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ANALYSIS

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Limitation of a patent and the Unified Patent Court's 'long arm'

The recent judgment of the Paris Local Division of the Court of First Instance of the Unified Patent Court, dated 16 January 2026 (UPC_CFI_369/2025), highlights the contradictions that can arise from the Unified Patent Court's improper application of the 'long arm'.

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1. The 'long arm' and patent limitation

1.1. In patent infringement proceedings, it is very common for the defendant to argue in its defence that the patent alleged to have been infringed is invalid and to file a corresponding counterclaim for revocation. When this occurs, it is also common for the claimant-patent holder, in order to overcome the grounds for revocation raised against their patent, to proceed — either in the main or in the alternative — to limit the patent during the infringement and revocation proceedings.

This possibility of limiting the patent is recognised by the Convention on the Grant of European Patents (following its 2000 Revision Act), Article 138(3) of which provides that, in proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceedings. This is also provided for in Rule 30 of the Rules of Procedure of the Unified Patent Court, which states that the defence to a counterclaim for revocation may include an application by the proprietor of the patent to amend the European patent (whether unitary or non-unitary, but validated in a State party to the Agreement on a Unified Patent Court — AUPC).

However, while the Unified Patent Court (UPC) has jurisdiction to examine the validity of the limitation of unitary patents and also of classic European patents validated in a State party to the aforementioned agreement, it lacks international jurisdiction to rule on the potential invalidity of European patents validated in States that are not party to that agreement, even if those patents are the validation in those States of the same basic European patent that has given rise to a unitary patent or to the patent validated in a State party to the agreement. And it lacks jurisdiction to rule on their validity, even though the UPC may have jurisdiction to rule on their infringement, pursuant to the Recast Brussels I Regulation (Brussels Ia Regulation)[1] or the Lugano Convention[2].

It should be noted that the limitation of the patent has the effect of a revocation in part, as expressly provided for in Article 138(2) of the Convention on the Grant of European Patents, which stipulates that, if the grounds for revocation affect the European patent only in part, the patent shall be limited by a corresponding amendment of the claims and revoked in part. Furthermore, Article 24(4) of the Brussels Ia Regulation and Article 22 of the Lugano Convention provide that, in proceedings concerned with the validity of a patent, exclusive jurisdiction

[1] Regulation (EU) No. 1215/2012 of the European Parliament and of the Council of December 12 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.

lies with the courts of the State in which the filing 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. It follows that, if the limitation has the effect of a revocation in part, the limitation of a national validation of a European patent validated in a State that is not a party to the AUPC may only be examined and upheld by the courts of that State.

1.2. It is clear that the UPC has jurisdiction to hear actions for infringement of unitary patents or European patents validated in the States that are party to the agreement. However, as we have previously explained in earlier documents[3], in certain cases the court also has jurisdiction to hear infringement actions regarding national validations of the European patent in States that are not party to said agreement, whether they are EU Member States (such as Spain) or States that are not even part of the EU (such as Switzerland). The international jurisdiction of the UPC to hear actions for infringement of the validation of the European patent underlying the unitary patent is based on the provisions of the Brussels Ia Regulation and the Lugano Convention, and is known as the court's long arm.

Now, when a claim is filed with the UPC for infringement of a unitary patent and, at the same time, for infringement of the validation of the basic European patent in States that are not party to the agreement (making use of that long arm), the defendant may, in parallel, file a counterclaim for invalidation of the unitary patent with the UPC and an action for revocation of the validations of the basic European patent in the States that are not party to the AUPC. However, in the latter case, this action for revocation must be brought before the national courts of those States, which have exclusive jurisdiction.

