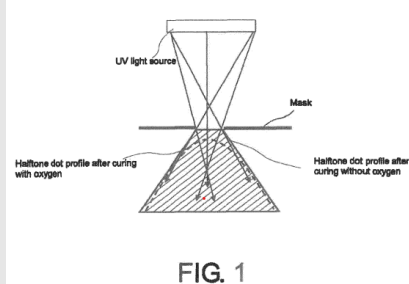


**UPC CFI, Local Division Munich, 10 February 2025,
Esko v XSYS**

curing of photo-curable printing plates



PATENT LAW – PROCEDURAL LAW

Preliminary objection admissible, but unfounded (R. 19 RoP)

- **The UPC's has jurisdiction relating to a European patent that has not yet lapsed at the time of entry into force of the UPCA pursuant to Art. 32(1)(a) UPCA, Art. 2g), Art. 3c) UPCA** and covers infringement actions to the extent that they are based on acts of use which are alleged to have taken place before the UPCA entered into force and/or in the period between an opt-out and the withdrawal thereof (**Article 84 UPCA**).
- **Jurisdiction and applicable law are separate aspects that must be assessed separately.** It cannot be concluded from the UPC's jurisdiction that the UPCA always applies to every case to be decided, nor is the applicable law decisive for the UPC's jurisdiction (**Article 24 UPCA, Article 32 UPCA**)

Source: [Unified Patent Court](#)

**UPC CFI, Local Division Munich,
10 February 2025**

(U. VoB)

UPC_CFI_483/2024

ORDER

of the Court of First Instance of the Unified Patent Court issued on 10 February 2025

HEADNOTES:

1. The UPC's jurisdiction pursuant to **Art. 32(1)(a) UPCA, Art. 2g), Art. 3c) UPCA** also covers infringement actions to the extent that they are based on acts of use which are alleged to have taken place before the UPCA entered into force and/or in the period between an opt-out and the withdrawal thereof.
2. Jurisdiction and applicable law are separate aspects that must be assessed separately. It cannot be concluded from the UPC's jurisdiction that the UPCA always applies to every case to be decided, nor is the applicable law decisive for the UPC's jurisdiction.

CLAIMANT

Esko-Graphics Imaging GmbH, Zusestraße 4a, 25524 Itzehoe, Germany,

represented by: Dr Steininger, Hogan Lovells International LLP, Karl-Scharnagl-Ring 5, 80539 Munich, Germany.

DEFENDANTS

- 1) **XSYS Germany GmbH**, Industriestraße 1, 77731 Willstätt, Germany,
 - 2) **XSYS Prepress N.V.**, Oostkaai 50, 8900 Ieper, Belgium,
 - 3) **XSYS Italia S.r.l.**, Corso Di Porta Nuova n. 46, 20121 Mailand, Italy,
- represented by: Dr Pansch, rospatt Rechtsanwälte PartGmbH, Emanuel-Leutze-Str. 11, 40547 Düsseldorf, Germany.

PATENT AT ISSUE:

European Patent [EP 3 742 231](#)

PANEL/DIVISION

Panel 2 Local Division Munich

DECIDING JUDGES:

This order has been issued by Presiding Judge Ulrike Voß as Judge-Rapporteur.

LANGUAGE OF THE PROCEEDINGS:

English

SUBJECT OF THE PROCEEDINGS

Preliminary Objection [R. 19.1 \(a\) RoP](#), [R. 20.1 RoP](#)

