

Limits of the Unified Patent Court's long arm with regard to Spain (IV): the recognition and enforcement of court decisions

This paper examines the conditions under which decisions handed down by the Unified Patent Court in relation to classic European patents validated in a State that is not a party to the Agreement on a Unified Patent Court, as is the case of Spain, may be recognised and enforced in such country.

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1. Recognition and enforcement of Unified Patent Court decisions relating to classic European patents

1.1. *Recognition and enforcement in States where the classic European patent is validated and which are party to the Agreement on a Unified Patent Court*

Decisions of the Unified Patent Court ('UPC' or 'Court') relating to a European patent with unitary effect shall have effect in all States in which the patent enjoys such unitary effect. Furthermore, in accordance with Article 34 of the Agreement on a Unified Patent Court ('UPC Agreement' or 'Agreement'), its decisions shall have

the force and effect of *res judicata*, in the case of a European patent, in the territory of the Contracting Member States in which the European patent has effect.

This provision of Article 34 of the UPC Agreement is highly relevant because, under the Brussels Ia Regulation¹, judgments given under the *locum delicti commissi* only have effect in the territory of the State of the court. However, according to the aforementioned Article 34, a decision given by a national division of the Court of First Instance of the UPC, under the criterion of the place of infringement of the classic European patent, is treated as a decision given on the basis of the *forum domicilii* of the defendant and, therefore has effect in all States in which the patent is validated and which are Contracting States to the Agreement. This is understandable because, in reality, all decisions of the UPC, regardless of the national division that issued them, are equivalent to decisions of the courts of the Member States party to the Agreement. This means, for example, that when a German division of the Court of First Instance of the UPC issues a decision on a classic European patent validated in Italy, that decision has the same status in Italy as an Italian court decision.

For all these reasons, Article 82 of the UPC Agreement establishes a system of automatic recognition of the

decisions of the Court in the other contracting States, so that in those States the decisions of the Court will be enforceable. In this regard, the enforcement procedure shall be governed by the law of the contracting Member State in which enforcement takes place, as any decision of the Court shall be enforced under the same conditions as a decision given in the contracting Member State in which enforcement takes place.

1.2. *Recognition and enforcement in States where the classic European patent is validated and which, like Spain, are not contracting parties to the UPC Agreement*

The legal regime applicable to the recognition and enforcement of UPC decisions is different when those decisions relate to classic European patents that are validated in European Union Member States that are not party to the UPC Agreement, either because they have not signed it (as is the case with Spain and Croatia), or because, although they have signed it, they have not yet ratified it.

The recognition and enforcement of UPC decisions in these States is not governed by the UPC Agreement, but by the provisions of the Brussels Ia Regulation, because it involves the recognition and enforcement in one Member State of the European Union of decisions of another Member State (given that the UPC is conside-

¹ Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December on jurisdiction, recognition and enforcement of judgments in civil and commercial matters.

red a national court of each of the Contracting States party to the UPC Agreement).

This is clearly established in Article 71d of the Brussels Ia Regulation, which provides that the Regulation shall apply to the recognition and enforcement of judgments given by a common court (such as the UPC) “which are to be recognised and enforced in a Member State not party to the instrument establishing the common court”, in the same way that the provisions of the Brussels Ia Regulation shall also apply to the recognition and enforcement of “judgments given by the courts of a Member State not party to the instrument establishing the common court which are to be recognised and enforced in a Member State party to that instrument”.

As is well known, the Brussels Ia Regulation greatly simplifies the recognition of foreign judgments, since it provides, as a general rule, that “a judgment given in a Member State shall be recognised in the other Member States without any special procedure being required” (Art. 36).

However, any of the parties concerned may request that recognition be refused on one of the grounds provided for in Article 45 of the Brussels Ia Regulation, referred to below.

2. Spanish rules on jurisdiction and procedure for the recognition and enforcement of UPC decisions

The recognition and enforcement in Spain of foreign court decisions under the Brussels Ia Regulation falls, according to the

Judiciary Act (Art. 87), within the jurisdiction of the companies divisions of the courts of first instance, insofar as they are recognised as having jurisdiction for the recognition and enforcement of foreign judgments and other court decisions on any of the matters for which those divisions have subject matter jurisdiction, including industrial property rights (which is the subject matter of the decisions of the Unified Patent Court).

