

Limits of the Unified Patent Court's long arm with regard to Spain (I): international jurisdiction

The limits to the jurisdiction of the Unified Patent Court (UPC) to hear disputes relating to classic European patents validated in States that are not party to the UPC Agreement, as is the case of Spain, or to supplementary protection certificates issued in those States, are examined.

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Partner

IP Practice, Gómez-Acebo & Pombo

ÁNGEL GARCÍA VIDAL

Professor of Corporate & Commercial Law, University of Santiago de Compostela

Academic counsel (external advisor), Gómez-Acebo & Pombo

1. Introduction

Ever since coming into operation, there has been a tendency on the part of the Unified Patent Court ('UPC' or 'Court') to extend its jurisdiction to include patents that produce effects in States that are not party to the Agreement on a Unified Patent Court (the 'UPC Agreement' or 'Agreement'), as is the case of the Kingdom of Spain. This phenomenon is known in specialised circles as the court's 'long arm'.

However, although in certain cases the UPC does indeed have such jurisdiction, this is only possible within strict limits, limits that do not seem to be taken into consideration in a consistent manner. It is with this in mind that we begin herewith a series of papers analysing the limits of the UPC's international jurisdiction, the choice-of-law rules where the UPC can hear disputes regarding patents having effect in non-Contracting Member States, and questions related to the recognition

and enforcement of UPC decisions and orders in those other States.

2. The UPC's international jurisdiction

The UPC is - as stated in Article 1 of the UPC Agreement - "a court common to the Contracting Member States and thus subject to the same obligations under Union law as any national court of the Contracting Member States"; it has jurisdiction for the settlement of disputes relating not only to European patents with unitary effect, but also to all types of classic (i.e. non-unitary) European patents and to supplementary protection certificates - both for medicinal and plant protection products - granted on the basis of unitary or classic European patents.

Being therefore a court equivalent to the other national courts of the Contracting Member States, the UPC is subject to the same rules of private international law that apply to those other courts. This explains why Article 31 of the UPC Agreement provides that the international jurisdiction of the Court shall be established in accordance with 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 (better known as the 'Brussels Ia Regulation'), or, where applicable, in accordance with the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (the 'Lugano Convention'), signed in 2007 by the European Union, Denmark, Iceland, Norway and Switzerland. And the application of the Brussels Ia Regulation also explains why it has been amended to adapt it to the creation of the UPC, an amendment carried out by "Regulation

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

3. The legislative basis of the UPC's long arm with respect to Spain

3.1. Both the Brussels Ia Regulation (Article 4(1)) and the Lugano Convention (Article 2) establish as the forum, when determining international jurisdiction, the courts of the defendant's domicile, so that persons domiciled in a Member State shall, whatever their nationality, be sued in the courts of that Member State.

Consequently, the UPC has jurisdiction in actions which, falling within its subject matter jurisdiction, have as defendant a person domiciled in one of the contracting states party to the UPC Agreement. That this is the case is made abundantly clear by the Brussels Ia Regulation when, after expressly recognising (Article 71a(2(a))) that the UPC is a "common court", it provides in Article 71b that "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".

Since the UPC Agreement recognises the jurisdiction of the court not only for unitary patents, but also for classic European patents, it follows that, where the defendant is domiciled in a contracting state party to the Agreement and the patent relates to a classic

European patent, the court will have international jurisdiction in the action (even if the classic European patent is validated in a State that is not a party to the Agreement, as is the case with Spain).

In fact, the UPC has already declared itself competent to hear a number of claims for infringement, by defendants domiciled in a contracting state, of classic European patents validated in States that are not a party to the UPC Agreement. This is the case, for example, of the Decision of the Düsseldorf Local Division of the UPC's Court of First Instance of 28 January

of the defendant, the defendant must be domiciled in a contracting state party to the UPC Agreement; and that, as the UPC's Court of Appeal has ruled in its Order of 19 August 2024 (UPC_CoA_388/2024), only those "Member States" that have signed and ratified the Agreement are considered "Contracting Member States".

