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ANALYSIS

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The *long arm* of the Unified Patent Court based on the "event giving rise to the infringement" and considerations on the application of *lex loci protectionis*

The decision of the Mannheim Local Division of 2 October 2025, constitutes a new milestone in the extension of the Unified Patent Court's long arm, declaring itself competent on the basis of Article 7(2) of the Brussels Ia Regulation, because the infringement occurred in a State party to the Agreement on a Unified Patent Court. The decision also establishes, in a manner open to criticism, the presumption that case law on the interpretation of claims is the same in all Contracting States of the European Patent Convention.

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1. Introduction

The Unified Patent Court (UPC) may, in certain very specific cases and within strict limits, extend its jurisdiction to hear cases of infringement of European patents that have effects in States that are not party to the Agreement on a Unified Patent Court (UPCA).

It should be noted that both the Recast Brussels I Regulation (Brussels Ia Regulation)[1], in Article 4(1), and the Lugano Convention[2], in Article 2, establish as the general forum, when determining international jurisdiction, that of the domicile of the defendant, so that persons domiciled in a Member State of the European Union are subject, regardless of their nationality, to the courts of that State. And according to the Brussels Ia Regulation (Art. 7a(2)(a)), the UPC is a "common court" and, on that basis (Article 71b), "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 UPCA recognizes the jurisdiction of the court not only in relation to unitary patents, but also in relation to classic European patents, provided that the opt-out has not been exercised in respect of the latter, it follows that, where the defendant is domiciled in a State party to the UPCA, and the patent relates to a classic European patent, the UPC has international jurisdiction to hear the case (even if the classic European patent has effect in a State that is not party to the UPCA).

The court bases its jurisdiction on the shipment of goods from UPC territory as event giving rise to damage

In addition, the international jurisdiction of the UPC in relation to European patents validated in States outside the aforementioned agreement may also be due to the fact that the defendant in an action for which the UPC has subject-matter jurisdiction is not domiciled in any Member State of the European Union or in any Contracting State of the Lugano Convention. In such cases, Article 6(2) of the Brussels Ia Regulation and Article 4(1) of the Lugano Convention stipulate that jurisdiction shall be governed, in each Member State, by the internal law of that Member State. However, in order to pre-

[1] 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.

[2] 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.

vent national laws from depriving the UPC of jurisdiction, Article 71b(3) of the Brussels Ia Regulation also assigns jurisdiction to the UPC in such cases, 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 regardless of the defendant's domicile", which implies recognition of the UPC.

This phenomenon, whereby the UPC extends its international jurisdiction to European patents that have effects in States that are not party to the UPCA, is known as the *long arm* of the UPC, and we have referred to it in a series of papers in which we criticize the sometimes excessively broad interpretation being made of that jurisdiction[3].

Now a new milestone in the expansion of the international jurisdiction of the UPC is the decision of the Mannheim Local Division of 2 October 2025 (UPC_CFI_162/2024), to which we refer below, in which that court assumes international jurisdiction on the basis of Article 7(2) of the Brussels Ia Regulation because the "event giving rise" to the infringement of European patents validated in States that are not party to the UPCA occurred in a State party to the UPCA.

2. Territorial jurisdiction based on the place of the "event giving rise to the infringement" (Art. 7(2) Brussels Ia Regulation)

In this case, the UPC heard the action brought by the South Korean company Hurom Co., Ltd. against the South Korean company NUC Electronics, Co., Ltd. for infringement of European patent validations in the territory of that court and in Poland, Spain, the United Kingdom, and Turkey. Given that at that time the Court of Justice had not yet handed down its judgment in the *BSH/Electrolux* case, it decided to separate the infringement action relating to Spain, Poland, and the United Kingdom and resumed it once the Court of Justice's judgment had been published. The decision in question resolves this second part of the proceedings, relating to the infringement of the European patent validations in these three countries.

To justify the jurisdiction of the UPC, the claimant argued that the defendant infringed the patent in Poland, Spain, and the United Kingdom by sending the infringing products to those countries through its German subsidiary NUC Electronics Europe GmbH and its French distributor Warmcook, which operated from the territory of countries that have ratified

[3] These are the following GA_P documents (the words in bold link to the respective papers): "Limits of the Unified Patent Court's *long arm* with regard to Spain (I): ***international*** jurisdiction", "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***", "Limits of the Unified Patent Court's *long arm* with regard to Spain (III): applicable ***law***", "Limits of the Unified Patent Court's *long arm* with regard to Spain (IV): the recognition and enforcement of court ***decisions***", "The Unified Patent Court grants interim relief regarding a European patent ***validated*** in Spain: critical considerations" and "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".

the UPCA (Germany and France, respectively), where they also have their place of business. Furthermore, it appears that the German company NUC Electronics Europe GmbH is also the importer of these products for the European Union and United Kingdom markets, as indicated by their CE and UK markings.

