

# The Unified Patent Court takes jurisdiction to hear a claim concerning the infringement of the UK national part of a European patent, even when the validity of the patent is being disputed

We examine the recent decision of the Mannheim Local Division of the Court of First Instance of the Unified Patent Court, of 18 July 2025, and explain why this decision cannot be relied on to extend the Unified Patent Court's long arm to the point of determining the validity of the Spanish part of a European patent.

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## **1. Introduction**

1.1. The Mannheim Local Division of the Court of First Instance of the Unified Patent Court (UPC) has recently issued a decision - dated 18 July 2025 (UPC\_CFI\_365/2023) - in which it takes jurisdiction to hear a claim filed against three companies belonging to the same business group, all domi-

ciled in Germany, for infringement of a classic European patent having effect in Germany and the United Kingdom.

1.2. The interest of this decision lies in the statements made regarding the court's jurisdiction in relation to the UK national part of the European patent. This is not the first time that the UPC has taken jurisdiction to hear actions

for infringement of classic European patents with effect in States that are not a party to the Agreement on a Unified Patent Court ('UPC Agreement' or 'Agreement'), brought by defendants domiciled in a party to the Agreement ('contracting State'), as there are previous decisions to this effect<sup>1</sup>. However, what is new about the decision of the Mannheim Local Division dated 18 July 2025 is that it applies the doctrine established by the Court of Justice in the judgment of 25 February 2025, C339/22, *BSH/ Electrolux* (ECLI:EU:C:2025:108), upholding the jurisdiction of the court despite a counterclaim for patent invalidity having been filed.

In fact, the UPC separated its proceedings in relation to the German part of the European patent and in relation to the UK patent because the aforementioned judgment of the Court of Justice was delivered after the oral stage of the proceedings. Consequently, in a decision of 2 April 2025, the Mannheim Local Division ruled on the German part (upholding the claim for infringement and dismiss-

ing the counterclaim for revocation); and in the decision now under discussion, of 18 July 2025, it deals with the UK national part of the European patent.

## 2. The UPC's jurisdiction to hear infringement actions concerning the UK national part of a European patent, even if the validity of the patent is disputed

2.1. The UPC has jurisdiction to hear actions falling within its subject matter scope of jurisdiction where the defendant is domiciled in one of the contracting States. It should be noted that both the Brussels Ia Regulation<sup>2</sup> (Art. 4(1)) and the Lugano Convention<sup>3</sup> (Art. 2) establish the defendant's domicile as the general forum for determining international jurisdiction, so that persons domiciled in a Member State of the European Union are subject to the courts of that State, regardless of their nationality. And, according to the Brussels Ia Regulation (Art. 71a(2)(a), the UPC is a "common court", and on that basis (Art. 71b), "a common court shall have jurisdiction where, under this Regulation, the courts of

<sup>1</sup> Decisions such as that of the Düsseldorf Local Division of 28 January 2025 (UPC\_CFI\_355/2023) concerning a European patent validated in the United Kingdom; the Order of the Paris Local Division of 21 March 2025 (UPC\_CFI\_702/2024) concerning classic patents validated in Spain and Switzerland; the Order of the Milan Local Division in of 8 April 2025 (UPC\_CFI\_792/2024) in relation to a European patent validated in Spain), or 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.

<sup>2</sup> 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.

<sup>3</sup> Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Lugano Convention), signed in 2007 by the European Union, Denmark, Iceland, Norway and Switzerland.

a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument”. Given that the UPC Agreement recognises the jurisdiction of the court not only in relation to the unitary patent, but also in relation to classic European patents, it follows that, where the defendant is domiciled in a contracting State and the patent relates to a classic European patent, the court has international jurisdiction to hear the claim (even if the classic European patent has effect in a non-contracting State, as is the case with the UK).

For this reason, and given that the three defendant companies are domiciled in Germany, the Mannheim Local Division’s statement that “the UPC has jurisdiction to decide upon the infringement action as far as it relates to acts infringing the UK national part of the patent-in-suit” is correct.

