

UPC Court of Appeal, 12 November 2024, AIM Sport v Supponor

See for continuation the case:

[IPPT20250211, UPC CFI, LD Helsinki, AIM Sport v Supponor](#)



PATENT LAW – PROCEDURAL LAW

Entitled to withdraw opt-out, unless the earlier national litigation was brought during the transitional regime ([Article 83\(4\) UPCA](#))

- Considering the wording, structure, object and purpose of Art. 83 UPCA as a whole, the Court of Appeal is of the opinion that the sentence “Unless an action has already been brought before a national court” in Art. 83(4) UPCA must be understood to refer to an action brought before a national court during the transitional regime.

Rules of interpretation of the UPCA

- The rules of interpretation laid down in Article 31(1) of the Vienna Convention: A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the term of the treaty and in the light of its object and purpose.
- The Rules of Procedure as a lower ranking instrument related to the UPCA may serve to fill a gap but cannot serve to overrule the clear meaning of a higher-ranking provision of the UPCA (R. 1(1) RoP)
- Preparatory work of the UPCA may be looked at only to confirm an interpretation, or to determine when the interpretation in accordance with the general rule of interpretation leaves the meaning ambiguous.

Source: [Unified Patent Court](#)

UPC Court of Appeal,
12 November 2024

(Kalden, Simonsson, Rombach)

UPC Court of Appeal

UPC_CoA_489/2023 APL_596007/2023

UPC_CoA_500/2023 APL_596892/2023

ORDER

of the Court of Appeal of the Unified Patent Court

issued on 12 November 2024

concerning the jurisdiction of the Unified Patent Court ([Art. 83 UPCA](#))

HEADNOTES

- The term ‘action’ in [Art. 83 UPCA](#) refers not only to infringement and revocation actions, but to all actions mentioned in [Art. 32 UPCA](#) over which the UPC has jurisdiction.

- Considering the wording, structure, object and purpose of [Art. 83 UPCA](#) as a whole, the sentence “Unless an action has already been brought before a national court” in [Art. 83\(4\) UPCA](#) must be understood to refer to an action brought before a national court during the transitional regime.

KEYWORDS

- Jurisdiction of the Unified patent court, withdrawal of opt-out

APPELLANT (CLAIMANT IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

AIM SPORT DEVELOPMENT AG, Luzern, Switzerland

hereinafter also referred to as: AIM

represented by: Johanna Flythström and Mikael Segercrantz, attorneys-at-law, Roschier, Helsinki, Finland; Ari Laakkonen and Siddharth Kusumakar, attorneys-at-law, Powell Gilbert (Europe), Dublin, Ireland; Ralph Nack and Niclas Gajec, attorneys-at-law, Noerr, Munich, Germany Maximilian von Rospatt, attorney-at-law, rospatt osten pross, Düsseldorf, Germany

RESPONDENTS (DEFENDANTS IN THE MAIN PROCEEDINGS BEFORE THE COURT OF FIRST INSTANCE)

SUPPONOR OY, Espoo, Finland

SUPPONOR LIMITED, Hammersmith Grove, London, United Kingdom

SUPPONOR SASU, Sophia-Antipolis, Valbonne, France

SUPPONOR ITALIA SRL, Busto Arsizio, VA, Italy

SUPPONOR ESPAÑA SL, Barcelona, Spain

hereinafter also jointly referred to as Supponor

all represented by: Dr. Henrik Lehment, attorney-at-law, Hogan Lovells International, Düsseldorf, Germany Dr. Matthias Sonntag, attorney-at-law, Gleiss Lutz, Düsseldorf, Germany Panu Siitonen, attorney-at-law, Hannes Snellman, Helsinki, Finland

LANGUAGE OF THE PROCEEDINGS:

English

PATENT AT ISSUE

[EP 3 295 663](#)

PANEL

Second Panel

DECIDING JUDGES:

This order has been adopted by the second panel consisting of:

Rian Kalden, Presiding judge and judge-rapporteur

Ingeborg Simonsson, legally qualified judge

Patricia Rombach, legally qualified judge

IMPUGNED ORDERS OF THE COURT OF FIRST INSTANCE

□ **Date: 20 October 2023,**

- ORD_581208/2023 in App_580529/2023 (preliminary objection) in ACT_545571/2023 (infringement action)
- ORD_572699/2023 (in ACT_551054/2023 concerning, inter alia, a request for a preliminary injunction and evidentiary measures)

□ Action number attributed by the Court of First Instance: UPC_CFI_214/2023

ORAL HEARING

The oral hearing, in person, was held on 23 September 2024.