SUMMARY OF FACTS

1. The Claimant is the registered proprietor of the European patent EP 3 742 231 filed on 25 May 2009 (hereinafter referred to as the patent at issue), the grant of which was published on 30 June 2021. On 30 May 2023, the Claimant made use of the possibility to opt out under **Art. 83 (3) UPCA** (opt-out) for the patent at issue. It withdrew from this opt-out on 26 August 2024 pursuant to **Art. 84 para. 4 UPCA** (opt-in).
 2. The Claimant is suing the Defendants for infringement of the patent at issue, inter alia, information and disclosure of the books, destruction, recall, removal from the distribution channels, (provisional) damages and compensation. The requests for relief sought by the Claimant in this regard also concern acts of use by the Defendants that are alleged to have taken place before the date of entry into force of the UPCA.
 3. The Statement of Claim filed with the UPC on 27 August 2024 was served on the Defendants on 15 September 2024 and 20 September 2024, respectively. By pleading dated 10 October 2024, the Defendants filed a preliminary objection pursuant to [Rule 19 RoP](#). The Claimant responded to this in a pleading dated 23 October 2025, to which the Defendants replied in a submission dated 24 January 2025.
- PARTIES' REQUESTS**
4. The Defendants request:
 - I. The preliminary objection is allowed
 - II.
 1. The claim is dismissed insofar as it relates to the period prior to 26 August 2024.
 2. In the alternative: the claims for the provision of information, disclosure of the books, destruction, recall and removal from the distribution channels, provisional damages in the amount of EUR 100,000.00, damages and payment of appropriate compensation (claims no. IV 1-4, VII, VIII 1-2) are dismissed insofar as they relate to

the period prior to the date of the decision. EUR 100,000.00, damages and payment of reasonable compensation (claims no. IV 1-4, VII, VIII 1-2) are dismissed insofar as they relate to the period prior to 26 August 2024.

III. Further in the alternative: the proceedings are stayed pursuant to [Rule 266 \(5\) sentence 1 RoP](#) and the following question is referred to the CJEU for a preliminary ruling pursuant to [Art. 21 UPCA](#) in conjunction with Art. 267 TFEU:

Does the Union legal order require the UPCA to be applied and interpreted in accordance with the principles of treaty application and interpretation codified in the 1969 Vienna Convention on the Law of Treaties and recognized by customary international law?

5. The Claimant requests:

I. The preliminary objection is rejected.

II. In the alternative: The preliminary objection will be dealt with in the main proceedings.

III. The (further) auxiliary request of the Defendant for a stay of proceedings pursuant to [R. 266.5 first sentence RoP](#) is rejected.

PARTIES' SUBMISSIONS

6. The Defendants are of the opinion that the UPC lacks competence pursuant to [Art. 32 \(1\) a\) and f\) UPCA](#) to decide on the infringement action insofar as it relates to the period prior to the entry into force of the UPCA on 1 June 2023. In this respect, the infringement action was brought before the Court without jurisdiction and was therefore already to be dismissed as inadmissible.

7. Whether the UPC can decide on alleged acts of use that are said to have taken place before 1 June 2023 is not only a question of applicable law, but also a question of competence under [Art. 32\(1\)\(a\) UPCA](#). This follows from [Art. 32 para. 1 \(a\) UPCA](#).

8. The UPCA does not provide for any substantive rights, but only a limited number of powers pursuant to [Art. 56 et seq. UPCA](#). These confer on the UPC the power to order certain measures against the Defendant at the Claimant's request, which are at the UPC's discretion. The UPCA is therefore not based on the Claimants' substantive claims, but on the UPC's powers. Since the UPCA does not recognize any substantive claims, the distinction between a substantive claim and its procedural enforcement does not apply. The consequence of this lack of distinction is that the UPC already has to examine, in the context of jurisdiction pursuant to [Art. 32\(1\)\(a\) UPCA](#), whether the powers pursuant to Art. 56 et seq. UPCA even cover the "*actual or threatened infringement of patents*" in the infringement action. At least if an infringement action is not suitable from the outset to fulfil the necessary requirements of the powers pursuant to [Art. 56 et seq. UPCA](#), the UPC must deny its jurisdiction pursuant to [Art. 32\(1\)\(a\) UPCA](#).

