

# PANORAMIC

# PATENTS 2025

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Panoramic guide (formerly Getting the Deal Through) enabling side-by-side comparison of local insights into patent litigation and patent office procedures, including types of enforcement proceedings; trial format and timing; standards of proof; standing to sue; inducement / contributory infringement; infringement by foreign activities / by equivalents; discovery; litigation timetable and costs; appeals; scope and ownership of patents; alternative dispute resolution; defences of absolute novelty, obviousness, inventiveness or prior use; types of remedy; voluntary and compulsory licensing; patent office proceedings, including timetabling, costs, appeals, opposition, and modification / re-examination of patents; and recent trends.

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# The UPC: The new forum defines its jurisdictional boundaries

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The Unified Patent Court (UPC) has been operating for almost two years. During this time, the Court has already made approximately 890 decisions and orders.

In doing so, the Court has had the opportunity to determine its jurisdiction in various case scenarios by interpreting the statutory provisions of its legal framework.

It is becoming apparent that the Court is pursuing a pragmatic but assertive approach when it comes to establishing itself as a new forum with comprehensive jurisdiction and effectiveness in patent disputes.

Some key trends and decisions of the UPC are summarised below.

## Final opt-out from the UPC?

An open and much-debated question has been whether an opt-out of a European patent from the jurisdiction of the UPC is definitive, provided that national proceedings relating to that European patent have commenced before the national courts of the contracting member states prior to the entry into force of the Unified Patent Court Agreement (UPCA).

After the bombshell decision of the Local Division (LD) Helsinki of 2023, there is now redemption for patent owners: the Court of Appeal (CoA) has overturned the decision of the LD Helsinki and its final answer to the above question is no!

In its decision of 20 October 2023 (*AIM v Supponor*, UPC\_CFI\_214/2023), the LD Helsinki had denied the jurisdiction of the UPC for a patent that had been opted out during the Sunrise Period and was already the subject of infringement proceedings in Germany that had been commenced prior to the entry into force of the UPCA and were still pending when the UPCA entered into force. The LD Helsinki considered that the withdrawal of the opt-out was not possible under article 83(4) UPCA, which precludes such a withdrawal if 'an action has already been brought before a national court'.

This decision of the LD Helsinki was subsequently overturned by the CoA by decision of 12 November 2024 (*AIM v Supponor*, UPC\_CoA\_489/2023, UPC\_CoA\_500/2023). The CoA found that the withdrawal of the opt-out was valid and consequently confirmed the jurisdiction of the UPC.

The CoA held that the wording and context of article 83 UPCA lead to an interpretation of the phrase 'unless an action has already been brought before a national court' in article 83(4) UPCA as referring only to actions brought during the transitional period.

According to the CoA, this narrow interpretation is also in line with the purpose of article 83 (4) UPCA:

- an abuse by improperly switching between jurisdictional regimes, which article 83(3) and (4) UPCA is intended to prevent, is not possible prior to the existence of the transitional regime;
- article 83(3) and (4) UPCA are not intended to limit parallel litigation and the risk of divergent claim interpretation; rather, the transitional regime deliberately creates a situation in which parallel proceedings between national courts and the UPC are expressly provided for; and
- finally, a broad interpretation of article 83(3) and (4) UPCA would lead to a different treatment of patent proprietors: patent proprietors whose patent has been the subject of litigation before a national court would be deprived of the possibility of first opting out and then withdrawing the opt-out, even though such national litigation may have taken place a long time ago and may not even have been the choice of the patent proprietor but was initiated by a third party.

What does this mean?

- According to the CoA, any national proceedings initiated prior to the entry into force of the UPCA (1 June 2023), whether still pending or not, will not prevent an effective withdrawal of an opt-out from the European patent made during the transitional period.
- On the other hand, any opt-out of a European bundle patent still carries the risk for the patent owners of being deprived of the enforcement of this European patent before the UPC, as any national proceedings (eg, a national revocation or declaration of non-infringement action) commenced after the entry into force of the UPCA (ie, during the transitional period) will block the withdrawal of the opt-out and thus the jurisdiction of the UPC for this patent.