- 3.2. The UPC's international jurisdiction in relation to European patents validated in Spain (or supplementary protection certificates granted by the Spanish Patent and Trademark Office on the basis of European patents) may also be due to the fact that the defendant in actions for which the UPC has subject matter jurisdiction is not domiciled in any Member State of the European Union (whether or not it is a Contracting State party to the UPC Agreement) or in any signatory State of the Lugano Convention. Take, for example, a company domiciled in Canada.

In this case, Article 6(2) of the Brussels Ia Regulation and Article 4(1) of the Lugano Convention provide that jurisdiction shall be governed in each Member State by the domestic law of that Member State, and not by the Regulation. However, in order to prevent national laws from depriving the UPC of jurisdiction, Article 71 *ter.3* of the Brussels Ia Regulation also assigns jurisdiction to the UPC in these cases, by providing that "where the defendant is not domiciled in a Member State, and this Regulation does not otherwise confer jurisdiction over him, Chapter II shall apply as appropriate

The UPC's international jurisdiction is subject to strict limits

2025 (UPC_CFI_355/2023) in respect of a European patent validated in the United Kingdom; of the Order of the Paris Local Division of 21 March 2025 (UPC_CFI_702/2024) in respect of classic patents validated in Spain and Switzerland (applying respectively the Brussels Ia Regulation and the Lugano Convention); of the Order of the Milan Local Division of 8 April 2025 (UPC_CFI_792/2024), in relation to a European patent validated in Spain), or of the Order of the Munich Local Division of 14 April 2025 (UPC_CFI_566/2024), which extends jurisdiction to Poland, the Czech Republic or the United Kingdom.

It should be noted, in any case, that for the UPC to have international jurisdiction on the basis of *the forum domicilii*

regardless of the defendant's domicile", which means recognising the UPC's jurisdiction.

3.3. Similarly, the Brussels Ia Regulation and the Lugano Convention allow the parties to submit (expressly or tacitly) to the authority of a court that does not initially have international jurisdiction, while respecting the exclusive jurisdiction laid down in these legal instruments. Consequently, where the parties have submitted to the authority of the UPC, this Court may also extend its long arm to hear disputes relating to classic patents validated in non-contracting states.

3.4. On the other hand, the UPC also has jurisdiction to take interim measures in relation to the infringement of a classic European patent validated in Spain (or in another non-contracting state) or of a supplementary protection certificate, even if the UPC does not have international jurisdiction as to the substance of the matter, in accordance with the criteria already examined.

Actions cannot be joined if one person infringes the European patent in Spain and a different person infringes the unitary patent

Article 35 of the Brussels Ia Regulation provides that "Application may be made to the courts of a Member State for such provisional, including protective, measures as may be available under the law of that Member State,

even if the courts of another Member State have jurisdiction as to the substance of the matter". In any event, and as clarified in recital 33 of the Brussels Ia Regulation, "[w]here provisional, including protective, measures are ordered by a court of a Member State not having jurisdiction as to the substance of the matter, the effect of such measures should be confined, under this Regulation, to the territory of that Member State".

4. The limits of the UPC's jurisdiction

Although, as has just been explained, the UPC has international jurisdiction in actions relating to patents having effect in non-contracting states, this jurisdiction is subject to strict limits:

4.1. *The UPC's jurisdiction does not extend to national patents.*

The first limit of the UPC's long arm is that it does not apply to actions relating to national patents, even if the defendant is domiciled in a contracting state party to the UPC Agreement. This is because the UPC Agreement does not give the court subject matter jurisdiction in actions relating to national patents. Consequently, under no circumstances can the UPC extend its long arm to the point of hearing disputes concerning a Spanish national patent granted by the Spanish Patent and Trademark Office, nor can it do so to hear disputes concerning supplementary protection certificates

granted on the basis of national patents.