SUMMARY OF FACTS AND INDICATION OF PARTIES' REQUESTS

1. The patent at issue was opted out on 12 May 2023, during the so-called sunrise period of three months prior to the entry into force of the Unified Patent Court (hereafter also: UPC) on 1 June 2023. In accordance with [R. 5.12](#) Rules of Procedure (RoP), this opt-out was entered into the register of the UPC on 1 June 2023.

2. On 5 July 2023 AIM applied to withdraw this opt-out. On the same day AIM lodged an infringement action (ACT_545571/2023) as well as a request for provisional measures (ACT_551054/2023) against Supponor, based on the patent at issue.

3. Supponor contested the effectiveness of the withdrawal of the opt-out.

4. In the [impugned orders](#), the Court of First Instance of the Local Division Helsinki in ACT_545571/2023 allowed the preliminary objection and in ACT_551054/2023 dismissed the requests. It was of the opinion that the UPC does not have competence over the patent at issue owing to its opt-out on 12 May 2023. The withdrawal of the opt-out on 5 July 2023 was held to be ineffective due to proceedings before the German national courts, commenced in 2020 and still pending before the Bundespatentgericht and the Munich Higher Regional Court (Oberlandesgericht) at the date of the opt-out and of the withdrawal.

5. In these appeal proceedings, AIM requests the Court of Appeal to:

(i) order the reversal of the impugned decision insofar as the Court of First Instance has dismissed the actions ACT_545571/2023 and ACT_551054/2023 due to the claimed lack of competence of the UPC over the patent at issue;

(ii) declare that the withdrawal of opt-out with regard to the patent at issue on 5 July 2023 is effective and therefore the UPC has competence to hear actions ACT_545571/2023 and ACT_551054/2023.

(iii)-(iv) order the remittance of the infringement action ACT_545571/2023 and the application for provisional measures ACT_551054/2023 back to the proceedings before the Court of First Instance.

6. Supponor requests that the appeal be rejected and that AIM be ordered to bear the costs of the proceedings.

PARTIES' SUBMISSIONS

7. AIM is of the opinion that the phrase "Unless an action has already been brought before a national court" in Art. 83(4) UPCA refers to an action brought before a national court during the transitional regime. Its arguments – insofar as relevant – are the following:

7.1. Provisions of the UPCA and their terms must be read in their context and terms with the meaning given to them in the UPCA. The general rules of interpretation under the Vienna Convention must be applied, which require proper consideration of the context, the special meaning given to the terms used in a consistent manner, and the object and purpose of Art. 83 UPCA as a whole.

7.2. Art. 83 UPCA – as is also apparent from its heading – as a whole specifically addresses situations taking place "during the transitional period" when parallel jurisdiction exists between the national courts and the UPC. It follows that the actions of Art. 83(1) UPCA only refer to infringement and revocation actions brought "during the transitional period". This special meaning of the term "action" applies to Art. 83 UPCA as a whole. The context of any of the other paragraphs does not require that the term "action" be given a different meaning.

7.3. The reading of 'action' in Art. 83(4) UPCA as referring to an action that has been "brought during the transitional period" is aligned with Rule 5.8 RoP. It follows from the wording "a matter over which the UPC also has jurisdiction pursuant to Art. 32 UPCA" that R.5.8 RoP applies only to actions commenced in matters over which there actually exists parallel jurisdiction between the national courts and the UPC and this is only the case during the transitional period.

7.4. If R.5.8 RoP had a broader meaning than Art. 83 UPCA, then the latter prevails.

7.5. An interpretation of actions in Art. 83(4) UPCA that includes actions brought prior to the transitional period (whether still pending or not) would be contrary to the object and purpose of the transitional regime with parallel litigation and the possibility to opt out and withdraw the opt-out, which is to respect the legitimate expectations of patent proprietors who obtained their patents under the national court system and to enable them to first obtain comfort (and thus first opt out) and use the UPC system once comfort is obtained (and thus withdraw the opt-out).

7.6. The limitation on the possibility to opt-out and withdrawal thereof serves the purpose of preventing abuse of the parallel litigation scheme by changing the jurisdiction after proceedings have been commenced before the one or the other court. Such abuse can only take place during the transitional period.

