

Cross-border Enforcement of European patents

Tuesday, 17th June 2025

Webinar starts at 9:00 (CEST)

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EUROPEAN PATENT ATTORNEYS

Agenda

- EP patent litigation – jurisdictions
- Relevant EU Regulations
- CJEU C-339/22 of 25th February 2025
- UPC_CFI_355/2023 of 28th January 2025
- Consequences

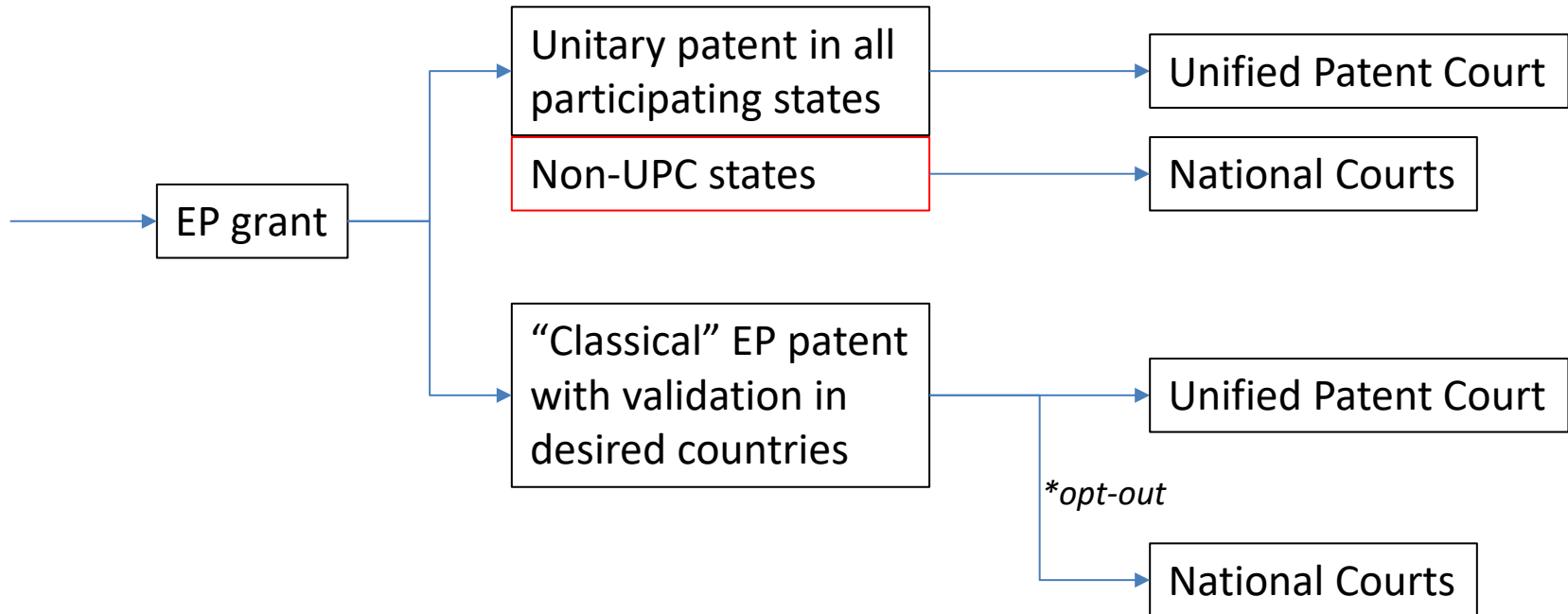


EP patent litigation - jurisdictions

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EUROPEAN PATENT ATTORNEYS

EP patent litigation – jurisdictions





Relevant EU Regulations



EUROPEAN PATENT ATTORNEYS

Brussels I *bis*; Regulation 1215/2012

- Jurisdiction and the recognition and enforcement of judgments in civil and commercial matters

Brussels I *bis* regulation 1215/2012

- Article 4 (1).
 - Subject to this Regulation, persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State

Brussels I *bis* regulation 1215/2012

- **Article 24**

- The following courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties [...]

...(4) in proceedings concerned with the registration or validity of patents [...] irrespective of whether the issue is raised by way of an action or as a defence, the courts of the Member State in which the deposit or registration has been applied for".

