), pp. 844-855, p. 848.

¹¹¹ CJEU, Judgment of 15 of November 1983, case *Duijnste* (C-288/82), ECLI:EU:C:1983:326, paragraph 23.

¹¹² P. L. C., TORREMANS, «The Widening Reach of Exclusive Jurisdiction: Where Can You Litigate IP Rights after *GAT*?» in A., NUYTS, *International Litigation in Intellectual Property and Information Technology*, Alphen aan den Rijn, Kluwer Law International, 2008, pp. 61-77, p. 76.

This reflects the universal application of Art. 4 of the Brussels I bis Regulation, a principle reinforced by the CJEU in *BSH Hausgeräte*. Nevertheless, the Court's reliance on the defendant's domicile as the key factor for asserting jurisdiction reveals a structural tension. Unitary patents and European patent with effect in UPCA Contracting States fall unequivocally within the subject matter jurisdiction of the UPC due to the combined application of the Unitary Patent Regulation, the UPCA and the EPC. However, the UPC's jurisdiction over European patents validated in non-Contracting MS and third countries is based exclusively on EU PIL rules. This does not guarantee that judgments rendered by the UPC will be recognised or enforced in those states, which are not part of the UPCA system and, thus, fall outside the UPC's territorially limited subject matter jurisdiction.

For third countries like the UK, this expansive jurisdictional approach may appear exorbitant, given that they are not bound by the Brussels I bis Regulation. For MS not party to the UPCA -like Spain-, the absence of subject matter jurisdiction is compensated by the operation of the Brussels I bis Regulation, which designates the UPC as a "common court". This legal fiction allows the UPC to assume jurisdiction over European patents validated in those MS, treating this international court as functionally equivalent to a national court. This is intended to ensure the practical effectiveness of UPC decisions involving patents validated in these territories.

Ultimately, the effectiveness of the UPC will depend not only on the strength of its legal foundations but also on the extent to which its judgments are recognised and enforced within and outside the EU. While the current framework represents a step forward for unitary protection of patents within the EU, it also highlights the unfinished nature of the integration process, one that still leaves space for fragmentation, inconsistency, and legal uncertainty.

44. The decision of the Düsseldorf local division of the UPC also provided a valuable opportunity -particularly in light of the CJEU's ruling in *BSH Hausgeräte*- to examine the impact of the exclusive jurisdiction ground under Art. 24(4) of the Brussels I bis Regulation when the validity of a registered IPR, such as a patent, is contested in infringement proceedings.

Following the *GAT* judgment and its codification in Art. 24(4), any validity challenge -whether brought as a counterclaim, a defence, or in separate proceedings- must be adjudicated by the courts of the MS in which the patent is registered. In *BSH Hausgeräte* the CJEU clarified that this exclusive jurisdiction does not deprive the court seised of the infringement claim of its authority to hear that claim. However, if the court entertains serious doubts as to the patent's validity, its only recourse is to stay the proceedings in order to obtain a preliminary assessment of validity from the competent court.

A different scenario arises when the patent in question is registered in a third state. In UPC_CFI_355/2023, the Düsseldorf Local Division of the UPC acknowledged the exclusive jurisdiction of UK courts to render judgments with *erga omnes* effect on the validity of a European patent registered in the UK. Nevertheless, it conducted an indirect, *inter partes* assessment of the UK patent's validity, based on the invalidity of the German part of the same European patent. Notably, a direct *inter partes* ruling on the validity of the UK patent would have been permissible under *BSH Hausgeräte*, where the CJEU affirmed that a court in a MS hearing an infringement action involving a patent registered in a third state may issue a decision on validity with *inter partes* effect.

The foregoing leads to an undesirable outcome. When the validity of a patent registered in a third state is at issue, a court in a MS seised of an infringement action may rule on validity *inter partes*. Conversely, where the patent is registered in another MS, Art. 24 and the relevant CJEU case law compel the court -if it deems a validity assessment necessary- to stay the proceedings until the matter is resolved by the competent court.