## **Long-arm jurisdiction of the UPC against defendants domiciled in the UPC territory**

In two recent infringement cases that Fujifilm brought against Kodak (German companies), the UPC had to deal with the question whether it has international jurisdiction to decide on infringement of a European patent not only for the UPC territory but also for the UK, even though the defendants (located in Germany) had raised an invalidity defence against the UK part of the European patent.

The LD Düsseldorf (*FUJIFILM v Kodak*, UPC\_CFI\_355/2023, 28 January 2025) ruled rather confidently that the UPC has international jurisdiction over the UK part of the infringement action and can also implicitly examine the validity of the UK designation of the European patent if the defendants are domiciled in a contracting member state.

The decision sheds light on the UPC's approach to long-arm jurisdiction and has caused quite a stir in legal circles, but is the UPC reinventing the wheel or simply applying the existing legal framework?

In principle, international jurisdiction between EU member states is governed by the Brussels Ibis Regulation, while the ECJ's *Owusu* decision (C-281/02) clarifies that the Brussels Ibis Regulation applies universally (ie, it is not limited to intra-EU disputes).

This also applies to the UPC. Under the recent amendments to the Brussels Ibis Regulation, the UPC is a common court with jurisdiction wherever a court of a contracting member state has jurisdiction in a matter governed by the UPCA.

According to article 4 and 63 Brussels Ibis Regulation, infringement actions can be brought against infringers in the state where they are registered. This supports the view that a single court can hear multi-state European patent infringement cases, allowing the patent holder to consolidate infringement claims in one forum (ie, the forum in which the defendant is registered). However, article 24(4) of the Brussels Ibis Regulation reserves exclusive jurisdiction for invalidation of the patent to the court of the state where the patent is registered.

The interplay of these provisions of the Brussels Ibis Regulation in intra- and extra-EU scenarios, and in particular when the invalidity of a patent in a third state is raised as a defence in an infringement action covering this third state, was the subject of a pending referral to the Court of Justice of the European Union (CJEU) (C-339/22 *BSH v Electrolux*) at the time of the LD Düsseldorf's decision.

This means that the LD Düsseldorf has taken a rather bold approach in accepting the UPC's jurisdiction over the UK part of the infringement action without waiting for the CJEU's decision. This contrasts with the more cautious approach taken by the LD Mannheim. In an order issued on 30 January 2025 (*FUJIFILM v Kodak*, UPC\_CFI\_359/2023), the LD announced in a similar scenario that it is inclined to deal with the UK part of the case only after the CJEU has ruled.

On 25 February 2025, the CJEU in *BSH v Electrolux* issued its decision and confirmed the position of the LD Düsseldorf. The CJEU ruled with regard to third- state patents (eg, UK patents):

'If a court of a Member State is seised, on the basis of Article 4(1) of that regulation, of an action alleging infringement of a patent granted or validated in a third State in which the question of the validity of that patent is raised as a defence, that court has jurisdiction, pursuant to Article 4(1), to rule on that defence, its decision in that regard not being such as to affect the existence or content of that patent in that third State or to cause the national register of that State to be amended'

This means EU courts and the UPC can assess the validity of European patents in third countries to determine infringement issues. However, their decisions will affect neither the existence nor content of the patent in that third country nor result in any amendment to the national register of the third country.

## UPC jurisdiction to deal with internet-induced infringement

In a recent decision *Aylo v Dish* of 3 September 2024 (*Aylo v Dish*, UPC\_CoA\_188/2024), the CoA provides important guidance on how patent infringement cases involving online services can establish the international jurisdiction of the UPC and the competence of its divisions, even if the defendants are not located in the UPC territory.