Brussels I *bis* regulation 1215/2012

- **Article 27**
 - Where a court of a Member State is seised of a claim which is principally concerned with a matter over which the courts of another Member State have exclusive jurisdiction by virtue of Article 24, it shall declare of its own motion that it has no jurisdiction

EU Regulation 542/2014

- Articles 71a – 71d added to Brussels I *bis* Regulation 1215/2012
- Article 71a(1)
 - For the purposes of [the Brussels I *bis* Regulation], a court common to several Member States (...) shall be deemed to be a court of a Member State (...)
- Article 71a(2)
 - The UPC is a common court



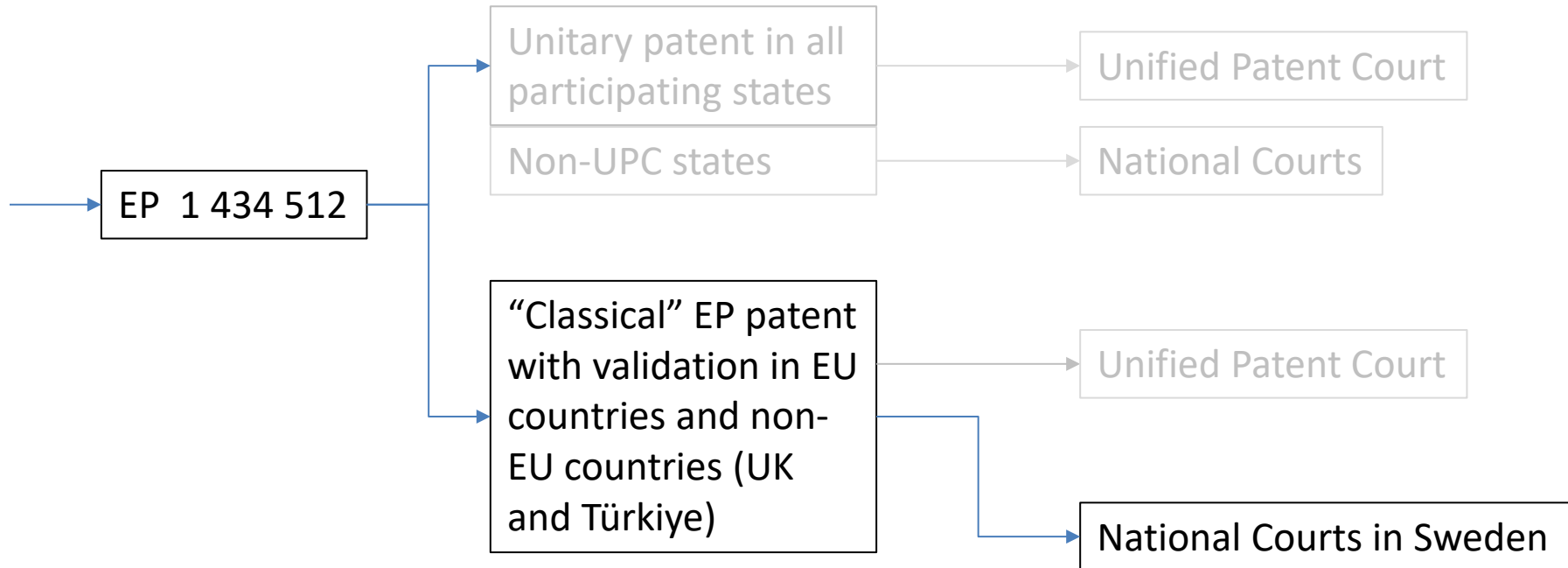
CJEU C-339/22

BSH Hausgeräte GmbH v. Electrolux AB

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EUROPEAN PATENT ATTORNEYS

CJEU C-339/22



EP 1 434 512 - BSH Hausgeräte GmbH

Patent validated in
Germany, Greece,
Spain, France, Italy,
the Netherlands,
Austria, Sweden, the
UK and Türkiye