In response to these parallel actions for revocation, the patent owner may limit the unitary patent before the UPC and the extensions of the basic European patent before the national courts of the States that are not party to the agreement. And, within the framework of the infringement proceedings concerning the unitary patent and its validations before the UPC, that court may take into account the action for revocation and the limitation carried on with the aforementioned national

[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", ***link***. "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", ***link***. "Limits of the Unified Patent Court's long arm with regard to Spain (III): applicable law", ***link***. "Limits of the Unified Patent Court's long arm with regard to Spain (IV): the recognition and enforcement of court decisions", ***link***. "The Unified Patent Court grants interim relief regarding a European patent validated in Spain: critical considerations", ***link***, 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", ***link***.

courts on the basis of the Court of Justice's *BSH/Electrolux* doctrine[4], according to which "the court seised of the infringement action may, where appropriate, stay the proceedings [...] [i]f it considers it justified, in particular where it takes the view 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".

1.3. Now, what happens if, in a scenario such as the one described above, where a claim is filed with the UPC for infringement of a unitary patent and, at the same time, for infringement of the validation of the basic European patent in States that are not party to the AUPC, the defendant only files a counterclaim for revocation of the unitary patent with the UPC, but does not initiate any parallel revocation proceedings with the competent national court against the validations of the basic European patent in the States that are not party to the agreement? In that scenario, the claimant, as the patent holder, may, in responding to the counterclaim for revocation, limit the unitary patent before the UPC, and the infringement proceedings must then continue with the limited unitary patent and with the European patent as validated in a State that is not a party to the agreement in its original version, as granted.

This type of situation can give rise to a series of complications and lead to rulings that could be considered "contradictory", since the court, if it finds the limited patent to be valid and dismisses the counterclaim for revocation, would have to examine the infringement claim with respect to the limited unitary patent and with respect to the validity of the European patent of the non-contracting State as originally granted (without limitation). And if that court were to find that the limited unitary patent, despite such limitation, is invalid and were to uphold the counterclaim for revocation, it would have to dismiss the infringement action with respect to the limited unitary patent, but with respect to the validation of the European patent of the non-contracting State, it should analyse the infringement, potentially concluding that infringement does exist and upholding the claim on this point.

Although it might seem that such situations are purely hypothetical, they are not, and the best proof of this is the recent Judgment of the Paris Local Division of the Court of First Instance of the Unified Patent Court dated 16 January 2026 (UPC_CFI_369/2025), to which we refer below.

2. Judgment of the Paris Local Division of the Court of First Instance of the Unified Patent Court dated 16 January 2026 (UPC_CFI_369/2025)

In this case, a unitary patent holder filed a lawsuit before the UPC claiming in-

[4] Judgment of 25 February 2025, C-339/22, *BSH v. Electrolux*.

fringement of said unitary patent, as well as infringement of the Swiss validation of the basic European patent, in response to which the defendant filed a counterclaim alleging the invalidity of the unitary patent, causing the holder, in defending itself against the corresponding counterclaim for revocation, to limit the unitary patent in the main proceedings. However, the Swiss patent is not limited in any way, since the UPC lacks jurisdiction to decide on its invalidity and the defendant has not initiated any parallel revocation proceedings before the Swiss courts (the only courts competent to decide on its invalidity).

In light of this situation, the Paris Local Division conducts the following analysis in the decision in question:

— First, it analyses the validity of the limited unitary patent and concludes that it is valid, thereby dismissing the counterclaim for revocation filed by the defendant.

— Next, it analyses whether there is infringement of the limited unitary patent and concludes that the defendant's product infringes the patent as limited, thereby upholding the infringement claim.

— And, regarding the Swiss validation of the underlying European patent, given that it could not be limited within the framework of the proceedings before the UPC and the infringement ruling regarding said Swiss patent could not be stayed because there are no parallel revocation proceedings pending before the Swiss courts, the Paris Local Division concludes that it cannot conclude infringement of said patent, given the circumstances of the case, and dismisses the infringement claim with respect to the Swiss patent.