9. The UPC must observe the Vienna Convention as a treaty under international law, in particular Art. 28 and Art. 31 VCLT, which reflect customary international law. Art. 28 VCLT contains the principle that, in case of doubt, a treaty has no retroactive effect. If an international treaty not only provides for a tribunal with

jurisdiction to settle disputes that have arisen in the past but also establishes both substantive law and an international court entrusted with the enforcement of that substantive law, the jurisdiction of that court is therefore limited to acts after the entry into force of the treaty. The provisions of an international treaty can therefore only exceptionally be applied to facts and situations prior to the entry into force of the treaty, if the treaty evidenced a corresponding intention on the part of the contracting states.

10. Based on these principles, the ILC and the practice of the European Commission of Human Rights and the ECtHR have dealt extensively and frequently with temporal jurisdiction. This is generally only assumed for the time from the entry into force of the respective treaty. The same applies to international arbitration tribunals. All of this must also be taken into account in the present case. The principles of the ECtHR on temporal jurisdiction would also apply to the UPC as an international court, even though the UPC does not have jurisdiction over disputes between states, but over disputes between private individuals.

11. It cannot be inferred from the UPCA that the Contracting Member States intended the Agreement or the (substantive) provisions of [Articles 25, 32, 34, 63, 64, 67](#) and [68 UPCA](#) to have retroactive effect. The Contracting Member States had neither undertaken to replace the respective national patent laws with the substantive provisions of the UPCA with regard to acts of use before 1 June 2023. Nor would they have withdrawn their jurisdiction from the national courts for acts of use that took place before 1 June 2023, nor would they allow the UPC to take the place of the national courts in this respect. For the period prior to the entry into force of the UPCA, only institutional provisions, but not substantive law, were applicable due to the Protocol on Provisional Applicability of 1 October 2015. It would constitute a disregard of the sovereign Decision of the contracting member states not to allow the UPCA to enter force until 1 June 2023 if the UPCA were also to extend to acts of use from the period prior to its entry into force and the national courts were to be deprived of jurisdiction in this respect as well.

12. [Art. 3\(c\) UPCA](#) confirms that the UPCA does not in principle have retroactive effect. In terms of time, this refers to the entry into force of the UPCA and not to an earlier date. In addition, [Art. 3 UPCA](#) only concerns the question of which IP rights the UPC should be competent for. This provision only concerns the absolute rights of protection, but not the so-called secondary right, i.e. the procedural powers pursuant to [Art. 56 et seq. UPCA](#). Since [Art. 3 UPCA](#) does not cover secondary law, no retroactive effect can be derived from [Art. 3\(c\) UPCA](#) either. Prior to the entry into force of the UPCA, the national courts had exclusive jurisdiction over such secondary rights. The UPCA does not expressly or implicitly state that the national courts should no longer have jurisdiction. Rather, the opposite follows from [Art. 32 para. 2 UPCA](#).

13. Likewise, jurisdiction cannot be established by means of [Art. 32 para. 1 f\) UPCA](#). This provision also does not have retroactive effect.

14. A limitation of the temporal jurisdiction of the UPCA to alleged acts of use in the period after 1 June 2023 also follows from the object and purpose of the UPCA. The validity of Directive 2004/47/EC prior to the entry into force of the UPCA does not change this, nor does the fact that the UPCA was already signed in 2013.

15. Thus, the UPC's competence pursuant to [Art. 32\(1\)\(a\) UPCA](#) is limited to matters occurring after 1 June 2023, while matters occurring before 1 June 2023 are excluded from the UPC's jurisdiction. This interpretation of [Art. 32\(1\)\(a\) UPCA](#) is also mandatory against the background of the requirement of legal certainty laid down in recital 5 of the UPCA preamble and the principle of proportionality according to recital 6 of the UPCA preamble and is also confirmed by the provisions of the UPCA and the RoP on the opt-out.