4.2. The UPC's jurisdiction does not extend to classic European patents that are the subject of an opt-out

The long arm of the court cannot extend to classic European patents or supplementary protection certificates in respect of which the holder has exercised the option to exclude the jurisdiction of the UPC under Article 83 of the UPC Agreement.

4.3. The UPC's jurisdiction cannot be based on the jurisdiction of the place of infringement.

Although the Brussels Ia Regulation and the Lugano Convention lay down as a general rule that the courts of the State of the defendant's domicile have jurisdiction, they also provide for a number of special jurisdictions, under which a person domiciled in one Member State may be sued in another Member State. This is the case "in matters relating to tort, delict or quasi-delict", since a person domiciled in one Member State may be sued "in the courts for the place where the harmful event occurred or may occur" (Article 7(2) of the Brussels Ia Regulation and Article 5(3) of the Lugano Convention).

However, although this jurisdiction applies to the infringement of patents or supplementary protection certificates, the UPC

can never rely on it to claim jurisdiction in relation to acts of infringement of a classic European patent validated in Spain (nor of a supplementary certificate granted by the Spanish Patent and Trademark Office). This is for the simple reason that, by definition, infringement of these titles can only occur in Spain and never in the territory of a Contracting Member State of the UPC Agreement.

4.4. The limits of jurisdiction when the action before the UPC concerns the infringement of a unitary patent and the infringement of the Spanish validation of the European patent on which the unitary patent is based.

Where the application to the UPC concerns both infringement of a unitary patent and infringement of the classic European patent validated in a State that is not a party to the UPC Agreement, different scenarios are possible.

- 1) It may happen, firstly, that the person responsible for these acts of infringement is the same person. In this case, the UPC has jurisdiction over all the acts of infringement if the defendant is domiciled in a Contracting State party to the UPC Agreement.
- 2) But it may also happen that the infringement is committed in each state by different persons. And in these cases, it may also happen that the

different persons responsible may or may not all be domiciled in a Contracting State party to the UPC Agreement:

- a) If they are, the UPC has jurisdiction on the basis of the jurisdiction of the defendant's domicile. Consider, for example, that several persons domiciled in the same Contracting State party to the Agreement (e.g. Germany) infringe a unitary patent (in one Contracting State) and the classic Spanish European patent (in Spain). In this case, as all the parties involved in the infringement are domiciled in the same State (in the example, Germany), the courts of that country have jurisdiction in the infringement actions (both for the unitary patent and the classic European patent). There is no need to apply the specific jurisdiction rule of Article 8(1) of the Brussels Ia Regulation, which will be referred to below, because in this case the parties are not domiciled in different States. See, for a case of this type, in relation to a classic British European patent, the decision of 28 January 2025 of the Düsseldorf Local Division of the Court of First Instance of the UPC (UPC_CFI_355/2023).

In the case where all the defendants are domiciled in Contracting States party to the UPC Agreement, but not all are domiciled in the same State, the UPC has jurisdiction on the basis of *the forum domicilii* of the defendant and for the internal allocation of jurisdiction within the UPC, Article 33(1)(b) of the Agreement applies, so that infringement actions may be brought before the local division of any of the States in which any of the defendants "has its residence or principal place of business or, in the absence of residence or principal place of business, its place of business, or the regional division in which that Contracting Member State participates".

- b) But the situation is different if the defendant accused of infringing the classic European patent in Spain (or in another non-contracting state) is not domiciled in a contracting state. Consider the case where A, domiciled in Italy, infringes there the unitary patent and B, domiciled in Spain, infringes there the classic European patent validated in Spain. In this case, it cannot be excluded that the claimant chooses to

bring the action before the UPC (on the basis of A's domicile) and seeks to have it also hear the infringement of the classic European patent in Spain by B, arguing that the Spanish classic patent is "the same" as the unitary patent and that, after the grant of the European patent, the unitary patent was applied for and, as Spain is not part of the system, it was validated in Spain, giving rise to a classic European patent here.