Dish brought an infringement action before the LD Mannheim against several Aylo entities located in Ireland and Cyprus (ie, outside the current UPC territory), which operate a streaming platform, accusing these Aylo entities (Aylo) of indirectly infringing one of its video streaming patents. Dish argued that the UPC had international jurisdiction and that the Mannheim Local Division was competent because Aylo's streaming services were accessible in Germany and other member states where the patent has effect. Aylo filed a preliminary objection challenging the jurisdiction and competence on the basis of article 7(2) in conjunction with article 71b(1) of the Brussels Ibis Regulation.

The CoA analysed article 7(2) of the Brussels Ibis Regulation in the light of the case law of the CJEU and concluded that the UPC has international jurisdiction and that the LD Mannheim is competent under article 33(1)(a) UPCA for an infringement action if the following two conditions are met:

- the European patent has effect in at least one contracting member state; and
- the alleged infringement or harmful event occurs or may occur in that contracting member state.

In cases where the alleged infringement is caused via the internet, this means that the UPC has jurisdiction if the infringing products and/or services can be obtained on the territory of the contracting state in which the European patent has effect. It is therefore irrelevant where the servers are located or whether the website is directed at users in the territory of the member states concerned. Similarly, in the case of indirect infringement, the claimant is not required to provide any further arguments as these are only relevant to the decision on the merits and not to the jurisdiction and competence of the UPC.

The present order makes it clear that the UPC has broad jurisdiction over actions for alleged infringement via the internet in the UPC's territory and that the transfer of a server outside the UPC's territory does not provide protection against such an infringement action.

## Parallel national and UPC proceedings – lis pendens

During the seven-year transitional period, both the UPC and the national courts of the contracting states have parallel jurisdiction to hear infringement and invalidity actions.

This may lead to parallel proceedings before national courts and before the UPC and consequently to irreconcilable decisions. Therefore, in accordance with article 71 (c), article 29 and 30 of the Brussels Ibis Regulation, the UPC must decide whether it has jurisdiction in cases where national proceedings are already pending and whether it should stay the proceedings. Recent case law has clarified a few questions as to how the UPC will deal with these cases.

The CoA has ruled on a fundamental principle, namely that the UPC must consider national proceedings already pending before the entry into force of the Unified Patent Court

Agreement on 1 June 2023 when assessing its jurisdiction in order to ensure that conflicting decisions are avoided (*Mala v Nokia*, CoA\_227/2024, 17 September 2024).

The Court must decline jurisdiction if the proceedings are identical (ie, if they involve the same cause of action and the same parties), article 29(3) of the Brussels Ibis Regulation. The first decisions of the UPC show that the UPC interprets these terms rather narrowly.

In particular, the UPC considers that the parties involved in the respective proceedings are not the same simply because they belong to the same group of companies (*Mala v Nokia*, CoA\_227/2024, 17 September 2024 ; CD Munich, *NanoString v Harvard College*, UPC\_CFI\_252/2023, 17 October 2024).

Another question is whether preliminary proceedings and main proceedings between the same parties and concerning the same infringement constitute the same cause of action within the meaning of article 29 Brussels Ibis Regulation (ie, whether national main proceedings may block a preliminary action before the UPC). The LD Düsseldorf decided that this is not the case (LD Düsseldorf, *Novartis v Genentech*, 6 September 2024, UPC\_CFI\_165/2024, 6 September 2024).

Finally, the CoA ruled that the UPC has still jurisdiction to determine the amount of damages even if a national court had previously decided on the question of infringement and the infringer's liability (*Fives ECL v REEL*, UPC\_CoA\_30/2024, 16 January 2025).

If the proceedings are not identical, the Court may stay the proceedings if a related action is pending before a national court, article 30(1) Brussels Ibis Regulation.

The UPC considers proceedings to be related if they are based on substantially similar facts, grounds, arguments and requests. An important factor to be taken into account by the UPC in its discretion is the status of the UPC and of the national proceedings. Only if a decision of the national court is expected soon (eg, if the national revocation proceedings are well-advanced while the UPC proceedings are still in their infancy), it is likely that the UPC revocation proceedings will be stayed.