In the aforementioned ruling, the UPC considers itself competent to hear the case against the South Korean company on the grounds that the *long arm* also extends to cases where the "event giving rise to the infringement" of a national part of a European patent in a State outside the UPCA takes place in a State that is party to the UPCA.

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

When analysing the special jurisdiction of the place where the infringement occurred, one line of interpretation[4] argues that, given the principle of territoriality governing intellectual property rights, these rights can only be infringed in the State that recognizes them. On that basis, it is concluded that the special jurisdiction of Article 7(2) of the Brussels Ia Regulation can only lead to the recognition of the jurisdiction of the courts of the State that grants the right. This means, according to the proponents of this view, that, in matters of intellectual property, the *forum loci delicti comissi* would always and necessarily match the exclusive jurisdiction in matters of invalidity of intellectual property rights, now recognized in Article 24(4) of the Brussels Ia Regulation. Furthermore, it is argued that this interpretation has the advantage that *forum* and *ius* would be one and the same, since the *lex loci protectionis* would be applicable and would be applied by the courts of the State that has passed such legislation.

However, this interpretation is not followed by the UPC in the Decision of the Court of First Instance of the Unified Patent Court, Local Division Mannheim, delivered on 2 October 2025 (UPC_CFI_162/2024).

In this ruling, the court bases its decision on the interpretation of the concept of "the place where the harmful event occurred or may occur" in Article 7(2) of the Brussels Ia Regulation, as noted by the Court of Justice, according to which this includes both the place where the damage occurs, and the place of the event giving rise to it, which allows the claimant to choose between both courts to file the claim (*Pinckney* judgment of 3 October

[4] See, inter alia, Von Meibom, W./Pitz, J., "Cross-Border Injunctions in International Patent Infringement Proceedings," *EIPR*, 1997, pp. 469 et seq. (470); Boschiero, N., "Il principio de territorialità in materia de proprietà intelletuale: conflitti di legge e giurisdizione," *AIDA*, 2007, pp. 34 et seq. (80 et seq.).

2013, C-170/12, paras. 26 et seq.; and *Wintersteiger* judgment of 19 April 2012, C-523/10, paras. 19 et seq.). It adds that, in the context of an intellectual property right, the place of the event is not limited to the State in which that right is registered, so that the territorial nature of a right registered as a patent does not preclude acts giving rise to infringement from being committed in a different State, provided that they have an effect on the national patent concerned. Thus, the doctrine established by the Court of Justice in relation to trademark infringement in its judgment of 19 April 2012, Wintersteiger, is applied to patents. In that judgment (paragraph 27), although the Court of Justice states that both "the objective of foreseeability and that of sound administration of justice militate in favour of conferring jurisdiction, in respect of the damage occurred, on the courts of the Member State in which the right at issue is protected" when applying the criterion of the place of the event giving rise to the damage, "the territorial limitation of the protection of a national mark is not such as to exclude the international jurisdiction of courts other than the courts of the Member State in which that trade mark is registered".

On this basis, the UPC considers that it has jurisdiction to hear the case in relation to Poland, Spain, and the United Kingdom because the infringing products were shipped to those States from a subsidiary and a distributor of the defendant, both domiciled in the territory of the signatories to the UPCA, one of them being registered as an importer and authorized representative in the EC and UK markets for those products. In other words, the shipment is considered to be the event giving rise to the damage. And, as that event takes place in the territory of the UPC, this gives it jurisdiction to hear the infringement of classic European patents validated in those countries outside that territory.

There are several UPC decisions in which international jurisdiction has been established on the basis of the authorized representative in the CE market, either because the latter is domiciled in the territory of a Member State party to the UPCA[5], or because, considering their involvement in the events, the place from which that authorized representative operates can be considered the place where the event giving rise to the damage occurred (as in the case under consideration). This is likely to lead companies operating in the territory of the European Union to redefine their commercial and operational strategy and to appoint as their authorized representative for the purposes of the CE marking a company domiciled in a Member State of the Union, but not party to the UPCA. This is because, if such a company is domiciled and operates from a Member State of the European Union that is not party to the UPCA, although it may be sued before the UPC for acts that have effects in the territory of the UPCA, its acts with effects in Member States that have not signed the UPCA should fall outside the jurisdiction of that court.