However, in this second type of case, the possibility for the UPC to extend its long arm to acts of infringement of the classic European patent in Spain (or in another non-contracting state) is subject to very strict conditions, laid down in Article 8(1) of the Brussels Ia Regulation and in the case law of the Court of Justice. According to this article, "*where he is one of a number of defendants, [a person may be sued] in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings*".

However, the Court of Justice - in its judgment of 13 July 2006 in Case C-539/03 *Roche*, EU:C:2006:458, paragraph 41 - held that the possibility of bringing proceedings before the courts of the domicile of any one of the defendants "does not apply in European patent infringement proceedings involving a number of companies established in various Contracting States in respect of acts committed in one or more of those States even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them". And, although this judgment was handed down in relation to the precedent Brussels Convention of 1968 on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, its doctrine is equally applicable to the Brussels Ia Regulation, since, "as is apparent from recital 34 of the Brussels Ia Regulation, the Court's interpretation of the provisions of that convention and those of Regulation No 44/2001 ('the Brussels I Regulation'), which replaced it,

also applies to the provisions of the Brussels Ia Regulation, which itself replaced the Brussels I Regulation, whenever those provisions may be regarded as ‘equivalent’” (Judgment of the Court of Justice of 8 September 2022, *IRnova*, C-399/21, EU:C:2022:648, paragraph 29).

The Court of Justice thus rejects the application of the so-called “*spider in the web*” criterion, a criterion according to which the party coordinating or directing the infringements in the various countries would bring the matter to the attention of the courts of its forum. In the opinion of the Court of Justice - *Roche* judgment, paragraph 35 - there would not be the same legal situation in these cases (because the European patent in each of the designated States is governed by the corresponding national legislation) and therefore no risk of contradictory decisions.

Consequently, when a company infringes a unitary patent and a different company (even if it belongs to the same corporate group) infringes the basic European patent

validated in a non-contracting state, it is not possible to base the jurisdiction of the UPC on Article 8(1) of the Brussels Ia Regulation as a basis for the jurisdiction of the UPC to hear all claims, the fact that the various defendant companies belong to the same corporate group and that the parent company which sets the guidelines for the group’s activities is domiciled in a Contracting State party to the UPC Agreement being insufficient for that purpose.

- c) The only cases in which Article 8(1) of the Brussels Ia Regulation can be invoked to establish the jurisdiction of the UPC to hear acts of infringement of a classic European patent validated in Spain (or in another non-contracting state) by a defendant domiciled in Spain (or in another non-contracting) are those referred to by the Court of Justice in its judgment of 12 July 2012, *Solvay*, C-616/10, ECLI:EU:C:2012:445. In this judgment, after reiterating the validity of the *Roche* doctrine, it states that the former Article 6(1) of the previous Regulation (EC) No 44/2001 (equivalent to the current Article 8(1) of the Brussels Ia Regulation) “ must be

interpreted as meaning that a situation where two or more companies from different Member States, in proceedings pending before a court of one of those Member States, are each separately accused of committing an infringement of the same national part of a European patent which is in force in yet another Member State by virtue of their performance of reserved actions with regard to the same product, is capable of leading to ‘irreconcilable judgments’ resulting from separate proceedings as referred to in that provision” (para. 30).

In other words, according to this *Solvay* doctrine, if a person domiciled in Spain and another person domiciled in a Contracting State party to the UPC Agreement infringe the classic European patent in Spain at the same time and with the same acts, if the patent owner were to sue in Spain the person domiciled in Spain and the other infringer before the UPC, we would be dealing with claims that “are so closely connected” that it is “expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from

separate proceedings”. Therefore, Article 8(1) of the Brussels Ia Regulation would allow actions to be brought both before the Spanish courts (to hear the infringement by both parties of the classic European patent validated in Spain and the unitary patent) and before the UPC (to hear the infringement by both parties of the classic European patent validated in Spain and the unitary patent).

