



UPC Exerts Long Arm Jurisdiction by Ruling on Infringement in UK

In a landmark decision, the Unified Patent Court has ruled that it has jurisdiction over infringement actions concerning the UK part of a European patent, at least when the defendant is domiciled in a Contracting Member State. The Court held that this is true even if the defendant raises a counterclaim for revocation in respect of the parts of the European patent concerning Contracting Member States.

Summary on Long Arm Jurisdiction

The dispute relates to an infringement action for the German and UK parts of a European patent, and a counterclaim for revocation of the German part. Given that the defendants in this case are domiciled in a Contracting Member State (Germany), the Court found that it was competent to rule on the infringement action based on the principles of Article 4(1) Brussels Ibis Regulation and Article 31 UPCA, even for non-EU states like the UK. The Court also held that the exclusive jurisdiction exception set out in Article 24(4) Brussels Ibis Regulation does not apply to the UPC's jurisdiction over infringement proceedings. The decision is considered in further detail below.

Background

The decision ([UPC_CFI_355/2023](#)) of the UPC's Düsseldorf Local Division relates to Fujifilm's European patent EP 3594009, directed to lithographic printing plate precursors. The patent is in force in Germany and the UK, and no opposition or national revocation action has been filed.

Fujifilm brought an infringement action against three Kodak entities, each of which are domiciled in Germany. The three defendants ("Kodak") filed counterclaims for revocation in relation to the German part of the patent and, under certain conditions, asked for a declaration that the UK part is invalid. Kodak also lodged a preliminary objection, challenging the Court's jurisdiction with regard to the UK part of the patent. In response to the revocation counterclaim, Fujifilm filed three auxiliary claim requests.

The Court decided to handle the preliminary objection as part of the main proceedings so that it would have the Advocate General's opinions on ECJ case *Hausgerate v. Electrolux* (C-339/22) in hand. However, the issues in that case turned out to be irrelevant to the assessment of jurisdiction in the present case.

Preliminary Objection

The Court ruled that Kodak's preliminary objection regarding jurisdiction was unfounded.

On the question of whether the UPC has competence to rule on the validity of the UK part of the patent, the Court did not need

to decide this point because the counterclaim for revocation was limited to the German part only. Kodak's auxiliary request for a declaration regarding the validity of the UK part was also dismissed for having no legal basis.

As regards the Court's jurisdiction to rule on infringement in the UK, the Court reviewed the provisions in the UPCA and the Brussels Ibis Regulation, as well as the CJEU's case law, and concluded that the UPC has jurisdiction to decide on infringement in the UK.

The Courts' finding was based on Article 31 UPCA (which provides that the UPC's international jurisdiction is established in accordance with the Brussels Ibis Regulation and the Lugano Convention), and Articles 4(1) and 71b(1) Brussels Ibis Regulation. Article 4(1) stipulates that defendants domiciled in an EU Member State can be sued in the courts of that Member State¹. If the Member State participates in the UPCA, the UPC replaces the national courts of that state under Article 71b(1).

The Court found that its jurisdiction arising from Article 4(1) may extend to all states for which the EP patent is granted, not just the EU Member States. This was based on the Court's reading of (i) the ECJ decision *Owusu* (C-281/02) which states that the rules of jurisdiction of the Brussels Convention may apply to relations between the courts of a Contracting Member State and those of a non-Contracting Member State, and (ii) the Advocate General's first opinion in *Electrolux*, which refers to the jurisdiction of the courts of a Member State in which a defendant is domiciled as being universal. Accordingly, the Court found that its jurisdiction may extend to infringement of the European patent committed in all states for which it was granted.

The Court held that this finding was not altered by Article 34 UPCA², which covers the territorial scope of the UPC's decisions within Contracting Member States but, in the opinion of the Court, does not exclude such decisions having effect beyond the Contracting Member States. Moreover, based on the reasoning in *Gat v LuK* (ECJ - C4/03), which decision is codified in Article 24(4) Brussels Ibis Regulation, the Court noted that exclusive jurisdiction does not apply where the dispute relates to infringement proceedings and not validity. Additionally, since the UK is no longer a Member State, the provision does not apply.

Validity and Infringement

The Court then turned to the assessment of the validity and infringement of the patent. In short, the patent was revoked in its entirety, both for the main request and all three auxiliary requests. The judgement has effect in relation to the German part of the patent.

In view of the Court's findings on the invalidity of the patent, the infringement action was held to be without basis in Germany.

Turning to the UK, even though the counterclaim for revocation did not cover the UK part of the patent, the Court noted that validity is a prerequisite for an order for relief resulting from a finding of infringement. Even though the UPC has no jurisdiction to rule on the validity of the UK part (as admitted by the Court), the validity of the patent had nonetheless been extensively discussed with the outcome that it should be revoked based on EPC law. Because the claimant had not explained why the assessment of the validity of the UK part would be different, the Court decided that it should assume that the UK part is also invalid.

Accordingly, the Court ruled that an infringement action in relation to the UK cannot be successful in these circumstances.

There are some similarities between this approach and the one proposed in the Advocate General's second opinion on ECJ case *Hausgerate v. Electrolux (C-339/22)* with regard to the third question of the referral. In that opinion, the Advocate General noted that a Member State court cannot rule on the validity of a patent of a non-Member State, but that it would not be against international law for the court to provide a validity finding as a preliminary issue in the context of an infringement action, because a valid patent is a requirement for the success of a finding of infringement. Thus, whilst a Member State court cannot revoke patents in non-Member States, the Advocate General's

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opinion is that the issue of validity may still contribute to the court's reasoning when deciding on infringement. It appears that the Düsseldorf Local Division has done exactly this in its decision.

Following the Court's findings, the patent was revoked in Germany, and the infringement actions for both Germany and the UK were dismissed, a resounding win for Kodak.

This decision means that infringement of a European patent in a non-EU country (such as the UK or Turkey) can nonetheless be litigated at the UPC, subject to the defendant being domiciled in a Contracting Member State. Another judgement on the same question is expected to be delivered on 28 February 2025 in two cases between the same parties at the Mannheim Local Division.

It will now be interesting to see the extent of the damages provided by the UPC₁ which will feed into the determination of how attractive the UPC will be compared to the courts of non-EU states covered by a European patent.

Footnotes

1. Article 4(1) Brussels 1bis Regulation: *Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.*
2. Article 34 UPCA: *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.*

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