- 2.2. This jurisdiction of the UPC to hear infringement cases relating to the UK national part of European patents is not affected by the fact that the validity of the patent is being disputed by the defendants.

It is true that the Brussels Ia Regulation (Article 24(4)) confers exclusive jurisdiction to hear the validity of the patent on the courts of the State that granted it, whether the validity is raised by way of a counterclaim or as a defence. However, the Court of Justice, in its judgment of 25 February 2025, C-339/22, BSH v Electrolux, ECLI: EU:C:2025:108—clarified that the

exclusive jurisdiction of the courts of the State in which the patent is granted or registered to hear cases concerning its invalidity or validity does not apply when the patent in question has not been issued or validated in a Member State of the European Union, but in a third country (such as Turkey or, after Brexit, the United Kingdom).

Therefore, in these cases where the patent has been granted in a State outside the European Union, as Article 24(4) of the Brussels Ia Regulation does not apply, the court of the Member State which, by virtue of the jurisdiction of the defendant’s domicile, hears the actions for infringement of that third State’s patent, may examine the validity of the patent by way of defence (provided that the third State is not a contracting party to the Lugano Convention, there is no bilateral agreement between that country and the European Union to the contrary, and no proceedings are pending before a court of that third State). However, the court hearing the infringement proceedings may not make a declaration of invalidity that would result in the revocation of the patent with *erga omnes* effect. According to the Court of Justice (paragraph 73 of the BSH/ Electrolux judgment), the principle of non-interference between States, which is specific to international law, means that “only the courts of the third State in which a patent is granted or validated have jurisdiction to declare that patent invalid by a decision that may cause the national register of that State to be amended as regards the existence or content of that patent”.

On the other hand, the court of the Member State of the defendant's domicile before which an action for patent infringement has been brought and in which, by way of defence, the invalidity of a patent granted or validated in a third State, has jurisdiction to rule on that issue, since the decision of that court requested in that regard cannot affect the existence or content of the patent in that third State or entail the modification of the national register of that State.

2.3. The Mannheim Local Division applies this case law of the Court of Justice and emphasises that “the UPC has no jurisdiction to revoke the national part of an European bundle patent for states other than UPCA contracting member states”. However, the UPC may assess “the validity of the patent-in-suit in relation to the United Kingdom as a mere prerequisite for the question of infringement with *inter partes* effect only”.

2.4. Furthermore, the decision of the Mannheim Local Division confirms what we already suggested in our previous analysis of the *BSH/Electrolux* judgment<sup>4</sup>, namely that, although the dispute underlying the Court of Justice's judgment was not heard before the UPC, the Court of Justice's interpretation in the *BSH/Electrolux* judgment is equally applicable to it, since this court is equivalent to the national courts of the contracting States. And, as the

Mannheim Local Division of the UPC points out, there is no evidence that the contracting States “intended to transfer jurisdiction to the UPC with regard to their national parts of a European patent only, thereby reserving jurisdiction with regard to other national parts to their national courts”.

### 3. Differences with cases concerning a European patent validated in Spain

3.1. The decision of the Mannheim Local Division and the arguments it puts forward to justify its jurisdiction over the UK national part of European patents are not applicable in all cases to European patents validated in Spain. This is because there is a significant difference between the two situations, since although both Spain and the United Kingdom (following Brexit) are not party to the UPC Agreement, the Kingdom of Spain is a member of the European Union and is therefore subject to the Brussels Ia Regulation. And, under that regulation, international jurisdiction to hear cases concerning the validity of a Spanish national patent or a European patent validated in Spain lies exclusively with the Spanish courts, and not with any other court in the other Member States of the European Union (nor with the UPC). This is derived from Article 24(4) of the Brussels Ia Regulation, which states that “courts of a Member State shall have exclusive jurisdiction, regardless of the domicile of the parties [...] in proceedings con-

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<sup>4</sup> “Limits of the Unified Patent Court's long arm with regard to Spain (II): the controversial judgment of the Court of Justice in the *BSH/Electrolux* case”, of 6 June 2025; see in this [link](#).

cerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, 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, has taken place or is under the terms of an instrument of the Union or an international convention deemed to have taken place”.