16. According to the principles of international law, acts that were commenced before the entry into force of an international treaty and that are continued thereafter are only covered by the treaty to the extent that they occur after the entry into force of the treaty. The principles established by the ILC and the ECtHR on (continued) acts would also apply to alleged acts of use that took place without the consent of the patent proprietor. Therefore, any individual (alleged) act of use by the Defendant that occurred before 1 June 2023 is excluded from the temporal jurisdiction of the UPC under [Article 32\(1\)\(a\) UPCA](#), even if it is part of a series of acts that began before 1 June 2023 and continued thereafter.

17. The UPC's lack of jurisdiction in temporal terms applies in any event to the claims brought by the Claimant for disclosure of information, disclosure of the books, destruction, recall and removal from the distribution channels, interim damages, damages and payment of appropriate compensation.

18. With regard to acts of use in the period prior to the entry into force of the UPCA, only the applicable law pursuant to Art. 8 Rome II Regulation is relevant. The order of legal consequences resulting from the respective applicable national law is the responsibility of the respective national courts. The UPCA does not contain any procedural powers pursuant to [Art. 56 et seq. UPCA](#) that would allow the UPC to order legal consequences resulting from a patent infringement under national law.

19. The Defendants are also of the opinion that the UPC lacks competence pursuant to [Art. 32\(1\)\(a\) and \(f\) UPCA](#) insofar as the infringement action relates to the period from 1 June 2023 to 26 August 2024. The opt-out becomes effective pursuant to Art. 83 para. 3 sentence 3 UPCA with the entry of the corresponding communication in the register and has no retroactive effect, as [Rule 5 para. 5 sentence 2 RoP](#) confirms. The “opt-in” is regulated in a mirror image in [Art. 83 para. 4 UPCA](#), so that it also has no retroactive effect. The opt-in has ex nunc effect, i.e. from the entry of the notification of withdrawal in the register. Consequently, the UPC lacks competence under [Art. 32\(1\)\(a\), \(f\)](#)

[UPCA](#) to decide on an infringement action insofar as it relates to the time of the opt-out of a European patent. In this respect, the patent proprietor must turn to the national courts which continue to have jurisdiction pursuant to [Art. 32 \(2\) UPCA](#) and whose exclusive jurisdiction he himself has established by opting out. This also follows from the meaning and purpose of the UPCA, which, according to recital 5 of its preamble, is intended not only to improve the enforcement of patents, but also to improve the defence against unfounded claims and to strengthen legal certainty.

20. The Claimant is of the opinion that the Court also has competence for actions for infringement of European patents that (also) relate to facts prior to the entry into force of the UPCA on 1 June 2023. The UPCA does not in any way limit the Court's jurisdiction to facts occurring after 1 June 2023. On the contrary, [Art. 3\(c\) UPCA](#) expressly provides for comprehensive applicability (in terms of time) for those European patents that have not yet expired before the entry into force of the UPCA (or are granted after that date). The wording of [Art. 3\(c\) UPCA](#) (*‘shall apply’*) is an unequivocal and comprehensive command for application to all European patents that have not previously expired.

21. The assumption of the court's competence is not a matter of (genuine) retroactivity from the outset. On this point alone, the Defendant's arguments, in particular those regarding the Vienna Convention on Treaties, fundamentally miss the point. In the context of this preliminary objection, the question to be decided is whether the Court has jurisdiction for an action brought on 27 August 2024. This aspect is to be strictly separated from the question of which (substantive) law the (competent) court would have to apply when dealing with facts prior to 1 June 2023. At the time the action is brought and at the time of the decision on this preliminary objection, the UPCA will undoubtedly be applicable, so that the question of the court's jurisdiction can be answered by looking at the UPCA, namely at [Article 32\(a\)](#) in conjunction with [Article 3c\) UPCA](#). The substantive law applicable to facts prior to 1 June 2023 is irrelevant for the court's jurisdiction. Furthermore – and this is a purely supplementary comment – the UPCA is in any case also applicable in substantive terms to facts prior to 1 June 2023. This follows from [Art. 3c\) UPCA](#). If one wants to see a (genuine) retroactive effect in this, it would not violate EU law, which must be observed in accordance with [Article 20 UPCA](#). According to established ECJ case law, an exception to the fundamental prohibition of retroactivity is possible if an objective of general interest requires it and the legitimate expectations of those affected are duly respected. The Defendants misunderstand Art. 28 VCLT. The provision's meaning is limited to the statement that the question of whether a treaty has retroactive effect or not is to be assessed by interpreting the treaty itself.