The decisions show that the UPC, of course, respects the Brussels Ibis Regulation and the relevant case law of the ECJ. However, whenever there is room for reasonable interpretation or discretion, the UPC seems to be keen to avoid any blockage of its jurisdiction or delay of its proceedings by parallel national proceedings.

## Damages: retroactive effect of the UPCA

Since the start of the UPC on 1 June 2023, an interesting question has been whether damages for patent infringement that occurred prior to the entry into force of the UPCA can be brought before the UPC and, if so, what substantive law should be applied to such damages claims. Recent UPC decisions, including *Fives ECL v REEL* (UPC\_CoA\_30/2024, 16 January 2025) and *ARM v ICPillar* (UPC\_CFI\_495/2023, 11 April 2024), provide important insights.

The UPCA does not explicitly address whether the UPC can award damages for infringements that occurred before 1 June 2023. In general, the contracting member states have only transferred jurisdiction to the UPC with effect from 1 June 2023. With regard to the retroactivity of the UPCA, article 28 of the Vienna Convention applies, which provides that '[u]nless the contrary intention appears from the treaty or is otherwise apparent, the

provisions of a treaty do not bind a party in respect of any act or matter which occurred or any situation which ceased to exist before the date of the entry into force of the treaty'.

As a result of *ARM v ICPillar*, LD Paris clarifies that 'the UPC has jurisdiction over the infringing acts that began before 1 June 2023 and continued after that date and that are not covered by the statute of limitations' – provided that the patent in question was still in force after 1 June 2023.

In *Fives v REEL*, however, the CoA did not focus on continuous acts of infringement, but explicitly confirmed the retroactive jurisdiction of the UPC in cases where damages 'accrued before the entry into force' or 'accrued partly before 1 June 2023 and partly thereafter, the only condition being that the patent was still in force on 1 June 2023'.

Another question, independent of the jurisdiction of the UPC over damages claims, is which substantive law (ie, national law or the law of the UPCA) the UPC has to apply to damages that accrued before the entry into force of the UPC on 1 June 2023. The LD Mannheim indicated in several orders (UPC\_CFI\_159/2024, 23 January 2025) and (UPC\_CFI\_359/2023, 30 January 2025) that this question is still open and needs to be discussed. On the contrary, the LD Paris (UPC\_CFI\_358/2023, 13 November 2024) held that the provisions of the UPCA should also be applied to acts of infringement committed before 1 June 2023.

The CoA did not need to decide this issue in *Fives ECL v REEL*. However, the reasons for the decision indicate that the CoA is inclined to apply the provisions of the UPCA when it comes to determining damages and once the UPC's jurisdiction over such damages claims – whenever they arose – has been established.

Further UPC decisions will have to clarify the issue of retroactive application of the UPCA to damages claims. However, the first decisions indicate that the UPC could become an interesting forum for collecting pan-European damages, even if they (partly) arose before the UPCA entered into force.

## Jurisdiction of the UPC over FRAND counterclaims

Standard essential patents (SEPs) have long been a hot topic in patent law and are now attracting even more attention after the European Commission scrapped the controversial EU SEP Regulation in early 2025. With its broad jurisdiction, the UPC is likely to become a major battleground for SEP disputes.

On 22 November 2024, the UPC issued its first decision involving an SEP, a FRAND defence and a FRAND counterclaim in the case between Panasonic and Oppo concerning an alleged standard-essential patent for 4G (UPC\_CFI\_210/2023, 22 November 2024).

The implementer (OPPO) filed a FRAND counterclaim, asking the Court to order the SEP owner to accept the implementer's licence offer or to submit a specific licence offer or, alternatively, to issue a declaratory decision confirming the implementer's right to a licence. The Court expressly confirmed its jurisdiction to hear the FRAND counterclaim under article 32(1)a) UPCA.

Pursuant to article 32(1) a) UPCA, the court has exclusive competence over infringement actions and related defences, including counterclaims concerning licences. According to



LD Mannheim, this also includes counterclaims aimed at the conclusion of a licence agreement.