[5] See, for example, the decision of the Hamburg Local Division of 14 August 2025, handed down in the Dyson case (UPC_CFI_387/2025), which we discuss in " The Unified Patent Court grants interim relief regarding a European patent validated in Spain: critical considerations." See in this *link*.

3. Legislation applicable to the infringement of patents validated in Spain, Poland, and the United Kingdom: the *lex loci protectionis* rule

The fact that the UPC may hear cases of infringement of a European patent validated in a State that is not party to the UPCA does not mean that the court may apply the same rules as if the cases concerned a unitary patent or a European patent validated in the States that are party to the UPCA. On the contrary, the applicable law will be the patent law of the State that is not party to the UPCA in which the classic European patent has been validated (in our case, Spanish law).

That being the case, the application of the UPCA and the Rome II Regulation[6] may lead to the court having to apply the national law of States that are not party to the UPCA (and, consequently, it may have to apply Spanish law). This is expressly recognized in Article 24(2) UPCA ("[t]o extent that the Court shall base its decisions on national law, including where relevant the law of non-contracting States...") and in Article 24(3), according to which the law of non-contracting states shall apply where appropriate, in particular in relation to the content and limits of the right, the burden of proof and its reversal, corrective measures in infringement proceedings, damages, and limitation periods. Article 24(3) UPCA literally states that the "law of non-contracting States shall apply when designated by application of the rules referred to in paragraph 2, in particular in relation to Articles 25 to 28, 54, 55, 64, 68 and 72".

In the case at hand, the Local Division in Mannheim is aware of this. However, although it points out that the applicable law with regard to the infringement of the European patent validated in Spain, Poland, and the United Kingdom is the national law of these States, it does not apply it in some respects, placing the burden of proof on the defendant.

Thus, when dealing with the scope of protection of claim 1 of the patent in dispute, the UPC notes that it "has to observe the relevant legal standards on the application of Art. 69 EPC [European Patent Convention] as set out in the relevant national case law of that non-UPC member state and, accordingly, apply Art. 69 EPC in the same way as a national court of that non-UPC member would do". However, while the starting point is appropriate, it goes on to point out that, since the claimant had stated that it could be "assumed that the findings of the panel in the case at hand are applicable to all EPC jurisdictions", it was incumbent upon the defendant to prove that this was not the case ("Against this backdrop, it would have been for the Defendant to point at any differences resulting from the case law regarding claim construction in Poland, Spain or the United Kingdom").

In our opinion, this "assumption" regarding the interpretation of the scope of patent protection is not supported by either the

[6] *Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II).*

Rome II Regulation or Article 24 UPCA. As the Court of Justice has stated, "proceedings concerning a patent infringement also involve a thorough analysis of the scope of the protection conferred by that patent in the light of the patent law of the country in which that patent was granted" (Judgment of September 8, 2022, *IRnova*, C-399/21, EU:C:2022:648, para. 48). We therefore consider that the burden of proving that under the applicable national law the interpretation of the scope of protection of the patent would be different should not fall on the defendant. In fact, a little later, when analysing the defendant's liability in this case, the UPC itself states that "[a]lthough the content of relevant national law of Non-UPC member states is a question of law and not a question of facts and the principles of demonstration and non-challenge do not apply to question of law, it is primarily up for the party who wishes to rely on national 33 law to present it to the court in a sufficiently detailed manner, in particular to make specific and precise statements as to its content relevant to the case".

Indeed, when addressing the question of whether it was possible to conclude that the defendant (the South Korean company) was liable for the infringements committed in Spain, Poland, and the United Kingdom by its German subsidiary and its French distributor, the UPC concluded that it was not and dismissed the action. It did so on the grounds that, although the claimant had submitted the relevant provisions of Polish, Spanish, and UK law, the claimant "did not elaborate on their application in a situation like the particular situation at hand in which no direct own acts by a defendant relating to the relevant territories exist, but only direct acts committed by separate legal entities that are part of defendant's distribution network. It is not self-explanatory that the national law including the case law considers these acts to be attributable as acts of infringement to Defendant".

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