Fig.1

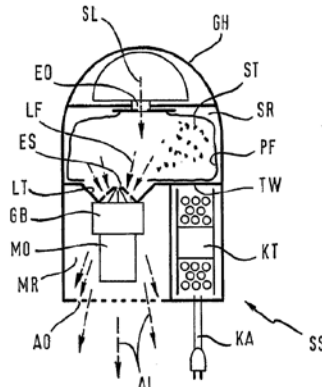
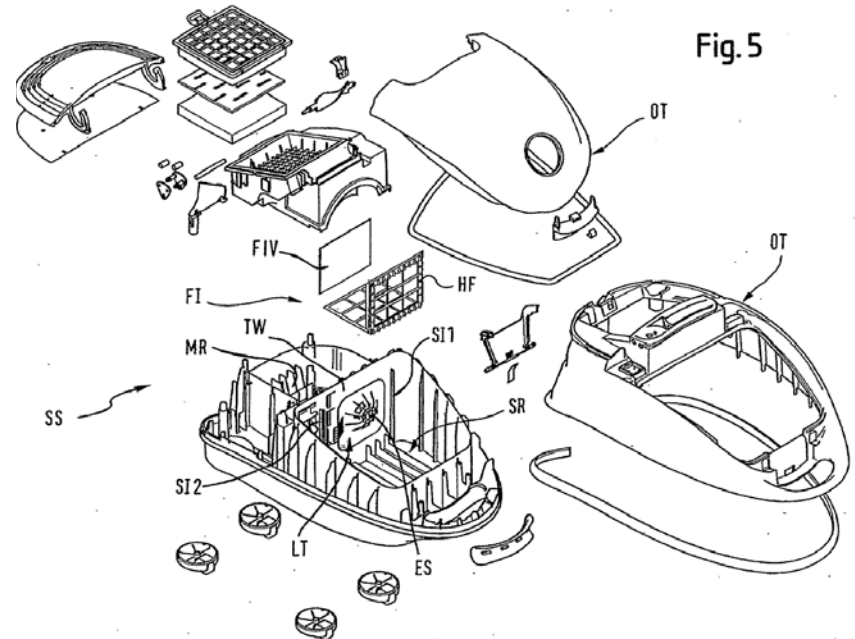


Fig.5



CJEU C-339/22 – Background (I)

- BSH sued Electrolux AB, a company incorporated under Swedish law, before the Patent and Commercial Court of Sweden (Patent- och marknadsdomstolen) for infringement of EP 1 434 512, seeking an order requiring Electrolux
 - to cease using the patented invention in all States in which the patent had been validated, including Türkiye;
 - to pay remuneration and damages for the alleged unlawful use of the invention

CJEU C-339/22 – Background (II)

- Electrolux argued that the non-Swedish parts of the European patent were invalid, and that
 - pursuant to Article 24(4) of the Brussels I *bis* Regulation, the Swedish Court had no jurisdiction to hear BSH's claims relating to the infringement of the non-Swedish parts of the patent
- The Patent and Commercial Court followed the arguments and declared, on the basis of Articles 24(4) and 27 of the Brussels I *bis* Regulation, that it did not have jurisdiction to hear the infringement action for the non-Swedish parts of the patent

CJEU C-339/22 – Background (III)

- **BSH appeal the decision to Svea hovrätt who expressed two possible interpretations of Article 24(4) of the Brussels /bis Regulation**
 - Where the defendant raises an invalidity action, the national court does not have jurisdiction to hear the infringement action for any other State but the State of that court
 - Where the defendant raises a plea alleging that foreign parts of the patent are invalid, the national court seised of the infringement action lacks jurisdiction to hear only that plea, and may rule on the infringement action
- **Svea hovrätt also asked if Article 24(4) of the Brussels /bis Regulation is applicable to a court of a third State, i.e., does the court of [Türkiye] have exclusive jurisdiction in respect of a European patent validated there**

CJEU C-339/22 – The Ruling of the CJEU (I)

- Pursuant to Article 24(4) of the Brussels I *bis* Regulation, the courts of a particular EU Member State have exclusive jurisdiction in respect of the validity of a national patent, regardless of the domicile of the parties
- When a court of a State, in which the defendant is domiciled, is seised of an infringement action in respect of a patent in another Member State, that court must declare in accordance with Article 27 of the Brussels I *bis* Regulation that it does not have jurisdiction as regards the validity of the patent in that other Member State

CJEU C-339/22 – The Ruling of the CJEU (II)

- Does the court, in the country where the defendant is domiciled, seised of the infringement action, still have jurisdiction to hear the infringement action in respect of the foreign part of the patent?
- Article 24(4) of the Brussels I *bis* Regulation concerns only the part of the dispute relating to the validity of the patent
- The national court does not lose jurisdiction to hear the infringement action merely because the defendant challenges the validity of the patent
- Rules of jurisdiction should be predictable
 - Such objective could not be achieved if a court of a Member State would lose jurisdiction, depending on the defence chosen by the defendant, whenever the defendant considers it appropriate

CJEU C-339/22 – The Ruling of the CJEU (III)

- Is Article 24(4) of the Brussels / bis Regulation applicable to a court of a third State, i.e., does the court of [Türkiye] have exclusive jurisdiction in respect of a European patent validated there?
- Yes and No....