The companies divisions of the courts of first instance shall apply for these purposes the provisions contained in the twenty-fifth final provision of the Civil Procedure Act on the recognition and enforcement in Spain of foreign court decisions. That final provision reiterates, with regard to the recognition of decisions, that decisions falling within the scope of the Brussels Ia Regulation “shall be recognised in Spain without any special procedure being required” (para. 1.1 of the 25th final provision). However, it also provides that, pursuant to Article 38 of the Brussels Ia Regulation, recognition may be suspended if the decision is contested in the Member State of origin (in our case, if the decision of the Court of First Instance of the UPC is not final and conclusive and is appealed before the Court of Appeal) or if a decision is sought declaring that recognition must be refused on one of the grounds listed in Article 45 of the Brussels Ia Regulation.

It is also stipulated that ‘judgments given in a Member State which are enforceable in that Member State shall also be enforceable in Spain without the need for a declaration of enforceability and shall be enforced under the same conditions as if they had been given in Spain’ (para. 2 of the 25th final provision). However, as the

Brussels Ia Regulation lists a number of grounds that may prevent the recognition and enforcement of foreign decisions, the 25th final provision of the Civil Procedure Act establishes in its fourth paragraph a series of rules on the procedure for refusing the enforcement of decisions enforceable in a Member State of the European Union under the Brussels Ia Regulation, a procedure that will follow the oral trial.

3. Reasons that may determine the non-recognition and non-enforcement in Spain of UPC decisions

In accordance with the Brussels Ia Regulation and the Spanish legislation referred to, the reasons why a Spanish court may refuse to recognise and enforce a UPC decision in Spain are as follows:

The recognition and enforcement in Spain of UPC decisions are not governed by the UPC Agreement

- 1) Firstly, recognition may be refused when the UPC decision does not respect the exclusive jurisdiction set out in the Brussels Ia Regulation, which will happen when it infringes Article 24(4) of that Regulation and examines, by way of an action as a defence, the invalidity of the classic European patent validated in Spain whose infringement is claimed against the defendant.

This will obviously happen if the UPC declares the patent invalid *erga omnes* or *inter partes*, for which it lacks jurisdiction. However, problems may also arise when the UPC has heard

an action for infringement of a classic European patent validated in Spain, even though an action for declaration of invalidity of that patent has been brought before a Spanish court and that circumstance has been relied on before the UPC.

Indeed, as already discussed in the second document in this series, the Court of Justice of the European Union ('CJEU'), in its Judgment of 25 February 2025 (C-339/22, *BSH/Electrolux*, ECLI:EU:C:2025:108), has ruled that in such situations, the court hearing the infringement proceedings may decide to stay such proceedings or to continue with them, despite the validity of the patent being challenged before the court with jurisdiction to rule on

that issue. It should be recalled that, according to the aforementioned judgment of the CJEU, a stay may be granted when the court hearing the infringement proceedings (in our case, the UPC) concludes "that there is a reasonable,

non-negligible possibility of that patent being declared invalid by the court of that other Member State that has jurisdiction". However, on closer inspection, when the court assesses whether or not to grant a stay, it is, strictly speaking, carrying out an analysis of the validity or invalidity of the patent, an analysis for which it is not competent. And it carries out this analysis of validity not in the context of proceedings for interim relief (in which the decision taken is provisional and reversible), but in the context of main infringement proceedings which may result in a judgment finding the de-

fendant liable for patent infringement, having found that it was “reasonable” to conclude that it was valid, despite not having jurisdiction to rule on its validity, either by way of an action or as a defence.

Furthermore, when the claimant brings an infringement action before the UPC in disregard of the rules of international jurisdiction laid down in the Brussels Ia Regulation and in the case law of the CJEU interpreting it, we may be faced with a case of abuse of rights and, in the event of a dominant position, an abuse of that position by the claimant, contrary to competition law and punishable by the competition authorities.