The Court further explained that the essence of the request concerns the right to defend against a patent by asserting a counterclaim based on antitrust law pursuant to article 102 of the Treaty on the Functioning of the European Union. As the competence conferred to the UPC is the same as that of the national courts when dealing with SEP disputes, and as the UPC is bound by EU law (article 20 UPCA), the court concluded that this includes the application of EU competition law in SEP disputes.

Although the FRAND counterclaim was found admissible, it was dismissed as unfounded. Unsurprisingly, the court emphasised the parties' obligations in FRAND negotiations, in line with the well-known guidelines provided by the Court of Justice of the European Union (CJEU) in *Huawei v ZTE*. On this basis, the implementer's offer was not FRAND-compliant because it was not calculated on the basis of the actual use of the patent and the limitation of the licence to sales in the UPC territory was also deemed not FRAND-compliant.

It remains to be seen whether the admissibility of such FRAND counterclaims before the UPC will be generally acknowledged. The UPC's reasoning in this area is likely to be closely watched given the interplay between patent and competition law.

## UPC jurisdiction for and initial guidance on PI proceedings

In the PI proceedings before the LD Düsseldorf (*Novartis/Genentech v Celltrion*, UPC\_CFI\_165/2024, UPC\_CFI\_166/2024, 6 September 2024), the court ruled that it had jurisdiction over a European sales and marketing hub located outside the UPC territory.

This was because the hub supplied products to group members within the UPC territory who then distributed them in UPC markets. In doing so, the court applied the principles set out by the Paris LD on article 33(1)(b) UPCA – namely that jurisdiction over multiple defendants, where one of the defendants has its residence within the UPC territory, only requires a commercial relationship between the defendants and that the case concerns the same alleged infringement.

Courts also do not shy away from complex legal issues in PI proceedings, despite the tight timeframe, with first instance decisions issued within three to five months. They provide a detailed examination of the validity of the patent, although some courts reasonably ask defendants to present only their three best invalidity arguments in order not to overload the summary proceedings. In particular, it is not necessary for the patent to have survived opposition or validity proceedings to form the basis of a PI (*Mammut v Ortovox*, UPC\_CoA\_182/2024, 25 September 2024).

The UPC reaffirmed on several occasions its 'more likely than not' approach to all relevant conditions for assessing PI applications, namely that it must be more likely than not that the applicant has standing and that the patent is valid and infringed.

The CoA denied that there is a strict time limit for undue delay (which is detrimental to urgency), but that this question depends on the circumstances of each case (*Mammut v Ortovox*, UPC\_CoA\_182/2024). The clock starts ticking for applicants as soon as they have all the knowledge and evidence that a promising PI application can be reliably submitted, meaning that the necessary laboratory tests or experiments can be carried out

professionally but quickly in advance. PI applications submitted within one to two months of this deadline will not be considered late, unlike PI applications submitted after six months.

Irreparable harm is not required to justify a PI, but it is sufficient that the interests of the applicant (who bears the burden of proof) outweigh those of the defendant (*Mammut v Ortovox*, UPC\_CoA\_182/2024). A loss of market share or a delay in filing the main proceedings may be relevant criteria. However, a defendant facing substantial recourse claims from third parties, which significantly exceed the plaintiff's damages, has been allowed to continue supplying this particular customer against security (*Valeo v Magna*, UPC\_CFI\_347/2024, 20 November 2024).

## Conclusion

As a newcomer to the world of patent litigation, the UPC has to find its place and to define the space in which it will operate.

Looking at the above decisions and trends, it can be concluded that the UPC is not shy about using the leeway that the legal framework provides to present itself as an efficient forum for patent disputes.

This applies, on the one hand, to the tendency to generously confirm its own jurisdiction regarding national courts of member and third states, and, on the other hand, to the assumption of own comprehensive competences under the UPCA.

It is too early for a final assessment, but the decisions taken so far are largely in line with the UPC's final goal of becoming a central pillar of the European patent system, providing users of the system with a single and effective litigation forum with effect for large parts of the European market.

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