7.7. The lis pendens rules under the Brussels I recast Regulation operate to avoid contradictory decisions. The

blocking mechanisms of Art. 83 UPCA (3) and (4) have nothing to do with that.

7.8. Applying the limitation on the possibility to withdraw to proceedings commenced prior to the transitional period, would lead to an arbitrary and unfair distinction between patentees whose patents have been subject of national proceedings in the past and patentees who have not been involved in legal proceedings.

8. Supponor is of the opinion that the phrase “Unless an action has already been brought before a national court” in Art. 83(4) UPCA refers to an action brought before a national court prior to the opt-out, either before or during the transitional regime. It argues, insofar as relevant, as follows:

8.1. Art. 83 UPCA must be interpreted in line with the literal wording, context and the object of Art 83 and in line with the guidance provided by Rule 5.8 RoP.

8.2. The term “action” in each of the five paragraphs of Art. 83 UPCA has a different meaning depending on the context of the different procedural aspects of the transitional regime dealt with in each of these paragraphs. The language of Art. 83(1) UPCA does not suggest that the term ‘action’ is a defined term.

8.2.1. The word “still” in Art. 83(1) UPCA indicates that it also covers national proceedings prior to the transitional period.

8.2.2. Art. 83(2) UPCA, stipulating that the expiry of the transitional period must not affect pending national actions, must apply irrespective of whether these have been commenced prior to or during the transitional period.

8.2.3. Art. 83(3) UPCA does not deal with national actions.

8.2.4. Art. 83(4) does not contain a temporal limitation to an action brought during the transitional period, because – like in the case of Art. 83(2) UPCA – the legal consequence set forth in Art. 83(4) UPCA shall apply irrespective of the date of commencement of the national action.

8.2.5. Art. 83(5) UPCA explicitly links the term “action” to actions brought during the transitional period by way of the reference “brought before the national courts pursuant to paragraph 1”. If action only meant actions brought during the transitional period anyway, there was no need to refer to paragraph (1) in Art. 83(5) UPCA. Such a reference is not made in Art. 83(4) UPCA and it should not be read into it.

8.3. R.5.8 RoP confirms the blocking effect of national actions commenced at any time prior to the opt-out. This is relevant in view of Art. 31(2) lit (b) and Art. 31(3) lit (b) Vienna Convention according to which contextual interpretation includes an instrument related to the Treaty. The language “or any time before the date pursuant to paragraph 5” was inserted in (now) R.5.8 RoP in the 18th draft of the Rules of Procedure to clarify that the blocking mechanism shall also apply to national actions commenced any time before the opt-out.

8.4. The object and purpose of Art. 83(3) and (4) UPCA is to limit parallel litigation and to avoid the risk of divergent decisions of the UPC and the national court with regard to the same patent. An opt-out excludes the jurisdiction of the UPC. This way, a divergent claim construction of the patent can effectively be avoided. For the same reason, an opt-out must not be withdrawn, if a national action concerning the patent at issue has already been brought. This risk is the same, irrespective of whether the national action was brought before or after the entry into force of the UPCA. Art. 83 was not designed as a lis pendens provision, but is patent related and even goes further than the Brussels I recast Regulation.

8.5. The point of giving patent owners the opportunity to observe the new court system in order to gain confidence was an aspect that influenced the drafting of the mechanism of opt-out and withdrawal of an opt-out, but it is not the main purpose of this mechanism.

8.6. The blocking-mechanism for withdrawals of opt-outs cannot serve the purpose of preventing abuse by “maintaining the ‘rules of the game’”, because a withdrawal of an opt-out simply leads to parallel jurisdiction and does not exclude the jurisdiction of the national courts.

8.7. It is not unfair, discriminatory or inequitable if national actions brought prior to the transitional period block the withdrawal of an opt-out. Any possible unequal treatment is justified by the objective reason of preventing contradictory claim interpretation.

POINTS AT ISSUE

The jurisdiction of the UPC ([Art. 83](#) Agreement on a Unified Patent Court (UPCA)), in particular the meaning of the phrase “Unless an action has already been brought before a national court” in [Art. 83\(4\) UPCA](#).

GROUND FOR THE ORDER

9. The Court of Appeal interprets [Art. 83](#) of the UPCA, in particular the phrase “Unless an action has already been brought before a national court” in [Art. 83\(4\) UPCA](#). As set out above, the parties have presented different opinions on the meaning of Art. 83 UPCA.