- 2) Recognition of a UPC decision may also be refused where such recognition is manifestly contrary to Spanish public policy (*ordre publique*).

In this regard, it should be noted that, although the objective of the Brussels Ia Regulation, like that of the 1968 Brussels Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, is “to secure the simplification of formalities governing the reciprocal recognition and enforcement of judgments of courts or tribunals, it is not permissible to achieve that aim by undermining the right to a fair hearing” (judgments of the CJEU of 11 June 1985, *Debaecker and Plouvier*, 49/84, paragraph 10, and of 28 March 2000, C-7/98, *Krombach*, ECLI:EU:C:2000:164, paragraph 43).

This case law of the CJEU is highly relevant because it clearly establishes

that the right to defence takes precedence over the rules on the recognition and enforcement of foreign judgments. Along the same lines, the Spanish Constitutional Court has ruled (Constitutional Court Judgments 43/1986, Point of Law 2, and 54/1989, Point of Law 4) — in relation to Article 24 of the Constitution, which regulates the right to a judicial remedy — that, although foreign courts are not bound by the Spanish Constitution, the decisions of Spanish courts that recognise “a foreign court decision in a case where, because it is contrary to the essential principles contained in Article 24 of the Constitution, it should have been rejected by the public policy of the forum” do violate fundamental rights. This latter concept “has thus acquired a different meaning in Spain, particularly influenced by the requirements of Article 24 of the Constitution”, since “although the fundamental rights and public freedoms guaranteed by the Constitution are only fully effective where Spanish sovereignty is exercised, our public authorities, including judges and courts, cannot recognise or accept decisions handed down by foreign authorities that involve a violation of the fundamental rights and public freedoms constitutionally guaranteed to Spanish nationals or, where applicable, to Spanish nationals and foreigners” (Supreme Court Judgment no. 43/1986, Point of Law 4).

Consequently, Spanish courts could refuse to recognise UPC decisions that involve a violation of the right of defence and, therefore, of the right to a judicial remedy and Spanish public policy.

Consider, in particular, cases in which the UPC hears an action for infringement of a unitary patent and, at the same time, an infringement of the classic European patent, parallel to the unitary patent and which has been validated in Spain. Imagine that the defendant claims before that court that it has brought an action for declaration of invalidity of the European patent validated in Spain before the Spanish courts, while at the same time

constitute a violation of the right of defence of the defendant for infringement of the classic European patent validated in Spain, a violation of the right of defence that would arise from the UPC's failure to stay the infringement proceedings so that the Spanish national court, as the court with exclusive jurisdiction, could rule on the invalidity of the patent. This does not appear to be the result desired by the CJEU when it handed down its judgment in *BSH/Electrolux*,

and it cannot be ruled out that a national court, faced with a situation of this kind, before enforcing in Spain a decision of the UPC such as the one referred to, may refer the matter to the CJEU for a preliminary ruling in

order to have it examined in the light of the undesirable effects that have been reported.

Similarly, it will be necessary to examine in detail whether the UPC decision does not violate the defendant's right of defence when the defendant merely points out to that Court the existence of grounds for invalidity of the patent, without having previously brought an action for declaration of invalidity of the patent before the Spanish courts, and the UPC simply continues with the infringement proceedings. It should be recalled, as explained in detail in the second document in this series, to which reference is made, that in the judgment of the CJEU in the *BSH/Electrolux* case, the defendant for infringement is in fact being forced to bring an action for declaration of invalidity in another jurisdic-

The Brussels Ia Regulation lists a number of grounds that may prevent the recognition and enforcement of UPC decisions

filing a counterclaim for a declaration of invalidity of the unitary patent before the UPC. If the Court does not stay the infringement proceedings, and having been unable to find any specific procedure in the rules of procedure of that court to disjoin the actions brought in proceedings at a stage prior to giving judgment, we could find ourselves in a situation where the UPC would deliver a judgment declaring the invalidity of a unitary patent (and, therefore dismissing the infringement action with respect to that unitary patent) and, at the same time, declaring the infringement of the parallel classic European patent validated in Spain. In addition to this situation being absolutely undesirable, which could arise from the application by the UPC of the doctrine established by the CJEU in the controversial judgment *BSH/Electrolux*, it may also

tion, thereby depriving it of a means of defence such as the possibility of simply pleading invalidity before the UPC without first bringing an action for declaration of invalidity. It should also be noted that the claimant was able to bring proceedings before this court in respect of the infringement of the Spanish validation of a European patent precisely in order to prevent the defendant from properly exercising its right of defence before the UPC, since it will not be able to raise the validity of the patent as a defence, thereby necessarily forcing it to bring an action for declaration of invalidity in Spain.