22. Furthermore, the UPC also has jurisdiction insofar as facts prior to the opt-in declared on 26 August 2024 are concerned. In this respect, too, the Defendant's

preliminary objection is unfounded. The opt-in only takes effect upon entry in the register. However, the opt-in has a retroactive effect. This is because, according to the wording of [Art. 83\(4\) UPCA](#), the opt-in is a withdrawal from the exception under [Art. 83\(3\) UPCA](#), and thus a withdrawal from the opt-out. The patent proprietor thus merely waives the right to claim the exception under [Art. 83\(3\) UPCA](#), so that the original concurrent jurisdiction of the Unified Patent Court and the national courts is restored.

23. The alternative request for a stay is to be rejected. It is already lacking the required relevance for a decision pursuant to Art. 267 TFEU, among others.

REASONS FOR THE ORDER

24. The admissible preliminary objection is not successful on the merits.

I.

25. The Defendant's preliminary objection is admissible. It was lodged in accordance with [Rule 19.1 RoP](#) within one month of service of the Statement of Claim and also satisfies the formal requirements of [Rule 19.2 RoP](#) and [Rule 19.3 RoP](#). The preliminary objection also relates to an admissible ground for preliminary objection. The Defendants raise the preliminary objection of lack of jurisdiction and competence of the UPC pursuant to [Rule 19.1 \(a\) RoP](#).

26. The fact that the preliminary objection of lack of jurisdiction is only raised in relation to (alleged) acts of use in certain periods does not affect the admissibility of the preliminary objection. [Rule 19.1\(a\) RoP](#) does not require that the preliminary objection contests the jurisdiction of the UPC for the claim as a whole. A preliminary objection can be in respect of only one (of several) matters in dispute.

27. The admissibility of the preliminary objection is also not precluded by the fact that the (alleged) partial lack of jurisdiction of the UPC is essentially based on the law which, in the opinion of the Defendant, should be applicable to the facts prior to 1 June 2023 or 26 August 2024. It is true that the list of grounds for preliminary objection set out in [Rule 19.1 RoP](#) is exhaustive, which is why a preliminary objection cannot be based on other grounds ([Court of Appeal, CoA 188/2024, Grounds for the Order of 03.09.2024 - Aylo/Dish](#)). It is also true that [Rule 19.1 \(a\) RoP](#) does not mention the applicable law. Nevertheless, an extension of the grounds for preliminary objection cannot be established in the present case. The Defendants explicitly object to the jurisdiction and competence of the UPC pursuant to [Rule 19.1\(a\) RoP](#) for a certain period. They only refer to the applicable law, which in their view should be relevant for determining jurisdiction, to justify their preliminary objection. This linking of jurisdiction and applicable law is neither arbitrary nor without any factual connection to each other, so that the preliminary objection cannot be rejected as inadmissible for this reason alone. Whether this link exists and whether the Defendant's reasoning warrants success on the merits is irrelevant to the question of the admissibility of the preliminary objection.

II.

28. The preliminary objection is unfounded. The UPCA has jurisdiction over the action pursuant to [Art. 32\(1\)\(a\) UPCA](#), [Art. 2\(g\)](#), [Art. 3\(c\) UPCA](#), without temporal limitation.

1.