General principles of interpretation

10. Both parties rightly refer to the rules of interpretation laid down in the [Vienna Convention](#). Art. 31 has the heading “General rule of interpretation”. Paragraph 1 of this Art. reads:

A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the term of the treaty and in the light of its object and purpose.

11. As rightly pointed out by AIM, the phrase “Unless an action has already been brought before a national court” in [Art. 83\(4\) UPCA](#), and in particular the term ‘action’ therein, must not be read in isolation, but in the context of Art. 83 UPCA as a whole. Also, when interpreting a legal provision, a word or a phrase used therein multiple times should be presumed to bear

the same meaning throughout the provision, unless the wording or the context clearly requires otherwise.

The meaning of the phrase “Unless an action has already been brought before a national court” in Art. 83(4) UPCA read in the context of Art. 83 UPCA as a whole

12. [Art. 83 UPCA](#) bears the title "Transitional regime". The systematic of the different paragraphs of Art. 83 UPCA is as follows: paragraph (1) sets out in general the jurisdictional regime that applies during the transitional period. The subsequent paragraphs (2) to (4) elaborate and further deal with the consequences of the scheme of parallel jurisdiction chosen for the transitional period, including the option given to patent proprietors to first opt out of the UPC jurisdiction altogether and subsequently undo that (thus returning to the parallel jurisdiction regime).

13. Art. 83 (1) UPCA provides that during a transitional period of seven years after the entry into force of the UPC (on 1 June 2023), actions within the jurisdiction of the UPC ‘may still be brought before national courts or other competent national authorities’ (hereinafter jointly referred to as ‘national courts’). **The Court of Appeal considers the term ‘action’ in [Art. 83 UPCA](#) to refer not only to infringement and revocation actions, but to all actions mentioned in [Art. 32 UPCA](#) over which the UPC has jurisdiction.**

14. For the duration of the transitional period there is therefore parallel jurisdiction of the national courts of the Contracting Member States (hereafter also referred to as ‘CMS’) and the UPC. It follows that the term ‘actions’ in paragraph (1) thus refers to actions brought during the transitional period. This is also clear from the use of the word ‘still’ in the English version, ‘weiterhin’ in the German version and ‘encore’ in the French version. It clarifies that, during the transitional period, despite the entry into force of the UPC, actions may nevertheless – like before – be commenced before a national court. The use of ‘brought’ ‘erhoben werden’ and ‘être engagée’, ‘obviously refers to actions commenced during the transitional period. The Court of Appeal therefore rejects Supponor’s argument that the use of ‘still’ in paragraph (1) also refers to actions that were already brought (commenced) prior to the transition period and that Art. 83(1) UPCA does not contain a temporal limitation of actions to those brought (commenced) during the transitional period. If the intention was to clarify that pending national actions could continue unaffected by the transitional period, the word ‘continued’ would have been used instead of ‘brought’ (and correspondingly ‘anhängig bleiben’ instead of ‘erhoben werden’ or ‘rester pendante’ instead of ‘être engagée’).

15. Paragraph (1) provides for parallel jurisdiction of the UPC and national courts only during the transitional period. Thereafter, cases within the jurisdiction of the UPC (as listed in Art. 32 UPCA), can only be brought before the UPC. There is therefore a

need to clarify what shall happen at the end of the transitional period with the actions brought before the national courts during this period. Paragraph (2) clarifies that these actions shall not be affected by the expiry of the transitional period, even though from that point only the UPC is exclusively competent and no further cases may be brought before the national courts.

16. Supponor has brought forward that the term ‘actions’ in paragraph (2) also refers to pending actions that were brought prior to the entry into force of the UPC, because these actions should also remain unaffected by the end of the transitional period. Even though true as such, these actions are not aimed at in Art. 83(2) UPCA, because these actions were not brought under the parallel litigation regime during the transitional period, but under the then existing (exclusive) jurisdiction of the national courts prior thereto. To these actions, the transitional regime never applied and these naturally remain unaffected by it. In relation to these cases, there is no provision dealing with the consequences of the introduction of the transitional period and likewise there is no need to deal with the consequences of expiry of the transitional period for these proceedings.

17. Paragraphs (3) and (4) deal with the option provided to patent proprietors to opt-out and the possibility to ‘undo’ this by withdrawing an opt-out – and sets out the limitations of this system as explained above.