Likewise, cases in which the UPC, after conducting a mere preliminary analysis of the validity of the patent, does not stay the infringement proceedings concerning a classic European patent validated in Spain and ends up giving a judgment ordering the defendant to pay damages, which becomes final and conclusive and enforced, and subsequently, a Spanish court declares the patent invalid, are problematic. Given the timeframes within which the UPC intends to operate, this scenario may not be merely “theoretical” or “exceptional”. In this case, however, even if the UPC considers that the defendant’s right of defence remains intact because it was able to plead the invalidity of the patent², the fact is that the court has not examined the validity or invalidity of the patent in sufficient depth (because it does not

have jurisdiction to do so, according to Article 24(4) of the Brussels Ia Regulation). This circumstance affects the defendant’s right of defence, especially in cases (which are common in patent litigation) where the main defence against the infringement claim, or one of the main defences, is precisely the invalidity of the patent. Furthermore, this infringement of the right of defence is even more evident when one considers that, once the Spanish court has declared the patent invalid, the Spanish Patent Act (Article 104) does not extend the retroactive effect of the invalidity of patents to the point of affecting decisions on patent infringement that have become final and conclusive and have been enforced prior to the declaration of invalidity, and only allows damages to be obtained in those exceptional cases where the defendant can prove that the patent holder acted in bad faith.

Furthermore, there may also be an infringement of the right of defence if the UPC ignores the applicable Spanish law, despite it having been invoked by one or both parties, and the defendant is ultimately found liable for something for which they would not have been found liable if the applicable national law had been applied.

- 3) Another case in which, according to the Brussels Ia Regulation, recognition of a decision of the UPC may be refused is where the decision was given

² See the Order of the Paris Local Division of the Court of First Instance of the UPC of 21 March 2025 (UPC_CFI_702/2024), paragraph 25.

in default, without the defendant having been served with a direction to appear or an equivalent document in sufficient time to enable him to defend himself, unless he failed to appeal against that decision when he could have done so.

- 4) Finally, recognition in Spain of a decision of the UPC shall also be refused if it is irreconcilable with a decision given between the same parties in the Member State addressed, i.e. in Spain; or if it is irreconcilable with an earlier decision given in another Member State or a third State between the same parties in a dispute having the same subject matter and cause of action, provided that the latter decision fulfils the conditions necessary for its recognition in the Member State addressed.

This ground for refusal of recognition and enforcement would exist where, following the filing with the UPC a claim of infringement of a classic European patent validated in Spain, the defendant had, in turn, brought an action for declaration of invalidity of the patent before a Spanish court, a Spanish court declaration of invalidity of the patent having already been given. It should be noted that the Brussels Ia Regulation only requires that the

decision of the UPC and the previous Spanish court decision have been given in proceedings involving the same parties, but not that the previous Spanish court decision has become final and conclusive. That being the case, it seems clear that a decision of the UPC declaring the infringement of a classic European patent validated in Spain is irreconcilable with a Spanish judgment declaring that patent invalid, even if that judgment has not become final and conclusive.

It should also be noted that what is relevant for the application of this ground for refusal of recognition and enforcement of the decisions of the UPC is not that the Spanish decision declaring the patent invalid is earlier than the date of the decision of the UPC, but that it is earlier than the date on which its recognition and enforcement were requested in Spain.

In any case, the possible problems of denial of defence already mentioned arise when the Spanish judgment declaring the invalidity of the classic European patent validated in Spain is subsequent to the judgment of the UPC declaring the infringement and its enforcement, once final and conclusive.