The court notes[5] that, according to the Court of Justice's judgment in *BSH/Electrolux*, the UPC lacks jurisdiction to rule on the validity of a national part of a patent granted by a country that is not a party to the AUPC, such as Switzerland. However, the court does have jurisdiction to hear an action for infringement of a patent granted by a European Union Member State or a State bound by the Lugano Convention, unless there is a reasonable and non-negligible risk that the patent will be invalidated by the courts of the granting State. If such a risk exists, the UPC may stay the proceedings until the granting State rules on the national part of the patent.

It goes on to note that, "in this case, the limitation of the unitary patent by the claimant, within the framework of the present proceedings, to avoid the allegation of lack of inventive step of the patent as granted, raises serious doubt as to the validity of the Swiss title initially granted, which constitutes a non-negligible reasonable risk of invalidity of the Swiss part of the title," and therefore it would be incumbent upon the patent owner to take the necessary steps to amend the Swiss part of the patent[6].

[5] Paragraph 123 of the judgment.

[6] Paragraph 124.

However, since this has not been done, the Paris Local Division concludes that "it is not in a position to assess the substantive existence of the alleged infringement of the Swiss part of the patent, and cannot stay the proceedings in the absence of an action for revocation pending in Switzerland," and therefore, "consequently, all claims made in this regard will be dismissed"[7] .

3. Critical considerations

At first glance, the UPC's decision might seem "logical," given that, if it were to hear the case regarding the infringement of the Swiss portion of the patent as granted (without limitation), the court might have to hold the Swiss portion of the patent infringed, knowing that there are elements that call its validity into question. However, on closer inspection, what the UPC is doing is rendering the Swiss portion of the European patent unenforceable when that patent is valid and fully enforceable until a Swiss court holds it wholly or partially invalid (if its limitation is upheld).

Although the solution adopted by the UPC may seem a "practical" solution to avoid contradictory rulings, it is not legally correct

Everything indicates that, had there been parallel revocation proceedings in Switzerland, the UPC would have stayed the proceedings before ruling on the infringement of the Swiss patent because, in accordance with the *BSH/Electrolux* doctrine, since the unitary patent has been limited, "there is a reasonable and non-negligible possibility that that patent will be revoked by the competent court of that other Member State". But since there are no revocation proceedings in Switzerland running in parallel, the UPC dismisses the infringement claim, as if the patent were invalid and had no effect.

Although the solution adopted by the UPC may be viewed as a "practical" solution to avoid rulings that could be considered contradictory, it is certainly not legally correct because it effectively implies that the court would have rendered the Swiss part of the European patent unenforceable as if it were invalid, thereby infringing upon the exclusive jurisdiction of the Swiss courts, under the Lugano Convention and contrary to the judgment of the Court of Justice in the *BSH/Electrolux* case. It should be recalled that in this ruling, the Court of Justice is very clear in stating that, in accordance with the Brussels Ia Regulation and the Lugano Convention, jurisdiction to hold a patent invalid, whether as a defence or by way of an action for revocation, lies exclusively with the courts of the State where

[7] Paragraph 125.

that patent has been validated and registered.

Thus, while the solution adopted by a decision such as that of the Paris Local Division might be appropriate with respect to a European patent validated in a State that is not a party to the AUPC, nor a member of the European Union, nor a party to the Lugano Convention (such as, for example, the United Kingdom) — since in such cases the Court of Justice noted in the aforementioned BSH/ Electrolux case that it would indeed be possible to rule on the validity of the national patent of that third State, albeit only with *inter partes* effect — in no case is this solution acceptable in a case such as the one analysed here, which concerns a Swiss patent.

It should also be noted that once the UPC has established that there is no infringement of the Swiss part of the European patent serving as the basis for the unitary patent, *res judicata* applies, and the patent holder cannot sue the same defendant in Swiss courts based on that Swiss part.

We are thus faced with an illustration of the contradictions that may arise from an improper application of the long arm by the UPC, which should lead patent holders to assess the advisability of invoking said long arm, particularly in cases where the patent may need to be limited, in order to avoid risks such as those materialized in the decision discussed.

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