18. The possibility to opt out only exists as from the start of the transitional period. Even though the filing of an opt-out was allowed during the Sunrise Period, these opt-outs were only registered on and thus effective as of the date of entry into force of the UPCA. The last moment to register an opt-out is one month before expiry of the transitional period. In addition, an opt-out is not possible if an action has already been brought before the UPC. The term ‘action’ in paragraph (3) thus necessarily refers to actions brought during the transitional period, because prior thereto the UPC did not exist and no actions could be brought before it.

19. Paragraph (4) allows a patent proprietor who made use of the possibility to opt out to undo this, by withdrawing the opt-out. This may be done at any moment, but no such withdrawal may be made if an action has already been brought before a national court.

20. The Court of Appeal is of the opinion that, within the context of Art. 83 UPCA and the transitional regime of parallel litigation it introduces for cases brought during the transitional period, there is no reason why ‘action’ in paragraph (4) should be interpreted differently than the term ‘action’ in paragraphs (1), (2) and (3), i.e. as an action (depending on the context, either before a national court or the UPC) brought during the transitional period.

21. Paragraph (5) of Art. 83 UPCA deals with the possibility that the transitional period is extended with another period of seven years. The explicit reference in

paragraph (5) to actions still brought before the national courts pursuant to paragraph (1) (which Supponor here interprets as referring to actions brought during the transitional period, contrary to its earlier – rejected – argument that ‘action’ in paragraph (1) is not limited thereto) and the lack of reference to paragraph (1) in paragraphs (2) and (4) cannot lead to a different conclusion. Upon reading paragraph (5), it is obvious that only actions brought during the transitional period are relevant in the context of that paragraph. The addition of “pursuant to paragraph (1)” is thus superfluous – as Supponor admits – and doesn’t add anything to the meaning of paragraph (5). No conclusions can be drawn from the absence of such a reference to paragraph (1) in paragraphs (2) and (4) of Art. 83 UPCA, which reference would be equally superfluous in the context of those paragraphs.

22. To conclude, the Court of Appeals is of the opinion that the wording and context of Art. 83 UPCA lead to an interpretation of the phrase “Unless an action has already been brought before a national court” in Art. 83(4) as referring (only) to actions brought during the transitional period. As said, national litigation brought prior to the transitional period is unaffected by the transitional regime. Likewise, there is no apparent reason why such earlier national litigation should affect the transitional regime. In particular, there is no apparent reason why such past litigation should influence the choices deliberately given to a patent proprietor during the transitional period.

The object and purpose of Art. 83 UPCA

23. This interpretation of Art. 83(4) UPCA in the opinion of the Court of Appeal also follows from and is supported by the object and purpose of Art. 83 UPCA.

24. As mentioned, Art. 83 UPCA sets out the transitional regime that applies after the entry into force of the UPC, as from 1 June 2023. This provision shows that the CMS did not want to replace the jurisdiction of the national courts by that of the UPC at once, but wanted to allow for a gradual transition, by introducing parallel jurisdiction of these courts for a period of seven years.

25. As part of this gradual transition, the possibility to opt out from the jurisdiction of the UPC, as provided for in Art. 83(3) UPCA, aims to respect the rights and expectations of proprietors of European patents (and applications), that often pre-date the entry into force of the UPC, and give them the opportunity to gain more confidence and familiarity with the functioning of the new UPC before subjecting their patents to the new system.

26. In accordance with that purpose, the possibility to withdraw an opt-out pursuant to Art. 83 (4) serves to allow a patent proprietor to undo the consequences of an earlier opt-out and start using the new UPC system with its advantages, once such confidence and familiarity was indeed gained. The fact that during the transitional regime the national courts still have parallel jurisdiction

after such a withdrawal, does not alter that a withdrawal allows the patent proprietor, as well as third parties, to bring cases before the UPC.

27. The limitations to the possibility to opt-out and withdrawal of opt-out as set out above, serve to prevent an abuse of this system. The logic behind the limitation to opt out pursuant to Art. 83(3) UPCA (‘unless an action has already been brought before the UPC’) is that once a patent proprietor either himself already used the UPC or allowed a third party to do so (by not using his right to opt out), a subsequent opt-out to prevent further use of the UPC system would be improper and contrary to legal certainty of third parties.