CJEU C-339/22 – The Ruling of the CJEU (IV)

- The jurisdiction of the court of the Member State seised of the infringement extends to the question of the validity of the patent raised as a defence in the context of the infringement action
 - The jurisdiction of the court of the defendant's domicile must be exercised without infringing the principle of non-interference, according to which a State may not interfere in cases – including the grant of patents - which essentially come within the national jurisdiction of that State
- Are these findings contradictory?

CJEU C-339/22 – Catch 22 resolved

- The national Court of a State where the defendant is domiciled, seised of the infringement action of a patent validated in a third State (e.g., Türkiye, the UK, Norway, etc.) has jurisdiction, pursuant to Article 4(1) of the Brussels I *bis* Regulation to rule on the validity defence
 - not such as to affect the existence or content of the patent
 - i.e. with *inter partes* effect only

UPC_CFI_355/2023

Fujifilm Corporation v. Kodak GmbH et al.

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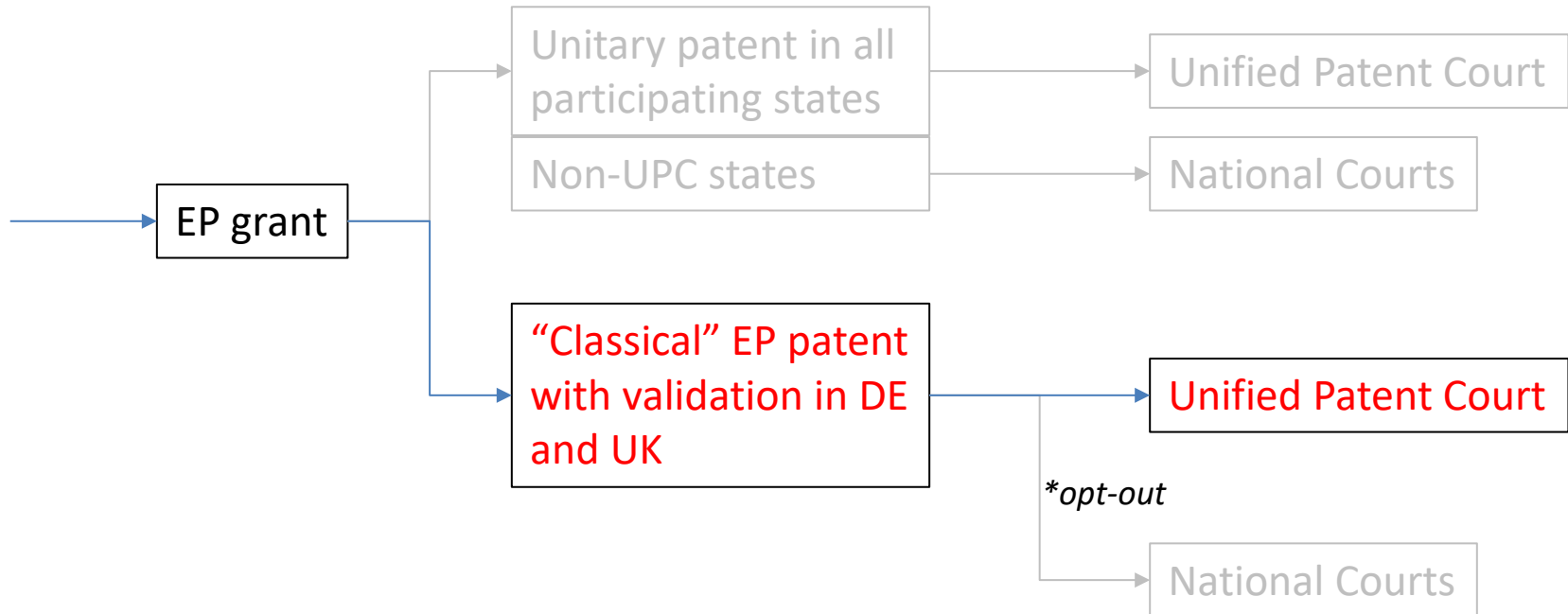
Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- Fujifilm Corporation (proprietor, claimant) pursued three Kodak companies based in Germany for infringement of EP 3 594 009 B1
- The patent in suit was a “classical” EP patent, validated and in force in Germany and the United Kingdom.
- Defendant 1) acted as the German sales company and purchased the Kodak products from the UK Kodak company, Kodak Ltd., Watford, UK, and sold them to Germany.

Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025



Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- Fujifilm requested the court order the defendants to refrain from making or marketing the products within Germany and the UK.
- Kodak denied the infringement and filed a counterclaim for revocation.
- Furthermore, Kodak argued that the UPC lacked jurisdiction over EP 009 insofar as it relates to the UK, given the UK is not a contracting member state of the UPC.



Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- **Court's findings:**
 - the patent was invalid in Germany
 - the lack of a revocation action in the UK meant that there was no decision on the validity of the UK part
- **What about infringement proceedings?**

Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- The defendants argued that Article 34 UPCA limited the UPC's jurisdiction to UPC Contracting Member States only.
- 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*".
- The Local Division: "*Art. 34 UPCA covers the territorial scope of the Court's decision within the territory of the Contracting Member States, but does not exclude decisions having effect beyond the territory of the Contracting Member States*"

Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- Defendants argued that Article 24(4) Brussels I Regulation gave exclusive jurisdiction to UK national courts.
- Article 24 Brussels I Regulation "*The following courts of a Member State shall have exclusive jurisdiction [...] (4) in proceedings concerned with the registration or validity of patents [...] irrespective of whether the issue is raised by way of an action or as a defence, the courts of the Member State in which the deposit or registration has been applied for*".
- The Local Division:
 - Article 24(4) only applies between EU Member States. Therefore, since the UK is now a third country, Article 24(4) does not give exclusive jurisdiction to UK courts over the UK part of the European patent.
 - Article 24(4) Brussels I Regulation "*does not apply to the question of which court has jurisdiction in infringement proceedings*"

Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- Article 4(1) Brussels I Regulation states that "*persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State*".
- Local Division found
 - All defendants are domiciled in Germany
 - ECJ Owusu vs. Jackson (C-281/02): *A Court could not decline jurisdiction on the basis that a court of another state was more appropriate to hear the case, even if that other state was a non-EU state.*

Dusseldorf Local Division

UPC_CFI_355/2023 – 28 January 2025

- Local Division, Article 31 UPCA International jurisdiction:

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

- Applying this, and their finding under Art. 4(1) Brussels I bis, the UPC found it had jurisdiction for infringement in the UK

(...the Local Division nonetheless declined to grant remedies regarding UK infringement)

Paris Local Division

UPC_CFI_702/2024 – 21 March 2025

- EP 4 153 830 – again a "classic" EP patent
- Infringement action brought before the UPC, also with regard to the UK, Spanish and Swiss designations.
- A preliminary objection contesting the jurisdiction of a local division to rule on the alleged infringement of national validations of a patent in force in non-UPCA member states should be dismissed without the need to refer this issue to the main proceedings.

Paris Local Division

UPC_CFI_702/2024 – 21 March 2025

- One of the defendants was located in Switzerland (signatory of the Lugano Convention), cf. Article 31 UPCA.
- Paris Local Division held itself territorially competent, due to the fact that one of the defendants was domiciled in France.
- Followed by Milan Local Division - Dainese v Alpinestars (UPC_CFI_792/2024) – 8 April 2025



Consequences



EUROPEAN PATENT ATTORNEYS

Consequences

- In freedom-to-operate circumstances, an EP patent cannot be disregarded because actions take place in a non-UPC state
 - Infringement actions against a defendant in their home country, seeking a cross-border injunction, cannot be ‘torpedoed’ by foreign invalidity actions
 - The UPC and national EU courts may rule on validity of an EPC patent in a third State with *inter partes* effect
- Europe is becoming a highly efficient jurisdiction for patent infringement actions against defendants domiciled in the EU, particularly in the UPC territory

A person in a dark suit and white shirt stands in the center of the frame, facing away from the camera. They are positioned in front of a large wall of server racks. The racks are filled with numerous circuit boards and components, creating a dense, textured background. The lighting is dim, with a soft glow emanating from the server racks, highlighting the person's silhouette. The overall color palette is dominated by dark blues and greys, with the white shirt providing a point of contrast.

Thanks for your attention!

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