29. Pursuant to [Art. 32 \(1\) a\) UPCA](#), the UPC has, inter alia, exclusive jurisdiction over Claimants for actual or threatened infringement of patents, whereby this subject-matter jurisdiction also exists pursuant to [Art. 2\(g\) UPCA](#) for infringement proceedings relating to a European patent that has not yet lapsed at the time of entry into force of the UPCA pursuant to [Art. 3\(c\) UPCA](#). Accordingly, the UPC has subject-matter jurisdiction in the present case. The plaintiff is asserting claims for (alleged) use of a European patent that had not yet expired on June 1, 2023.

30. However, during the transitional period, the exclusive jurisdiction of the UPC pursuant to [Art. 32\(1\)\(a\) UPCA](#), [Art. 2\(g\)](#), [Art. 3\(c\) UPCA](#) does not apply without restriction. According to [Art. 83 para. 1 UPCA](#), during a transitional period of seven years after entry into force of the UPCA, claimants may continue to bring actions for (alleged) infringement of a European patent (without unitary effect) before national courts. [Art. 83\(3\) UPCA](#) also gives the proprietor of a European patent the possibility of opting out of the UPC's jurisdiction over a European patent. The claimant or the proprietor of the European patent therefore has a fundamental right of choice during the transitional period, provided that the relevant requirements are met. During the transitional period, the exclusive jurisdiction with regard to a European patent pursuant to [Art. 32\(1\)\(a\) UPCA](#) is therefore a concurrent jurisdiction.

31. During the transitional period, the delimitation of the UPC's jurisdiction pursuant to [Art. 32\(1\)\(a\) UPCA](#) in relation to the national court, is determined, in view of the above, by whether or not the European patent whose infringement is alleged has been opted out from the exclusive jurisdiction of the UPC. If there is an (effective) opt-out within the meaning of [Art. 83\(3\) UPCA](#), only the national court has jurisdiction. The UPC, on the other hand, does not have jurisdiction, unless the jurisdiction of the UPC is deemed to be recognized pursuant to [Rule 19.7 RoP](#) in the absence of a objection. If the opt-out under [Art. 83\(3\) UPCA](#) is not invoked or if the patent proprietor (effectively) withdraws from the opt-out under [Art. 83\(4\) UPCA](#), the concurrent jurisdiction of the UPC and the national court is restored, so that the UPC - because of the exercise of the claimant's right of choice in this respect - has jurisdiction.

32. Applied to the facts of the present case, this means that the UPC has jurisdiction for the claim pursuant to [Art. 32 para. 1 a\) UPCA](#) in conjunction with [Art. 2\(g\)](#), [Art. 3\(c\) UPCA](#). On 26 August 2024 in accordance with [Art. 83 para. 4 UPCA](#), the claimant (effectively) withdrew from the opt-out under [Art. 83 para. 3 UPCA](#) declared on 12 May 2023. As of that point in time, there was again a concurrent jurisdiction between the national court and the UPC. Therefore, the applicant could on 27

August 2024 decide to bring the present action before the UPC.

33. The relevant point in time for the aforementioned delimitation is the point in time at which the claimant files or has filed the claim with the UPC. The only decisive factor is the situation at that time. It is of no interest which court had or would have had jurisdiction at a previous point in time. Nor is jurisdiction, once established, subsequently removed due to changed circumstances.

2.

34. The UPC's jurisdiction covers the entire period asserted in the action. The UPC also has to deal with the legal dispute to be decided insofar as the Claimant asserts claims for (alleged) acts of use before 1 June 2023 (entry into force of the UPCA) and before 26 August 2024 (withdrawal from the opt-out). This does not constitute a violation of Art. 28 VCLT. With regard to jurisdiction, there is already no case of retroactive effect.