28. In a similar vein, where a patent has been opted out, Art. 83(4) UPCA provides that this opt-out cannot be withdrawn when an action has already been brought before a national court. Consistent with this purpose to prevent an abuse of the system by improperly switching between jurisdictional regimes, the words ‘already brought’ must be understood to mean an action brought before a national court after the transitional regime came into existence. Prior thereto, an abuse of the system is not even possible.

29. Supponor has not provided any convincing reason why an action brought before a national court prior to the transitional period should block the withdrawal of an opt-out. The Court of Appeal rejects Supponor’s argument that the limitations to the possibility of opting out and withdrawal of opt-out serve the purpose of limiting the possibility of parallel litigation and the inherent risk of divergent claim interpretation. The chosen transitional regime deliberately creates a situation where parallel proceedings between national courts and the UPC are explicitly foreseen. If the CMS really would have wanted to prevent (the consequences of) parallel litigation, they would have chosen a different transitional regime.

30. In addition, the aim of minimizing parallel litigation and of avoiding the risk of contradictory decisions is already covered by the lis pendens rules in the Brussels I recast Regulation. In its [decision of 17 September 2024 in the case Mala v Nokia \(APL 26889/2024, UPC CoA 227/2024\)](#), the Court of Appeal held that in the light of that objective of [Art. 29 to 32](#) of the Brussels I recast Regulation, [Art. 71c\(2\)](#) of that Regulation must be interpreted as meaning that the provisions apply where, during the transitional period of Art. 83 UPCA, proceedings are pending before the UPC and a national court, even if the proceedings before the national court were initiated prior to the transitional period. Other than as advanced by Supponor, an interpretation of Art. 83(4) UPCA as only referring to actions brought during the transitional period is not contradictory to this decision. That is so precisely because the object and purpose of Art. 83 UPCA is not to prevent parallel litigation and contradictory decisions, but to provide the mechanism for the transitional regime

during which the patent proprietor is given a choice to opt out from the UPC jurisdiction and undo that choice later, while at the same time ensuring that the rights of third parties and legal certainty are not compromised by the way the patent proprietor makes use of that system.

31. Were the relevant phrase in Art. 83(4) UPCA interpreted that it refers to any action brought before a national court, including actions brought before the entry into force of the UPC, as Supponor argues, this would lead to a different treatment of patent proprietors. Under such interpretation, patent proprietors whose patent had ever been subject to litigation before a national court would be deprived of the possibility to first opt out and subsequently withdraw its opt-out. If such a patent proprietor would opt-out, a withdrawal would not be possible, thus depriving it from the possibility to ever use the UPC system and its advantages. The only other option would be to not opt out from the UPC jurisdiction, but then the patent proprietor would be deprived from the possibility to first observe the functioning of the system, prior to subjecting its patent to the new system. This consequence is contrary to the object and purpose of the opt-out and withdrawal system, without there being a justification for a different treatment of proprietors of patents that have been subject to national litigation in the past. Such litigation could have taken place long ago, even before the actual coming into existence of the UPC could be anticipated with some certainty and may not even have been a choice of the patent proprietor itself but initiated by a third party. There is no indication in the UPCA that such different treatment has been the intention of the CMS.

32. To conclude, considering the wording, structure, object and purpose of Art. 83 UPCA as a whole, the Court of Appeal is of the opinion that the sentence “Unless an action has already been brought before a national court” in Art. 83(4) UPCA must be understood to refer to an action brought before a national court during the transitional regime.

R. 5.8 Rules of Procedure

33. R.5.8 RoP reads as follows:

In the event that an action has been commenced before a court of a Contracting Member State in a matter over which the Court also has jurisdiction pursuant to Art. 32 of the Agreement in respect of a patent or application contained in an Application to withdraw, prior to the entry of the Application to withdraw in the register or any time before the date pursuant to paragraph 5, the Application to withdraw shall be ineffective in respect of the patent or application in question, irrespective of whether the action is pending or has been concluded.

34. Supponor has argued that its interpretation of the term ‘action’ in Art. 83 UPCA is confirmed by Rule 5.8 RoP, as it is clear from its wording that ‘action’ in this Rule must also be understood to include actions brought before a national court prior to the transitional period.