- d) In the practice of the UPC there are already several decisions in which the Court declares that it has jurisdiction in actions brought against several defendants for infringement of unitary patents and validations of classic European patents. However, the decisions lack a clear explanation of the reasons for the application of Article 8(1) of the Brussels Ia Regulation.

As is clear from the *Roche* doctrine of the Court of Justice, it is not sufficient that the patents infringed by the defendants are parallel, in the sense that they are based on the same European patent application which, after grant by the European Patent Office, gives rise, on the one hand, to a unitary

patent and, on the other hand, to a classic European patent validated in a non-contracting state. Nor is it sufficient that the infringing companies belong to the same corporate group, so that each national subsidiary operates in its respective territory by infringing the respective national validations of the same European patent. On the contrary, the specific elements laid down by the Court of Justice in the *Solvay* judgment must be present, namely that the defendants infringe “the same national part of a European patent” and “by virtue of their performance of reserved actions with regard to the same product”. Consequently, in order for the UPC to be able to apply Article 8(1) of the Brussels Ia Regulation to hear a claim concerning a classic European patent validated in Spain (or in another non-contracting state), when the defendant is not domiciled in a contracting state party to the Agreement, it is necessary that the defendant carries out such acts of infringement together with another person domiciled in a contracting state and that both parties carry out their acts in relation to the same product. This would

be the case, for example, if the parent company domiciled in a contracting state (for example, a company domiciled in Germany) imports infringing products into Spain which it sells in Spain to its distributors domiciled in Spain, so that they can market them in Spain. In this case, the UPC could hear the infringement action brought against the company domiciled in Germany and its Spanish distributors.

The fulfilment of all these conditions for the application of Article 8(1) of the Brussels Ia Regulation should be specified and explained in the decisions of the UPC, but this is not always the case, as is the case, for example, in the Order of the Milan Local Division of 8 April 2025 (UPC_CFI_792/2024).

4.5. The UPC has no jurisdiction over the validity of classic European patents validated in non-contracting states and supplementary certificates granted in those states.

Article 24(4) of the Brussels Ia Regulation provides that, in matters relating to the registration or validity of patents, regardless of whether the matter has been brought by way of action or as a defence, the courts of the state

in which the deposit or registration has been applied for, made or deemed to have been made by virtue of the provisions of an instrument of the Union or an international convention shall have exclusive jurisdiction, irrespective of the domicile of the parties. And it is added that, “[w]ithout prejudice to the jurisdiction of the European Patent Office

The UPC cannot hear disputes concerning the validity of a classic European patent validated in Spain

under the Convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member State shall have exclusive jurisdiction in proceedings concerned with the registration or validity of any European patent granted for that Member State”. And by virtue of this exclusive jurisdiction, any other court must declare of its own motion that it has no jurisdiction (Article 27 of the Brussels Ia Regulation).

This deprives the UPC of jurisdiction to hear the validity of a classic European patent validated in a

non-contracting state, as well as the validity of supplementary protection certificates granted in that state. On the other hand, the UPC retains jurisdiction to take provisional or protective measures even if an action for invalidity has been brought before the courts with exclusive jurisdiction. This is because, as the Court of Justice has stated in

its aforementioned judgment *Solvay* (point 50), the provisional decision taken by the court before which the interim proceedings have been brought

will not in any way prejudice the decision to be taken on the substance by the court having jurisdiction.

In any case, in relation to the exclusive jurisdiction over the validity of patents and other intellectual property rights, the Court of Justice has recently handed down the controversial judgment of 25 February 2025, in case C-339/22 *BSH/Electrolux* (whose doctrine also applies to the UPC), to which the second document in this series is devoted and to which reference is made.