35. The UPCA entered into force on 1 June 2023. The jurisdictional provisions in Part I, Chapter VI UPCA take effect from that date; they have been applicable since that date. The Defendants do not deny this either. Consequently, for claims filed with the UPC on or after the cut-off date of 1 June 2023, in the context of a preliminary objection pursuant to [Rule 19 et seq. RoP](#), it must be examined whether the international and subject-matter jurisdiction of the UPC pursuant to [Art. 31 et seq.](#) and [83, 3 UPCA](#) is given. The jurisdiction of the UPC must be established at the time of the decision on the preliminary objection wherein the lack of jurisdiction is raised. Whether or not it existed beforehand is irrelevant. As claimants can only file claims with the UPC from 1 June 2023, meaning that a preliminary objection can only be raised and decided after this date, the situation at a point in time after the entry into force of the UPCA is always decisive for jurisdiction. There will be no shifting forward (to a date before 1 June 2023).

36. In the event that the examination pursuant to [Art. 31 et seq., 83, 3 UPCA](#) leads to the conclusion that not the UPC but the national court has jurisdiction because the Claimant has exercised his existing right to opt out, the national court has (exclusive) jurisdiction. If the patent proprietor has not opted out, the UPC has (concurrent) jurisdiction. In the event that a Claimant, without opting out, brings parallel proceedings before the UPCA and a national court against the same parties involving the same cause of action, the court last seized must decline jurisdiction ([Art. 31 UPCA](#), [Art. 71c \(2\)](#) and [29 Brussels Ia 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). The UPC therefore in no way (retroactively) "withdraws" jurisdiction from the national court. In particular, proceedings already pending before the national court remain there. According to [Art. 83 para. 2 UPCA](#), this also applies to claims pending before a national court at the end of the transitional period. These

are not affected by the expiry of the transitional period. The UPCA therefore expressly establishes the principle of *perpetuatio fori* in this respect.

37. The point that the UPC has no jurisdiction in the event of an opt-out does not apply here. This is basically correct. However, if the opt-out has been (effectively) withdrawn before an action is brought before the UPC pursuant to [Art. 83 para. UPCA](#), the situation of concurrent jurisdiction arises again and the UPC has concurrent jurisdiction. The fact that only the national court had jurisdiction for a previous period is irrelevant. This is because no action was brought (before the national court) during this period, which would have meant that it would no longer have been possible to withdraw the opt-out.

38. A temporally limited jurisdiction of the UPC also does not follow from the (alleged) non-applicability of [Art. 25 et seq. UPCA](#) and/or [Art. 56 et seq. UPCA](#) to (alleged) acts of use that are said to have taken place before 01 June 2023 or 26 August 2024. In the context of the preliminary objection, it can be left open whether the Defendants' considerations in this regard are correct. It is not at the stage of scope of jurisdiction pursuant to [Art. 32 para. 1 a\) UPCA](#) already necessary to examine whether the procedural powers pursuant to [Art. 56 et seq. UPCA](#) cover the actual or threatened infringement of patents asserted in the infringement action at all.

39. Jurisdiction and applicable law are separate aspects that must be assessed separately from each other. It cannot be concluded from the UPC's jurisdiction that the substantive law of the UPCA always applies to every matter to be decided, nor is the applicable law decisive for the UPC's jurisdiction. The link made by the Defendants does not exist.

40. It may be that the Defendants' comments on the approach of the UPCA are correct and that [Art. 56 et seq. UPCA](#) are not structured as claims of a claimant, but as powers of the Court. However, this does not alter the necessary distinction between jurisdiction and applicable law. They concern different aspects. The former deals only with the question of what type of dispute is assigned to a court for decision. If a dispute then falls within the jurisdiction of the court, the second step is to determine which law the (competent) court must apply to the facts of the case submitted for decision. 41. This distinction also underlies the UPCA. It is true that [Article 3 UPCA](#) only speaks of scope of application ("*Geltungsbereich*" and "*champ d'application*", respectively), without making a distinction between procedural provisions and substantive law, which could lead to the understanding that this article applies to both aspects and that a link between jurisdiction and applicable law could be assumed in the manner described. Ultimately, however, this is not the case. Even if [Article 3 UPCA](#) is or should also be decisive for the question of which law is applicable, the UPCA differentiates elsewhere between jurisdiction and applicable law. The UPC's rules on jurisdiction can be found in Part I, Chapter VI UPCA, the rules on substantive law and sources of law in Part I, Chapter V UPCA. There is no link or reference between these

separate provisions. The same applies with regard to the powers of the court regulated in Part II, Chapter IV. There is also no indication in these provisions that the applicable law should be of significance in determining jurisdiction