35. The Court of Appeal appreciates that the Rules of Procedure may be considered as an instrument related to the UPCA as meant in Art. 31 (2) lit (b) Vienna Convention. However, this cannot in this situation lead to the interpretation of Art. 83(4) UPCA as suggested by Supponor. As explained above, the Court of Appeal considers the meaning of the phrase “Unless an action has already been brought before a national court” in Art. 83(4) UPCA to be clear based on its wording read in the context of Art. 83 UPCA as a whole and considering its object and purpose. Even if R.5.8 RoP were to be interpreted that also national proceedings brought before the transitional period could block a withdrawal of an opt-out, then there would be a clear inconsistency with Art. 83(4) UPCA. In that situation, in accordance with R.1.1 RoP, the provision of the UPCA shall prevail. In other words: the Rules of Procedure as a lower ranking instrument related to the UPCA may serve to fill a gap but cannot serve to overrule the clear meaning of a higher-ranking provision of the UPCA.

36. As to the preparatory work for the Rules of Procedure that Supponor has referred to, the Court of Appeal considers that preparatory work of the UPCA may be looked at only to confirm an interpretation, or to determine when the interpretation in accordance with the general rule of interpretation leaves the meaning ambiguous. This situation does not arise. This applies even more to preparatory work of the Rules of Procedure, it being a lower ranking instrument related to the UPCA.

37. It follows that it is not relevant whether upon a proper interpretation of R.5.8 RoP an inconsistency between R.5.8 RoP and Art. 83(4) UPCA indeed exists. The Court of Appeal nevertheless notes that it is of the opinion that R.5.8 RoP must be interpreted such that only national actions commenced during the transitional period block the withdrawal of an opt-out. The reason for this is the use of the phrase “in a matter over which the Court also has jurisdiction pursuant to Art. 32 of the Agreement”. Especially the use of the word ‘also’ makes clear that this phrase refers to the situation in which there exists actual parallel jurisdiction of the UPC and the national courts in these matters (i.e. matter in the abstract, not in relation to any case in particular). This is only possible during the transitional period. The actions referred to in R.5.8 RoP can thus only be actions commenced during this period.

38. The phrase “prior to the entry of the Application to withdraw in the register or any time before the date pursuant to paragraph 5” in R.5.8 RoP does not lead to another conclusion. It clarifies that the action must have been commenced prior to the effective date of an opt-out. The earliest date an action could be commenced during the transitional period is 1 June 2023. The earliest effective date of an opt-out is also 1 June 2023. Thus, at most it can be said that R.5.8 RoP does not clarify what should happen if the date of commencement of the action and the effective date of

the opt-out coincide. Since the meaning of ‘before the date pursuant to paragraph 5’ (i.e. the effective date of the opt-out) when read in context of the Rule as a whole, as explained in the previous paragraph, is limited to any time during the transitional period, this lacuna in the Rules cannot lead to the conclusion that actions prior to the transitional period are meant to be included.

39. In view of the above considerations, the Court of Appeal sees no reason for referral of this matter to the full Court, as suggested by Opponor.

Conclusion

40. The Court of Appeal concludes that Art. 83(4) UPCA must be understood to mean that an earlier opt-out cannot effectively be withdrawn if an action has been brought before the national court at any time during the transitional period. Proceedings that were brought prior to the transitional period, whether still pending or not, do not stand in the way of an effective withdrawal of an opt-out. The Court of First Instance therefore was wrong to consider the withdrawal of the opt-out of the patent at issue ineffective and wrongly dismissed actions ACT_545571/2023 and ACT_551054/2023 for lack of its competence to hear the actions.

41. This means that AIM’s appeals succeed. The impugned orders of the Court of First Instance must be set aside. AIM has requested that the Court of Appeal refer both actions back to the Court of First Instance to decide on the substance, since the technical aspects of the case have already been presented to this court at the oral hearing, but not yet been decided upon. Supponor has not opposed this request. The Court of Appeal is of the opinion that a referral back under the given circumstances serves efficiency and procedural economy.

42. It is for the Court of First Instance to decide on the obligation to bear the costs of the proceedings.

ORDER

The Court of Appeal

- sets aside the impugned orders
 - o ORD_581208/2023 in App_580529/2023 (preliminary objection) in ACT_545571/2023 (infringement action);
 - o ORD_572699/2023 (in ACT_551054/2023 concerning, inter alia, a request for a preliminary injunction and evidentiary measures);
- refers the actions ACT_545571/2023 and ACT_551054/2023 back to the same panel of the Court of First Instance for further adjudication.

Issued on 12 November 2024

Rian Kalden, Presiding judge and judge-rapporteur

Ingeborg Simonsson, legally qualified judge

Patricia Rombach, legally qualified judge