Consequently, although in certain exceptional cases a Member State of the European Union may have jurisdiction

## ***This decision cannot be relied upon to require the court to examine the validity of the Spanish part of a European patent***

to hear actions for infringement of a patent validated in Spain (or a Spanish national patent), particularly if the defendant is domiciled in that other Member State, what that court may never do is hear the validity of that patent, either *erga omnes* or *inter partes* (by way of defence). And, on that basis, what the Court of Justice stated in its *BSH/ Electrolux* judgment is that the court before which the infringement action has been brought retains jurisdiction to hear the infringement, even though the question of the va-

lidity of the intellectual property right has been raised, without, according to the court, being obliged to stay the infringement proceedings until the question of the validity of the intellectual property right has been resolved. As we explained in detail in a previous document to which we now refer<sup>5</sup>, this interpretation by the Court of Justice is open to criticism because it has adverse effects on the defendant’s right of defence and is not in line with the exclusive jurisdiction established in Article 24(4) of the Brussels Ia Regulation. In order to decide whether or not to stay ordinary infringement pro-

ceedings, the court must assess whether “there is a reasonable, non-negligible possibility of that patent being declared invalid by the court of that other Member State that has jurisdiction”; it is clear that such an analysis entails, in practice,

an analysis of validity by way of defence, with *inter partes* effects, in the context of infringement proceedings, an analysis that it could not carry out in any case because Article 24(4) of the Brussels Ia Regulation establishes that it is the exclusive jurisdiction of the Member State where the patent was validated and produces effects.

However, the situation is different when a court of a Member State of the Union (including ordinary courts such

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<sup>5</sup> See footnote number 4.

as the UPC) is hearing infringement proceedings concerning a patent from a country outside the European Union. In such cases, given that the patent in question has not been issued or validated in a Member State of the European Union, but in a third country (such as Turkey or, after Brexit, the United Kingdom), the exclusive jurisdiction of the courts of the State of grant or registration of the patent to hear cases concerning its invalidity or validity does not apply. This was stated by the Court of Justice in its judgment of 8 September 2022, *IRnova* (Case C-399/21), and in the aforementioned *BSH/Electrolux* judgment.

Therefore, in these cases where the patent has been granted in a State outside the European Union, as Article 24(4) of the Brussels Ia Regulation does not apply, the court of the Member State which, by virtue of the jurisdiction of the defendant's domicile, hears the actions for infringement of that third-country patent may examine the validity of the patent by way of defence. However, the court hearing the infringement proceedings may not make a declaration of invalidity that would result in the revocation of the patent with *erga omnes* effect.

3.2. In view of the above, it is clear that the decision of the Mannheim Local Division referred to in this commentary cannot be invoked to attempt to extend the long arm of the UPC to the point of hearing the validity of a Spanish validation of a European patent.

It should also be noted that when the UPC hears the validity of the UK national part of a European patent, it may analyse all the defence arguments relied on by the defendant, both those of non-infringement and those of invalidity (although with regard to invalidity only with *inter partes* effect), which guarantees the defendant's right of defence. However, this would not be the case for patents validated in Spain (or in any other European Union country that is not a contracting State). On the contrary, with regard to these patents, if the infringement proceedings continue, despite the defendant raising their invalidity as a defence, their right of defence may ultimately be adversely affected, as we explained in our aforementioned commentary on the *BSH/Electrolux* judgment, with the consequences that this could have in the context of the recognition and enforcement of that decision<sup>6</sup>.

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<sup>6</sup> On this issue we refer to our previous commentary, "Limits of the Unified Patent Court's long arm with regard to Spain (IV): the recognition and enforcement of court decisions", of 13 June 2025; see in this [link](#).