42. The distinction between jurisdiction and applicable law is also recognized at European level, as evidenced by the Brussels Ia Regulation (EU), for example. This only contains provisions on international jurisdiction, without determining the substantive law applicable by the competent court and/or considering this as an aspect of jurisdiction. Therefore, if the international jurisdiction of the UPC is at issue, this must be determined in accordance with [Art. 31 UPCA](#) without recourse to the applicable law. It is not apparent that there is any intention to deviate from this fundamental approach with regard to substantive jurisdiction and competence. On the contrary, during the transitional period pursuant to [Art. 83 UPCA](#), [Art. 29](#) to [32 Brussels I Regulation](#) apply to any conflicts of jurisdiction between the UPC and the national courts pursuant to [Art. 71c \(2\) Brussels I Regulation](#).

43. Finally, the object and purpose of the UPCA and the preamble to the UPCA do not justify a different understanding. Neither the intended contribution to the integration process in Europe (Recital 1) nor the intention to improve and enhance legal certainty with regard to legal disputes concerning infringement and validity of patents (Recital 5) nor the principle of proportionality (Recital 6) require that the separation of jurisdiction and applicable (substantive) law enshrined in the UPCA be disregarded and that the question of jurisdiction be linked to the question of applicable law.

3.

44. Whether the legal consequences requested by the Claimant in its action due to (alleged) acts of use by the Defendant are to be acknowledged by the court and which law is to be applied in this respect, in particular also for facts that are alleged to have taken place before 1 June 2023 and 26 August 2024, is a question of the merits of the action. This examination remains reserved for the main proceedings.

III.

45. There is no reason to stay the proceedings pursuant to [Rule 266 \(5\) sentence 1 RoP](#) and to refer the question formulated by the Defendants to the ECJ for a preliminary ruling pursuant to [Art. 21 UPCA](#) in conjunction with Art. 267 TFEU. In the Judge-rapporteur's opinion, there is no reasonable doubt that the UPCA, as an international treaty, is to be assessed against the principles of the Vienna Convention on the Law of Treaties. Moreover, the question referred is not relevant to the decision on the preliminary objection.

IV.

46. In accordance with [Rule 20.1 RoP](#), the parties are informed that the proceedings will be continued in accordance with the Rules of Procedure as the preliminary objection is rejected. The parties have the opportunity to submit any outstanding pleadings in due time.

47. Pursuant to [Rule 21.1 RoP](#), an Appeal may only be lodged against a Decision of the Judge-rapporteur to reject the preliminary objection in accordance with [Rule 220.2 RoP](#). Appeal must therefore be allowed, which is at the discretion of the Judge-rapporteur. Taking into account Recital 8 of the Rules of Procedure, appeal is allowed in the present case. The decision concerns a question of law that may be relevant to a number of cases, so that a uniform application and interpretation of the UPCA's rules of jurisdiction is appropriate.

ORDER

1. The preliminary objection of the Defendants, including the auxiliary requests, is rejected.
2. The proceedings will be continued.
3. Appeal is allowed.

INFORMATION ON APPEAL

Against the Order may be lodged in accordance with [Rule 21.1 RoP](#) in conjunction with [Rule 220.2 RoP](#) within 15 days of service of the Order.

DETAILS OF THE ORDER

Order Nr. ORD_6847/2025 in Action no.:
ACT_46804/2024
UPC No.: UPC_CFI_483/2024
Art des Vorgangs: Infringement action
Application no.: 55619/2024
Applicatio: Preliminary Objection
10.02.2025
Ulrike Voß
Presiding Judge
